

Examiners' Report on Paper B/1992 (Chemistry)

It should have been recognised by the candidates - and a majority did so - that all the claims of paper B were anticipated by the documents cited in the communication.

The candidates were expected to present use claims in accordance with the decisions G 2/88 and G 6/88 and thus to demonstrate that they were aware of these decisions. They were also expected to present claims directed to herbicidal compositions in which the active ingredients were defined in a particular way. These items are discussed in more detail below. Moreover, a claim relating to a specific product was possible.

In addition to claims meeting the requirements of Art. 123 (2) EPC the candidates were also expected to produce arguments in support of novelty and inventive step of the subject-matter of their claims, based on the information and advantageous results given in the application, e.g. in the examples. The candidates should not have relied on any further information or evidence which could possibly be provided or not by the client.

A number of candidates did not realise that the closest prior art documents as regards novelty and inventive step are not necessarily identical and that the problem to be solved is only considered with respect to inventive step. "The question - is there inventive step? - only arises if there is novelty." (Guidelines C-IV, 9.1, last sentence). Both criteria should have been considered separately. Candidates mixing up both criteria could not get the full number of marks.

On the other hand, many candidates recognised Document II, which also relates to a herbicidal composition, to be the closest prior art as regards inventive step, and they defined the problem to be solved with respect to this closest prior art to lie in an improvement of the herbicidal activity and a reduction of any disadvantageous effects, e.g. damaging of the crop. They also considered Documents IV and V and came to the conclusion that these documents did not disclose or suggest the herbicidal use of the compounds of the general formula in suit.

Many candidates explained in their letter where the features of the amended claims could be found in the original disclosure (Guidelines E-II, 1). The candidates were given credit for this.

Some candidates were not aware of the fact that Decisions G 2/88 and 6/88 (second non-medical use) do not relate to claims for "a physical entity", i.e. a substance or product, a composition or "ein Mittel", but to claims for "a physical activity", i.e. a process, a method or a use (points 2.2, 2.3 of both and 7 or 9 of G 2/88 and G 6/88, respectively).

A number of candidates did not give arguments consistent with the wording of the claims.

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Most candidates realised that product claims relating to the compounds in the scope of original claim 4 of paper B were no longer possible in view of the Documents IV and V.

Some candidates filed a claim limited to compound III and argued that none of the documents suggested that this compound would solve the problem to provide herbicidal active agents having improved properties compared to the closest prior art, Document II, and as shown in the examples of paper B. Such a claim and such arguments were accepted.

A process claim directed to the preparation of this new compound got some marks as well in view of the Guidelines C-IV, 9.5a.

A process claim directed to the preparation of compounds of the general formula in its broadest scope further limited by some additional feature (e.g. use of propionitrile as solvent) did not attract any marks because there was no basis in the application for arguing that there was an inventive step.

As indicated above the candidates were also expected to draft an independent claim to a herbicidal composition comprising compounds IV and V and at least one additive based on the superior results demonstrated in both tables for these two compounds and some candidates did so. This claim could also specify compound III as active ingredient because it is distinguished over the disclosure of Document II. Furthermore the disclosure of Document IV could not prejudice a composition based on this compound either. Such a broad claim was given some additional marks.

It had to be kept in mind that a composition claim had to include the presence of an additive in order to avoid a novelty objection.

Claims were suggested by some candidates directed to compositions which claims had their original broad wording but were limited in respect of the additives they contained. Such claims did not attract any marks as there was no basis in the application for arguing that there was an inventive step.

Many of the candidates drafted acceptable use claims. These use claims were often presented as process or method claims which were deemed equivalent (cf. the Guidelines C-III, 3.1 and Decision G 2/88). Reference is also made to Decisions G 1/83, G 5/83 and G 6/83, point 13 of the Reasons for the Decision, pointing out that a use claim "is in no way different in essential content" from a method claim. This means, however, that where both a use claim and a method or process claim of this kind were presented additional marks were normally not awarded.

FORM, for use by individual examiners, in PAPER B

Schedule of marks

Category	Maximum possible	Individual marks awarded	Where grades awarded are not identical	
			Revision of marks/grade (if any)	Remarks*
Claims:	24			
Argument	24			
TOTAL	48			
CORRESPONDING GRADE				

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.