

G.1/04 (OJ 2006, 334) concerned **diagnostic methods**. The Enlarged Board held that a diagnostic method within the meaning of Art. 52(4) EPC 1973 had an inherent and inescapable multi-step nature. If diagnosis as the deductive medical or veterinary decision phase was a purely intellectual exercise, the feature pertaining to the diagnosis for curative purposes and the features relating to the preceding steps which were constitutive for making the diagnosis represented the essential features of a diagnostic method within the meaning of Art. 52(4) EPC 1973. Thus, in order to satisfy the requirements of Art. 84 EPC 1973, an independent claim relating to such a method must include these features. The Enlarged Board further held that, while essential features were for the most part of a technical nature, a non-technical feature constitutive for defining the invention must likewise be included as an essential feature in the independent claim. Thus, although diagnosis *stricto sensu* was a purely intellectual exercise unless it was carried out by a device, the feature pertaining to it was such an essential feature as to be included in the independent claim. See also chapter I.B.4.6.1 c) "Clarity of a claim relating to diagnostic methods".

G.1/07 (OJ 2011, 134) concerned **surgical methods**. The Enlarged Board referred to **G.1/04** and stated that a claim should explicitly specify all essential features and must be clear. Under Art. 84 EPC, whether or not a step being or encompassing a surgical step excluded from patentability can be omitted either by using positive wording for such omission like "pre-delivered" or by simply leaving it out from the claim depends on whether the claimed invention is fully and completely defined by the features of the claim without that step. See also chapter I.B.4.4.4 c) "Surgical step part of claimed method or simply a preparatory measure?".

In **T.2102/12** the application related to medical robotic systems which allow to robotically move a tool on an articulated arm in response to the surgeon's manipulation of an input device. The board referred to **G.1/07** and held that claiming the measurement of the movement of the tool while "unclaiming" the movement itself rendered the claim unclear under Art. 84 EPC. The claimed method of intertwined non-surgical ("claimed") and surgical ("unclaimed") steps was not comparable to that underlying **T.836/08**.

In decision **T.923/08** the board decided as follows: If a method for recording measurements on the human or animal body necessarily entails a surgical step in order to fix to the human or animal body a measuring device which is indispensable for performing the method, this step has to be deemed an essential feature of the method and is comprised in such a method, even if the claim contains no method feature explicitly directed to it. Such a method is excluded from patentability under Art. 53(c) EPC. The exclusion of such a surgical step, whether by stating that the surgically attached measuring device was already fixed to the body before the start of the method or whether by use of a disclaimer, breaches Art. 84 EPC 1973 because such a process claim does not then include all the essential features of the claimed invention.

3.3. Clarity of broad claims

It was established in **T.238/88** (OJ 1992, 709) that the clarity of a claim is not diminished by the mere breadth of a term of art (e.g. "alkyl") contained in it, if the meaning of such