

CLAIMS

The claims define the monopoly in words. They are the parts of a patent specification, which define the boundaries of patent protection, when the patent is granted. Patent claims are the legal basis for the patent protection forming a protective boundary line that lets others know when they are infringing on the patent rights. The limits of this line are defined by the words and phrasing of your claims.

A typical claim has the following form:

Preamble ... transitional phrase ... claim elements.

i.e. claims are most commonly of the form having a brief preamble describing the apparatus or method in terms of its field of use, the transition "comprising", and followed by the claim elements (apparatus elements or process steps) which are like a checklist of the components of the claimed invention.

The description in the complete specification is to be followed by a statement of “claims” preceded by the prescribed preamble “I (We) claim”.

The purpose of preambles or introductory statements to name or define the thing that is to be claimed. Preambles may be quite long or very short, depending on the type of claim one is using.

The best type of preamble for most claims is simply a general definition of the combination to be claimed, with whatever detail or length is necessary to define what appears in the body of the claim. The preamble and the body of the claim should be consistent one with the other, two parts making up a whole. The preamble cannot be written properly until the scope of the claim-to-be is determined.

The claim or claims of a complete specification should relate to a single invention, should be clear and succinct and should be fairly based on the matter disclosed in the

specification. In case of inventions relating to substances intended for use or capable of being used as food, medicines or drugs or relating to substances prepared or produced by chemical processes the claims (including alloys, optical glass, semi-conductors and inter-metallic compounds) should relate to a single method or process of manufacture. The object of the statement of claims is –

- to show with conciseness, precision and accuracy as to what the invention is;
- to point out how much of what is described in the specification constitutes the invention; and
- to show what is not claimed and therefore open to public use.

The statement of claims should not be regarded as a part or summary of the description. The function of the claims is to state explicitly and precisely what the applicant desires to protect by his patent. The claims should not be made for the efficiency or advantages of the invention. Each claim should be in one continuous sentence and it does not matter even if it runs into a big paragraph. It is not necessary that the statement of claims should be confined to a single claim. It may comprise of more than one claim provided that the claims are based upon a common idea, which in itself is new, and there is no unnecessary multiplicity of claims.

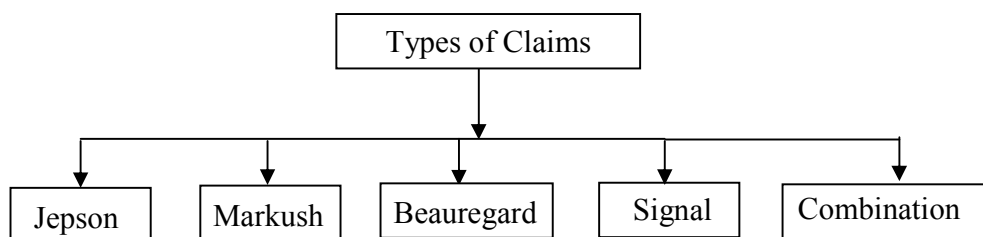
If there are two or more claims, the principal claim should clearly define the essential novel features of the process, apparatus or product, which constitutes the invention. Optional features may be made the subject matter of subordinate claims, and should be claimed in combination with the subject matter of the principal claim and should be so worded as to indicate clearly the optional features invented to be covered by them. A patent may have many claims, each defining the invention in different words and describing it broad or narrow functional language.

It is the Indian Patent Office practice to allow omnibus claims at the end of the claims. An omnibus claim is a relic of the British Patent Office practice. It basically covers all features disclosed but not claimed. Thus the inventor owes a responsibility to define the invention with certainty and in detail.

An example of omnibus claim is as follows:

----- substantially as herein described with reference to the accompanying drawings and examples.

Some e.g. of drafting the main claim are given below:



Jepson claim: Jepson type claims are used for improvement-type inventions, where new or modified elements are added to an otherwise old and unchanged combination. The old elements should be described from the closest single reference in the preamble while the new or modified elements are describe in the body of the claim after a transition such as “wherein the improvement comprises,” or “the improvement comprising.” The new elements are related to each other and to the preamble elements, as with any other claim, particularly in mechanical combination (machine) claims.

e.g.:—In an apparatus for _____ [old elements] ... the improvement comprising...[new elements]—

An apparatus for _____ [old elements] ... the wherein ...[improvement on one of the old elements]—

An apparatus for _____ [old elements] ... characterized in that the[new elements]—

A sodium halide discharge lamp containing a fill including sodium halide, said lamp comprising an arc chamber having an arc chamber wall of fused silica or fused quartz, characterized in that said wall includes less than about 0.05 parts per million of sodium.

