



AMICUS BRIEF FILED ON BEHALF OF AIPPI IN CASE G 1/23 PENDING BEFORE THE ENLARGED BOARD OF APPEAL OF THE EUROPEAN PATENT OFFICE

WRITTEN STATEMENT IN ACCORDANCE WITH ARTICLE 10 OF THE RULES OF PROCEDURE OF THE ENLARGED BOARD OF APPEAL

INTRODUCTION

The European Patent Office (hereafter EPO) has called for Amicus Briefs in case G 1/23, pending before the Enlarged Board of Appeal. The deadline for filing a brief is **November 30, 2023**.

The Standing Amicus Brief Committee (hereafter ABC) of AIPPI, makes the present submission in the form of an Amicus Curiae Brief in the above-mentioned case.

SUMMARY OF ISSUES IN CASE G1/23

The invention concerns a solar cell sealing material comprising a polymer defined by features A, B, C, D, and E.

Document D1 discloses the commercial product ENGAGE8400 as a suitable material for encapsulating solar cells.

Other documents disclose that ENGAGE8400 has features A, B, C and D. As a result, ENGAGE8400 appears as a good candidate for closest prior art.

Document D18 discloses how to produce ENGAGE polymers **in general**, but not specifically how to produce ENGAGE 8400.

The Patent Proprietor has argued that ENGAGE8400 is not part of the prior art since it cannot be reproduced without undue burden. The general information provided in D18 does not allow the person skilled in the art to exactly reproduce ENGAGE 8400 without undue burden.

QUESTIONS PUT TO THE ENLARGED BOARD OF APPEAL OF THE EPO

In accordance with [Article 112\(1\)\(a\) EPC](#), Technical Board of Appeal 3.3.03 has referred the following points of law to the Enlarged Board of Appeal by interlocutory decision of 27 June 2023 in case [T 438/19](#):

The questions put to the Enlarged Board of Appeal are 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?

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?



As will be noted from the above questions, the main issue in this case is whether a prior art disclosure (in this case, a product which was put on the market before the filing date of the EP application) must be sufficiently disclosed (using European Patent Convention language; in other jurisdictions, this might be called “enablement”) in order for it to be opposable for purposes of novelty and inventive step. The question of the prior art’s sufficient disclosure is framed here in the context of reproducibility without undue burden by the person skilled in the art.

RELEVANT RESOLUTIONS OF AIPPI:

Q126 (Montréal, 1995): methods and principles of novelty evaluation in patent law;

Q167 (Lisbon, 2002): Current standards for prior art disclosure in assessing novelty and inventive step requirements.

1. According to **Q126** (concerning novelty evaluation):
 - a. *“a disclosure should be considered as accessible to the **public** when **any person** has the possibility of gaining knowledge from the disclosure without any explicit or implied confidentiality” (1.1);*
 - b. *“a disclosure should be deemed to comprise **any information** in written or oral form **or knowledge resulting from an act of use**, independently of the language and of the form, whether material or immaterial” (1.2)*
 - c. *“In order to destroy the novelty of an invention, a prior disclosure should be enabling to the extent that it must make all features of the invention as claimed accessible to the public in such a manner that those features may be discerned by a person skilled in the art.” (4.7)*
2. According to **Q167** (concerning both novelty and inventive step):
 - a. *“the prior art with respect to an invention claimed in a patent or patent application shall consist of **all information which has been made available to the public** anywhere in the world **in any form** before the filing date or, where applicable, the priority date” (1);*
 - b. *“to qualify as prior art under item 1, information may be made available to the public **in any form**, such as in written form, by oral communication, by display, by telecommunication means **or through use**” (3);*
 - c. *“the **public** means **any person** who is free to disclose the information” (4);*
 - d. *information shall be deemed to have been made available to the public, if there is **a reasonable possibility that it could have been accessed by the public**” (4).*

With regard to the specific question of reproducibility without undue burden for a document/product to be opposable prior art, Resolution 4.7 of **Q126** appears to be most relevant.

AIPPI, in light of its prior resolutions and in light of the approach taken in several key EPC national laws in relation to “undue burden”, posits that for the features to be “discerned” by the person skilled in the art, there should not be an undue burden.

