



2019 Study Question

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Plausibility

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I. Current law and practice

Please answer all questions in Part I on the basis of your Group's current law.

1 Does your law in general provide a plausibility requirement?

Yes

Please Explain

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

No

Please Explain

Integrated into inventive step requirement: the essence of the invention must be open to such an extent that a person skilled in the art can understand the nature of the technical problem and its solution by the invention (*Patent Regulation* – PR § 23).

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

Yes

Please Explain

A patent application shall include: 2) a description of the invention in which the subject matter of the invention shall be disclosed in a

sufficiently clear and concise manner which enables a person skilled in the art to make the invention (*Patent Act* - PA §19; §50(2)(2)).

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.

Criteria of patentability: an invention is patentable if it is new, involves an inventive step and is susceptible to industrial application (PA §8). During an examination, the Patent Office shall verify the compliance of an invention with the criteria of patentability .

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

Yes

Please Explain

The question of plausibility is assessed by the Patent Office and the Industrial Property Board of Appeal on a case by case bases. The requirement of sufficiency of disclosure must be met at the date of filing of application. The "best mode requirement" also applies.

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.

There is no explicit plausibility requirement.

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 of in the relevant technical field, and/or is a surprising effect?

Yes

Please Explain

7.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?

Yes

Please Explain

From the perspective of a person having ordinary skill in the art.

7.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?

Yes

Please Explain

If it is obvious to the person having ordinary skill in the art, then invention simply does not involve an inventive step.

7.c Do all the promises of the patent description have to seem achievable for the person skilled in the art?

No

Please Explain

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)?

8.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?

The applicant must ensure that the inventive step requirement is met.

8.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?

No answer.

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?

No

Please Explain

9.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)?

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9.b Do all examples (or embodiments) need to pass this plausibility test? What is the consequence if only some examples (or embodiments) do not pass the test?

Yes

Please Explain

Office can require limitation of patent claims.

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?

No

Please Explain

It is not possible to make a clear distinction between the above-mentioned aspects.

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?

Post-grant opposition by the opponent and pre-grant request by the applicant.

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.)?

Yes

Please Explain

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

Burden of proof for plausibility - patentee/applicant.

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.

Our Group's practice has not any specific issues concerning any aspect of plausibility.

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

Please Explain

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

Please Explain

The "best mode requirement" applies.

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

Please Explain

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? If YES, please respond to the following questions without regard to your Group's current law. Even if NO, please address the following questions to the extent your Group considers your Group's current law could be improved.

Yes

Please Explain

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.

Yes

Please Explain

The requirement of sufficiency of disclosure must be met at the date of filing. The "best mode requirement" would be desirable.

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?

Yes

Please Explain

20.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?

From the perspective of a person having ordinary skills in the art.

20.t Should all the promises of the patent description have to seem achievable for the person skilled in the art?

Yes

Please Explain

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)?

Yes

Please Explain

21.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?

Evidence should apply which supports that the invention has technical advantages.

21.t 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?

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?

22.a If yes, which standard should apply to identify a prophetic examples?

22.t 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?

Yes

What should be the consequence if only some examples (or embodiments) do not pass the test?

The patent claims must be limited.

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 priority date.

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.)?

Yes

Please Explain

Presumably yes. Our Group does not have sufficient number of cases to make conclusions.

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

Burden of proof for plausibility - patentee/applicant.

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.

No additional issue to comment.

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

Electronics and chemical industry.