

preparing a product covered a product directly obtained by that process (Art. 64(2) EPC 1973), but it was not protected when obtained by any other process. However, the protection conferred by a claim directed to a product per se was absolute upon that product. The product claim thus conferred protection on that product regardless of the process by which it was prepared. The appellant attempted to overcome this objection by formulating the product claim as amended in the form of a product-by-process claim using the term "directly obtained". The board did not agree with this line of argument, stating that a product-by-process claim was interpreted as a claim directed to the product per se, since the only purpose of referring to a process for its preparation was to define the subject-matter for which protection was sought, which was a product. Thus amended claim 1 in the case in question contravened Art. 123(3) EPC 1973.

In T 1206/01 the board pointed out that according to the established case law of the boards of appeal a product claim conferred protection on the claimed product, regardless of the process or method by which it was prepared. Therefore a change of category from a granted product claim to a process claim restricted to one or more methods of preparing the product did not extend the protection thereby conferred.

2.7.4 From a product claim to a product-by-process claim

In T 794/03 claim 1 as granted had been a substance claim for a plain-bearing composite material, preferably for manufacturing bearing bushes, whereas claim 1 according to the main request pending on appeal was for a plain-bearing bush made of the (in the meantime, limited) composite material. The board found that this amended claim amounted to a kind of "product-by-process" claim, which meant that, in order to determine the extent of protection it conferred, it had to establish what features the process lent the end product. It concluded that the scope of protection had indeed been extended.

2.7.5 From method of operating a device claim to product claim

In T 426/89 (OJ 1992, 172) claim 1 as granted and claim 1 of the main request related to a process for operating a pacemaker. The board noted that an actual operating method for a pacemaker for arresting a tachycardia would necessarily be a method for treating the human (or animal) body by therapy, and would not be patentable. However, the board agreed with the patentee that the claim referred to the steps in a technical method which did not define a method of treatment but rather, in functional terms, the structural features of a pacemaker. However, the board found the claim to be contrary to Art. 84 EPC 1973. The differences between the claim 1 according to the auxiliary request and the granted version were that in claim 1 the terms "Method for the operation of a pacemaker", had been replaced by "Pacemaker". The board held that claim 1 as granted was already a product claim containing a functional definition of a pacemaker. So the seeming change of category did not alter the content of the claim but simply served to clarify it (see also T 378/86, OJ 1988, 386).

In T 82/93 (OJ 1996, 274) claim 1 as granted related to a method of operating a pacer. The board found that this claim defined a method for treatment of the human body by therapy and therefore was not allowable under Art. 52(4) EPC 1973. It held that the device