

Registry of the Enlarged Board of Appeal

For the attention of Mr Nicolas Michaleczek (EBAamicuscuriae@epo.org).

Eindhoven, 10 July 2023,

Your reference: G 1/23

Our reference: case number G 1/23 - written statements in accordance with Article 10 RPEBA

Dear Mr Michaleczek,

I would like to take the opportunity to, as a third party, file written statements in accordance with Article 10 of the Rules of Procedure of the Enlarged Board of Appeal.

Topic is the referral in accordance with Article 112(1)(a) EPC by Technical Board of Appeal 3.3.03 by interlocutory decision T 438/19 who referred the following questions to the Enlarged Board of Appeal (referral pending under G 1/23 "solar cell"):

1. Is a product put on the market before the date of filing of a European patent application to be excluded from the state of the art within the meaning of Article 54(2) EPC for the sole reason that its composition or internal structure could not be analysed and reproduced without undue burden by the skilled person before that date?
2. If the answer to question 1 is no, is technical information about said product which was made available to the public before the filing date (e.g. by publication of technical brochure, non-patent or patent literature) state of the art within the meaning of Article 54(2) EPC, irrespective of whether the composition or internal structure of the product could be analysed and reproduced without undue burden by the skilled person before that date?
3. If the answer to question 1 is yes or the answer to question 2 is no, which criteria are to be applied in order to determine whether or not the composition or internal structure of the product could be analysed and reproduced without undue burden within the meaning of

opinion G 1/92? In particular, is it required that the composition and internal structure of the product be fully analysable and identically reproducible?

In my opinion:

1. The answer to Q.1 should be that:

Where it is not possible for the skilled person to discover the composition or the internal structure of the product and to reproduce it without undue burden, then the composition or internal structure of the product does not become state of the art, but the product becomes prior art to the extent that the skilled person can directly and unambiguously derive a technical teaching from it. The prior art effect of the product may, e.g., extend to just the technical effect that is (shown and proven to be) achieved by the product.

2. The answer to Q.2 should be that:

Technical information about said product which was made available to the public before the effective date (e.g. by publication of technical brochure, non-patent or patent literature) is state of the art within the meaning of Article 54(2) EPC to the extent that that technical information is sufficiently disclosed.

3. In view of the answers to Q.1 and Q.2, Q.3 does not need to be answered.

I submit my detailed reasoning on the next pages.

Yours faithfully,



Roel van Woudenberg
European Patent Attorney

Referred questions

1. Technical Board of Appeal 3.3.03 has by interlocutory decision T 438/19 referred the following questions to the Enlarged Board of Appeal (referral pending under G 1/23 "solar cell"):
 1. Is a product put on the market before the date of filing of a European patent application to be excluded from the state of the art within the meaning of Article 54(2) EPC for the sole reason that its composition or internal structure could not be analysed and reproduced without undue burden by the skilled person before that date?
 2. If the answer to question 1 is no, is technical information about said product which was made available to the public before the filing date (e.g. by publication of technical brochure, non-patent or patent literature) state of the art within the meaning of Article 54(2) EPC, irrespective of whether the composition or internal structure of the product could be analysed and reproduced without undue burden by the skilled person before that date?
 3. If the answer to question 1 is yes or the answer to question 2 is no, which criteria are to be applied in order to determine whether or not the composition or internal structure of the product could be analysed and reproduced without undue burden within the meaning of opinion G 1/92? In particular, is it required that the composition and internal structure of the product be fully analysable and identically reproducible?

Introduction

2. In the referral, the Board indicates:

Reasons interlocutory decision T 438/19

10.4 [...] it would [...] appear that the expression "available to the public" in Art. 54(2) EPC was intended to express the possibility of the public to take note of the prior art, i.e. the accessibility to the public of the prior art, without any requirement as to its enablement. The requirement to reproduce the product without undue burden in section 1.4 of the Reasons of opinion G 1/92 would appear to go beyond the intended meaning of "available to the public" in Art. 54(2) EPC.

10.5 This could be seen to imply that any element of the composition or internal structure of a product put on the market which can be discovered by the skilled person per analysis is state of the art within the meaning of Art. 54(2) EPC, irrespective of the reproducibility of the product by the skilled person.

11. In the case law of the Boards of Appeal, diverging approaches have been adopted in applying opinion G 1/92. The present Board has identified divergent decisions with regard to the following aspects:

- (i) interpretation of "available to the public" leading to the exclusion from the state of the art within the meaning of Article 54(2) EPC of the product itself (including its chemical composition/internal structure) or only of its chemical composition/internal structure,
- (ii) the degree of detail required for the analysis of said product and
- (iii) the requirements for its reproducibility.

