



FÉDÉRATION INTERNATIONALE DES CONSEILS  
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF  
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION  
VON PATENTANWÄLTEN

**Elia Sugrañes**  
Secretary General

30 November 2023

Registry of the Enlarged Board of Appeal  
European Patent Office  
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Germany

Attention: Mr. Nicolas Michaleczek

Via email: [EBAamicuscuriae@epo.org](mailto:EBAamicuscuriae@epo.org)

## **RE // Case Number G 1/23**

Dear Mr. Michaleczek

FICPI is pleased to have the opportunity to submit this Amicus Curia Brief and provide comments with respect to the Referral to the Enlarged Board of Appeal – G1/23 (“solar cell”).

Yours sincerely,

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## Amicus Curiae Brief Referral to the Enlarged Board of Appeal G 1/23 (“solar cell”)

30 November 2023

Founded over 100 years ago, **FICPI** is the international representative association for IP attorneys in private practice throughout the world, with about 5,500 members in 86 countries and regions, including European patent attorneys, national patent attorneys and patent agents in all EPC contracting and extension states.

**FICPI** aims to study all administrative or legislative reforms and all improvements to international treaties and conventions, with the object of facilitating the exercise by inventors and IP owners of their rights, of increasing their security and of simplifying procedure or formalities.

In pursuance of this aim, **FICPI** strives to offer well balanced opinions on proposed international, regional and national legislation based on its members’ experience with a great diversity of clients having a wide range of different levels of knowledge, experience and business needs of the IP system.

**FICPI** is pleased to have the opportunity to submit this Amicus Curia Brief and provide comments with respect to the Referral to the Enlarged Board of Appeal – G1/23 (“solar cell”).

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?

FICPI provides the following remarks.

Re Question 1:

Art. 54 (2) EPC forms a clear definition for the state of the art, i.e. 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.

This definition was considered in G1/92, point 2 and 2.1, which read as follows:

“(…)

*2. There is no support in the EPC for the additional requirement referred to by Board 3.3.3 in case T 93/89 (cf. point II above) that the public should have particular reasons for analysing a product put on the market, in order to identify its composition or internal structure. According to Article 54(2) EPC the state of the art shall be held to comprise everything made available to the public. It is the fact that direct and unambiguous access to some particular information is possible, which makes the latter available, whether or not there is any reason for looking for it.*

*2.1 The introduction of such an additional requirement 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.*

(…)”



Therefore, FICPI is of the opinion that QUESTION 1 should be answered NO, as the question refers to the product that was put on the market before the date of filing of a European patent application, not the information derivable from it by analysis.

Re Question 2:

For the same reasons as outlined with respect to Question 1, we come to the conclusion that the circumstances as outlined in Question 2 do not justify a treatment beyond the criteria as set out in Art. 54 (2) EPC and also the reasons as set forth in points 2 and 2.1 of G 1/92 should be fully applied.

Therefore, FICPI is of the opinion that QUESTION 2 should be answered YES.

Following these answers, question 3 does not need to be answered.

On a more general note, the current approach of the EPO is clear on whether or not a disclosure belongs to the prior art, and this should be maintained. Discussions with IP users and IP practitioners around the world reveal that they are in favour of clear and predictable rules.

FICPI believes that the legal provisions and its case law thereto are already clear and there is no need for further tests to be introduced.



**IMPORTANT NOTE:**

The views set forth in this paper have been provisionally approved by the Bureau of FICPI and are subject to final approval by the Executive Committee (ExCo). The content of the paper may therefore change following review by the ExCo.

The International Federation of Intellectual Property Attorneys (FICPI) is the global representative body for intellectual property attorneys in private practice. FICPI’s opinions are based on its members’ experiences with a great diversity of clients having a wide range of different levels of knowledge, experience and business needs of the IP system.

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FICPI has national sections in Argentina, Austria, Brazil, Chile, China, Czech Republic, Greece, Hungary, India, Ireland, Israel, Malaysia, Mexico, Netherlands, New Zealand, Romania, ~~Russia~~<sup>\*</sup>, Singapore, South Korea, Spain, Turkey and the United States of America, a regional section covering for the Andean States (Bolivia, Colombia, Ecuador, Perú and Venezuela), a provisional national section in Poland and individual members in a further 41 countries and regions.

\* Membership of the Russian Section in FICPI was suspended on 9 March 2022 by Resolution EXCO/EB22/RES/001 of FICPI’s Executive Committee in response to Russia’s invasion of Ukraine.

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