Registry of the Enlarged Board of Appeal
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY

For the attention of: Mr Nicolas Michaleczek (EBAamicuscuriae@epo.org).

Official Ref: G 1/23

Dear Members of the Enlarged Board of Appeal,

Amicus Curiae Brief – G 1/23

The IP Federation submits this written statement, in accordance with Article 10 of the Rules of Procedure of the Enlarged Board of Appeal, for the assistance of the Enlarged Board in considering referral G 1/23 "Solar Cell".

With apologies for submitting this statement after the date requested by the Enlarged Board, the IP Federation politely requests that the Enlarged Board nevertheless considers these concise submissions. The IP Federation would also like to express its support for the views contained in the *amicus curiae* brief of the Chartered Institute of Patent Attorneys (CIPA) in relation to this referral.

Introduction

The IP Federation represents the views of UK industry in IP policy and practice matters in the UK, Europe and internationally. Its membership of influential IP intensive companies has wide experience of how IP works in practice to support the growth of technology-driven industry and generate economic benefit. Details of the IP Federation membership are given at the end of this letter. The IP Federation membership invest heavily in IP and are very active users of the European Patent Office (EPO). This submission follows a detailed consideration in the IP Federation Council of the question referred in this case, and the views expressed are based on our members' considerable experience of prosecuting European patent applications and the opposition procedure for European patents, including proceedings before the Boards of Appeal.

Summary

In summary, the IP Federation's submission is that the answer to question 1 should be **no**; a product put on the market before the date of filing of a European patent application should not 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. Rather, if

there are features in the composition or internal structure of the product that cannot be analysed and reproduced, it is **those features** of the product that do not form part of the state of the art. Any other feature of the product which can be analysed and reproduced by the skilled person must be considered as directly and unambiguously disclosed and therefore form part of the state of the art.

It is the IP Federation's submission that the answer to question 2 should follow similar reasoning. The answer to question 2 should be **yes**; in that technical information about a product which was made available to the public before the effective date (e.g. by the publication of a technical brochure) forms part of the state of the art **to the extent that said technical information is sufficiently disclosed**. In essence, as long as a skilled person is able to reproduce a product which embodies the technical features in question without undue burden, **those features** form part of the state of the art.

In view of the answers to questions 1 and 2, an answer to question 3 is not necessary. Nevertheless, it is the IP Federation's submissions that it would not be appropriate for the Enlarged Board to set a specific test, criteria or rule to define what would constitute an "undue burden". Rather, this should continue to be assessed on a case-by-case basis following the body of case law that already exists in the area.

The Questions

Under Art. 112(1)(a) EPC, Technical Board of Appeal 3.3.03 has, by interlocutory decision T 0438/19, referred the following questions to the Enlarged Board of Appeal, assigned **G 1/23**:

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?*

The IP Federation respectfully submits the following observations as *amicus curiae*.

Admissibility of the Referral

1. The IP Federation agrees with the referring Board's identification of a divergence of case law on these points summarised at paragraph 11 of the referring decision and that it is a point of practical significance, being relevant to the assessment of both novelty and inventive step. The referral should therefore be admissible.

Observations – Question 1

2. It is the application of opinion G 1/92 of the Enlarged Board of Appeal that is relevant to the present referral. Point 1 of the headnote of G 1/92 states:

   "*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.*"

3. This is further clarified at paragraph 1.4 of G 1/92 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.*"

4. In the referring decision it appears that the key question is whether, in instances where a product is insufficiently disclosed, it is either a) entirely excluded from the state of the art, or b) only the features of the product which are insufficiently disclosed are excluded from the state of the art. It is the IP Federation's submission that the latter approach b) is correct.

5. G 1/92 (and in particular paragraph 1.4) leaves open the possibility that the composition or internal structure of a product cannot be analysed and reproduced by the skilled person, and therefore does not form part of the state of the art, but the product itself (or at least other features of the product) are available to the public. As such, the reasoning above is consistent with this.

6. If, on the contrary, the answer to this question is a), this would lead to a somewhat absurd result where features of the product which ***are*** sufficiently disclosed no longer form part of the state of the art because another, possibly unrelated, feature of the product cannot be reproduced. From a practical perspective, this would effectively provide patentees in these scenarios an opportunity to test a product on the market and then subsequently be entirely unhindered when filing for patent protection for that product, as the product put on the market prior would not form part of the state of the art at all.

7. Article 54(2) EPC states:

   *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 (emphasis added).*

8. Therefore, anything that is made available to the public by way of a disclosure (of any form) must form part of the state of the art. On this basis, it does not follow that a product which has been made available to the public, even if it none of its internal features are accessible, can be *wholly* excluded from the state of the art. In every case of a public disclosure, a member of the public will, at the very least, be able to ascertain some visible external features of the product. At least these features of the product will then form part of the state of the art. In short, if a product has been put on the market, its features must form part of the state of the art to the extent that it can be analysed and these features can be reproduced by the skilled person without undue burden. This should be determined on a case-by-case basis in relation to each relevant feature of a product.

