

2019 AIPPI World Congress - London
Final Draft Resolution
September 18, 2019

Resolution

2019 – Study Question – Patents

Plausibility

Background:

- 1) This Resolution concerns the question whether “plausibility” should be considered as a (further) patentability requirement, and if so, how to define its preconditions.
- 2) Plausibility, if considered as a patentability requirement, generally addresses the question whether there is sufficient evidence/disclosure in the patent application that the purported technical effect of a claimed invention can be actually achieved, as opposed to “speculative” patent applications. In this respect the plausibility requirement can relate to various established disclosure requirements, including sufficiency, clarity, utility, industrial applicability and use of post-filing data, as well as traditional patentability requirements such as novelty and inventive step. The issue of plausibility is becoming relevant, in some countries, in the chemical and pharmaceutical fields, and may become relevant to other technologies such as those involving artificial intelligence.
- 3) Given the (potentially) extremely broad and sweeping implications of this notion, the scope of this Resolution is limited to the sub-issues of (1) the general credibility of the invention, (2) the general prohibition of speculative patent claims and (3) specific restrictions regarding “prophetic” examples. In the context of the resolution, these sub-issues are understood as follows:
 - credibility of the invention refers to whether patent claims found in applications which describe a technical effect appear credible or not, for example because the described effect contradicts the common perception;
 - speculative patent claims refers to patent claims for an invention that was not made, conceived or disclosed] until after the application is filed;
 - “prophetic” examples refer to description which does not describe experiments that have actually been performed but which rather predicts that a specific experiment will prove a technical effect.

- 4) This Resolution does not consider the general sufficiency of disclosure and inventive step requirements, the general utility requirement or the use of post-filing data.
- 5) 34 Reports were received from AIPPI's National and Regional Groups and Independent Members providing detailed information and analysis regarding national and regional laws relating to this Resolution. These Reports were reviewed by the Reporter General Team of AIPPI and distilled into a Summary Report (see links below).
- 6) At the AIPPI World Congress in London in September 2019, the subject matter of this Resolution was further discussed within a dedicated Study Committee, and again in a full Plenary Session, following which the present Resolution was adopted by the Executive Committee of AIPPI.

AIPPI resolves that:

No need for a stand-alone plausibility requirement

- 1) There should be no stand-alone ground of patentability or validity based on plausibility. The already existing patentability (novelty, inventive step, industrial application and/or utility) and validity (e.g. sufficiency, right to priority, added matter) requirements are sufficient to ensure that the invention protected by the claims is commensurate with the technical contribution made by the specification to the state of the art. The introduction of a separate plausibility requirement would create legal uncertainty without a commensurate benefit.
- 2) If plausibility is to be examined (in any of its possible aspects, notably as a requirement of credibility of the technical effect, as a prohibition of speculative patent or as condition of use of prophetic examples), it should be considered as one of many elements of the examination of the already existing patentability and validity requirements.

Aspects of plausibility relating to the credibility of the invention, speculative claims and use of prophetic examples

- 3) If credibility of the claimed invention is considered with respect to the requirements of patentability and validity, the threshold should be low and narrowly understood.
- 4) The credibility threshold should be met when, based on the specification and common general knowledge, at least one of the following is satisfied:
 - the patent application contains, even implicitly, a convincing explanation as to why a technical effect may be obtained; or
 - it is credible for the person skilled in the art that at least one of the technical effects disclosed in, or derivable from, the application of the claimed invention may be obtained; or

- the person skilled in the art has no serious reason to doubt that at least one of the said technical effects could work as described.
- 5) Any effect claimed or relied upon for the assessment of the patentability (e.g. novelty or inventive step) and validity of the patent should be credible. But a promise of the specification that is not claimed or relied upon for such assessment does not have to be credible.
 - 6) The patentability and validity requirements should prohibit speculative claims, i.e. the patent application should provide a basis for the skilled person, with their common general knowledge, to establish that the inventor has in fact made the technical contribution for which protection is claimed.
 - 7) A claim should not be considered speculative for the mere reason that the purported technical effect or the substantiation thereof is not explicitly mentioned in the specification provided that the effect and the achievement of this effect by the claimed subject matter are credible to the skilled person on the priority date, on the basis of the specification and common general knowledge. The number and nature of data and examples provided in the application should not be determinative in this respect.
 - 8) If plausibility is considered, it should be assessed, in consideration of the claimed subject matter, in particular by taking into account whether the claimed invention is characterized (i) only by structural features or (ii) also by functional features or a use. Under (i), it should not be critical for the purpose of assessing plausibility to disclose its technical effect or use. Under (ii), it should be plausible that the technical effect of this use or function can be obtained.
 - 9) It should not be presumed that if an effect is found plausible to the skilled person at the priority date based in part on the common general knowledge, then the invention would necessarily lack inventive step. In the assessment of plausibility the teaching of the patent is taken into account.
 - 10) Plausibility considerations should not prohibit the presence of prophetic examples in the specification.

Relevant date and burden of proof

- 11) If plausibility is to be considered, it should be evaluated as at the priority date.
- 12) If plausibility is challenged with respect to a given validity/patentability requirement, the burden of proof should be that of said requirement under consideration.

Miscellaneous

- 13) Patent offices should agree on the basic principles and issue guidelines regarding possible issues of plausibility.

Links:

- [Study Guidelines](#)
- [Summary Report](#)
- [Group Reports page](#)