

Patent Drafting for Beginners
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Lecture – 28
Structure of Claims

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Placement of Claims after the Specification

- 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;



Structure of claims; the placement of the claims is usually after the specification, there is a written description in the specification and it as we have already seen the complete specification will end with the claims, and they define the scope of the invention. Claims are normally written in a single sentence.

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Single Sentence

“I/We claim” or “It is claimed as” “The invention claimed is”

- By convention, clear and succinct.
- A set of words that makes complete sense (grammar).
- Begins with a Capitalised word and ends with a period.
- Capitalised words not allowed (exception °C and °F)



Now, this is either in the form of I slash We claim it begins with that statement or it is claimed as or the invention claimed is there are various combinations of using this this is how a usual claim will begin it will begin with a I claim or it is claimed or the invention claimed is.

Now by convention, it is written as a single sentence. Claim regardless of how long it is, it is written as a single sentence. So, you may find some claims unusually long and it may even you may even find the difficult to follow it follow what is being claimed in a first in the first reading , but it is a convention that is being followed. One of the idea behind having the claim being written in the form of a single sentence is to make it clear and succinct. Now that is a requirement under the law. So, the understanding is that if the claim is in the form of a sentence and that to a single sentence, it should be clear and it should convey the information that is covered clearly.

Now, in English a sentence refers to a set of words that make complete sense. So, claims also need to follow because they are written in a single sentence, they need to follow all the rules and grammar of a normal sentence, which means it has to begin with a capitalized word and end with a period or a full stop. The capitalized words are usually not allowed in the sentence of the claim, apart from using certain capital letters like C and F for denoting centigrade and Fahrenheit apart from that words within the claim are not capitalized.

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Get the verb form right

- A pen having a spheroidal marking point and a cap.
 - A pen **comprises** a spheroidal marking point and a cap.
 - A pen **comprising** a spheroidal marking point and a cap.
- Select a verb form ('ing') and use it throughout the claim
- Use different verb forms for different claims, if needed use present tense



Now it is important to get the verb form right in the claim. Now let us take the example which we had already seen, a pen having a spheroidal marking point and a cap. Now you could write this as a pen comprises a spheroidal marking point and a cap or you could have it in a more direct language like a pen comprising a spheroidal marking point and a cap.

Now comprises there is enough of case laws on this to say that comprising the ing form is the one to be used, because that verb form allows you to present the claim in the present tense. Now you could use different verb forms for different claims, but if needed you could use the present tense there will be some instances where you may have to use the past tense or even the future tense, but normally it is a preferable practice to keep it in the present tense and in the ing form, which is the working form.

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Ordering of claims

“... end with one or more claims”

- Single claim, not numbered
- Claims to be numbered sequentially
- Begin with broadest, proceed to narrowest
- Group similar claims together
- Claim numbers are unique, not reused
 - During prosecution, if a claim is cancelled, that number is not reused
- Claims are renumbered before grant



Ordering of claims; now we are already is mentioned that they can be one or more claims the axis that the specification shall end with one or more claims. So, what do you do if there are more than one claim, if it is a single claim it is not numbered, but if there are more than one claims the claims have to be numbered sequentially.

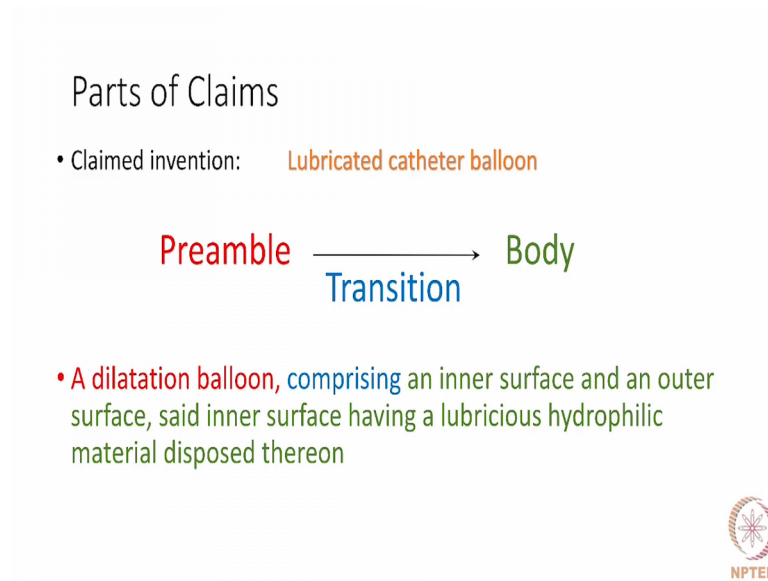
Now, you normally begin with the broadest claim and proceed to the narrowest. So, you would have a broad claim of claim number one is the independent claim, it would be a broad one claim 2 if it is dependent on claim 1 will be a narrower claim and claim 3 if it is dependent on claim 2, it will be the narrowest claim in case you have 3 claims in your for your invention.

