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Plausibility

REPORT OF THE SWISS GROUP*

I. Current law and practice

1. Does your law in general provide a plausibility requirement?

No.

Neither the Swiss Patent Act (hereinafter "PatA") nor the Swiss Patent Ordinance (hereinafter "PatO") make any reference to a plausibility requirement.

2. Is the plausibility requirement, if any, a stand-alone requirement or is it integrated into another requirement (e.g. inventive step)?

As mentioned above, plausibility is not an explicit requirement in Switzerland.

If a plausibility requirement was recognised at all, which has not been the case so far, it could become relevant as part of the inventive step (PatA 1[2]) or sufficiency/enableness analysis (PatA 50[1]).

3. Are there any statutory provisions that specifically apply to plausibility? If yes, please briefly explain.

No.

4. Please briefly describe the general patentability requirements in the statutory law of your jurisdiction that are or would be relevant to the issue of plausibility.

According to the PatA, patents for inventions are granted for new inventions applicable in industry (PatA 1[1]); anything that is obvious with regard to the state of the art is not patentable as an invention (PatA 1[2]). Furthermore, the invention must be described in the patent application in such a manner that it can be carried out by a person skilled in the art (PatA 50[1]). All of those requirements are also grounds for nullity of a patent (PatA 26[1][a] and PatA 26[1][b], respectively).

As indicated above, the issue of plausibility is considered under the title of inventive step and/or sufficiency of disclosure (possibly also industrial applicability), as is the case in other jurisdictions. However, see also the answers to questions 5) and 6) below.

5. Under the case law or judicial or administrative practice in your jurisdiction, are there decisions or rules that specifically apply to plausibility? If yes, please briefly explain.

No.

Swiss courts tend to follow the case law of the European Patent Office (see FSC 137 III 170 para. 2.2.1, "Alendronsäure"). In EPO proceedings plausibility is discussed primarily in the context of the inventive step and sufficiency requirements. However, the plausibility case law of the EPO has not been adopted by Swiss judgments yet.

A reference to plausibility is only made in the Patent Examination Guidelines when assessing sufficiency of disclosure (Guidelines, chapter 4.2, 28), although not necessarily in the context discussed in

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this Question. Such guidelines for examiners issued by the Federal Institute of Intellectual Property are not a legal act and have no legally binding effect.

- 6. Please briefly describe the general patentability requirements under the case law or judicial or administrative practice of your jurisdiction that are or would be relevant to the issue of plausibility. If there is no explicit or implied plausibility requirement in the law or under the judicial or administrative practice in your jurisdiction, please skip the below questions and proceed directly to question 15.**

As stated above, there is no explicit plausibility requirement in Swiss law. The Swiss Group does not exclude that considerations that are relevant in the context of “plausibility” are also taken into account in Switzerland when assessing inventive step (Art. 1[2] PatA) or sufficiency of disclosure (Art. 50[1] PatA). Yet, so far neither Swiss case law nor doctrine has referred to a “plausibility” requirement as such or explicitly mentioned a “plausibility requirement” as part of those criteria in court judgments.

As a consequence, the assumption that an implied plausibility requirement implicitly applies under Swiss law or practice seems far-fetched and construed. Thus, questions 6 to 14 do not apply.

- 7. Can the plausibility requirement be regarded primarily as a “credibility” requirement, i.e., a requirement applying to patent applications that describe a technical effect that appears non-credible, e.g., because the described effect contradicts the common perception in the relevant technical field, and/or is a surprising effect?**

n/a.

- a) If yes, is the credibility determined from the perspective of a person having ordinary skill in the art, or from the perspective of an expert in the field?
- b) If the relevant perspective is the person having ordinary skill in the art, why is a “credible” technical effect not also obvious at the same time?
- c) Do all the promises of the patent description have to seem achievable for the person skilled in the art?

- 8. Can the plausibility requirement be regarded primarily as a prohibition of “speculative” patent applications which do not (expressly) disclose a technical effect or concrete use, e.g., of a chemical substance (the potential technical effect or concrete use rather remains speculative)?**

n/a.

- a) If yes, which standard does apply to determine a speculative filing? Which requirements does the applicant have to meet in order to reach a non-speculative filing?
- b) If a technical effect (which is not expressly described in the specification) is nonetheless plausible because the skilled person would understand that the technical effect was, at the priority date, implied or self-evident from the specification, why was the technical effect not obvious at the priority date?

- 9. Can the plausibility requirement be regarded primarily as specific prohibition against “prophetic” examples (or embodiments) in the specification in support of the technical solution purported by the claimed invention, e.g., the description merely “predicts” that a specific experiment “will” prove a special property of the claimed compound?**

n/a.

