

they were interpreted in accordance with Art. 69 EPC 1973 and its Protocol. In this context, the national laws of the contracting states relating to infringement should not be considered, for there was a clear distinction between the protection which was conferred and the rights which were conferred by a European patent. The **protection conferred by a patent** was determined by the terms of the claims (Art. 69(1) EPC 1973), and in particular **by the categories of such claims and their technical features**. In contrast, the rights conferred on the proprietor of a European patent (Art. 64(1) EPC 1973) were the legal rights which the law of a designated contracting state might confer upon the proprietor. In other words, in general terms, determination of the "extent of the protection conferred" by a patent was a determination of what was protected, in terms of category plus technical features; whereas the "rights conferred" by a patent were related to how such subject-matter was protected. When deciding upon the allowability of an amendment involving a change of category, the considerations were, in principle, the same as when deciding upon the allowability of any other proposed amendment under Art. 123(3) EPC 1973.

### 2.7.1 From product claim to a claim directed to the use of the product

#### a) Different categories of use claims

Enlarged Board decision G 2/88 (OJ 1990, 93) related to a change of claim category in opposition proceedings, and in particular to the change from a product claim to a claim directed to the use of the product for a particular purpose, which the Enlarged Board allowed for the use of a particular physical entity to achieve an effect. The **protection conferred by a patent** was determined by the terms of the claims (Art. 69(1) EPC 1973), and in particular **by the categories of such claims and their technical features**. An amendment of granted claims directed to "a compound" and to "a composition including such compound", so that the amended claims were directed to "the use of that compound in a composition" for a particular purpose, was not open to objection under Art. 123(3) EPC 1973. For it was generally accepted as a principle underlying the EPC that a patent which claimed a physical entity per se, conferred absolute protection upon such physical entity, for all uses of such physical entity, whether known or unknown. It followed that if it could be shown that such physical entity (e.g. a compound) was already part of the state of the art, then a claim to the physical entity per se lacked novelty. It also followed that a claim to a particular use of a compound was in effect a claim to the physical entity (the compound) only when it was being used in the course of the particular physical activity (the use), this being an additional technical feature of the claim. Such a claim therefore conferred less protection than a claim to the physical entity per se.

However, the Enlarged Board distinguished between use claims, which define the use of a particular physical entity **to achieve an "effect"**, and claims which define such a use **to produce a "product"**. The latter type of claim was a process claim within the meaning of Art. 64(2) EPC 1973.

In T 401/95 the board, with reference to G 2/88 (OJ 1990, 93), identified two different categories of use claim, namely