

New referral to EPO over hidden internal structure or composition in prior art

Edward Farrington of Inspicos reports that guidance is being sought from the EPO Enlarged Board of Appeal three decades after a decision on the analysis of complex products

Patentees and patent applicants before the EPO are occasionally faced with prior art – for example, products which have been put on the market – the internal structure or composition of which is not clear without further investigation. In mechanical fields, such products might be devices or apparatuses which have to be disassembled or broken up to determine the contents. In the chemical field, such products might be polymers or similar chemical compositions, which are difficult or impossible to analyse.

[Enlarged Board decision G 1/92](#) (OJ EPO May 1993) considered what “hidden properties” such products actually disclosed. Decision G 1/92 found that “[t]he 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... 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.”

Although decision G 1/92 is regularly relied upon by parties before the EPO, it did not clearly explain the meaning of the phrases “reproduce without undue burden”, “available to the public”, and “can be analysed”. Divergent case law has developed since G 1/92: some decisions requiring a high level of certainty when analysing hidden properties, others requiring a less complete analysis, and still other decisions excluding such disclosures from the state of the art altogether.

The Enlarged Board of Appeal (EBA) has therefore been asked to clarify some of the issues remaining after G 1/92 in a new referral, G 1/23.

In particular, the EBA will consider whether a marketed product can be excluded from the prior art if its composition or internal structure cannot be analysed. It will also consider whether technical information about a marketed product is state of the art, regardless of whether the composition or internal structure of the product can be analysed. The EBA is also being asked to clarify which criteria apply in determining whether the composition or internal structure of a product could be analysed and reproduced without undue burden.

It is hoped that decision G 1/23 will provide guidance as to which level complex products such as polymers must be analysed if they are to be considered state of the art.