- a) If yes, which standard does apply to identify a prophetic example? Must the applicant submit test data etc. to support examples (unless self-evident)?
- b) Do all examples (or embodiments) need to pass this plausibility test?

- 10. Is it possible to make a clear distinction between the above-mentioned aspects (as set out in the questions 7–9 above) or do they merge into each another?**

n/a.

- 11. What is the relevant point in time for the plausibility test? What if for example the technical effect of an invention appears plausible at the priority date, but later proves to be wrong, or vice versa?**

n/a.

- 12. Are there different plausibility tests for different types of claims (e.g. pure product/compound claims without a functional feature, product claims including a functional feature, second medical use claims, etc.)?**

n/a.

- 13. Who has the burden of proof for (lack of) plausibility (patentee/applicant or patent office/opponent)?**

n/a.

- 14. Please comment on any additional issues concerning any aspect of plausibility that is being regulated by your Group's law/practice you consider relevant to this Study Question, having regard to the scope of this Study Question as set out above.**

n/a.

II. Policy considerations and proposals for improvements of your Group's current law

- 15. Are there aspects of your Group's current law relating to plausibility that could be improved? If yes, please explain.**

No. The Swiss Group is satisfied with the current state of the law in this respect.

- 16. Under your Group's current law, does the availability of patent protection aim to incentivize an early disclosure of technical achievements, or rather the disclosure of "completed" inventions (which may involve a mandatory disclosure of a "best mode")?**

Yes. In Switzerland, technological progress is considered important for economic growth. The patent system provides one option to incentivize technological progress. The prevalent theories on the legitimation of patent law, i.e. the reward, incentive and contract theory refer to two justification arguments: the earnings/profit argument and the disclosure argument. Patents enable the right holder to obtain a return relative to the economic benefit of its invention and to recoup his/her investments. With the grant of the patent, the inventive technical knowledge is generally accessible and can be used as the basis for further research and development (disclosure and dissemination emanating from the patent system).

Switzerland employs a first-to-file system, i.e. patent rights are granted to the applicant with the earliest valid priority date. The "first-to-file system" provides motivation to file a patent application as early as possible and thus also for a disclosure of inventive knowledge as quickly as possible – provided that a "completed" invention exists. A patent application should convince a person skilled in the art that a technical problem underlying the invention has been solved. The technical problem according to the invention must be solved in its entirety by the means included in the patent application. It only discloses a solution if the person skilled in the art can reproduce the invention according to the technical teaching with constant success and without undue burden.

Therefore, the Swiss patent law aims at an early disclosure of "completed" inventions. However, it does not involve a mandatory requirement of a "best mode".

- 17. Under your Group's current law, does the plausibility requirement, if any, interfere with the incentive for an early disclosure provided by the first-to-file system?**

No.

As mentioned under point 16), the incentive for an early disclosure does not come at the expense of the patentability requirements. An explicit, standalone plausibility requirement has not yet been recognized in Swiss law and practice (see questions 1 to 5 above). An implied plausibility requirement, if any, is applied as a way to determine whether patentability requirements such as sufficiency of disclosure and inventive step are met, and therefore does not interfere with the early disclosure incentive (which itself requires fulfilment of the patentability requirements).

III. Proposals for harmonization

Please consult with relevant in-house/ industry members of your Group in responding to Part III.

18. Do you consider that harmonization regarding plausibility is desirable?

Yes.

A harmonization of principles applicable in the context of the validity of European patents that are governed by the same EPC rules appears desirable. A wider harmonization throughout different legal systems appears to be challenging.

19. Should there be a plausibility requirement? If no, please briefly explain why and then please also answer the following questions assuming there is a plausibility requirement.

No.

It is the Swiss Group's view that at present plausibility should not be a standalone requirement. The EPO appears to consider plausibility as an aspect of two main patentability requirements, namely sufficiency and inventive step (which are validity criteria already harmonized through the EPC for all European patents). Against this background, it does make sense to clarify and harmonize the corresponding standard under sufficiency and inventive step, yet it does not seem practicable to institute plausibility as a new standalone patentability requirement.

20. Should plausibility be a "credibility" requirement that excludes patent applications describing a technical effect of the claimed invention which however looks "incredible", e.g. because the described effect contradicts the common perception of in the relevant technical field, and/or is a surprising effect?

No.

In general, an invention must somehow show a "surprising effect", otherwise it could not be considered inventive. Therefore, the existence of a surprising effect should not make an invention implausible.

