

#### 2.4.10 Replacement of "cell of a plant" by "plant"

In T 579/01 independent claim 1 and dependent claims 2 to 6 of the new main request were directed to a "vegetable plant", while the respective claims as granted were directed to a "cell in a vegetable plant". The board decided that **any** plant as subject-matter of claim 1 of the new main request fell within the protection conferred by a claim to "a cell of a plant", and finally that the "plant" now claimed was characterised by the same genetic features, as recited in the granted claim to "a cell of a plant". Also taking account of legislative developments in Europe in respect of the legal protection of biotechnological inventions (i.e. Art. 8.1 and 9 of Directive 98/44/EC), the board concluded that the amendment of the "cell of a plant" claim to a "plant" claim was not contrary to the requirements of Art. 123(3) EPC 1973.

#### 2.4.11 Replacement of substance by device containing substance or substance with mechanical device

In T 352/04, claim 1 as granted had been directed to a haircare composition defined only by its components, whereas claim 1 of the main request pending on appeal included a variant that additionally characterised it as "present in the form of a nonaerosol hairspray with a mechanical spray device". Observing that the dependent claims as granted had similarly made no reference to any device features, the board held that the addition of this mechanical spray device extended the protection conferred in breach of Art. 123(3) EPC 1973. Its inclusion as a separate element also changed the category of the claim, as it now encompassed a device containing the cosmetic composition too. See also in this chapter II.E.2.7. "Change of claim category".

In T 1898/07 the appellant (patent proprietor) argued that a claim referring to a packaged kit containing the liquid composition of claim 1 as granted was in fact narrower in scope than a claim referring to the liquid composition, as this claim encompassed the liquid formulation in any possible container, vessel, package or reservoir. The board agreed with the appellant in so far as the scope of protection covered by a claim referring to a physical entity should be considered to encompass the physical entity in any possible package or container. However, it was self-evident that "a packaged kit" was a different physical entity than "a liquid composition". In the board's view the content of a package is not a characterising feature of the package per se. Thus, a procedural situation was created where an act, for instance the production of the box, package or other container, which did not infringe the patent as granted, became an infringing act as a result of an amendment after grant. It is precisely this situation which should be prevented by the requirements of Art. 123(3) EPC. A referral under Art. 112(1)(a) EPC was not justified since the board, which examined the teaching of cases T 579/01 and T 352/04 (amendment from cosmetic agent to combination of the agent with a mechanical device) referred to by the appellant, concluded that they did not apply in this case.

#### 2.4.12 Replacement by aliud

In T 867/05, the product claims as granted defined a composition of matter (membrane material of claims 1 to 9 and permselective material for use in dialysis of claim 12),