9. The IP Federation notes the comments of the President of the EPO regarding the referral, in particular in the conclusion at paragraph 7.3, where in relation to question 1 he states "…*such a product is part of the state of the art to the extent that it has been proven that it had technical features of the invention claimed in the examined patent application or patent."* To the extent that the President is suggesting that a product put on the market must only be "proven" to comprise certain technical features for those features to form part of the state of the art, and to the extent that "proven" means anything other than *analysed and reproduced without undue burden by the skilled person,* the IP Federation respectfully disagrees.

10. The IP Federation believes this would be at odds with the EU directive on trade secrets (Directive (EU) 2016/943) and relevant provisions of the TRIPS agreement. Businesses, including members of the IP Federation, regularly rely on trade secret protection for products that are put on the market. For example, in the case of chemical compositions that cannot be easily reverse engineered (i.e. analysed and reproduced by the skilled person without undue burden, in the words of question 1). If the simple act of putting such a product on the market would make features of such products part of the state of the art if those features can be "proven" to exist in the product, this would conflict with both the EU directive on trade secrets and the TRIPS agreement.

11. The EU directive on trade secrets states, at Article 2, that:

    (1) 'trade secret' means information which meets all of the following requirements:

(a) *it is secret in the sense that it is not, as a body or in the precise configuration and assembly of its components,* ***generally known among or readily accessible to persons within the circles that normally deal with the kind of information in question****;* (emphasis added)

12. The TRIPS agreement similarly states, at Section 7, Article 39, that undisclosed information is protected as long as it:

(1) is secret in the sense that it is not, as a body or in the precise configuration and assembly of its components, ***generally known among or readily accessible to persons within the circles that normally deal with the kind of information in question****;* (emphasis added)

13. If a different standard of "*proven that it had technical features*" is applied to determine what features of a product on the market form part of the state of the art, this could lead to an absurd result where a technical feature should be protected as a trade secret, but also forms part of the state of the art for the assessment of patent protection. In contrast, if question 1 is answered in the manner outlined above, whereby features that are cannot be *analysed and reproduced without undue burden by the skilled person* (and so are not *directly and unambiguously disclosed*) are excluded from the state of the art, this would remain reconcilable with trade secret protection; it would be understood that such features would also not be *generally known among or readily accessible to persons within the circles that normally deal with the kind of information in question*.

Observations – Question 2

14. The answer to question 2 should follow similar reasoning. Technical information about a product made available to the public before the filing date forms part of the state of the art, to the extent that that technical information is sufficiently disclosed. As long as a skilled person is able to reproduce a product which embodies a technical feature disclosed in the technical information, that technical feature forms part of the state of the art.

15. The IP Federation once again notes the comments of the President of the EPO regarding the referral, in particular in the conclusion at paragraph 7.4, where in relation to question 2 he states: "*technical information about said product which was made available to the public before the filing date, in any way, e.g. by publication of technical brochure, non-patent or patent literature, is state of the art within the meaning of Article 54(2) EPC on its own, 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 and irrespective of whether the product to which it relates, or its internal composition are part of the state of the art.*"

16. To the extent that the President is suggesting that there is no requirement of reproducibility (i.e. sufficient disclosure), the IP Federation respectfully disagrees, for the same reasons outlined in relation to paragraphs 10 to 13 above. The requirement of reproducibility / sufficient disclosure in relation to technical information remains reconcilable with trade secrets protection.

Observations – Question 3

17. In view of the answers to questions 1 and 2, an answer to question 3 is not necessary. However, the IP Federation shares the views of CIPA, expressed at paragraph 4.4 of their submissions. In particular, the IP Federation shares the view that, given the facts of each case will differ, it does not appear to be appropriate for the Enlarged Board to set a threshold test, specific criteria or rule to ascertain whether a particular act, or acts, would constitute an "undue burden". Rather, this should continue to be assessed on a case-by-case basis following the body of case law that already exists in the area.

IP Federation
13 March 2024

IP Federation members 2024

The IP Federation membership comprises the companies listed below. The UK Confederation of British Industry (CBI), although not a member, is represented on the IP Federation Council, and the Council is supported by a number of leading law firms which attend its meetings as observers. The IP Federation is listed on the joint Transparency Register of the European Parliament and the Commission with identity No. 83549331760-12.

AGCO Ltd
Airbus
Arm Ltd
AstraZeneca plc
BAE Systems plc
BP p.l.c.
British Telecommunications plc
British-American Tobacco Co Ltd
Canon Europe Ltd.
Caterpillar U.K. Ltd
Cummins Ltd.
Cytiva
Dyson Technology Ltd
Eisai Europe Limited
Eli Lilly & Co Ltd
Ericsson Limited
HP Inc UK Limited
IBM UK Ltd
Johnson Matthey PLC
Merck Sharp & Dohme (UK) Ltd
Microsoft Limited
Mitsubishi Heavy Industries, Ltd.
NEC Europe
Nokia UK Limited
Ocado Group plc
Oxford Nanopore Technologies plc
Pfizer Ltd
Philips Electronics UK Ltd
Pilkington Group Ltd
Procter & Gamble Ltd
Reckitt
Regeneron UK Ltd
Renishaw plc
Rolls-Royce plc
Shell International Ltd
Siemens plc
Smith & Nephew
Syngenta Ltd
UCB Pharma plc
Unilever plc
Vectura Group plc
Vodafone Group