

Examiners' Report on Paper A/1992 (Chemistry)

There were numerous aspects of the invention in the client's letter that could be found by the candidates. Thus, product claims directed to compounds defined by a general formula, claims to their preparation, claims to herbicidal compositions based on these compounds and claims to the use of these compounds were expected. The claims directed to the use of the compounds could be worded as process, method or use claims. These latter claims directed to the use of the compounds will further be referred to as "use claims" in this report. In view of the prior art the use claims were necessary to cover part of the disclosure which could not be included in the product and composition claims.

Candidates should have realised that Document III disclosed a compound falling within the scope of the general formula. Many among them correctly filed a product claim including a disclaimer to avoid the novelty objection in the terms of the single compound disclosed in Document III. This disclaimer was however often drafted more broadly than was necessary. In some cases even examples (e.g. compound I) of the client's letter were excluded from the claims. Such defects resulted in some loss of marks.

It should be mentioned that since Document III dealt with additives for lubricants and polymers and not with herbicides it was necessary only to exclude the specific compound of example 2 from the product claims.

A claim for a product cannot be delimited from known compounds by the use of a phrase such as "for use as a herbicide" in the claim (cf. the Guidelines C-III, 4.8). Decisions G 2/88 and G 6/88 clearly and only refer to use claims. Such a broad product claim covering the compound known from example 2 of Document III resulted in a significant loss of marks due to lack of novelty.

The use by some candidates of erroneous nomenclature instead of the structural formula provided by the client led to a lack of clarity or even to misdescription.

As indicated above, candidates were also expected to draft a claim to a process for the preparation of the novel chemical compounds for which claims some further marks were allocated (cf. the Guidelines C-IV, 9.5a).

Claims for herbicidal compositions were expected also. The broadest protection possible could be obtained by drafting claims relating to compositions including two essential components: in the first place - as an active ingredient - the compounds of the general formula without disclaiming the known compound from example 2 of Document III and, in the second place, one or more additives. Such a wording was necessary in order to

unambiguously exclude the pure compound per se. Otherwise such a claim would not provide a distinction over the prior art, thus leaving the claim open to a novelty objection based on Document III. Such a poor claim resulted in a significant loss of marks.

A claim for a herbicidal composition containing as an active ingredient at least one compound as claimed in the product claims did not give the broadest protection possible since it excluded the known compound of Document III which could have been included in the composition claims. Such a claim defined novel subject-matter but, due to the disclaimer, was not of the broadest scope possible which, again, resulted in marks being lost.

Many candidates filed claims directed to the use of the compounds in controlling weeds. These claims were worded as use and/or as process and/or as method claims ("use claims" for short). These wordings were deemed equivalent. Such use claims made it possible to extend the protection sought to the first embodiment in paragraph 2 of page 5 of the client's letter.

A wider claim relating to the use of the compounds in the treatment of agricultural areas could be based on paragraph 3 of page 4 of the client's letter. Such a broader claim attracted additional marks.

In some of these use claims the definition of the compounds was limited to that of the product claims, which was not necessary. Again such claims resulted in some marks being lost.

The number of marks awarded to independent and especially to dependent claims is limited. The examiners came to the conclusion that candidates filing large numbers of claims directed to many or even to each and every detail of the client's letter had not analysed the client's letter sufficiently and determined what were the essential points. The answer papers were marked accordingly (cf. Rule 29 EPC and the Guidelines C-III, 5.1).

Paragraph 4 of the Instructions to Candidates requires to prepare independent claims having a good chance of succeeding before the EPO. An independent claim clearly not meeting the requirements of Art. 52 (1), especially the novelty requirement of Art. 54, with respect to the prior art already considered relevant by the client and therefore cited in the client's letter, demonstrates that the candidate did apparently not recognise that this independent claim could not be successful. This is a major deficiency.

# EXAMINATION COMMITTEE I

Candidate's answer sheet No. ....

Report by examiner No. ....

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FORM, for use by individual examiners, in PAPER A (Chemistry)

## Schedule of marks

Category	Maximum possible	Individual marks awarded	Where <b>grades</b> awarded are not identical	
			Revision of marks/grade (if any)	Remarks*
Claims: - Scope of protection = independent claim or claims	24			
	16			
Description: (Field and prior art, problem and/or discovery, solution and advantages)	8			
<b>TOTAL</b>	<b>48</b>			
<b>CORRESPONDING GRADE</b>				

### Translation of marks into grades

	Grade
0 - 11	7
12 - 17	6
18 - 23	5
24 - 29	4
30 - 35	3
36 - 41	2
42 - 48	1

\* to be filled in if both the following requirements are fulfilled:

- (a) the grades awarded by the two individual examiners before their discussion differ by two grades or more;
- (b) the marks awarded by at least one of the two individual examiners have been changed during their discussion.

If remarks are to be filled in, they should briefly explain why the examiner has changed his marks.