12. The Boards have reached diverging conclusions when it was found that the product put on the market could not be analysed or reproduced, deciding either that

- (a) **its chemical composition** (or internal structure) **was not state of the art** (T 946/04, reasons 3.31; T 1666/16 reasons 11), i.e. adopting the wording of the conclusion of opinion of G 1/92, **or** that
- (b) **the product itself was not state of the art**, thus including its chemical composition or internal structure (T 370/02 reasons 8.8; T 2045/09 reasons 29 to 39; T 1833/14 reasons 1.9 and 1.10; T 23/11 reasons 2.5) based on the wording in point 1.4 of the Reasons for opinion G 1/92.

12.1 While the difference may seem of theoretical interest at first sight, it may lead in practice to significantly different conclusions. As a direct example related to the present case, **if in application of opinion G 1/92 a product is not state of the art pursuant to Art. 54(2) EPC, that product cannot be used as starting point for assessing inventive step.**

If the conclusion is only that its composition is not state of the art, but the product itself is still state of the art as commercially available, it could be used as a starting point for the assessment of inventive step, should technical information about that product reported in documents of the state of the art, including its potential uses and advantages, make it of particular interest for the skilled person. This is the case in the present appeal, as the commercial product ENGAGE® 8400 is shown in the examples of D1 to be suitable for the same purpose as the present invention, namely as an encapsulating material for solar cells and solar cell modules.

24. From the above, it can be seen that opinion G 1/92 has given rise to diverging interpretations by the Boards of Appeal over the past 30 years, leading to legal uncertainties when it comes to assessing what constitutes state of the art within the meaning of Article 54(2) EPC in relation to a commercially available product.

This results in the need to refer a number of questions to the Enlarged Board of Appeal, both to ensure uniform application of the law and because points of law of fundamental importance have arisen.

A decision as to under which conditions for a product put on the market before the filing date, as is the case for ENGAGE® 8400, the product itself and partial information about its composition published prior to the filing date is state of the art within the meaning of Article 54(2) EPC is relevant to the present case, as the possibility to use such a product in the analysis of inventive step is decisive to determine the outcome of the case.

In addition, the diverging interpretations made of G 1/92 are of considerable practical relevance in a large number of cases as illustrated by the various decisions mentioned above, and a mere theoretical importance is excluded.

3. In view of the cited reasons, Q.1 is understood to mean:
Is the product as a whole excluded from the prior art if it is insufficiently disclosed, or is the product prior art but are just its insufficiently disclosed technical features excluded?
4. Further, the Technical Board suggested that the relevance of the question may especially be seen in whether the insufficiently disclosed product can, in one way or another, play a role when assessing inventive step of a later invention.

Article 54(2) EPC itself

5. In the following, the terms “state of the art” and “prior art” are synonyms and are to be understood as prior art with respect to the effective date of an invention of which the patentability is assessed.
6. Article 54(2) EPC reads:
Article 54(2)
The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application.
7. Thus, “**everything**” that is “**available to the public**” by a disclosure “**in any kind of way**” is state of the art.

A first example

8. As a first example, a product P1 comprising a non-identified composition C1 is available on the market before the effective date of an invention.

9. Composition C1 could not be analysed and reproduced without undue burden by the skilled person before the effective date of an invention. Composition C1 is thus, as a chemical composition, insufficiently disclosed.
10. However, written disclosures from before the effective date of an invention show that, when product P1 is swallowed in a certain dosage once per day, it provides an almost instant relief from headache, much quicker than any other known products and compositions can.
11. Product P1 is still available and the testing its effect of almost instant relief from headache still these same results.
12. What is publicly disclosed?
13. It cannot be denied that the public/ the skilled person directly and unambiguously recognizes the technical teaching that “some kind of product (named P1) comprising some kind of composition (named C1) exhibits the effect of almost instant relief from headache”.
As an effect is also a technical feature, see G 2/88, it can thus not be denied that there is a disclosure of “something providing almost instant relief from headache”, albeit without any disclosure what the “something” really is nor how it can be made.
14. Thus, the prior art effect of the insufficiently disclosed composition C1 is that of “something providing almost instant relief from headache” is disclosed and this effect is Art. 54(2) prior art.
The product P1 and its composition C1 may thus be considered as incompletely disclosed (I deliberately do not use the term insufficient), but they are disclosed to the extent that the effect of “providing almost instant relief from headache” is obtainable by the product P1 and its composition C1.
15. As the “something” is not disclosed to any further extent than that it is “providing almost instant relief from headache”, the “something” cannot be novelty destroying to any later (and sufficiently disclosed) invention; it would need to be a complete disclosure of the composition C1 and product P1 to have a novelty destroying effect.
16. However, as the “something” is disclosed to the extent that it is “providing almost instant relief from headache”, the “something” (named P1 with a named but insufficiently disclosed composition C1) could be relevant in assessing inventive step of any later (and sufficiently disclosed) invention.
17. In particular, the “(something) providing almost instant relief from headache” could serve as the closest prior art in assessing inventive step.
18. To cite Guidelines (2023) G-VII, 5.1; terms in italics added- “[T]he closest prior art is that which in one single reference discloses the combination of features (*the rather vague “something” with as a technical feature the proven technical effect of “providing almost*

