

claim of the auxiliary request was not allowable under Art. 123(3) EPC 1973. The subject-matter protected by the granted claim was a pacer, **when in use**; in contrast, the claim of the auxiliary request only included technical features which defined physical characteristics of the pacer device itself. The board explained that in general terms, if a patent as granted only included claims defining the operation of a device and therefore **containing both "device features" and "method features"**, and the proposals to amend the patent during opposition proceedings included claims which only contained "device features", the proposed amendment was not allowable having regard to Art. 123(3) EPC 1973, because the patent as granted conferred protection upon the device only when it was in use so as to carry out the method, whereas the proposed amended patent would confer protection upon the device whether or not it was in use, and would therefore confer additional protection compared to the patent as granted. In contrast to the findings in T. 426/89, in the case at issue the board held that claim 1 as granted was clear, defined the use of a device to carry out a method of treatment of the human body by therapy and was not a pure "device claim" since it also included method steps. Thus, under such circumstances, Art. 52(4) and Art. 123(3) EPC 1973 might operate in combination as an "inescapable trap".

T. 1830/14, too, concerned the conversion of a granted method claim to a device claim. The board recalled that a claim directed to an apparatus provided absolute protection of the defined apparatus and, hence, its scope of protection was broader than the scope defined by a claim directed to a method of production or use of the same apparatus. In the case at issue, compared to the cooling apparatus defined in claim 1 as granted, in the apparatus claim 1 of the main request a feature had been deleted. The appellant argued that granted independent method claim 9 defined a cooling apparatus without the deleted feature and that, therefore, deleting this feature from the apparatus claim did not broaden the scope of protection. However, referring to the principles stated in T. 82/93 (OJ 1996, 274), the board observed that in the case in hand two features defining the operation of the cooling apparatus in claim 9 as granted were missing from claim 1 of the main request. The protection conferred by granted claim 9 to the defined cooling apparatus was limited to the apparatus when it was transferring heat according to the missing features, i.e. only when it was in operation. Claim 1 at issue defined the same cooling apparatus as granted claim 9, but conferred absolute protection to it, irrespectively of whether it was in operation or not. Hence, its scope of protection was broader than that of granted claim 9 and the main request did not fulfil the requirements of Art. 123(3) EPC. The board accepted auxiliary request IV, as the apparatus claim also contained the features defining the operation of the apparatus.

2.7.6 From use claim to process claim, and vice versa

In T. 279/93 the board found that a claim to the use of a compound A in a process for preparing compound B had no broader scope than a claim to a process for preparing compound B from compound A. It had already been stated in G. 2/88 (point 2.5 of the Reasons) that the technical features of a claim to an activity were the physical steps which defined such activity. In this case, the board considered that process claim 1 as filed, process claim 1 as granted and use claim 1 filed on appeal all related to the same physical steps, and that the claims were therefore of the same scope. On this view, the scope of