

The board in T.1731/12 endorsed T.775/95 and continued its approach, holding that a device defined by a feature that could be arrived at only by a surgical or therapeutic step was excluded from patentability under Art. 53(c) EPC. It agreed with the thinking that a product defined by a surgical step could not exist without it, and thus that the surgical step was part of the claimed product. Moreover, the exclusion of such a product from patentability was not contrary to the second clause of Art. 53(c) EPC, which provided that products for use in therapeutic or surgical methods were patentable. Otherwise medical and veterinary practitioners' freedom would be limited, as also discussed for example in G.1/07. The board saw a fundamental difference between the actions of "using" and "making" a product. Using patented subject-matter was generally allowed once that subject-matter had been duly purchased. To be allowed to make a patented product, by contrast, medical staff would need to purchase a licence for the process of making it; where that process involved a surgical or therapeutic method step, that would interfere precisely with the freedom of medical staff that the exclusion from patentability under Art. 53(c) EPC intended to protect.

4.4.5 Avoiding the exclusion of methods of treatment by surgery from patent protection under Article 53(c) EPC

a) Claim cannot be left to encompass surgical step

A claim encompassing an embodiment which is excluded from patentability under Art. 53(c) EPC cannot be left unamended (G.1/07, OJ 2011, 134; as previously held in G.1/98, OJ 2000, 111).

In G.1/07 the board also found the following: 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, under Art. 84 EPC, on whether the claimed invention is fully and completely defined by the features of the claim without that step. That requires an assessment of the individual case under consideration.

b) Disclaimer

The Enlarged Board in G.1/07 went on to say that the exclusion from patentability under Art. 53(c) EPC can be avoided by disclaiming an embodiment, it being understood that in order to be patentable the claim including the disclaimer must fulfil all the requirements of the EPC and, where applicable, the requirements for a disclaimer to be allowable as defined in decisions G.1/03 (OJ 2004, 413) and G.2/03 (OJ 2004, 448) (see also G.1/16). Whether or not the wording of a claim can be amended so as to omit the surgical step without offending against the EPC must be assessed on the basis of the overall circumstances of the individual case under consideration (see T.923/08, in this chapter I.B.4.4.4 d)).