instant relief from headache”) which constitutes the most promising starting point for a development leading to the invention (*the “something providing almost instant relief from headache” being the trigger and the inspiration to let the the skilled person wanting to start a development to be able to achieve a real product with this -proven- effect*). In selecting the closest prior art, the first consideration (*hence, the wish to obtain a real product with the same purpose/effect as the “something” is a leading consideration in selecting the CPA*) is that it must be directed to a similar purpose or effect as the invention or at least belong to the same or a closely related technical field as the claimed invention. In practice, the closest prior art is generally that which corresponds to a similar use (*again, the use/effect is leading...*) and requires the minimum of structural and functional modifications (*...hence,- disclosed- structure is less important than -proven- use/effect as a consideration in CPA selection*) to arrive at the claimed invention (see T 606/89).”.

19. The objective technical problem could be “How to obtain a “something” that can provide almost instant relief from headache”.
20. Denying that “providing almost instant relief from headache” is prior art, would imply that a skilled person would never even consider the incomplete teaching.
21. As any public disclosure before the effective date is prior art, any test results and any other technical information about the product which was made available to the public before the filing date (e.g. by publication of technical brochure, non-patent or patent literature) is state of the art within the meaning of Article 54(2) EPC to the extent that they are sufficiently disclosed. E.g., any documentation of dosage, administration, test results, ... can be prior art.
22. Hence, when using “(something) providing almost instant relief from headache” as closest prior art in assessing inventive step of a later invention, and using “How to obtain a “something” that can provide almost instant relief from headache” as objective technical problem, considering whether the later invention is obvious may involve these other public disclosure as state of the art within the meaning of Article 54(2) EPC to the extent that they are sufficiently disclosed in the same way as any other second prior art disclosure (could-would approach) – Guidelines (2023) G-VII, 5 (problem-solution approach) and G-VII, 6 (Combining pieces of prior art).

A second example

23. As a second example, product PP is a mechanical construction. PP comprises a first sufficiently disclosed element FSD1, a second sufficiently disclosed element FSD2 and a third

sufficiently disclosed element FSD3. PP is shown at a fair before the effective date of an invention. The builder of PP claims that PP is a perpetuum mobile, and that FSD1, FSD2 and FSD3 cooperate to generate eternal motion after being put in motion by some initial force.

24. What is publicly disclosed?

25. A claim to “product PP, wherein FSD1, FSD2 and FSD3 are arranged to cooperate to generate perpetual motion” would not be enabled, as the claimed effect cannot be obtained.

26. It cannot be denied that the public/ the skilled person directly and unambiguously recognizes that PP is a mechanical construction, and that PP comprises a first sufficiently disclosed element FSD1, a second sufficiently disclosed element FSD2 and a third sufficiently disclosed element FSD3.

Thus, the mechanical construction PP itself is sufficiently disclosed and is Art. 54(2) prior art.

27. However, “PP as perpetuum mobile” is not disclosed and not prior art. Also, the effect of “providing perpetual motion (by PP)” is not achieved, i.e., the effect of achieving perpetual motion is not disclosed and not prior art.

28. However, the construction PP and its elements FSD1, FSD2 and FSD3 are, as mechanical constructions, sufficiently disclosed and are all Art. 54(2) prior art.

29. Either of them could be, as such, relevant in novelty or inventive step of any later (and sufficiently disclosed) invention. However, that prior art effect does not extend to achieving perpetual motion.

30. Another mechanical construction that comprises the same elements may thus lack novelty.

31. If one of the elements, FSD1, FSD2 or FSD3 is on its own usable in another mechanical construction, it may be relevant for inventive step of another mechanical construction.