In UK patent law, an “undue burden” requirement can apply, inter alia:

- (1) to the question of whether the invention itself is apparent to the skilled person from the prior art, without undue burden.
- (2) to the question of whether the disclosure of a product (especially a medicament) constitutes an enabling disclosure of the effect caused (especially therapeutic effect) of the product, when that effect is part of the invention.
- (3) to the question of whether the patent discloses the invention sufficiently well such that it may be carried out by the skilled person without undue burden.

The first two issues were considered in *Synthon BV v SmithKline Beecham Plc (Paroxetine)* ([2006] R.P.C. 10; [2005] UKHL 59) in which the UK House of Lords held that:

*“The prior art description may be sufficient in itself to enable the ordinary skilled man, armed with common general knowledge of the art, to perform the subject-matter of the invention. Indeed, **when the prior art is a product, the product itself, though dumb, may be enabling***



if it is ‘available to the public’ and a person skilled in the art can discover its composition or internal structure and reproduce it without undue burden.”

*“...for the purpose of disclosure, the prior art must disclose an invention which, if performed, would necessarily infringe the patent. It is not enough to say that, given the prior art, the person skilled in the art would without undue burden be able to come up with an invention which infringed the patent. **But once the very subject-matter of the invention has been disclosed by the prior art and the question is whether it was enabled, the person skilled in the art is assumed to be willing to make trial and error experiments to get it to work.”***

In France, three decisions from the Tribunal de Grande Instance de Paris may be cited: (TGIP; May 7, 2015 MIXEL vs JB TEC; March 2, 2017 FELCO vs PELLENC; May 24, 2018 THURL and URETEK vs TEMSOL) where, even if the question of the enabling character of the prior art was not discussed, the Tribunal stated that: *“There is accessibility if [...] the disclosure is sufficiently complete and precise to enable the skilled person to understand and reproduce the invention at the date of said invention”*. Enablement of a disclosure is thus required by the French courts for said disclosure to be considered as being comprised in the prior art.

We note the above cited sentence clearly indicates that the person who should be enabled is the skilled person, so that an acceptable level of difficulty for the reproduction of the invention must be evaluated in reference to the skilled person. The absence of an undue burden is not explicitly required in the decisions cited. However, the term “enabling” could be considered as meaning just that, i.e. making the skilled person able to reproduce the invention without undue burden.

German case law has dealt with this issue in various decisions. These decisions concern firstly different scenarios in which the respective product was presented to the public. In general, one has to observe the circumstances of that presentation. For example, if a product is shown at a trade fair or on the occasion of a tour for a group of people visiting a company, only those features will have been made available to the public which could be seen on such an occasion for the visitor of the trade show or the company. In general, they will not have the opportunity to inspect the product in detail. This is different if the product was clearly in the possession of a member of the public.

If the product already reveals the relevant features by way of its visual appearance this will be enough to establish state of the art (cf. BGH decision of 5 March 1996, X ZB 13/92, GRUR 1996, 747 – *Lichtbogen-Plasma-Beschichtungssystem*). This also requires that the information was available which is necessary for the skilled person to recognize and to understand the technical teaching in that product (cf. BGH decision of 5 June 1997, X ZR 139/95, GRUR 1997, 892 – *Leiterplattennutzen*).

Regarding the efforts which have to be undertaken to find the features of the invention in a product the German case law very often also makes reference to the EPO case law. There are few decisions which deal with this. One of the more detailed decisions concerned a case in which a certain element for the construction of a building was used only at a single construction site and would have required the demolition of the part of the building in which the element was used. In this case the BGH decided that the use at this construction site did not constitute a prior art, since it would have been rather unlikely that a person would have undergone those efforts (cf. BGH decision of 13 March 2001, X ZR 155/98, GRUR 2001, 819 – *Schalungselement*).

The essence of this case law are mainly two conditions.

(1) The possibility for a person to get to know the information is sufficient. In general, it is not necessary that a person actually obtained the knowledge from the product as long as the mere possibility is there.
 (2) It must have been sufficiently likely that a person would have obtained the knowledge. Both has to be assessed on a case-to-case basis taking into consideration all circumstances of the specific case. If the possibility of obtaining the sufficient knowledge is only theoretical, e.g. because of the undue burden, this may exclude the public knowledge. This may include economic considerations. If the efforts are disproportionate to the potential benefits to be achieved this may also deter the skilled person from inspecting the product in more detail. Again: this has to be assessed on a case-to-case basis.

