

a new and inventive process, the protective effects of which also extended to the direct products of this process.

The first decision in this regard was T 150/82 (OJ 1984, 309). The board stated that claims for products defined in terms of processes for their preparation (known as "product-by-process" claims) were admissible only if the products themselves fulfilled the requirements for patentability and there was no other information available in the application which could have enabled the applicant to define the product satisfactorily by reference to its composition, structure or some other testable parameter (established case law, see e.g. G 2/12, OJ 2016, A28 and G 2/13, OJ 2016, A29; T 956/04; T 768/08; T 150/12).

With regard to product-by-process claims, the requirement of clarity means that the skilled person should be able to determine, either from the claim alone or, by construction of the claim in the light of the description, or by construction in the light of the skilled person's common general knowledge, which identifiable and unambiguous technical features are imparted to the product by the process by which it is defined (T 967/10, T 1988/12, T 354/17, T 2243/18). In T 1988/12 the board rejected the idea that the claim was necessarily clear if a skilled person (i.e. a plant breeder) could determine whether or not a candidate plant fell within its terms. The suggestion that the skilled person had to rely on an analysis of a potentially infringing product to know what the subject-matter for which protection was sought actually was, ran counter to the purpose of Art. 84 EPC.

7.2. Requirement that the claimed product must be patentable

In decision T 248/85 (OJ 1986, 261) it was stated that a product could be defined by the use of various parameters, such as its structure or its process of preparation. The use of a different parameter by which to define a particular product could not by itself give the product novelty. Furthermore Art. 64(2) EPC 1973 did not confer novelty upon a claim which was formulated as a "product-by-process" when no novelty existed in such product per se, and did not entitle or enable an applicant for a European patent to include such claims in his patent which did not satisfy the requirements of Art. 52(1) EPC 1973.

In T 219/83 (OJ 1986, 211) the board stated that product-by-process claims had to be interpreted in an absolute sense, i.e. independently of the process. If their subject-matter as such was new, they still did not involve an inventive step merely because the process for their preparation did so. In order to be patentable, the claimed product as such had to be a solution to a separate technical problem which was not obvious in the light of the state of the art.

These criteria were confirmed and applied in many decisions (see e.g. T 251/85, T 563/89, T 493/90, T 664/90, T 223/96, T 59/97, T 748/98, T 620/99, T 1113/10).

The board clarified the conditions for novelty of product-by-process claims in decision T 205/83 (OJ 1985, 363). It stated that the polymer product of a known chemical process was not rendered new merely by virtue of a modification to the process. If a chemical product could not be defined by structural characteristics but only by its method of manufacture, novelty could be established only if evidence was provided that modification