

Enlarged Board of Appeal, 18 December 1992,
Availability to the public



PATENT LAW

The composition of 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 without undue burden

- The 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, irrespective of whether or not particular reasons can be identified for analysing the composition.
- The same principle applies mutatis mutandis to any other product.
- An essential purpose of any technical teaching is to enable the person skilled in the art to manufacture or use a given product by applying such teaching. Where such teaching results from a product put on the market, 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. 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.

No implicit disclosure of extrinsic characteristics which are only revealed when the product is exposed to interaction with specifically chosen outside conditions

- It may be added that a commercially available product per se does not implicitly disclose anything beyond its composition or internal structure. Extrinsic characteristics, which are only revealed when the product is exposed to interaction with specifically chosen outside conditions, e.g., reactants or the like, in order to provide a particular effect or result or to discover potential results or capabilities, therefore point beyond the product per se as they are dependent on deliberate choices being made.

Typical examples are the application as a pharmaceutical product of a known substance or composition (cf. Article 54(5) EPC) and the use of a known compound for a particular purpose, based on a new technical effect (cf. G 2/88, OJ EPO 1990, 93).

Thus, such characteristics cannot be considered as already having been made available to the public.

No distinction between means of information

- It should also be noted that Article 54(2) EPC does not make any distinction between the different means by which any information is made available to the public. Thus, information deriving from a use is governed in principle by the same conditions as is information disclosed by oral or written description.

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Enlarged Board of Appeal, 18 December 1992

(P. Gori, C. Payraudeau, O. Bossung, G. Gall, E. Persson, G. Szabo en P. van den Berg)

Case Number : G 1/92

OPINION of the Enlarged Board of Appeal of 18 December 1992 on a point of law referred to the Board by the President of the European Patent Office under Article 112(1)(b) EPC.

Summary of the Procedure

I. On 30 December 1991, the President of the European Patent Office, making use of his power under Article 112(1)(b) EPC, referred to the Enlarged Board of Appeal the following points of law:

"1) Is the chemical composition of a product made available to the public by virtue of the availability to the public of that product, irrespective of whether particular reasons can be identified to cause the skilled person to analyse the composition?"

and, if the answer to this first question is positive,

"2) Does the principle extend to the more general case whereby all information which can be obtained from a product is made available to the public by virtue of the availability of that product, irrespective of whether particular reasons exist to cause the skilled person to search for that information?"

II. The President referred to the decisions in cases T 93/89 (to be published) and T 406/86 (OJ EPO 1989, 302) and made essential the following submissions: The Board of Appeal 3.3.3 had in the case T 93/89 disregarded late filed evidence of a prior public use on the grounds that it was not relevant. As part justification, the Board stated that the composition of a product was not made available to the public by virtue only of the availability of the product to the public. The Board held that a particular reason (ausreichender Anlaß) must be identified why the skilled person would have analysed the product. In particular, the Board stated that the simple fact that a new product is introduced onto the market is no necessary reason for a competitor to analyse the composition of the product.

In contrast with this decision, the Board of Appeal 3.3.1 held in case T 406/86 that the availability to the public of a product should be considered as also making its composition available when it can be determined without any difficulty by chemical analysis.

III. The President stated that although the divergence occurred in respect of the composition of a chemical product, the principle was relevant to all technical areas

as regards disclosure by prior use of characteristics which are not immediately visible but can only be ascertained by, for example, dismantling or destroying the product.

Reasons for the Opinion

1. The points of law referred to the Enlarged Board of Appeal by the President of the EPO relate to the application of Article 54(2) EPC which defines the content of the state of the art as follows:

"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".

1.1 These points of law concern the interpretation of the requirement "made available to the public" in relation to the prior use of a product. In this context, it should be noted that the EPC does not make any distinction between chemical products and other products such as mechanical or electrical articles.

It should also be noted that Article 54(2) EPC does not make any distinction between the different means by which any information is made available to the public. Thus, information deriving from a use is governed in principle by the same conditions as is information disclosed by oral or written description.

1.3 The Enlarged Board of Appeal considers it appropriate to make first some general remarks on the kind of information which can be derived from the public use of products for the purpose of the application of the requirement "made available to the public" in Article 54(2) EPC.

1.4 An essential purpose of any technical teaching is to enable the person skilled in the art to manufacture or use a given product by applying such teaching. Where such teaching results from a product put on the market, 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. 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.

2. There is no support in the EPC for the additional requirement referred to by Board 3.3.3 in case T 93/89 (cf. point II above) that the public should have particular reasons for analysing a product put on the market, in order to identify its composition or internal structure. According to Article 54(2) EPC the state of the art shall be held to comprise everything made available to the public. It is the fact that direct and unambiguous access to some particular information is possible, which makes the latter available, whether or not there is any reason for looking for it.

2.1 The introduction of such an additional requirement would remove a commercially available and reproducible product from the public domain. It would mean an unfounded deviation from the principles applied in respect of the other sources of the state of the art as defined in Article 54(2) EPC and it would

obviously represent an element of subjectivity leading to uncertainty in applying the concept of novelty as defined in this Article.

3. It may be added that a commercially available product per se does not implicitly disclose anything beyond its composition or internal structure. Extrinsic characteristics, which are only revealed when the product is exposed to interaction with specifically chosen outside conditions, e.g., reactants or the like, in order to provide a particular effect or result or to discover potential results or capabilities, therefore point beyond the product per se as they are dependent on deliberate choices being made. Typical examples are the application as a pharmaceutical product of a known substance or composition (cf. Article 54(5) EPC) and the use of a known compound for a particular purpose, based on a new technical effect (cf. G 2/88, OJ EPO 1990, 93). Thus, such characteristics cannot be considered as already having been made available to the public.

CONCLUSION

For these reasons, the Enlarged Board of Appeal, in answer to the questions put by the President of the EPO in the letter dated 30 December 1991 concludes that:

1. The 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, irrespective of whether or not particular reasons can be identified for analysing the composition.

2. The same principle applies mutatis mutandis to any other product.
