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Referral to the Enlarged Board of Appeal - G 1/23

Amicus Curiae Brief by the Patentanwaltskammer according to Art. 10(1) RPEBA

With its interlocutory decision T 0438/19 of June 27, 2023 (herein forth "referring decision"), the Technical Board of Appeal 3.3.03 in accordance with Art. 112(1)(a) EPC has referred the following questions to the Enlarged Board of Appeal for decision:

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*

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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?

I. Executive summary

The position of the Patentanwaltskammer regarding the referral questions can be summarised as follows:

Question 1 does not distinguish between state of the art for assessing novelty and for assessing inventive step. In view of the case law requiring reproducibility for novelty destroying state of the art, the question is to be answered "yes" for questions of novelty. However, the reproducibility of a product available to the public, its composition and/or its initial structure should not be decisive for it to become state of the art according to Art. 54(2) EPC for assessing inventive step. Accordingly, for assessing inventive step, the answer should be "no".

Question 2 has to be answered in the positive: all published technical information generally constitutes prior art – for questions of novelty and inventive step. Whether the disclosure of such publication is sufficient to render a claimed invention obvious is a question to be discussed in the context of Art. 56 EPC, but not Art. 54(2) EPC.

In view of a positive answer to Question 1 and a negative answer to Question 2, Question 3 does not have to be answered with respect to the question of inventive step. Question 3 would have to be answered with respect to the question of novelty. As, however, the focus of the referring decision is inventive step, we will limit our comments thereto.

II. The referred questions

Question 1

In view of diverging interpretations of the earlier Enlarged Board of Appeal decision G 1/92 (cf. the referring decision, reasons no. 14-21), Question 1 is referred to the Enlarged Board of Appeal in a generalized form and detached from a specific case constellation.

However, as the decision by the Enlarged Board of Appeal will also have general effect, care must be taken that no undesirable consequences result from the decision in the case of situations presently not in the focus of the referring decision. While the referring interlocutory decision as well as many of the decisions cited therein are concerned with the question of inventive step and suitable starting points for the problem-solution-approach, the answer to Question 1 as posed in the referral potentially encompasses state of the art to be taken into account as a whole, e. g. also when assessing novelty. In compliance with the focus of the referring decision and as stated above, we will limit our comments to Art. 54(2) in conjunction with Art. 56 EPC.

Considerations on Question 1

Decision G 1/92 sets out a general principle for the composition or the internal structure of a product available to the public to become state of the art:

> 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.*
>
> (G 1/92; headnote)

While the headnote of G 1/92 does not provide for any restrictions regarding the analysability or reproducibility of the chemical composition of a product, its reasoning appears to enter an "undue burden" criterion:

> *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.*
>
> (G 1/92; reasons no. 1.4; emphasis added)

Apparently in line with at least some of the decisions by the Boards of Appeal, it can be argued that in the above recited passage, the Enlarged Board of Appeal distinguished between the reproducibility (or "preparation") of a product as such on the one hand and its composition or internal structure on the other hand. While for a product to constitute state of the art, the skilled person only needs to gather all the information required for its preparation, its chemical composition or internal structure only becomes state of the art (in addition to the product itself), if and when said composition or internal structure may be analysed and reproduced by the skilled person without undue burden.

In a diverging interpretation of the above-cited passages, some prior decisions by different Boards of Appeal did not see a product as belonging to the state of the art, if its chemical composition could not be analysed and reproduced.

In the referring decision, other previous decisions are cited which are based on an even further diverging interpretation of the analysability or reproducibility requirement set out in G 1/92 and in-between the two interpretations presented above. They range from the analysability being required to the last detail of a composition to only the main components being identifiable. For the reproducibility, in some cases an exact replication of a product or a composition had to be enabled, while in other cases only the properties relevant to the question of patentability of a later filed application, i.e. its claims, had to be reproducible; in some cases, the reproducibility requirement was not even addressed and, consequently, not considered for determining whether a composition or internal structure is state of the art.

It is established case law that, in order for a patent application to disclose an invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art, the skilled person must be able to reproduce the subject matter of the invention as disclosed in the patent application without undue burden (cf. Case Law of the Boards of Appeal, 10th edition, chapter II.C.6.6).