In Dutch case law, it is generally required that the product was publicly accessible, and that the invention could be derived directly and unambiguously by the skilled person (e.g. Court of Appeal in *BRS*



Excell/Portal & Brake). The limited case law consistently applies the requirement that this should be done without undue burden. In one case (i.e. *Van Weezenbeek Specialties/Ventraco*), it was held that the publicly adding an additive to asphalt was not novelty destroying because the patented method for rejuvenating asphalt could not be reproduced without undue burden.

The prior art in question may be a document or a product, or the “prior art” may also be a living person, if the disclosure alleged to have been made is the therapeutic effect of a medicament on that person. In the case of a therapeutic effect, the “undue burden” test depends at least in part on the effort required to discover the effect through tests, but it may be complicated by additional factors related to whether the prior art has been made available to the public, such as whether tests could in principle have been carried out on the individuals concerned.

An undue burden requirement for disclosure may (or may not) be the mirror image of the requirement that a patent discloses the invention sufficiently well such that it may be carried out by the skilled person without undue burden. When starting with knowledge of the patent, certain experiments may not require an undue burden, but when starting from the prior art *without any advance knowledge of the prior art*, those same experiments might appear non-obvious or unduly burdensome for the skilled person.

AIPPI’s POSITION ON CASE G1/23

A previously decided case of the EPO Enlarged Board of Appeal, case G 1/92 is relevant to the present case.

Point 1. of the headnote of G1/92 states that:

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

A contrario, if the product cannot be analyzed or reproduced, its chemical composition is excluded from the state of the art.

The question in G 1/23 is whether the product itself, without the knowledge of its composition, should also be excluded from the state of the art. The object of question 1 of G 1/23 is thus to clarify this point.

According to the Board of Appeal making the referral to the Enlarged Board of Appeal (point 12.1 of their decision of 27 June 2023) the distinction between the product and its composition would matter because: *« 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 ».*

The opinion of AIPPI, is that G1/92 already answers question 1 in the affirmative.

Indeed, it is explained at point 1.4 of G1/92 that:

“Where it is possible for the skilled person to discover the composition or the internal structure of the product and reproduce it without undue burden, then both the product and its composition or internal structure becomes state of the art.”

According to the Board of Appeal referring the present case, the fact that point 1. of the head note of G1/92, states “*when the product as such is available*” could be interpreted as meaning that the product as such is included in the state of the art even if the product cannot be analyzed and reproduced.

However, such an interpretation would be contradictory with point 1.4 of G1/92.

It is thus AIPPI's position that Question 1 of G 1/23 should be answered as “yes”.



Question 2 of G 1/23 is not to be answered here, as it was indicated that it should only be replied to if the answer to Question 1 is “no”.

However, the following remarks are made: it may happen that the technical information about a specific product, which cannot be reproduced, renders obvious another product. For example, if combining the information from several disclosures leads the skilled person to believe that only some of the features of the non-enabled product are required to obtain a given technical effect and the skilled person knows how to obtain another product having said features, then a claim to a product having said features becomes obvious if the problem to be solved is to obtain said technical effect.

With regard to Question 3, the position of AIPPI is as follows: the criteria to be applied should be that the composition and internal structure of the product should be identically reproducible.

The disclosure of a specific product is enabled only if this specific product and not another product can be reproduced. This implies that the composition and internal structure of the product should be identically reproducible.

The requirement of analyzability of the product does not appear to be relevant, because it is not clear what “fully analyzable” means (in particular in the case of a polymer, it is difficult to define the level of detail that correspond to a full analysis). On the other hand, identical reproducibility is clear and objective. For example, even in the case of a product that is difficult to define exactly (polymers, products-by-process in general), if the same process was used to obtain the product it can be assumed that the product is identically reproduced.

Sometimes the main difficulty in reproducing a product can be to be able to analyze it. In this sense, it can be said that analysis of the product enables the product but, ultimately, the enablement still comes with the fact that the skilled person is able to reproduce the product.

