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THE IMPORTANCE OF DRAFTING PROPER PATENT CLAIMS FOR NEW INVENTORS IN SRI LANKA.

" The patent system added the fuel of interest to the fire of genius.[1]"

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General Introduction

The Law of Patents strives to strike a balance between the promotion of technological invention and the dissemination and of access to its fruits[3]. A patent granted by the state give a monopolistic right to the inventor of the thing patented to exclude others from making, using or selling the invention. A patent, granted by the state, describes an invention and creates certain legal rights in respect of the described invention that can be exercised only by the owner of the patent, for a limited period[4].

The Law of Patents in Sri Lanka is governed by the provisions of the Intellectual Property Act No 36 of 2003. For a Product to be patented the invention must be new, involves an inventive step and is industrially applicable[5]. Out of the above requirements, proving the inventive step is the most difficult to overcome and is the hardest hurdle to clear.

When an inventor is applying for a patent he must fulfill the requirements set forth in the Act[6] and among them is the need to draft a claim or claims and the purpose of which is to delimit the scope of the monopoly[7]. The Act further stipulates that the claim or claims shall be clear, concise and supported by description[8]. Regulation No 37 declares some of the norms that must be followed regarding the drafting of claims[9]. However, this set of norms would not be much help to a person who has very limited amount of experience regarding patents. Regulation 37 has more to do with the content and the scope of the claim than the art and crat of drafting the claim itself.

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1 Abraham Lincoln's Second Lecture on Discoveries and Inventions delivered on April 6, 1858,
3 Donald S Chisum, *Understanding Intellectual Property Law* (6th edn, LexisNexis 2011). 163
4 20 years under the Intellectual Property Act No 36 of 2003
5 Intellectual Property Act No 36 of 2003 Section 63
6 *Ibid* Section 71
7 William Rodolph Cornish and David Llewelyn, *Intellectual Property* (6th edn, Sweet & Maxwell 2007). p 170
8 Supra Note 5,Section 71 [4]
9 The Gazette of the Democratic Socialist Republic of Sri Lanka EXTRAORDINARY No. 1,445/10 – WEDNESDAY, MAY 17, 2006

Importance of the Claim

Claims are the heart of patent law. Chisum, one of the most prominent scholars in the field opines that 'the claim is the most important part of the patent, setting forth the meets and bounds of the patentee's right to exclude the others[10]. Giles Rich, the former Chief Judge of the Federal Circuit, once famously stated that "the name of the game is the claim." Meaning, the patent claims themselves define the scope of the property right held by a patent owner[11].

McCarthy in his desk encyclopedia of Intellectual Property states that 'a claim is the part of a patent that define the technology which is the exclusive property of the patentee for the duration of the patent. A patent claim sets the bounds of the technical area within which the patent owner has the legal right to exclude others from making, using and selling[12]. Further in ***A.B Dick Co v. Burroughs Corp***[13] the federal court of the United States declared that 'it is elementary that the property rights bestowed by a patent is measured in the first instances by the claim'

The claims mark the boundaries of the protection provided by a patent, just as a physical boundary such as a fence, marks the limits of a parcel of real property. Thus, the claims are a written approximation of the abstract inventive concept created by the inventor[14]. The claims define the scope of protection provided by a patent. The Claims can also be explained as the statement of technical facts expressed in legal terms defining and identifying the scope of the invention, the protection of which is sought[15].

A claim provides the basis to determine whether the rights of the patentee is violated or not. It then becomes pivotal that it be drafted in such a manner that the patentee be protected in the broadest sense possible. If a patent claim is drafted in such a way where due to the drafting of the claim even a slight modification to the existing patent claim will not be infringed because of the claim which is poorly drafted could be catastrophic to the inventor. Claims are not technical descriptions of the disclosed inventions but are legal documents like the descriptions of lands by metes and bounds in a deed which define the area conveyed but do not describe the land[16].

10 Donald S Chisum, *Principles Of Patent Law* (3rd edn, Foundation Press 2004). P90
11 *Ibid*
12 Supra Note 10
13 713 F. 2d 700 - 1983
14 *Mccarthy's Desk Encyclopedia Of Intellectual Property* (3rd edn, BNA Books 2005).
15 D. M Karunaratna, *Elements Of The Law Of Intellectual Property In Sri Lanka* (1st edn, Sarasavi Publishers 2010). p151
16 H.E Dunham, 'Drafting Patent Claims' (1947) 29 Journal of the Patent Office Society.318

How One Should Draft the Claims

To be a successful draftsman of claims, one must be possessed of a good degree of imagination. He must have the ability to look beyond the precise physical structure before him and visualize how the same results or advantages might be obtained by more or less obvious modifications or substitutions. Unless he has this ability and exercises it, there is a very good chance that the claim will be so narrowly drawn that it may be very readily avoided[17]. The patent agent needs to understand the differences between three legal constructs related to patents: inventions, embodiments and claims. An "invention" is a mental construct inside the mind of the inventor and has no physical substance. An "embodiment" of an invention is a physical form of the invention in the real world. The "claims" must protect at least an "embodiment" of the invention – but the best patent claims will protect the "invention" itself so that no physical embodiments of the invention can be made, used or sold by anyone without infringing the claims[18].

