

2.7.2 From device claim to a method claim directed to using the device to carry out a work method

In T 653/16 the appellant (opponent) took the view that changing the category of claim 1 as granted from one directed to a device (floatable harbour power supply) to a method claim for carrying out a work method (method for supplying external power to a ship in the harbour) using the device extended the scope of protection. The board disagreed. In the case in hand, the patent as granted had solely contained claims directed to a physical entity per se. The Enlarged Board of Appeal had acknowledged that it was a fundamental principle of the EPC that any patent which claimed a physical entity per se conferred absolute protection upon that entity, i.e. for all uses of the entity, whether known or unknown (G 2/88, OJ 1990, 93). Contrary to the appellant's opinion, the scope of protection conferred by the patent as amended in line with auxiliary request 2 did not extend to cover the ship since that request was no longer directed to physical entities – for want of any device claims.

2.7.3 From product or product-by-process claim to a claim directed to a process for manufacturing/preparing the product, and vice versa

According to established case law, a product claim confers protection to all processes for making that product, such that the replacement of a claim directed to a product by a claim directed to a specific process or method for making that product does not extend the protection conferred thereby (T 674/02 with reference to T 54/90, T 28/92, T 468/97, T 554/98; see also T 191/90, T 762/90, T 153/91, T 601/92, T 646/98, T 425/02, T 1139/06).

In T 423/89 the change in category from a product-by-process claim to a manufacturing process claim was admissible. In T 402/89, however, the board pointed out, in passing, certain difficulties in interpreting the term "protection conferred".

In T 5/90 the patent was granted with a claim in the form "a product having product features x and product-by-process features characteristic of process steps y". This claim, however, turned out not to be novel. The patentee finally claimed "a process of making a product having product features x by using process steps y and process steps z". The board interpreted such a claim as covering the process steps only in so far as a product having product features x actually resulted. This was called a **process-limited-by-product claim** by the board. The direct product of this process would also be protected under the provisions of Art. 64(2) EPC 1973, but such product inevitably fell within the scope of the product claim originally granted. The board regarded a process-limited-by-product claim of this type as clearly complying with the requirements of Art. 123(3) EPC 1973 because it would only be infringed if the product fell within the originally granted product claim and in addition the particular form of manufacture using process steps z was used (see also T 562/04).

In T 20/94 the patent as granted exclusively comprised process claims for preparing a product. In the form as amended it comprised a product claim relating to the product per se. The board stated that the protection conferred by a claim directed to a process for