Respectfully submitted on behalf of AIPPI

Amicus Brief Committee of AIPPI

QUESTION 126

Methods and principles of novelty evaluation in patent law

Yearbook 1995/VIII, pages 383 - 385
36th Congress of Montréal, June 25 - 30, 1995

Q126

Question Q126

Methods and principles of novelty evaluation in patent law

Resolution

AIPPI

- CONSIDERING that novelty is a basic requirement of all states for the patenting of an invention;
- CONSIDERING that the criteria for determining novelty are not uniform for all states;
- CONSIDERING that different criteria for determining novelty in different states may mean that an invention is patentable in one state and not in another and that this leads to uncertainty;
- CONSIDERING the past efforts by AIPPI to promote the harmonization of patent legislations;
- ACKNOWLEDGING that perfect harmonization is not always possible and that certain situations of prior rights in one state as opposed to another may permit the patenting of an invention in one but not another of the states;
- CONSIDERING past resolutions of AIPPI and in particular the Question 89C Resolution regarding self-collision (Sydney, 1988 - Yearbook 1988/II, pages 212-213);

- CONSIDERING the work of AIPPI regarding Question 89 relating to harmonization and guidelines with respect thereto for presentation to WIPO (Yearbook 1991/I, pages 280 and following); and
- CONFIRMING its position favourable to a more comprehensive grace period of uniform duration at an international level (Moscow 1982, Question 75, Yearbook 1982/III).

TAKES THE FOLLOWING POSITION:

1. Novelty should be absolute whereby, without prejudice to the adoption of a grace period, any disclosure accessible to the public anywhere before the priority date of a patent application, or any other critical date for the assessment of novelty determined by national or regional laws, should be a basis for questioning the novelty of the invention claimed.
 - 1.1 A disclosure should be considered accessible to the public when any person has the possibility of gaining knowledge from the disclosure without any explicit or implied confidentiality;
 - 1.2 A disclosure should be deemed to comprise any information in written or oral form or knowledge resulting from an act of use, independently of the language and of the form, whether material or immaterial. However, AIPPI recommends that national or regional laws provide for at least limited exceptions in the case of experimental use accessible to the public by the inventor, his assignees or successors, always taking into account the particular nature of such use, the necessity for their being carried out in a manner accessible to the public and the precautions taken to limit accessibility to third parties.
2. The requirement of absolute novelty reflects the reality of modern technology which permits and promotes the rapid worldwide dissemination of information. It is no longer reasonable to consider that information available in one country is necessarily less available in another and consequently it is no longer realistic for an invention lacking novelty in one country to be held novel and patentable in another.
3. The recognition of any disclosure as defined above to serve as a basis for contesting the novelty of a later application is fully in accordance with the spirit of the TRIPS Agreement which prohibits discrimination between countries with respect to the recognition of inventions made in other member countries. Absolute novelty is wholly non-discriminatory.
4. For the purpose of determining novelty the combination of more than one disclosure should not be permitted.
 - 4.1 When a disclosure specifically refers to or relies upon any other disclosure in such a way that consideration of such other disclosure is essential for a full understanding thereof, such other disclosure should be deemed to be incorporated therein.

- 4.2 Should a disclosure set forth different features without specifically or implicitly providing for combinations thereof, it should not be considered to destroy the novelty of such combinations.
- 4.3 A single prior art disclosure may be proved by a number of documents or acts in order to determine the date and content of the disclosure.
- 4.4 The appreciation of novelty should be considered separately from that of inventive step or obviousness.
- 4.5 The interpretation of a disclosure must take into account the understanding of a person skilled in the art.

Such interpretation should extend to what the person skilled in the art, on considering the disclosure, would understand as implicitly or inherently disclosed. It should not extend to technical equivalents not covered by such an interpretation, nor should it extend to the realm of inventive activity.