32. Thus, an insufficiently disclosed product, here a perpetuum mobile, is prior art to the extent that the public/the skilled person directly and unambiguously recognizes a technical teaching.

Conclusion from the first and second example

33. From the two examples, we can conclude that the answer to Q.1 may thus be given as:

Where it is not possible for the skilled person to discover the composition or the internal structure of the product and to reproduce it without undue burden, then the composition or internal structure of the product does not become state of the art, but the product becomes prior art to the extent that the skilled person can directly and unambiguously derive a technical teaching from it. The prior art effect of the product may, e.g., extend to just the technical effect that is (shown and proven to be) achieved by the product.

34. The answer to Q.2 may be given as:

Technical information about said product which was made available to the public before the effective date (e.g. by publication of technical brochure, non-patent or patent literature) is state of the art within the meaning of Article 54(2) EPC to the extent that that technical information is sufficiently disclosed.

35. In view of the answers to Q.1 and Q.2, Q.3 does not need to be answered.

Supportive case law

G 1/92 “Availability to the public”

36. G1/92 provides that “Where it is possible for the skilled person to discover the composition or the internal structure of the product and to reproduce it without undue burden, then both the product and its composition or internal structure become state of the art.”

37. This is not incompatible with:

Where it is not possible for the skilled person to discover the composition or the internal structure of the product and to reproduce it without undue burden, then the composition or internal structure of the product does not become state of the art, but the product becomes prior art to the extent that the skilled person can directly and unambiguously derive a technical teaching from it.

38. Headnotes G 1/92

1. The chemical composition of a product is state of the art when the product as such is available to the public and can be analysed and reproduced by the skilled person, irrespective of whether or not particular reasons can be identified for analysing the composition.

2. The same principle applies mutatis mutandis to any other product.

39. Reasons G 1/92

1.4. An essential purpose of any technical teaching is to enable the person skilled in the art to manufacture or use a given product by applying such teaching. Where such teaching results from a product put on the market, the person skilled in the art will have to rely on his general technical knowledge to gather all information enabling him to prepare the said product. Where it is possible for the skilled person to discover the composition or the internal structure of the product and to reproduce it without undue burden, then both the product and its composition or internal structure become state of the art.

2.1 The introduction of such an additional requirement [that the public should have particular reasons for analysing a product put on the market, in order to identify its composition or internal structure] would remove a commercially available and reproducible product from the public domain. It would mean an unfounded deviation from the principles applied in respect of the other sources of the state of the art as defined in Article 54(2) EPC and it would obviously represent an element of subjectivity leading to uncertainty in applying the concept of novelty as defined in this Article.

3. It may be added that a commercially available product per se does not implicitly disclose anything beyond its composition or internal structure. Extrinsic characteristics, which are only revealed when the product is exposed to interaction with specifically chosen outside conditions, e.g., reactants or the like, in order to provide a particular effect or result or to discover potential results or capabilities, therefore point beyond the product per se as they are dependent on deliberate choices being made. Typical examples are the application as a pharmaceutical product of a known substance or composition (cf. Art. 54(5) EPC) and the use of a known compound for a particular purpose, based on a new technical effect (cf. G 2/88). Thus, such characteristics cannot be considered as already having been made available to the public.

G 2/88

40. G2/88 provides, in reason 10, that “. The word "available" carries with it the idea that, for lack of novelty to be found, all the technical features of the claimed invention in combination must have been communicated to the public, or laid open for inspection.” and in 10.3 “The attaining of such a technical effect should then be considered as a functional technical feature of the claim (e.g. the achievement in a particular context of that technical effect).”

41. This is not incompatible with considering that, what is “available” from a product is the set of features (including effects) that can be recognized (sufficiently disclosed explicit and implicit, but not inherent hidden features) from the product, but not those that were hidden or unrecognized.

42. Hence, G 2/88 is not incompatible with considering that:

Where it is not possible for the skilled person to discover the composition or the internal structure of the product and to reproduce it without undue burden, then the composition or internal structure of the product does not become state of the art, but the product becomes prior art to the extent that the skilled person can directly and unambiguously derive a technical teaching from it.

