Update on G 1/23

The Preliminary Opinion of the Enlarged Board of Appeal on the Referral ›Solar cell‹

Introduction into the matter of G 1/23

After receiving a multitude of Amicus curiae briefs, observations by the Opponent and the Proprietor from the interlocutory decision T 438/19, and comments from the EPO President, the Enlarged Board of Appeal has issued their Preliminary Opinion in the Referral G 1/23 (›Solar cell‹).

G 1/23 is essentially concerned with the question if reproducibility should be a requirement for products put on the market to form part of the state of the art within the meaning of Article 54(2) EPC, and, if so, to what extent.

More specifically, the questions are as follows:

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?

This referral can be seen as the culmination of the diverging jurisprudence emerging subsequent to G 1/92, in which such a reproducibility requirement for commercial products was introduced. Especially in the field of polymer chemistry, this requirement has proven to be rather critical, as the reproduction, in particular the identical reproduction of polymers, is historically difficult if not impossible.

In their Preliminary Opinion, the Enlarged Board has taken a rather philosophical perspective on reproducibility with far reaching implications for other types of state of the art, such as written disclosures.

Summary of the Preliminary Opinion of the Enlarged Board of Appeal

The Enlarged Board preliminarily concludes that there is no legal basis for a reproducibility requirement for products put on the market. Although they acknowledge that this would somewhat deviate from the well-established case law regarding the enablement requirement for written disclosures originally based on T 206/83, the Enlarged Board also emphasizes that *»general acceptance in the case law cannot substitute a lacking legal basis of a legal concept, in particular where other interpretations also appear reasonable«* (par. 21).

In addition to a lack of legal basis for the reproducibility requirement, the Enlarged Board further elaborates that basically *»everything under the sun«* (par. 27) would be excluded from the state of the art under this requirement,

as somewhere in every reproduction chain a starting material would have to be used, which itself is not reproducible, such as for example chemical elements (par. 29).

In the opinion of the Enlarged Board, this further implies that written disclosures would also not be enabled, as the materials used to reproduce the written teaching would again not be reproducible.

Accordingly, the Enlarged Board is of the opinion that this consequence of the reproducibility requirement, i.e., the exclusion of physically existing products from the state of the art, directly contradicts everyday experience and that such a legal fiction was not intended by G 1/92 (par. 26).

As a solution to this predicament, the Enlarged Board proposes to assume that *»the enablement requirement foreseen by G 1/92 is also satisfied by the non-reproducible product in its readily available form, so that a* ***physical product is by definition enabled by being put on the market****«* (par. 32, emphasis added).

Consequentially, non-reproducible commercial products with all their analysable properties and features would form part of the state of the art.

Regarding non-analysable features, the Enlarged Board considers it undisputed that such non-analysable features would not form part of the state of the art (par. 31).

In conclusion, the current proposition of the Enlarged Board for the answers to the referred questions is that Question 1 has to be answered with »no«, so that a lack of reproducibility does not lead to the exclusion of a commercial product from the state of the art. Question 2 regarding technical information of an irreproducible product would be answered in the affirmative and Question 3 concerned with the degree of reproducibility would be moot for this combination of answers.

Remarks

The proposed assumption that a physical product is by definition enabled by being put on the market seems to be an elegant solution to the depicted issues and also appears to not interfere with the established case law for written disclosures. Overall, this approach seems to represent the reality quite adequately as commercial products are valuable assets for the skilled person and their exclusion from the start of the art would be rather unfounded. Further, unwanted consequences of a reproducibility requirement such as subsequent patenting of an already existing product can be avoided and uncertainties regarding the necessary degree of reproduction or about what constitutes the composition or internal structure of a product would no longer have to be addressed.

However, some of the issues that were raised in the Amicus curiae briefs or the observations by the parties still remain in need of clarification.

For example, would the commercial product, in particular the available technical information thereof, cease to be state of the art when the product is no longer available on the market?

Will the EPO introduce a concept similar to the›on-sale bar‹ limitation known from the USPTO (35 U.S.C. § 102) that grants an inventor a grace period of 1 year before the commercial product becomes state of the art when the commercial product is put on the market by the inventor himself?

At least for the latter question an affirmative answer seems rather improbable, since the EPO generally does not grant grace periods for filing applications after an inventor's own prior public disclosure, contrary to other jurisdictions such as the US or Germany (for utility models).

Outlook

Since the Oral Proceedings in proceedings concerning the interlocutory decision T 438/19 are scheduled to take place 15 to 17 October 2025, a decision on G 1/23 can be expected next summer. It will be highly interesting to see if the Enlarged Board will deviate from their current position as elaborated in their Preliminary Opinion and if they will give further guidance for some of the remaining issues that the Preliminary Opinion does not address.

Dr. Berthold Lux
/ Partner
/ German Patent Attorney
/ European Patent Attorney
/ UPC Representative
/ Chemist

Dr. Gabriel Kiefl
/ Senior German and European Patent Attorney Trainee
/ M.Sc. Chemistry