

Patent Drafting for Beginners
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Lecture – 26
Provisions Relating to Claim

Before we draft the claims, let us look at the provisions relating to the claims. There are certain legal provisions under the patents act and the rules, which are specifically meant for claim drafting. They tell us what the claims are for. What the function of the claim is, and how the claims should be drafted in special situation.

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Claims define the invention

- Section 10(4)(c)

10. Contents of specifications.

(4) Every complete specification shall-

(c) end with a claim or claims defining the scope of the invention for which protection is claimed;



Now, the claim does the function of defining the invention. In section 10 4 c, we know that the contents of the specification should end with a claim or claims defining the scope of the invention for which protection is claimed. So, if you look at the structure of a specification, the specification would end with the claims.

Now, there are various other parts there is a title to the invention there is a background of the art. You could have a brief description, a detailed description drawing. The, if you look at the written part, the claims come at the end of the specification.

So, the claims are the last portion or what we call the specification ends with the claim. Now, the claims have to define the scope now that is the function of the claim, the claims

have to define the scope of the invention for which protection is claimed. Defining the scope is done by the language of the claim itself. And you will see why the structure of the claim is important in defining the scope. In defining the scope, there are two things that would be important.

One to look at the prior art so, that the claims do not read into what has gone before; and two to keep the claims clear in such a way that a person who reads it is not in doubt with regard to the scope of the claim. In other words, the claims have to be definite. They have to be clear and succinct.

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Claims relate to single invention

- Section 10(5)

10. Contents of specifications.

(5) The claim or claims of a complete specification shall relate to a **single invention**, or to a group of inventions linked so as to form a **single inventive concept**, shall be clear and succinct and shall be fairly based on the matter disclosed in the specification.



Now, the claims should relate to a single invention. We get that from section 10 5 again, which states that the claim or claims of a complete specification shall relate to a single invention or a group of inventions linked so, as to form a single inventive concept. Now, we will just stop there.

Now, the claims should either cover a single invention. So, if there are multiple inventions, we had already discussed this you should have multiple problem solution statements, which would lead to multiple independent claims.

Now, multiple inventions would normally be covered by different patent applications. In case you file an application with multiple inventions in it, there is a procedure by which you can later on divide the inventions into separate applications by filing a divisional

application. A divisional application could also arise from an objection that is raised by the patent office. If the point of your application having more than one invention is pointed out by the patent office, then the patent office would direct the applicant to file a divisional application.

So, in summary you can have only one invention covered in an application. This is called the unity of invention. Even if the inventions are covered by a single inventive concept, there are different aspects to the invention. They are all covered by a single inventive concept. You could still claim that in a single application.

So, either you have a single invention, or a group of inventions which are linked to form a single inventive concept. Still it can be the subject matter of a single application. So, the claims should relate to a single invention or a single inventive concept.

The claims have to be clear and succinct. Now, being clear is to be without ambiguity and to be succinct is to be precise. The claims also have to be fairly based on the disclosure. Now, this is the part where the claims have to be related back to what was disclosed in the specification.

Though the claims come at the end, it is not possible to claim something which you have not disclosed and it is also not possible to claim something for which the disclosure does not enable a person. Now, that is another requirement, but whatever is claimed in a claim has to be fairly based on what you have disclosed in the application.

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Claims to contain reference signs

- Rule 13(4)

13. Specifications

(4) Where the invention requires explanation through drawings, such drawings shall be prepared in accordance with the provisions of rule 15 and shall be supplied with, and referred to in detail, in the specification, including the claims where the features illustrated in the drawings shall be followed by their respective reference signs in parentheses



Now, claims should also contain certain reference signs. Now, this we get from the rules. Rule 13, sub rule 4 reads that where the invention requires explanation to through drawings; such drawings shall be prepared in accordance with the provisions of rule 15, and shall be supplied with and refer to in detail, in the specification including the claims where the features illustrated in the drawings shall be followed by their respective reference signs in parentheses. Now, this is important because wherever you mention a element of your claim, which you have marked in your drawing with a number

Then the claims where the features are the illustrated features in the drawing shall be followed by their respective reference number. So, if your invention is for a pen, and there is a nib in the pen which has been marked as 7.

So, when you mention nib in the claim you it has to be followed by 7 in parentheses. The; you would we will be showing you examples. You would have already seen the Bajaj TVS the patent that was involved in the Bajaj TVs, case where this point was shown.