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## Referral G 1/23 (T 438/19): clarification on how to construe G 1/92?

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**This appeal concerns the decision of the Opposition Division rejecting the opposition against European patent EP 2 626 911. Its claim 1 specifies a material that is suitable for encapsulating a solar cell and comprises certain polymer constituents, physical properties and a specific aluminum content. In the case under appeal, the Board found that the inventive step of the subject matter of claim 1 hinges on the question whether the product ENGAGE® 8400 was *"made available to the public"* within the meaning of Art. 54(2) EPC.**

**It was undisputed that documents D1, D2, D5/5a (all except D5 having been published before the earliest priority date) demonstrate that the copolymer ENGAGE® 8400, which was commercially available before the earliest priority date, comprises all the properties of the claimed material except its aluminum content. D1 specifically referenced D18 as a document describing the preparation of ENGAGE® 8400, and D18 discloses a level of aluminum overlapping with the range defined in claim 1.**

**However, the question was to which extent the commercial availability also led to the product being *"available to the public"*.**

### 1. General principles set out by G 1/92

The previous decision G 1/92 set out a test for the *"availability to the public"* and found that the chemical composition of a product is state of the art when the following three criteria are met:

- the product as such is available to the public and
- can be analyzed by the skilled person (irrespective of the difficulty of the analysis) and
- can be reproduced by the skilled person without undue burden, irrespective of whether particular reasons can be identified for analyzing the composition.

This generally means that, if a product is on the market, but cannot be reproduced by the skilled person *"without undue burden"*, the product can still be patented later (if the patent application describes the details on how to reproduce it). As was clarified by T 952/92, reproducibility *"without undue burden"* means that reproducibility has to be enabled to the same extent that a patent application has to disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Art. 83 EPC).

In T 438/19, the Board outlined that the headnote of G 1/92 only refers to the *"chemical composition of a product"*. However, the reasons of G 1/92 set out that, if it is possible

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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.

**2. Questions referred and reasons for referral**

The referring Board has put the following three questions before the Enlarged Board of Appeal:

**a. Questions 1 and 2**

> *"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 analyzed 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 analyzed and reproduced without undue burden by the skilled person before that date?"*

Questions 1 and 2 might be paraphrased to read: what precisely is excluded from the state of the art if the test set out by G 1/92 is not passed: are the product itself and certain *"technical information"* about the product (e.g. here: its physical properties, etc.) also excluded from the state of the art?

Having regard to G 1/92, the referring Board finds that it has led to divergent case law by the Boards of Appeal. Some Boards found that in case the test (see above) set out by G 1/92 is not *"passed"*, both the product (here: ENGAGE® 8400) and its composition/structure are not comprised in the prior art (e.g., T 946/04 and T 1666/16). In particular, the referring Board notes that this interpretation might be motivated by reasons of G 1/92 according to which both the product and its composition or internal structure become state of the art if the criteria specified by G 1/92 are met.

Other Boards assumed that only the composition/structure is not prior art if the test under G 1/92 is not *"passed"* (e.g., T 370/02, T 2045/09, T 1833/14, and T 23/11). The referring Board notes that this might be motivated by the headnote of G 1/92 which only concerns the chemical composition of a product.

In the present case, the referring Board finds this distinction to be of *"decisive"* importance since in the former case, where neither the product ENGAGE® 8400 nor its composition would be prior art, the product ENGAGE® 8400 could not be considered the starting point for assessing inventive step. On the other hand, 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 be reported in documents of the state of the art, including its potential uses and advantages, make it of particular interest for the skilled person, see reasons 12.1.

**b. Question 3: standard required for analyzability and reproducibility**

> *"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 Board also finds that case law is divergent regarding the degree of detail required to comply with the required analyzability and reproducibility by the skilled person.

