

## Lack of Industrial Application: Differing Judgments of the EPO and the Court of Appeal

---

In a [recent decision](#), the England and Wales Court of Appeal found a European patent (UK) invalid, despite the fact that an EPO Board of Appeal had previously held that the same patent, with the same claims, was valid.

### Background

Under the European Patent Convention, an invention is patentable if it is “susceptible of industrial application”, i.e. if it can be made or used in any kind of industry. This case looked at patent applications to genes and the proteins they produce. It considered how much information, relating to the use of the gene/protein, must be in the original patent application, for the gene and/or protein to be “susceptible of industrial application”.

The patentees (Human Genome Sciences Inc) were granted a patent with claims directed to a protein. Both the EPO Technical Board of Appeal (TBA) and the England and Wales Court of Appeal (CoA) considered whether it was plausible that the protein had an industrial application - an effect against a particular disease – based solely on the data in the application and common general knowledge at the filing date of the application.

The TBA found that the effect of the protein against the disease was plausible on the basis of the original application. The CoA found that it was not.

### The Court of Appeal Judgment

Jacob LJ stated that, “What matters is a sufficient specification of the function of the protein. Just describing the existence of a protein and its structure is not enough. Nor is it enough to describe the function at a high level of generality... You have to say what it is for with more particularity. What amounts to a sufficient specification will depend on the facts of the case and involves a question of degree.”

Jacob LJ referred to EPO case law ([T 1329/04](#)) which held it must be “at least plausible”, from the information in the application, that a disclosed protein has the specific effect taught by the application. EPO case law uses this test in connection with inventive step, and it was noted with approval by Lord Hoffman in [Conor vs Angiotech](#). Jacob LJ said that the same principle applied to industrial applicability, and added that, “The word [plausible] is not being used in the sense of “not incredible” but in the sense of having significant degree of likelihood to be true.”

The CoA made the point that, “You cannot have a patent for an invention when only years later you or someone else finds out what it is for.” The CoA upheld EPO case law, confirming that an applicant cannot rely on post-filing evidence of an effect; any effect must be at least plausible from the original patent application and common general knowledge at the filing date.

The CoA found the opposite to the TBA, and held that patent had *not* reached the plausibility bar. In the opinion of the CoA, at the filing date the applicant had not shown that it was plausible that the protein had the specific effect taught in the application. They stressed that they took their decision on the facts before them, which were different to the facts before the TBA.

### **The power of national courts as ultimate arbiter of validity**

The CoA considered the EPO case law on the plausibility threshold test. Jacob LJ acknowledged that the CoA, “Follow any principle of law clearly laid down by them [the TBAs].” However, he asserted the CoA’s right to make decisions contrary to the EPO, stating that the CoA had, “The right to differ if we [the CoA] are sure that the commodore is steering the fleet on to the rocks.”

In summary, the CoA will always follow the EPO on law but can differ on their decision if the facts and evidence before them differ. Jacob LJ focused on the different ways in which the TBA and the CoA assess evidence. He particularly singled out cross-examination, used in the UK courts but rarely in the EPO, as a major difference. Given this difference, he thought it *inevitable* that the UK courts might differ from the EPO.

Controversially, Jacob LJ said the TBAs act as a “coarse filter” of the validity of European patents but that the UK courts are “for real”.

### **Conclusion**

If there is any doubt that a claimed product has utility, despite the data in an application as filed, then it may be prudent to delay filing until the requisite data is available for inclusion in the application as filed.

In recent years the UK courts have shown a more conciliatory attitude to the EPO, and UK case law has aligned itself much more with the EPO. Unfortunately, this decision illustrates that the UK courts remain keen to assert their independence in some ways.