European Patent Office
Enlarged Board of Appeal
Attn.: Mr Nicolas Michaleczek (EBAamicuscuriae@epo.org)
80298 Munich
GERMANY

November 8, 2023

Re: AMICUS CURIAE LETTER CONCERNING REFERRAL G1/23

Dear members of the Board,

I hereby provide you with my answers to the following questions.

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?

My answers:

To question 1: no.

To question 2: yes.

To question 3: no answer needed.

Explanatory notes.

My answer to the first question is “no”. The answer “yes” would lead to the situation that commercial products put on the market that cannot be analysed and reproduced without undue burden could, at a later point in time, be patented by someone (e.g. the original producer) who discloses full process details. For instance, the Coca Cola Company may then at some future time elect to patent Coca Cola as product by disclosing full manufacturing details while until then, at least before the European patent office, Coca Cola as product does not exist. Allowing for this would mean that before the European patent office evidence is artificially divided into evidence which counts as prior art (e.g. published patent documents) and evidence which does not count as prior art in the form of commercial products which cannot be analysed and reproduced without undue burden. Why artificial? Because patent documents are oftentimes not enabled either. Patent attorneys versed in opposition/appeal proceedings know this. For instance, in several opposition/appeal proceedings I have asked polymerization experts to repeat Examples from opposed patents that describe the manufacture and properties of polymer products. There were always one or more polymer properties that could not be reproduced. Yet, on the part of the opposition divisions and boards of appeal this outcome never led to doubts about the patent Examples. The patent Examples were by definition correct and something must have gone wrong during the repetition experiments. This “logic” is widely accepted, as can also be seen in the

historical documentation related to the genesis of Article 54(2) EPC. See T 438/19[1], Reason 10.2, which recounts Mr. Van Benthem submitting that very often descriptions given in patent applications are not sufficient to carry out the invention and that such patent applications are yet considered forming part of the prior art. This was accepted by the Working Party. As a result, proposed language to the effect that "the prior art had to be made available in a manner adequate to enable a skilled person to produce the subject-matter of the publication." was *not* incorporated into Article 54(2) EPC.

In conclusion: whether the composition or internal structure of a product put on the market can or cannot be analysed and reproduced without undue burden by the skilled person, is an unhelpful criterion when it comes to deciding whether or not that product belongs to the prior art because it would create an artificial dividing line between products, such as polymer products, put on the market and products, such as polymer products, described in patent documents.

For question 2, my answer is "yes". The answer "no" would mean the introduction of artificial ways to divide evidence. As we have seen above, patent Examples describing the manufacture of polymer products often do not allow for the exact reproduction of that product. It will be no different even for commercial products whose internal structure can be fully analysed. To reproduce them identically based on such analysis is - similar to the patent Examples discussed above - asking too much. However, *not* asking for *identical* reproduction is inviting the introduction of the criteria of question 3. Such criteria will necessarily be arbitrary and therefore the source of debates which will never end.

Respectfully yours,

Peter H. van Deursen

[1] The referring decision.