

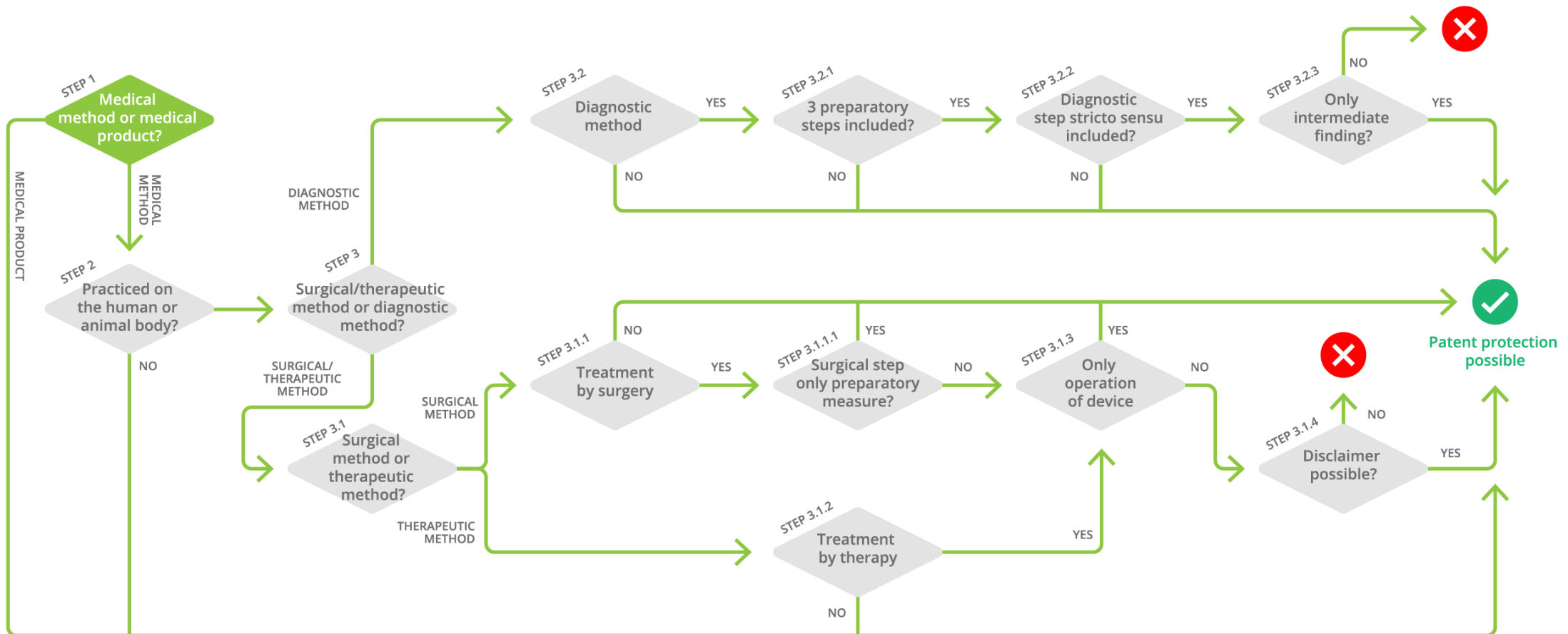
**BERGGREN**



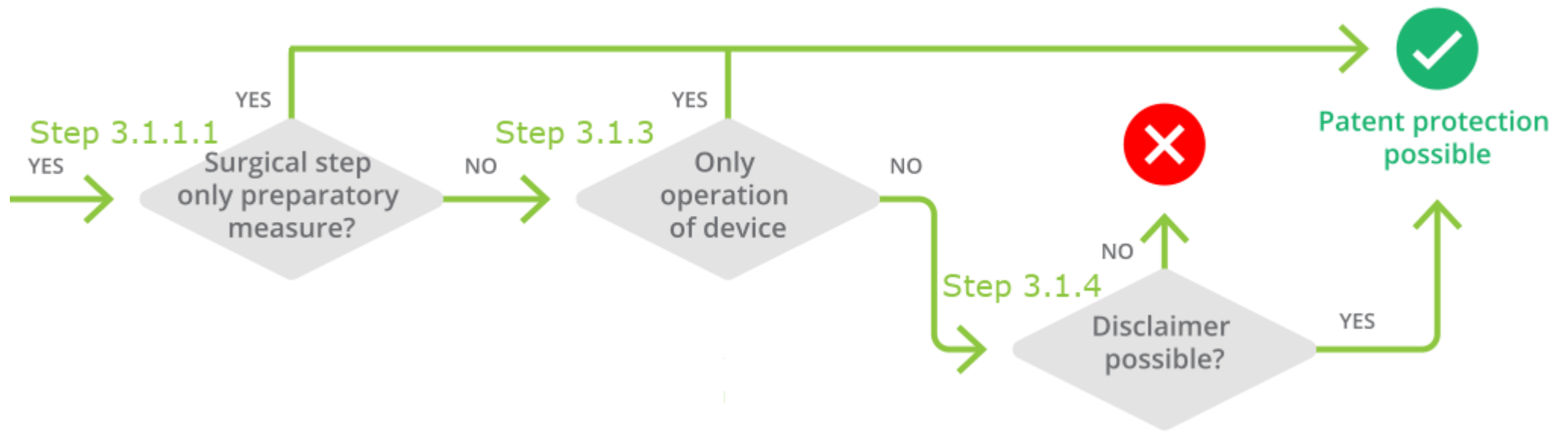
# **Is my medical invention patentable?**