This requirement in the context of Art. 83 EPC has been justified by the trade-off inherent to patents: a patent provides its proprietor with a monopoly right for a limited period of time in return for contributing to the state of the art with the invention for others to be able to build upon it. For the latter to be enabled, of course, the invention must be sufficiently disclosed. To this end, the patent specification generally not only provides the technical teaching for carrying out the invention, but also the context in which the invention may be used, thus

providing information, which knowledge and skill set may be assumed for the skilled person, etc. Furthermore, the point in time when the reproducibility is to be determined is clearly established, i. e. the date of filing. This additional information allows a fair assessment, whether an invention has been sufficiently disclosed in a patent application or patent for a skilled person to carry it out without undue burden.

With a product put on the market, however, the situation is completely different, especially in view of the chemical composition or internal structure of the product. Starting with an almost opposite interest of the producer that will usually try to keep concealed all information about the product which is not required for compliance with legal requirements and/or for promoting the product, the further circumstances for assessing the burden required of a skilled person to reproduce the product are usually difficult to assess.

Consequently, considering the range of decisions by the Boards of Appeal applying the rationale of G 1/92 to certain prior art introduced in the proceedings for assessing whether they belong to the state of the art, those decisions that apparently only looked at the analysability of a publicly available product and implicitly assumed the reproducibility of the product to be at least theoretically possible, provide for the clearest and most unambiguous approach to determining the scope of state of the art conveyed by a product having been put on the market. With this approach, only features of a product that could not be determined without undue burden by way of analysis would not constitute state of the art in accordance with Art. 54(2) EPC. All other features of the product would belong to the state of the art.

While pitfalls when determining novelty of a claimed invention over a product that had been put on the market prior to the date of filing may readily be avoided when applying said interpretation of G 1/92, this approach also provides ample possibility to consider the actual and/or practical reproducibility for assessing inventive step. In case the alleged invention is at least partly based on an adaptation of the composition or the internal structure of a known product, the assessment of inventive step may comprise an assessment whether a skilled person would indeed be able to adapt the composition as required for the invention. This might certainly entail an assessment whether the skilled person is able to reproduce the original composition to an extent where the required adaptation may indeed be made. This kind of assessment would even be possible within the problem-solution-approach, which – even though not being a legally prescribed method for assessing inventive step – is

generally applied in proceedings at the European Patent Office and has a proven track record.

In view of these further considerations, not only should Question 1 in its current wording be answered in the negative as far as it concerns inventive step, but – potentially by means of redrafting the referred question – the general principle as set-out in the decision G 1/92 should be clarified beyond the posed question. In a nutshell, a product and all features that could be determined by analysing said product without undue burden and all features that are reproducible without undue burden should be considered state of the art within the meaning of Art. 54(2) EPC, if put on the market before the relevant date.

This is in line with G 2/88 which states that there is no "inherent disclosure" in the prior art. G 2/88 (OJ 1990, 93, Corr. 469) emphasized that "the question to be decided is what has been "made available" to the public: the questions is not what might have been "inherent" in what was made available" to the public. In each case „a line must be drawn between what is in fact made available, and what remains hidden or otherwise has not been made available". A product has been "made available" only if all features could be determined by analysing said product without undue burden and all features are reproducible without undue burden.

Question 2

With the rationale above, according to which a product constitutes state of the art for the assessment of inventive step to the extent it is analysable once it is put on the market, all technical information about said product also constitutes state of the art within the meaning of Art. 54(2) EPC. Technical brochures, non-patent or patent literature published before publication of the product itself must, of course, be assessed solely based on their disclosure relevant to the individual case, especially as to whether they convey a sufficient technical teaching as such to unambiguously identify the product described therein; once the product described therein is available on the market, potential omissions in the technical information may, however, be supplemented by information derivable from the product itself by means of analysis (see above).

As a result, Question 2 should be answered in the positive. Whether technical information – either in conjunction with the actual product or not – provides sufficient technical information for discussing inventive step must be assessed in the context of Art. 56 EPC, but not in the context of Art. 54(2) EPC.

Question 3

As the answer to Question 1 is "no" and the answer to Question 2 is "yes for the question of inventive step", Question 3 does not need to be answered as the focus of the referral is inventive step only.

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