43. Reasons (G 2/88, r.10 = G 6/88, r.8)

10. The word "available" carries with it the idea that, for lack of novelty to be found, all the technical features of the claimed invention in combination must have been communicated to the public, or laid open for inspection. In the case of a "written description" which is open for inspection, what is made available in particular is the information content of the written description. [...] In each such case, however, a line must be drawn between what is in fact made available, and what remains hidden or otherwise has not been made available. In this connection the distinction should also be emphasised between lack of novelty and lack of inventive step: information equivalent to a claimed invention may be "made available" (lack of novelty), or may not have been made available but obvious (novel, but lack of inventive step), or not made available and not obvious (novel and inventive). Thus, in particular, what is hidden may still be obvious.

10.1 [...] the Enlarged Board would emphasise that under Article 54(2) EPC the question to be decided is what has been "made available" to the public: the question is not what may have been "inherent" in what was made available (by a prior written description, or in what has previously been used (prior use), for example). Under the EPC, a hidden or secret use, because it has not been made available to the public, is not a ground of objection to validity of a European patent. In this respect, the provisions of the EPC may differ from the previous national laws of some Contracting States, and even from the current national laws of some non-Contracting States. Thus, the question of "inherency" does not arise as such under Article 54 EPC. Any vested right derived from prior use of an invention is a matter for national law (see, in this connection, e.g. Article 38 of the Community Patent Convention, not yet in force). Furthermore, as to the suggested problems concerning infringement referred to above, it is to be noted that analogous problems would result from G 1/83 in the medical area.

10.3 [...] With respect to a claim to a new use of a known compound, such new use may reflect a newly discovered technical effect described in the patent. The attaining of such a technical effect should then be considered as a functional technical feature of the claim (e.g. the achievement in a particular context of that technical effect). If that technical feature has not been previously made available to the public by any of the means as set out in Article 54(2) EPC, then the claimed invention is novel, even though such technical effect may have inherently taken place in the course of carrying out what has previously been made available to the public.

G 2/21

44. G2/21 provides, in reason 90, that “The principle of free evaluation of evidence depicts a universally applicable principle of both procedural and substantive law in assessing any means of evidence submitted by a party in proceedings under the EPC.” and in reason 93 that “The relevant standard for the reliance on a purported technical effect when assessing whether or not the claimed subject-matter involves an inventive step concerns the question of what the skilled person, with the common general knowledge in mind, would understand at the filing date from the application as originally filed as the technical teaching of the claimed invention. The technical effect relied upon, even at a later stage, needs to be encompassed by that technical teaching and to embody the same invention, because such an effect does not change the nature of the claimed invention.” And in reason 94 “Hence, a patent applicant or proprietor may rely upon a technical effect for inventive step if the skilled person, having the common general knowledge in mind, and based on the application as originally filed, would consider said effect as being encompassed by the technical teaching and embodied by the same originally disclosed invention.”

Hence, G 2/21 also puts emphasis on what the skilled person, with the common general knowledge in mind, would understand at the relevant date from an original disclosure (the application as originally filed) as the technical teaching of the original disclosure (the claimed invention). Thus, the prior art effect of a disclosure extends to what the skilled person understand to it – anything within that extent is disclosed and forms prior art; anything outside that extent is not disclosed and not prior art.

45. This is not incompatible with:

Where it is not possible for the skilled person to discover the composition or the internal structure of the product and to reproduce it without undue burden, then the composition or internal structure of the product does not become state of the art, but the product becomes prior art to the extent that the skilled person can directly and unambiguously derive a technical teaching from it.

46. Headnote G 2/21

I. Evidence submitted by a patent applicant or proprietor to prove a technical effect relied upon for acknowledgement of inventive step of the claimed subject-matter may not be disregarded solely on the ground that such evidence, on which the effect rests, had not been public before the filing date of the patent in suit and was filed after that date.

II. A patent applicant or proprietor may rely upon a technical effect for inventive step if the skilled person, having the common general knowledge in mind, and based on the application as originally filed, would derive said effect as being encompassed by the technical teaching and embodied by the same originally disclosed invention.

47. Reasons (G 2/21)

73 As noted in points 11 and 12 above, the referred questions do not require an answer to the issue of sufficiency of disclosure and Article 83 EPC. However, as the terminological notion of plausibility relied upon by the referring board in questions 2 and 3 of the referral and the reasons for it is mainly to be found in the case law of the boards of appeal with regard to the patentability requirement of sufficiency of disclosure, the Enlarged Board accepts the appropriateness of a comparative analysis and comparative considerations in this regard.

74 While the issues of sufficiency of disclosure (Article 83 EPC) and inventive step (Article 56 EPC) and their assessment are clearly to be treated separately and on their own, as correctly pointed out by the referring board in point 13.3.1 of the Reasons of the referring decision, the Enlarged Board is aware of the case law in particular concerning second medical use claims where the notion of "plausibility" has been used. For such claims, the issue of reliance on post-published evidence for a purported technical effect arises in particular in the context of sufficiency of disclosure.

