

For the assessment of novelty of claims containing parameters, see GL/PCT-EPO G-VI.6.

For further issues relating to clarity, lack of support and sufficiency of disclosure regarding parameters, see GL/PCT-EPO F-III.11, and GL/PCT-EPO F-IV.6.4.

4.12 Product-by-process claim

Claims for products defined in terms of a process of manufacture are allowable only if the products as such fulfil the requirements for patentability, i.e. inter alia that they are new and inventive. A product is not rendered novel merely by the fact that it is produced by means of a new process. A claim defining a product in terms of a process is to be construed as a claim to the product as such. The claim may for instance take the form "Product X obtainable by process Y". Irrespective of whether the term "obtainable", "obtained", "directly obtained" or an equivalent wording is used in the product-by-process claim, it is still directed to the product per se and confers absolute protection upon the product.

GL/ISPE 5.26

As regards novelty, when a product is defined by its method of manufacture, the question to be answered is whether the product under consideration is identical to known products. The burden of proof for an allegedly distinguishing "product-by-process" feature lies with the applicant, who has to provide evidence that the modification of the process parameters results in another product, for example by showing that distinct differences exist in the properties of the products. Nevertheless, the examiner needs to furnish reasoned argumentation to support the alleged lack of novelty of a product-by-process claim, especially if this objection is contested by the applicant.

The EPO applies option GL/ISPE A5.26[1] of the Appendix to Chapter 5 of the ISPE Guidelines.

4.12.1 Product claim with process features

Section F-IV.4.12.1 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

4.13 Interpretation of expressions stating a purpose

Section F-IV.4.13 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

GL/ISPE 5.21, 5.23

For claims directed to a known substance or composition for use in a surgical, therapeutic or diagnostic method, see GL/PCT-EPO G-II.4.2.

4.14 Definition by reference to use or another entity

Section F-IV.4.14 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

GL/ISPE 5.37

4.15 The expression "in"

Section F-IV.4.15 in the Guidelines for Examination in the EPO applies *mutatis mutandis*.