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THE TRICKY BUSINESS OF PUBLIC PRIOR USE AT THE EUROPEAN PATENT OFFICE

According to the European Patent Convention, the state of the art for a European patent application or a European patent includes *"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."* This means that a public prior use of the invention, made before the filing date of the European patent application, also forms part of the state of the art for that application.

Of course, while showing what a traditional publication (e.g. a patent application, a scientific article, a textbook) actually discloses is very simple, because all that is needed is the actual publication itself, showing what was disclosed by way of a public prior use is far from simple. This becomes particularly tricky in oppositions filed against granted European patents, as it often happens that the opponent relies on a public prior use made prior to the filing date of the European patent to argue that the patent is invalid.

As a result, the Boards of Appeal (BoAs) of the European Patent Office (EPO) have built up quite a substantial body of case law to determine which party carries the burden of proof when it comes to prior public use – i.e. whether it is the opponent or the patentee. In general, BoA case law holds that when the evidence relating to the public prior use lies fully within the power and knowledge of the opponent – e.g. because it is the opponent that made such prior public use of the invention – then the burden of proof rests entirely with the opponent and the threshold to be met is that of 'beyond reasonable doubt'.

In a very recent decision of September 2021, the BoAs have had to address this question again. In that decision, the opponent had argued that the claimed invention (a turbocharger) was anticipated by the prior public use of a vehicle with the turbocharger sold as a component of the vehicle. The patentee countered that evidence by arguing that the vehicle in question was entirely within the opponent's control and that the opponent had not shown that the vehicle actually contained a turbocharger that included all the features of the claim.

Instead, the BoA found that because the turbocharger was mass-produced, and was an item with a relatively long lifespan, the patentee could have collected evidence to show that the turbocharger used in the vehicle in question was not the one asserted by the opponent.

The BoA held that in this case, exceptionally, the content of the public prior use was not solely within the power and knowledge of the opponent, and that instead the patentee was in a position to provide actual counter-evidence to address that prior use. The BoA added that, in the present case, any investigation by the patentee to collect information and evidence on the mass-produced turbocharger did not represent an undue burden. The BoA stated that under those circumstances *"the appropriate standard of proof to apply to the prior use OV was the 'balance of probabilities'."*

The BoA's decision in this case represents an important guidance on when the burden of proof and the threshold to be met in the context of an allegation of public prior use can actually change in the course of opposition proceedings at the EPO, and will surely be helpful in future opposition proceedings, both for patentees and for parties challenging the validity of a patent.

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