However, when the technical effect described in the patent application is "incredible" in that it clearly contradicts the prior art as understood by the skilled person, it should be clarified in a credible way why and how the invention achieves the claimed effect irrespective of the common perception in the prior art.

a) If yes, which standard should apply to determine the credibility of the invention? Is the credibility determined from the perspective of a person having ordinary skills in the art, or from the perspective of an expert in the field?

Pursuant to established case law and literature, patentability criteria are assessed from the viewpoint of a person of ordinary skill in the art. This applies independently of questions related to plausibility/credibility. There is no different standard applicable specifically to plausibility/credibility questions.

b) Should all the promises of the patent description have to seem achievable for the person skilled in the art?

Not necessarily, but protection (in an appropriate generalized scope) is only awarded to those promises, for which it has been (credibly) shown that they are achievable.

21. Should plausibility be a prohibition of “speculative” patent applications which do not (expressly) disclose a technical effect or concrete use e.g. of a chemical substance (the potential technical effect or concrete use rather remains speculative)?

In principle, yes.

A patent application should either make plausible *how* a certain technical effect is achieved or show *that* this technical effect can be achieved.

- a) If yes, which standard should apply to determine a speculative filing? Which requirements should the applicant have to meet in order to reach a non-speculative filing?

A speculative filing arises from an insufficient disclosure or lack of sufficient evidence. A non-speculative filing is achieved if at the time of filing the technical effect is made plausible through sufficient evidence, whether in the form of technical data, based on prior art or common general knowledge or by being self-evident from the patent application.

- b) What should be the consequence if a technical effect which is not expressly described in the specification is nonetheless plausible because the skilled person would understand that the technical effect was, at the priority date, implied or self-evident from the specification?

Whether the invention is obvious is determined in comparison to the state of the art, including the common general knowledge. A technical effect has to be made plausible by the application as filed in order to be considered in the assessment of inventive step. How the technical effect has been shown to be plausible, namely whether it is implied or self-evident from the specification, is not the relevant test for the inventive step.

22. Should plausibility be a specific prohibition to refer to “prophetic” examples (or embodiments) in the specification in support of the technical solution purported by the claimed invention, e.g. the description “predicts” that a specific experiment “will” prove a special property of the claimed compound?

No.

Plausibility should not be understood as a specific prohibition of prophetic examples, but rather as a standard in the assessment of enablement. The number and nature of examples, whether prophetic or not, is not determinative in the assessment of patentability. The question is rather, whether the application as a whole contains sufficient credible and enabling support to enable the skilled person to work the invention without undue burden.

Thus, while the inclusion of prophetic examples (only) may increase the hurdle for a showing of enablement (in particular for unpredictable technologies), they do not necessarily deny plausibility as such.

- a) If yes, which standard should apply to identify a prophetic examples?

See question 22 above.

- b) Should all examples (or embodiments) need to pass this plausibility test? What should be the consequence if only some examples (or embodiments) do not pass the test?

No. See question 22 above.

Non-prophetic examples can facilitate a showing of enablement but are not a prerequisite.

23. What should be the relevant point in time for the plausibility test? What if for example the technical effect of an invention appears plausible at the priority date, but later proves to be wrong, or vice versa?

The relevant point in time should be the effective date of the application (i.e. the priority date or the filing date if no priority is claimed). A technical effect that appears plausible at the effective date, but which later proves to be wrong, may be used as a ground for refusal of the application or revocation of the patent.

Conversely, if the application has already been finally refused, there would be no remedy.

24. Should there be different plausibility tests for different types of claims (e. g. pure product/compound claims without functional feature, product claims including functional feature, second medical use claims, etc.)?

No. The rationale underlying the plausibility test should be the same for all types of claims. Rather it is the extent of evidence necessary to show plausibility, which may change with the nature and predictability of the technology.

25. Who should have the burden of proof for (lack of) plausibility (patentee/applicant or patent office/opponent)?

The burden of proof resides with the applicant in case of a pending application (or the third party in case of a third-party observation). The burden of proof resides with the opponent in case of a granted patent. In inter partes proceedings, the burden of proof may be shifted according to standard practice at the EPO.

26. Please comment on any additional issues concerning any aspect of plausibility you consider relevant to this Study Question, having regard to the scope of this Study Question as set out above.

It should be noted that a first-to-file system (like that in Switzerland) creates a greater urgency for the applicant to file a patent in the early stages of the invention than a first-to-invent system, which allows more time to carry out and collect evidence to show a technical effect. Thus, it may be appropriate to have a lower standard for the examination of plausibility in countries with a first-to-file system.

27. Please indicate which industry sector views provided by in-house counsel are included in your Group's answers to Part III.

n/a.