## **Part 6 – Avoiding exclusion re surgical step**

# Overview



# Avoiding exclusion re surgical step



- Surgical treatment just **preparatory measure**  
→ Feature relating to **surgical treatment** can be **omitted**
- Only **operation of a device**  
→ Claimed method has no influence or impact on the body
- **Disclaimer**  
→ Feature relating to **surgical step** can be **disclaimed**

# Preparatory measure

- **Primary purpose** of surgical step lies in **treatment of a patient** and **not only** in **enabling** the (remaining) **claimed method**
  - Surgical step is a mere **preparatory measure**<sup>1</sup>
  - Preparatory measure, i.e., surgical step, may be omitted from claim
  - **Not excluded from patentability**

<sup>1</sup> Yes: T 992/03; T 836/08  
No: T 923/08; T 2438/11

# Operation of a device

- Methods **used during but not forming a therapeutic or surgical treatment**
- **No functional link between operation of a device and effects produced by the device on the body<sup>1</sup>**
- **No inextricable link between claimed method and surgical (or therapeutic) treatment**
  - No step of treatment by surgery (or therapy)
  - **Only operation of a device<sup>2</sup>**
  - **Not excluded from patentability**

<sup>1</sup> G 1/07, Reasons 4.3.2

<sup>2</sup> Yes: T 0245/87; T 0789/96; T 699/12

No: T 82/93; T 1680/08; T 141/15; T 1075/06; T 944/15

# Disclaimer

- Exclusion from patentability avoidable by disclaiming<sup>1</sup>
- **Clear delimitation/distinction** of allowable **non-surgical applications** from surgical applications **must be possible**
- Requirements of EPC and for disclosed disclaimers or undisclosed disclaimers must be fulfilled<sup>2</sup>:
  - Subject-matter of claim with **undisclosed disclaimer** must:
    - be **clear**<sup>3</sup>
    - disclaim **non-patentable subject-matter**<sup>4</sup>
    - **not remove more than is necessary**<sup>5</sup>
  - Subject-matter of claim with **disclosed disclaimer** must:
    - be (explicitly or implicitly) **directly and unambiguously disclosed in the application as filed**<sup>6</sup>

1 G 1/07, Headnote 2b,  
Reasons 4.2

2 G 1/16, Reasons 43.

3 G 1+2/03, Headnote 2.4;  
T 923/08

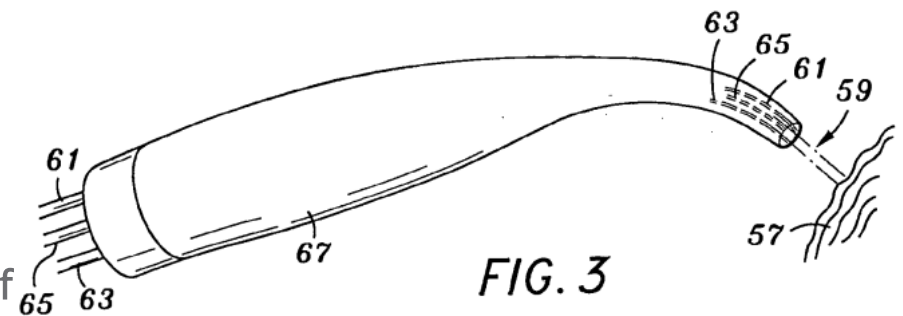
4 G 1+2/03, Headnote 2.1

5 G 1+2/03, Headnote 2.2

6 G 2/10, Headnote 1a

## Case law example: **Disruptive force cutter (T 1487/09)**

Claim 29: A method of imparting disruptive forces onto a target surface (57),  
with the exception of such uses that comprise or encompass an invasive step representing a substantial physical intervention on the body of a human or an animal which requires professional medical expertise to be carried out and which entail a substantial health risk even when carried out with the required professional care and expertise [...].



- Disclaimer uses wording of G 1/07 for describing a surgical method  
→ Surgical applications removed and thus patentable?

### **BUT:**

- Merely choosing wording of G 1/07 doesn't render the claim clear.
- The description doesn't allow for a clear delimitation of non-surgical applications from surgical applications, too.  
→ Claim wording is **not clear and concise**.  
→ **Disclaimer is not allowable**.





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