The referring Board found that some Boards construed G 1/92 to require a full analysis (referring to T 946/04, T 2068/15, T 877/11), while other Boards understood it to be sufficient to inform a person skilled in the art that the product had a composition falling within the terms of the claimed subject-matter (T 952/92, T 1452/16, T 2048/12, T 2458/09), see reasons 14.2.

The referring Board finds that the situation is similar for the reproducibility criterion: Some Boards have found that the exact replication of an identical copy is required in all its properties and not only in those properties specified in the relevant claim (e.g., T 977/93, T 1833/14). Other Boards have found that the reproducibility condition in G 1/92 did not require a full reproduction of the product in question (e.g., T 952/92, T 1540/21, and T 1452/16). The referring Board also discussed the decision of the High Court of England and Wales TAKEDA UK LTD v F. HOFFMANN-LA ROCHE AG [2019] EWHC 1911, wherein the High Court concluded that as long as the information the skilled person could obtain by analyzing the product enabled the skilled person to produce a version of the product anticipating the claim, the claimed subject matter lacks novelty.

## 3. Comments

**a. Exclusion from the state of the art**

The contradiction, the referring Board derives from G 1/92 may be resolved as follows: The headnote of G 1/92 details the conditions to be fulfilled for the composition of a product to be state of the art. One condition is that the *"product as such is available to the public"*. Thus, the condition defined by the headnote of G 1/92 uses the same wording as Art. 54(2) which specifies that the state of the art shall be held to comprise everything "*made available to the public*".

In other words, one of the conditions in G 1/92 seems to be that the product itself must be part of the state of the art.

The reasons 1.4 refer to both the product and its composition or internal structure becoming state of the art for a *"product put on the market"* if *"it is possible for the skilled*

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*person to discover the composition or the internal structure of the product and to reproduce it without undue burden"*. Thus, what was described as condition (*"product as such is available to the public"*) in the headnote of G 1/92 now appears to be a result of the analyzability and reproducibility of a *"product put on the market"*. However, both passages may be reconciled with each other if the latter is simply assumed to outline that – if the defined conditions are met – not only the product, but the product and its composition become state of the art.

However, the present case appears to be somewhat different from the situation described in reasons 1.4 of G 1/92 at any rate. The latter assumed a product that was only put on the market. In this situation, *"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"* (G 1/92, reasons 1.4). In the instant case, however, much of the *"technical information"* about the product was available from written prior art documents. G 1/92 does not address the question whether (partial) technical information about a product (here: properties such as density, melt flow rate, etc.) are nonetheless comprised in the state of the art, even if the conditions defined by G 1/92 are not met. It will be interesting to see which guidance the Enlarged Board of Appeal will provide in this regard.

**b. Analyzability and reproducibility**

Concerning the analyzability and reproducibility criteria, the Enlarged Board of Appeal might closely study the decision by High Court. The High Court analyzed the different opinions amongst the EPO's Boards of Appeal in detail and essentially follows what appears to be the majority interpretation of G 1/92 amongst the EPO's Boards of Appeal as set out in T 952/92:

*"Thus in the board's view, the novelty of a claimed invention is destroyed by the prior use of a product, for example, sale of a product, if an analysis of a product using available analytical techniques is such as to inform the skilled person of an embodiment of the product which* ***falls within the claim of the patent****. The board therefore* ***does not accept*** *the patent proprietor's submissions to the effect that a* ***complete analysis*** *of a prior used product must be possible, so as to enable an* ***exact reproduction*** *of such product, in order to destroy the novelty of the claimed product"* (T 952/92, reasons 2.3).

It seems likely that the Enlarged Board of Appeal will largely follow the reasoning of the High Court. The referring Board has so far represented what appears to be a minority opinion and seeks clarification from the Enlarged Board of Appeal with the instant *ex officio* referral. Notably, it even states that requiring exact reproducibility would entail "*the use of subjective criteria, resulting in legal uncertainty*" (reasons 13.2.2). Indeed, it would be unclear, at best, what exact reproducibility means and whether it would depend on the tolerances as defined for the product by the original manufacturer.

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