

features appear in a claim directed to a product or in a claim directed to a process. Applying the principles developed in the jurisprudence for product-by-process claims to claim 8, the board stated it would have been possible to define the sintered body in terms of structural features. Accordingly, the use of a product-by-process definition in claim 8 resulted in a lack of clarity.

7.5. Combination of product and process features

In decision T.148/87 the board stated that it was admissible to combine product parameters and process parameters in the same claim. In T.129/88 (OJ 1993, 598) the board was of the opinion that the inclusion in a product claim of one or more process features might be permissible if their presence was desirable having regard to the impact of the national laws of one or more contracting states (see also T.592/95, T.288/02). See also in this chapter II.A.3.7.

7.6. Extension of protection conferred by product-by-process claims

In T.411/89 the board had to decide whether the amendment of a product-by-process claim from "obtained" to "obtainable" extended the protection conferred by the patent. The board took the view that the protection was not extended because the amendment did not modify the definition of the product which was claimed per se from the beginning and because the process used for its characterisation remained the same.

In T.423/89, by restricting the claim to only one of a number of manufacturing processes specified in the original claim and disclosed in the description, the patent proprietors had ceased to claim absolute product protection and had undertaken a significant limitation of their claim. There were therefore no objections under Art. 123(3) EPC 1973. The change in category from a product-by-process claim to a manufacturing process claim was also admissible in this case, as the protection afforded by the granted patent had to extend to all those methods of manufacture covered by the processes described in the claim and disclosed in the patent specification.

In T.20/94, however, objections under Art. 123(3) EPC 1973 led to the board's refusing a change from process claims to a product-by-process claim by way of amendment, as despite the fact that a product-by-process claim was characterised by the process for its preparation, it nevertheless belonged to the category of claim directed to a physical entity and was a claim directed to the product per se. The scope of protection conferred by a product claim exceeded the scope conferred by a process claim under Art. 64(2) EPC 1973. See also chapter II.E.2.7. "Change of claim category".

8. Claims fees

Until 31 March 2008, under R.31(1) EPC 1973 and then the new R.45 EPC, any European patent application comprising more than ten claims incurred payment of a claims fee in respect of each claim over and above that number. With effect from 1 April 2008 the number of fee-exempt claims was increased to fifteen. For international applications