

Art. 123(3) EPC 1973, since the sintered composite body was defined in the use claim in a more restricted way than the composite body of the granted claim (narrower range of the graphite content, etc.).

T 37/90 allowed the change from a claim to a product comprising a certain material to the use of the material for the manufacture of the product.

In T 282/09 the claims of the main request as amended comprised only use claims, which had replaced the product claims directed to a physical entity of the patent as granted. The board held that according to EPO practice (see T 401/95) a claim directed to "the use of a physical entity to produce a product" was to be considered as a process claim comprising physical steps for producing the product using the physical entity, with the consequence that this type of use claim was a process claim within the meaning of Art. 64(2) EPC. Pursuant to that article of the EPC, the product, insofar as it was directly obtained by that process, was also protected. Hence, the product, when obtained by that process, was within the scope of protection conferred by that type of use claim (see decision G 2/88, OJ 1990, 93, point 5.1 of the Reasons). In the case at issue, the protection conferred after amendment extended beyond that conferred before, contrary to the requirements of Art. 123(3) EPC, because the product obtained using the physical entity was not protected before the amendment of the claims, but was now protected as a result of the amendment. See also T 1471/14.

In T 1954/12 claim 3 as granted was to a cell characterised by the presence of a recombinant nucleic acid encoding VKOR. Claims 2 and 3 of the main request were directed to the use of the cell of granted claim 3 for making a VKD protein. The board observed that a distinction had been made in G 2/88 (OJ 1990, 93) between "a patent whose claimed subject-matter is the use of a product to achieve an effect ... [and] ... a patent whose claimed technical subject-matter is a process of manufacture of a product". For this latter case, it was stated with reference to Art. 64(2) EPC that "protection is conferred not only upon the claimed process of manufacture, but also upon the product resulting directly from the manufacture". The board noted that the methods of claims 2 and 3 were directed to the manufacture of a particular product, namely a VKD protein, and thus, the protection conferred by these claims was not limited to the claimed process of manufacture but extended also to this product. The protection conferred by granted claim 3 did not extend to this product and, in this regard, the protection conferred by claims 2 and 3 went beyond the protection conferred by granted claim 3. However, decision G 2/88 required **comparing the totality of the claims before and after the amendment**. In the case at issue, the protection conferred by granted claims 4-7 extended, in accordance to Art. 64(2) EPC, to the product obtained, i.e. a VKD protein. The board came to the conclusion that granted claims 4-7 provided protection for the product obtained by the methods of claims 2 and 3 of the main request, namely a VKD protein. The requirements of Art. 123(3) EPC were fulfilled.