

1. Paper B calls upon a candidate to respond effectively to a communication from an examiner. The marks are rewarded for the amended claims, and half for the supporting argumentation. The present paper tested a candidate's proficiency in drafting certain specific kinds of claims, namely first and second medical use type claims.

2. The candidates should have realised that:

- document DI disclosed insecticidal compounds anticipating all product claims except for those compounds in Tables I and II wherein R=benzyl. (A compound in which R = butyl was also not anticipated by DI, but it was difficult to justify inventive step for such a compound).

Candidates should also have realised that:

- document DII related to pharmaceutical compounds which also fell inside the original claims and which were effective against intestinal infections by pathogenic microorganisms.

There was therefore room for the following kinds of claim:

- compounds of formulae (III) and (V) where R= benzyl, m=3 and n=4. These compounds were not disclosed in DI or DII and were shown to be extremely effective against cancer (see Tables I and II of the description).
- a first medical use claim ("Compounds ... for use as pharmaceuticals") (see the Guidelines C-IV, 4.2 and T128/82) of compounds of the formulae (III) and (V) (or (I)), where R, R' and R'' are hydrogen atoms, C1-C5-alkyl or benzyl radicals, at least one of R, R' and R'' not being hydrogen. This claim was to cover those compounds which were stated to be effective against cancer (i.e. the compounds of formulae (III) and (V); see 76/40-41 of the English paper) and which were not disclosed in DII. The disclosure for R being C1- to C5-alkyl or benzyl could be found on 75/38-44 of the English version.
- a second medical use ("Use of the compounds ... for making a pharmaceutical for treating cancer") for the compounds of formulae (III) and (V) (see Guidelines C-IV, 4.2 and G05/83). None of the documents disclosed that these compounds might be useful in the treatment of cancer or gave any indications in that direction.

3. Several candidates did not realise that first and/or second medical use claims could have a wider scope, in terms of the formulae, than claims to the compounds themselves. Instead, they restricted the first and second medical use claims to certain specific compounds or to the compounds of formula (V) only. This resulted in a loss of marks. The description clearly stated (see 76/40-41) that the compounds of formulae (III) and (V) in general were effective against cancer.

Other candidates failed to note that product per se claims were available at all. This also resulted in a significant loss of marks.

4. Claims such as those set out in point 2 above generally gave no problem with unity. The general inventive concept of the claim could be seen in the structural similarity of the groups, coupled with the effectiveness of the claimed compounds against cancer. Some candidates who did not file claims along the above lines (perhaps because they assumed that the prior art disclosed more than was in fact the case), realised that they had ended up with a set of claims which were lacking in unity. Whilst a non-optimal scope inevitably resulted in loss of marks, if the candidate noted the lack of unity and suggested possibly in a note to the examiners marking the paper a divisional application

then no additional points were lost. Occasionally, however, candidates erred in regarding unity claims which were, in fact, defensible as being unitary. This did lead to a loss of marks.

5. In the argumentation, a number of marks were awarded for clearly pointing out the derivation of the new claims, and in general this was done well.
6. In the letter of reply, the candidates were expected to refer to all the objections raised in the communication, including the lack of clarity objection raised against original claim 4 and the objection under Article 52 (4) EPC raised against claim 7, if only to point out that the objections no longer applied to the amended claims. The letter of reply was expected to be clear, to the point, and set out in a logical and structured manner. A chaotic response led to a loss of marks.
7. A small number of candidates spent a considerable amount of time agreeing with the findings as to novelty of the examiner in the EPO communication. This was not only unnecessary, but also unfortunate, as such admissions may prove prejudicial in both subsequent examination and national infringement or validity actions. Consequently, marks were deducted for over-zealous admissions.
8. No additional marks were given for formal requests for a hearing, oral proceedings, an interview with the examiner, or a further communication, etc. The same applied to further examples to be filed in order to support the arguments on inventive step.
9. Many candidates appended to their answers a short note to the examiners marking their paper. Whilst such notes may be helpful in clarifying the reasons the candidate has opted for a given approach, in some cases it was felt that the matter contained in the note could more profitably have been taken up in the response to the EPO communication.

EXAMINATION COMMITTEE I

Candidate No.

Paper B (Chemistry) 1999 - Schedule of marks

Category	Maximum possible	Marks awarded		Marking by further examiners if any	
		Marker	Marker	Marker	Marker
Claims	50				
Argumentation	50				
Total	100				

Sub-Committee for Chemistry agrees onmarks and grade

	PASS
	COMPENSABLE FAIL
	FAIL

The Hague, 18 August 1999

J. Combeau - Chairman of Examination Committee I