

of the process parameters resulted in other products. It was sufficient for this purpose if it was shown that distinct differences existed in the properties of the products. This evidence might not include properties which could not be due to the product's substance parameters. See also T 279/84, T 151/95, T 728/98, T 564/02, T 1247/03.

In T 300/89 (OJ 1991, 480) it was stated that the application lacked novelty if the claim neither defined the product structurally nor mentioned all the specific conditions needed to obtain necessarily the products whose novelty could be demonstrated, e.g. by means of comparative tests. Similarly, in T 552/91 (OJ 1995, 100) the board ruled that the claim had to include all the process parameters required for unambiguously defining the claimed substances as inevitable process products. As chemical reactions only rarely took one particular course and therefore only rarely led to uniform substances, it was generally necessary to indicate not only the starting materials and reaction conditions, but also the method by which the reaction mixture was processed to obtain the claimed substances. This case law was confirmed in T 956/04, where the board considered that without clearly indicating the specific starting materials and the specific reaction conditions, the "obtainable-by" features as claimed failed to unequivocally define the claimed catalysts as inevitable process products.

In T 728/98 (OJ 2001, 319) the board stated that the general rule that the level of purity of a low molecular chemical compound could not entail novelty was also valid in the case of a product-by-process claim where the purity level was the inevitable result of the preparation process indicated in the claim. In the case in hand the appellant (applicant) had not been able to prove the existence of an exceptional situation where all attempts had failed to achieve a particular level of purity by conventional purification methods. See also chapter I.C.6.2.4. "Achieving a higher degree of purity".

In T 803/01 the board noted that there was no statement whatsoever in T 205/83 (OJ 1985, 363) which prohibited the presence of parameters relating to impurities in a claim for reasons of clarity. The parameters relating to the purity of the polylactides were technical features in line with R. 29(1) EPC 1973. This was considered to be a relevant criterion for assessing the extent to which the use of purity parameters in a product claim was allowable from the point of view of clarity (G 2/88, OJ 1990, 93).

In T 394/03 the board ruled that improved product quality achieved by means of a process did not generally constitute, in a product-by-process claim, a structural feature giving rise to novelty or inventive step. In the case in hand, a decorated ceramic product was claimed which differed from known products of this type only by virtue of its better quality, which had been achieved by means of the process according to the invention.

In T 564/02, when examining whether the product itself met the requirements for patentability, the board had to deal with the burden of proof. The respondent (opponent) had raised an objection of lack of novelty which was based on the disclosure in an example in a prior art document. The board observed that the validity of this objection rested exclusively on the validity of certain assumptions made by the respondent with respect to parameters of the product disclosed in prior art. In such a case, the concept of the balance of probabilities could not be applied for the assessment of the validity of each assumption;