Indeed, a technical effect, which in the case of for example a second medical use claim is usually a therapeutic effect, is a feature of the claim, so that the issue of whether it has been shown that this effect is achieved is a question of sufficiency of disclosure under Article 83 EPC.

Hence, because the subject-matter of second medical use claims is commonly limited to a known therapeutic agent for use in a new therapeutic application, it is necessary that the patent at the date of its filing renders it credible that the known therapeutic agent, i.e. the product, is suitable for the claimed therapeutic application. The Enlarged Board explained the legal and historical background to the patentability of further medical uses in its decision G 2/08.

88 As already mentioned in points 55 to 59 above, the proceedings under the EPC are governed by the principle of free evaluation of evidence which is also known in various EPC Contracting States with a civil law system.

89 The principle of free evaluation of evidence depicts a universally applicable principle of both procedural and substantive law in assessing any means of evidence submitted by a party in proceedings under the EPC, be it an administrative department of the EPO or a

board of appeal as the competent judicial body reviewing decisions of such administrative departments pursuant to Article 106(1) EPC.

90 As the principle of free evaluation of evidence is enshrined in the right of each party to proceedings under EPC to give evidence in appropriate form pursuant to Articles 113(1) and 117(1) EPC, it may not be used to disregard evidence per se insofar as it is submitted and relied upon by a party in support of an inference which is challenged as to its plausibility and is decisive for the final decision.

91 Hence, evidence submitted by a patent applicant or proprietor to prove a purported technical effect relied upon for acknowledgement of inventive step of the claimed subject-matter may not be disregarded solely on the ground that such evidence, on which the effect rests, had not been public before the filing date of the patent in suit and was filed after that date.

92 The term "plausibility" that is found in the case law of the boards of appeal and relied upon by the referring board in questions 2 and 3 of the referral and the reasons for it, does not amount to a distinctive legal concept or a specific patent law requirement under the EPC, in particular under Article 56 and 83 EPC. It rather describes a generic catchword seized in the jurisprudence of the boards of appeal, by some national courts and by users of the European patent system.

93 The relevant standard for the reliance on a purported technical effect when assessing whether or not the claimed subject-matter involves an inventive step concerns the question of what the skilled person, with the common general knowledge in mind, would understand at the filing date from the application as originally filed as the technical teaching of the claimed invention. The technical effect relied upon, even at a later stage, needs to be encompassed by that technical teaching and to embody the same invention, because such an effect does not change the nature of the claimed invention.

94 Hence, a patent applicant or proprietor may rely upon a technical effect for inventive step if the skilled person, having the common general knowledge in mind, and based on the application as originally filed, would consider said effect as being encompassed by the technical teaching and embodied by the same originally disclosed invention.

95 The Enlarged Board is aware of the abstractness of some of the aforementioned criteria. However, apart from the fact that the Enlarged Board, in its function assigned to it under Article 112(1) EPC, is not called to decide on a specific case, it is the pertinent circumstances of each case which provide the basis on which a board of appeal or other deciding body is required to judge, and the actual outcome may well to some extent be influenced by the technical field of the claimed invention. Irrespective of the actual circumstances of a

particular case, the guiding principles set out above should allow the competent board of appeal or other deciding body to take a decision on whether or not post-published evidence may or may not be relied upon in support of an asserted technical effect when assessing whether or not the claimed subject-matter involves an inventive step.

Conclusions

48. The answer to Q.1 may thus be given as:

Where it is not possible for the skilled person to discover the composition or the internal structure of the product and to reproduce it without undue burden, then the composition or internal structure of the product does not become state of the art, but the product becomes prior art to the extent that the skilled person can directly and unambiguously derive a technical teaching from it. The prior art effect of the product may, e.g., extend to just the technical effect that is (shown and proven to be) achieved by the product.

49. The answer to Q.2 may be given as:

Technical information about said product which was made available to the public before the effective date (e.g. by publication of technical brochure, non-patent or patent literature) is state of the art within the meaning of Article 54(2) EPC to the extent that that technical information is sufficiently disclosed.

50. In view of the answers to Q.1 and Q.2, Q.3 does not need to be answered.

Looking forward to your considerations and your decision/opinion,

Kind regards,



Roel van Woudenberg
European Patent Attorney
DeltaPatents