One point, which will be well to keep in mind in connection with the drafting of claims, is that, while the specification is addressed to persons skilled in the art or science to which the invention pertains, the claim is addressed to an interpreter of written instruments i.e.: the lawyer and the Court. Early patents did not have claims and the scope of the patented invention was determined in court proceedings during patent infringement litigation by reviewing the specification filed by the inventor. Not surprisingly, this process eventually became unworkable and the process of patent claiming was born as a means for providing greater notice of the boundaries of the patent. On early days of the patent system the courts were much liberal with their interpretation of the claims as well but this trend changed with time and now though the courts use a purposive approach in interpreting claims it is nonetheless done in a strict manner.

A good patent draftsman will probably not want all the claims to meet the apparent theoretical maximum of protection since subsequent litigation will likely raise invalidity arguments not contemplated by the patent examiner. Thus, the patent draftsman will want to draft some narrower claims in the event that the broadest claims are invalidated. A narrower set of claims will often be upheld as valid during litigation but will still be "broad enough" to prove infringement against the patent infringer.

17 *Ibid*
18 WIPO Patent Drafting Manual available at http://www.wipo.int/edocs/pubdocs/en/patents/867/wipo_pub_867.pdf

There is no universal code for drafting patent claims. The WIPO Patent Drafting Manual is a useful guide for understanding the basics of drafting claims. It lays out the considerations one must take in to account when drafting claims. While, as we have indicated, there are no general rules of universal application with reference to the drafting of claims, there are certain principles which the draftsman should continually keep in mind in framing the language of the claim.

Claims are usually made up of three parts: a preamble, a transition phrase and a body. The preamble identifies the invention or the technical field of the invention. The transition phrase joints the preamble to the body of the claim, and is usually made up mainly of the word 'comprising' however, some other words such as containing, consisting and including may also be used. This will mean that the invention includes the listed elements, but does not exclude others. The body of the claim includes a recitation of the elements: the steps or parts that make the invention[19].

Claims can be independent, dependent, or multiple defendant in form. An independent claim is completely self-contained. A defendant claim refers to an earlier claim and thus it incorporates by reference all limitations of the previous claim and includes its own limitations. A multiple dependent claim refers back in the alternative to two or more claims and is considered to include all of its own limitations as well as those of any one of the referenced claims.

A draftsman of patent claim should certain that the claim must include the features or characteristics which yield the most beneficial or useful result. This is just another way of saying that the claim must be complete, since if it is not complete it may be subject to the criticism that it is broader than the invention.

In order to satisfy the above requirement, the claim, if for a machine or an article of manufacture, must include structural limitations, otherwise it would be objected to as being purely functional. In this respect, the draftsman may find good opportunity for the exercise of his ingenuity. In reciting structure, he may be able to choose words which will convey the structural idea without limiting the claim to the particular structural form or forms disclosed in the specification. For example, "member" or "support" is broader than "rod," "bar" or "shaft" and "driving means" while verging upon the functional, is broader than a recital of a "shaft," "pulley," "gearing," 'crank," etc.

19 Supra Note 10 at 91

Whatever the language used, its meaning should be clear. If any terms are used in a sense which varies somewhat from their ordinary dictionary meaning the specification should make clear the sense in which such terms are used. One of the most common criticisms which are leveled against patent claims is that of ambiguity and in many cases the patent lawyer has been accused of purposely drafting claims in ambiguous language so that they could be "twisted like a nose of wax" to meet various forms of alleged infringement which might arise.

There is always present in the draftsman's mind the fear that if too much is included in the nature of structural limitations the claim may be unduly narrowed. In reaching a decision in this direction the draftsman must make full use of his imagination. If the structural limitation is one which constitutes an essential feature of the invention and no other structure could be employed for the same purpose, obviously its inclusion does not unduly limit the claims. Another thing to keep in mind in drafting claims is to avoid as far as possible the use of relative terms. the use of such terms in the claim is likely to result in a holding of invalidity because of indefiniteness. If the practice of using comparative words is to be approved, a patent might claim the same combination except to make the one element thinner and lighter. Then along with time might come another inventor who could get a patent because he made that particular element still thinner and still lighter than the first.

Another situation with which the claims draftsman is sometimes confronted is that of the case where an invention is made relating to an element of an old combination. In order to give the matter as wide coverage as possible,' there is a rather natural desire to present claims to the Whole combination as well as to the individual element. Quite obviously the Courts do not welcome such efforts because of the fact that such claims may embrace much more than the actual invention involved.

Conclusion

In presenting claims for an invention, we should keep in mind not only the presentation of broad claims but also much more specific claims. If we could be sure of the exact form in which everybody would want to use the invention, a specific claim to that form would be the most valuable claim that we could have. It would, of course, be infinitely easier to win an infringement suit on such a claim than on a broader claim which might meet with unexpected defenses. We cannot always, however, or even in the majority of cases, foresee the exact form in which the invention will be most used before the patent expires.

Therefore, we want to have claims as broad as we are entitled to have and at the same time a careful study will indicate the specific important features which should also be claimed.

Finally, a careful check should always be made between the specification and claims to make sure that the language of the specification and its disclosure furnishes ample basis for all of the claims. There is no excuse for the situation which so often occurs when the patent is put in litigation, where a specification furnishes no description of the subject matter claimed or where the particular language used in the claims is entirely unsupported by any language of the description.

As we more observe from the above, the drafting of patent claims is not a simple task, it may even more difficult than drafting a statute at times. As an attorney drafting patent claims, one must acquaint himself with the full knowledge of the invention itself to have a good understanding mechanics and mechanisms involved therein. There can never be a hard and fast rule on the precise drafting of claims, therefore it is always better to get some subject knowledge of the invention before you draft the claims.

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