Now claims have to be grouped together, assume that your invention has is for an apparatus it is a product and you also have a method of making the product that comes out of the apparatus. Delete last few sentence, assume that your claim is for a device you have a device claim. All the device claims and all the combinations of the device claims should be grouped together you also have a method of using the device, in that case all the method claims with all their combinations will be grouped together.

Claim numbers are unique the number which you a lot for a claim is not reused. So, you have three claims in your application, claim 1 2 and 3. During prosecution if you cancel claim number 2 in the process of prosecution, there is an objection of whatever reason you want to cancel that you just continue with 1 and 3 throughout the prosecution. The number that you cancel is not reused because it it leaves a track of the cancellation and it

keeps a track of what was given up. But before the grant the claims are renumbered by the patent office and granted. So, most of the cases when you see a granted patent you will see a sequential numbering, but it is quite possible that during the course of prosecution some claims were deleted or omitted and during the course of prosecution the numbering is not changed.

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Now, let us look at the parts of a claim. Claims normally have a structure and most of the claims what we call combination claims. Combination claims are claims which combine things. So, this is the structure of a normal claim. There is a preamble an introductory statement there is a transition, transition is most likely a verb and there is a body.

Let us take this claimed invention lubricated catheter balloon. A dilatation balloon which is the preamble, comprising the transition an inner surface and an outer surface said inner surface having a lubricious hydrophilic material disposed thereon. Now what is highlighted in green is the body, and the body you can see that the body is connected to the preamble through the transition. The transition is a word verb and it is a verb of action comprising.

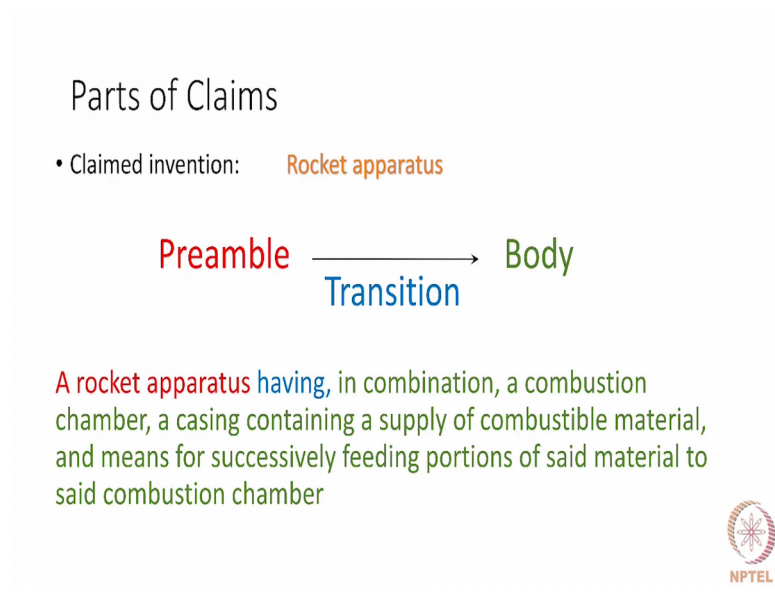
Now, what the transition does? It gives further information about the preamble the preamble is a dilatation balloon, now which is a lubricated catheter balloon. The description of the dilatation balloon is that it has an inner surface and an outer surface and the inner surface has a lubricious hydrophilic material disposed thereon. So, what

has been claimed is not the dilatation balloon or the catheter balloon per say. A variant which has a lubricious hydrophilic material is being claimed.

Now, so, the preamble introduces the broad field of invention, the comprising or the transition tells you where the claim or the claimed part of the invention begins because after the transition you can what is being highlighted in the green, it is what is unique for this invention. And again they could you could have dilatation with inner and outer surface that is perfectly fine, but in this case the inner surface has a lubricious hydrophilic material. So, the lubricious hydrophilic material in the inner surface which forms a part of a dilatation balloon makes this invention unique.

. So, you need to understand I mean the more patent specifications you read, you will get comfortable with the structure of the claim. So, claims normally is there for a combination normally have these three parts a preamble, a transition and a body.

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Let us look at another example, rocket apparatus rocket apparatus which is the preamble having the transition in combination a combustion chamber a case in containing a supply of combustible material and a means for successively feeding portions of said material to the said combustion chamber.

Now you can clearly see the preamble and the body connected by the transition. So, the transition tells us that it is not that all rocket apparatus is being claimed here, only the

rocket apparatus that has what has been described in the body. So, the body is actually what is being claimed, preamble introduces you to the field of invention the rocket apparatus is. It could be rocket apparatus, but what is being claimed here is where there is a combination of a combustion chamber a casing containing fuel and a means of successively feeding portions of the said material into the combustion chamber let us look at one more example.

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Parts of Claims

- Claimed invention: Packaging frozen food



A method of packaging and preserving food, which consists in first packing the food in a container and freezing the same under pressure applied to substantial surface areas of the packed container



Packaging frozen food; the method of packaging and preserving food which is the preamble it could be any method, which consists in the use of consist is different from the use of comprising we will be looking at that in the forthcoming lectures. First packing the food in a container and freezing the same under pressure applied to substantial surface areas of packed container. So, you can clearly see the preamble the transition, transition need not be just one word it could also be a group of words and then the body.