

Registry of the Enlarged Board of Appeal  
Attn. Mr. Nicolas Michaleczek

**ELION IP, S.L.**  
P° Castellana, 150, 4°D  
28046 Madrid, SPAIN  
info@elionip.com  
(+34) 91 005 90 92  
elionip.com

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Y/Ref.: G1/23

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**Amicus Curiae Brief for Referral G1/23 (“Solar Cell”) before the Enlarged Board of Appeal**

In our view, the questions referred to the Enlarged Board of Appeal are to be answered as follows:

**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?*

No, it is not to be excluded.

**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?*

Yes, it is state of the art as long as the technical information enables the skilled person to derive at least one technical teaching from it.

**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?*

Not applicable given the answers above.

### **Reasons for the above answers**

The state of the art comprises everything made available to the public, in whatever form, to the extent that any teachings of the disclosure are sufficiently disclosed, i.e., enabled for the skilled person. A teaching that is part of the public domain because it has been disclosed but which is not enabled for the skilled person and thus cannot be reproduced by the public, then said teaching cannot be regarded as being made available to the public. The above is not only valid in Europe, i.e., at the European Patent Office and the National Patent Offices of the Member States of the European Patent Convention, but also in other jurisdictions abroad.

Analysis and reproducibility by the skilled person are the technical facts that are needed to determine whether disclosures have enabled teachings. In the affirmative, i.e., there are enabled teachings, they are held to be comprised in the state of the art. When there is no possible analysis and reproducibility of a teaching before the date of filing of a European patent application, the public cannot put the teaching into practice, hence the public does not benefit from the disclosure in any way. Namely, the public does not learn anything new that they can reproduce. In such cases, stakeholders have the right of making a disclosure of the teaching, as long as it is enabled, and get patent protection in return.

An insufficient disclosure does not make possible to compare the features of a claimed invention with those allegedly existing in a product already put on the market basically because it remains unknown whether the features are in fact novel and inventive over those to be found in the product. Having said that, any feature of the product already on the market, that can be regarded as a technical teaching enabled for the skilled person does form part of the state of the art insofar it is analysable and reproducible. The lack of knowledge of the composition or internal structure of a product does not render other features that can be derived therefrom not to be part of the state of the art. In this sense, by answering Question 1 in the affirmative, the entire product would

be excluded from the state of the art regardless of any other technical information that the skilled person can extract from the product. However, there is no necessary link between the recognisability of the substance and the technical effect the substance may produce to be patentable. For the sake of the completeness, reference is made to the Case Law of the Boards of Appeal (cf. CLBoA I.A.2.2.1 "Discoveries and scientific theories"): *"To find a previously unrecognised substance occurring in nature is also mere discovery and therefore unpatentable. However, if a substance found in nature can be shown to produce a technical effect, it may be patentable."* It is thus sufficient that whatever is unknown can still be made to solve a technical problem and the solution to the technical problem can be disclosed for it to be patentable. A necessary precondition for the patentability of the substance (use, combination, etc.) is that it is sufficiently disclosed for the skilled person. It is, however, not a precondition to disclose the properties or principle based on which the substance achieves the technical effect as long as it is analysable and reproducible. That the properties, the underlying principle, or the composition or internal structure of the substance remains unknown does not change the fact that the skilled person learned a new technical teaching involving the unrecognisable substance. In this sense, a product of nature, of unknown structure or that it is (yet) unknown how to obtain it synthetically, may be obtained and used for solving a technical problem.

As soon as the composition or internal structure of the product becomes analysable and reproducible by the skilled person, that product already on the market shall be also considered to be part of the state of the art with regards to, precisely, its composition or internal structure as from that moment. The date when this occurs will be decisive whenever the novelty or the inventive step of some subject-matter defined in a patent application or patent is contested by third parties since the product might predate said subject-matter yet its composition or internal structure not having become state of the art after the effective date for that subject-matter.

Turning to Question 2, technical information about the product put on the market is, by definition of the referred question itself, technical. However, technical information is not always enabled for the skilled person. For example, a press release or a brochure related to a new product may include details of, e.g., the behaviour, the operation, etc., of the product. This type of information, which could be comprised in the state of the art by the mere fact that it is literature available to the public by way of a publication,

could only limit the patentability of new inventions if, again, it cannot be analysed and reproduced. Similarly, it is not uncommon that scientific literature available to the public acknowledges the existence of, e.g., advantages, drawbacks, and the like of new alleged developments, yet when said developments are put up to the test, the claimed advantages or drawbacks cannot always be observed.

The extent to which the technical information is to be part of the state of the art depends upon the content of the information itself. Those parts of the information that are not enabled to the skilled person cannot be regarded as being comprised in the state of the art whereas enabled parts are technical teachings that are to be comprised in the state of the art.

The sufficiency of disclosure of such technical information has to be considered by the skilled person to determine whether the information may be held to be comprised in the state of the art or not. The technical information is, thus, to be treated like any other disclosure regardless of whether it relates to a given product or not. This is well-established practice (cf. Headnote of T 0206/83: *"A document (in this case a co-pending European application) does not effectively disclose a chemical compound, even though it states the structure and the steps by which it is produced, if the skilled person is unable to find out from the document or from common general knowledge how to obtain the required starting materials or intermediates. [...]"*) and there is no reason to deviate from it.

Respectfully submitted,

Elion  
Association No. 1209