

#### 4.16 Use claims

GL/ISPE A5.21

The EPO applies the first sentence concerning "use" claims of point GL/ISPE A5.21 of the Appendix to Chapter 5 of the ISPE Guidelines.

Thus a claim in the form "the use of substance X as an insecticide" should not be interpreted as directed to the substance X recognisable (e.g. by further additives) as intended for use as an insecticide. Similarly, a claim for "the use of a transistor in an amplifying circuit" would be equivalent to a process claim for the process of amplifying using a circuit containing the transistor and should not be interpreted as being directed to "an amplifying circuit in which the transistor is used", nor to "the process of using the transistor in building such a circuit". However, a claim directed to the use of a process for a particular purpose is equivalent to a claim directed to that very same process.

Care should be taken when a claim relates to a two-step process which combines a use step with a product production step. This may be the case e.g. when a polypeptide and its use in a screening method have been defined as the only contribution to the art. An example of such a claim would then be:

"A method comprising:

- (a) contacting polypeptide X with a compound to be screened and
- (b) determining whether the compound affects the activity of said polypeptide;

and then formulating any active compound into a pharmaceutical composition."

Many variations of such a claim are conceivable, but in essence they combine (a) a screening step (i.e. using a specified test material to select a compound having a given property) with (b) further production steps (i.e. further transforming the selected compound for instance into the desired composition).

Two different types of process claim exist: (i) the use of an entity to achieve a technical effect and (ii) a process for the production of a product. The above claim and its analogues represent a combination of two different and irreconcilable types of process claim. Step (a) of the claim relates to a process of type (i), step (b) to a process of type (ii). Step (b) builds on the "effect" achieved by step (a), rather than step (a) feeding into step (b) a specific starting material and resulting in a specific product. This results in an unclear claim according to Art. 6.

#### 4.17 References to the description or drawings

Rule 6.2(a)

See ISPE Guidelines 5.10.