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“Tip of the Month”

Are Medical and Surgical Procedures Patentable?

In most foreign countries, medical and surgical procedures are not patentable. Foreign patent laws often explicitly state they are not. New and nonobvious medical and surgical procedures in the U.S., however, are considered patentable subject matter under U.S. patent law. This has been somewhat controversial. The American Medical Association has condemned the patentability of medical and surgical procedures and has sought to outlaw the practice. The AMA’s Board of Directors has reaffirmed the AMA’s stance against such practice several times in the past.

As a result of the controversy, Congress changed the Federal Statute in 1996. Unlike other countries, the U.S. Congress did not change the section of the Federal Patent Statute that defines patentable subject matter or the section that defines infringement. Instead, Congress amended 35 U.S.C. §287, which is the “remedies” section under the statute. Congress added a new subsection (c). This new subsection (c) deprives a patentee of its infringement remedies, which include civil trial, injunction, damages, and attorney fees, when a medical practitioner or a related health care entity performs a patented medical activity.

For purposes of the amendment, the term “medical activity” is explicitly defined. It means the performance of a medical or surgical procedure on a body, but shall not include (i) the use of a patented machine, manufacture, or composition of matter in violation of such patent, (ii) the practice of a patented use of a composition of matter in violation of such patent, or (iii) the practice of a process in violation of a biotechnology patent. In addition, this new subsection does not apply to any patent issued based on an application having an earliest effective filing date prior to September 30, 1996. These exceptions still allow the enforceability of medical and surgical procedure patents.

Thus, unlike most foreign countries, the amendment to the Federal Statute does not prevent an inventor from obtaining a patent for a medical or surgical procedure. It does, however, impact the way in which any resulting patent can be enforced.

If you have any questions about the patentability of your medical or surgical-related invention, the patent attorneys at Mesmer & Deleault are ready to assist you. Please call us at 668-1971 or contact us through the Internet at mailbox @ biz-patlaw.com.

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