- 4.6 In determining the understanding of the person skilled in the art, it should be permitted to rely upon his general knowledge.
 - 4.7 In order to destroy the novelty of an invention, a prior disclosure should be enabling to the extent that it must make all features of the invention as claimed accessible to the public in such a manner that those features may be discerned by a person skilled in the art.
5. AIPPI, in recognizing the necessity to avoid double patenting, considers that the disclosure contained in an unpublished earlier patent application, which is later published in the same jurisdiction, should be taken into account for the purpose of determining novelty of an invention claimed in a subsequent patent application. The assessment of novelty in such circumstances should not differ from the general rule with respect to other disclosures that are accessible to the public as defined in Item 4 above.
- 5.1 AIPPI confirms the Sydney resolution which recommends an express provision for preventing "self-collision" whereby, excluding the possibility of double patenting, the disclosure of the unpublished prior patent application should not affect the novelty of the subsequent patent application where there is total or partial identity between the applicants at the time of filing the subsequent application (Sydney 1988, Question 89C, Yearbook 1988/II).
6. While recognizing that inventions in certain new areas of technology may give rise to specific difficulties in the application of the criteria for appreciating novelty, AIPPI considers that such criteria do not require alteration which would represent undesirable exceptions from the general rule.

* * * * *

QUESTION 167

Current standards for prior art disclosure in assessing novelty and inventive step requirements

Yearbook 2002/I, pages 273 - 274
Executive Committee of Lisbon, June 16 - 22, 2002

Q167

Question Q167

Current standards for prior art disclosure in assessing novelty and inventive step requirements

Resolution

AIPPI

Considering that:

- a) The patent system is designed to protect inventions which, amongst other requirements, are new and involve an inventive step with respect to the prior art.
- b) Standards for prior art disclosure in assessing novelty and inventive step (non-obviousness) requirements are of primary importance regarding patentability of inventions and validity of patents.
- c) The emergence of new media, such as the Internet, raised the issue as to whether the standards for prior art disclosure in assessing novelty and inventive step should be reassessed.
- d) A common definition for prior art disclosure is also being addressed by WIPO in their Draft Substantive Patent Law Treaty (SPLT).

And whereas:

- e) Only a minority of countries having a patent system provide for additional intellectual property rights, such as utility models, for inventions which are new and involve an inventive step, and, therefore, the following resolution is directed to patents and patent applications only and not to utility models and other intellectual property rights,
- f) Since its origins patent law has adapted to new means of prior art disclosure,
- g) Problems resulting from this expansion have been resolved without substantially modifying the standards of prior art disclosure,
- h) Additional, heretofore unknown means of prior art disclosure may emerge as technical progress advances,
- i) The questions of a grace period and of the impact of abusive disclosure or the breaching of confidentiality agreements which are closely related to a prior art disclosure not affecting patentability are exempt from the following resolution,

Adopts the following Resolution:

1. The prior art with respect to an invention claimed in a patent or patent application shall consist of all information which has been made available to the public anywhere in the world in any form before the filing date or, where applicable, the priority date.
2. If the filing date or, where applicable, the priority date, of a patent application filed in, or with effect for, a country ("earlier application") is earlier than the filing date or, where applicable, the priority date of another patent application filed in, or with effect for, the same country ("later application") and if the earlier application is made publicly available on or after the filing date, or where applicable, the priority date of the later application, the whole contents of the earlier application excluding the abstract, if any, shall be considered to form part of the prior art with regard only to the novelty of an invention claimed in the later application, but not with regard to the inventive step. Where such earlier application has been made publicly available in spite of the fact that, before the date of becoming publicly available, it was withdrawn or abandoned, was considered withdrawn or abandoned, or was rejected, it shall not be considered as prior art with regard to such later application.
3. To qualify as prior art under item 1, information may be made available to the public in any form, such as in written form, by oral communication, by display, by telecommunication means or through use.
4. The public means any person who is free to disclose the information.
5. Information shall be deemed to have been made available to the public, if there is a reasonable possibility that it could have been accessed by the public.
6. With regard to new media the same principles should apply which have been developed for the assessment of a disclosure to the public through other means. Since the place and means of a disclosure are not determinative, the Internet or other new media do not require a treatment different from other forms of disclosure. It has to be evaluated on a case-by-case basis whether passwords or other means restrict the access so that information is not public.
7. Because a disclosure through new media can lead to specific evidentiary issues, the relevant authorities, such as patent offices or (inter-) governmental bodies, are urged to investigate new means for providing evidence. However, the existing principles regarding the burden of proof should remain applicable.
8. As a result of the present resolution, further harmonization of the standards for prior art disclosure in assessing novelty and inventive step requirements in the various countries is desirable.