Markush claim: Used when there is no general or generic term to define a particular group or subset of items. (e.g. there is no generic term to describe apple trees, oak trees, or maple trees)

Example

"chosen from the group consisting of..."

"chosen from the group consisting essentially of..."

do not use "wherein A, B, or C ..."

Markush claiming can be extended to alternative chemical ingredients, process steps or to mechanical elements.

For example "a fastener selected from the group consisting of nails, rivets and screws." or "... weakening the bond by a process selected from the group consisting of heating, freezing, and pulling the pieces apart..."

The standard format is "a ----- selected from the group consisting of A, B and C."

Beauregard claims: Is a relative of the apparatus claim. It is used when claiming an Internet related business method is a computer-readable medium claim or article of manufacture claim. Claims cover a computer-readable storage device, e.g., a floppy disk or CD, containing a set of instructions that causes a computer to perform a process.

The term is derived from *In re Beauregard*, wherein the Federal Circuit upheld a computer program as patentable subject matter since it was claimed in terms of an article of manufacture as contained on a floppy disk

e.g.

A computer-readable storage medium containing a set of instructions for a general purpose computer having a user interface comprising a mouse and a screen display, the set of instructions comprising:

a) an input routine operatively associated with said user interface for permitting a user to select an icon displayed on said screen display with said mouse, said icon associated with an applications program accessible to said computer;

b) a run routine for implementing said applications program selected by the user with said mouse; and

c) a display routine responsive to said run routine for displaying on said screen display text or images generated by said applications program

Signal claims are defined as "a claim directed to a manufactured transient phenomenon, such as an electrical, optical, or acoustical signal".

Signal claims are analogous to Beauregard claims. A signal claim is a relatively new type of patent claim and will likely become a popular and necessary technique when claiming Internet related business methods.

Signal claims are unique in that the "computer-readable medium" covered by the claim is an electronic signal or carrier wave that is propagated over the Internet between computers, instead of a floppy disk that can exchange hands

Combination claims: The body of the claim lists the main elements of the combination (parts, steps, chemicals, etc) and details how they work together or are related to each other. Most claims are directed to combinations of two or more elements. The claims should be so directed that they reflect the invention and not its advantages.

Fingerprint claims: The fingerprint claims are widely used to characterize a new product of unknown structure in terms of its properties.

For example, an antibiotic obtained from mutant strain of microorganisms are of unknown structure. To claim such compounds for the purpose of monopoly in a patent specification, said compounds may be defined with reference to physical properties such as melting point, infra-red spectrum, nmr-spectrum, chemical and bio-chemical properties etc.

Example

A polyester filamentary yarn comprising at least 90 mol% polyethylene terephthalate and having a fineness of 3 to 5 denier per filament, **characterized** in that said yarn satisfies the following i) ~ iii) characteristics, after it has been treated for 3 minutes at temperature of 240⁰C, tension of 0.1 g/d, such that the said yarn satisfies the following iv) ~ vii) variations of microstructural physical properties:

- i) a density of 1.38 ~ 1.39 g/cm³,
- ii) a birefringence index in amorphous portions of 0.06 ~ 0.09,
- iii) tan δ peak temperature of 140⁰C and below,
- iv) the increment of a percent crystallinity (ΔX_c) of 10 ~ 20 wt%,
- v) the decrement of an amorphous orientation coefficient (ΔF_a) of at least 0.05,
- vi) the increment of a long period value (ΔLP) of at least 10 Å, and
- vii) the decrement of tan δ peak temperature ($\Delta \tan \delta_{\text{peak}}$) of least 5⁰C.

Product-by-process claims: Product-by-process claims may be obtained whenever the product has novelty and is unobvious over prior art products. These are claims reciting a product or composition of matter or its elements by the process by which it was made, rather than by its structural or chemical characteristics. Mixed claims are also permitted,

defining some features in “regular product” phraseology, and one or more features in product-by-process language. It is up to the applicant to describe what he thinks his invention is, and he can use product-by-process language whenever he thinks necessary or best for a particular claim.