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The claims constitute the most important part of the specification due to the fact that the validity of a patent is often attacked both in the opposition proceedings before the Controller and in infringement proceedings before courts on the ground of some error(s) in the claim.

CLAIMS

The claims can be categorised as:

- (a) Claim which is the main claim—It should state what the invention is in the broadest possible terms.
- (b) Subordinate claim(s)—which claim(s) refer to the additional feature(s) of the invention.
- (c) Omnibus claim—which relates to any arrangement substantially as described and as shown in the drawings.

The omnibus claim protects the applicant from infringement of his invention by creation of equivalent alternatives.

The claims should be drafted in such a manner that designing around the patent is not easily possible.

When question arises as to what forms part of claims and what not, the construction of the claims assumes importance.

The principles of the construction of specification:

- (1) The complete specification must be read as a whole in the context of surrounding circumstances prevailing at the date of publication of the specification without regard to subsequent infringement or conduct of the patentee.

The pith and marrow of the claim, that is novelty and newness of the product or process, have to be considered.

- (2) The claim itself marks out the legal limits of the monopoly granted by the patent. If an applicant fails to claim something, it is considered as being disclaimed. He cannot later claim that the features which he failed to mention were a part of his claim.
- (3) The language of the claim must be clear and un-ambiguous so that the claim cannot be restricted, expanded or amended by a reference to some limitation in the language used in the claim or in any earlier part of the specification. For instance, an applicant cannot say that he meant something in a claim but forgot to draft it in a precise manner.

However, for clarity, the rest of the specification can be referred to for deducing the real meaning of the technical terms and to resolve any ambiguities in the construction of the claim.

- (4) The meaning of a specification is addressed to a person skilled in the art; whose level of knowledge extends to the state of art in the particular field at the time of the invention. What is new and non-obvious is determined with reference to the level of knowledge of such a person.

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- (5) The subjective opinion of the patentee or his witnesses regarding the invention are immaterial in arriving at the meaning of claims.
- (6) The Court of competent jurisdiction is the authority to interpret the specification. The Court can call expert evidence to explain the meaning of technical or specific terms and phrases used in the specification.
- (7) If the other party relies on documents other than the complete specification to plead invalidity of the patent, such a document would be inadmissible.
- (8) The meaning of the claim is to be the same whether for the purpose of infringement or challenge to its validity.

WHETHER A SPECIFICATION CAN BE AMENDED ONCE IT HAS BEEN FILED

A complete specification once filed is not absolute. It can be amended, subject to certain conditions, at the following three stages:—

- (a) Amendment before acceptance.
- (b) Amendment after acceptance.
- (c) Amendment after the sealing of patent.

Amendment before acceptance

The Patents Act, 1970, as amended by the Patents (Amendment) Act, 2005, provides under section 15 that where the Controller is satisfied that the application or any specification or any document filed in pursuance thereof, does not comply with the requirements of the Act or any rules made thereunder, the Controller may refuse the application or may require the amendment in the application, specification or other documents before he proceeds with the application and refuse the application on failure to do so. The amendment may also be sought by the applicant himself. In such a case if the proposed amendment is not based on a matter fairly based on the specification filed earlier, it would be unacceptable. If such amendment does not add a new dimension to the matter covered in the original specification, the date of the applicant would remain the same. That is to say, that in spite of such amendment, the priority date of the specification would remain intact. However, if the amendment sought to be introduced by the applicant brings in matter which is new or which changes the character of the earlier matter in the specification, then the date of the specification would be changed to the date when such amendment is filed. Such an application for amendment will be advertised for anyone to oppose the proposed amendment.

Amendment after acceptance

When the application has been accepted by the Controller and published in the Official Gazette, a party may oppose any of the claims in the specifications. If the Controller finds merit in the Opposition, he may direct the applicant to amend the specification. However, the Controller shall not pass any order allowing or refusing an application to amend an application for patent or a specification, while any suit before a court for the infringement of a patent or any proceeding before the High Court for the revocation of the patent is pending.

Amendment before the grant of patent

Before the grant of patent, a person other than patentee, can apply for revocation of the patent before the High Court. The High Court in a given case instead of revoking the patent, may order amendment of the specification to preserve the rights of the patentee.

CONDITIONS FOR AMENDMENT

An applicant for a patent or a patentee to whom a patent has already been granted, cannot on his own, amend his specification at any stage, *i.e.*, before or after acceptance of the specification. Granting such a liberty would result in repeated changes being incorporated in the specification all the while, thereby keeping the entire process in confusion.

The amendments can, however, be made only under certain conditions imposed by the Act, as below:

Disclaimer

The amendment must be by way of disclaimer. A disclaimer is a statement by the applicant denying a claim. Such a clause reduces the scope of monopoly by restricting the spread of the claim. *For example*, a wide claim covering two or more ways of construction can be reduced to a claim which covers only one of those ways of construction. A disclaimer would be read like this: "This invention claims -----but does not claim-----."

Correction

The amendment can also be for the purpose of correcting an obvious mistake in the specification. The correction which can be made in a specification is limited to any typographical or minor mistakes that have been made in the preparation of the specification and not any correction so as to produce an effect of the invention being altogether different from what was presented earlier. A mistake may be apparent on the face of the specification in which case the Controller himself may require the applicant to make an amendment. The applicant himself can also seek correction of any such mistake. When the mistake is not apparent on the face of the specification, the applicant, in case he is the one who applies for amendment, has to furnish evidence to support that there indeed was a mistake in the specification.

For instance, where the correction in a specification amounts only to a mere change in the nomenclature, it may be allowed. But in case the amendment completely alters the identity of the compound in the specification, it cannot be allowed.

The correction is not easily allowed where the mistake in the document is clearly incorrect and inconsistent with the body of the specification. *For example*, an applicant realises after the filing of his specification that he missed out an essential claim, even though it was evident in the specification which if not protected, could enable anybody to design around the patent without being held liable for infringement. He can seek such amendment.

The amendment has to confine itself to the matters disclosed in the earlier specification. The proposed amendment cannot claim or describe matter not in substance disclosed in the earlier specification.

The scope of the specification must not be widened by an amendment. This means that he cannot make a claim for a monopoly right which was not included in the earlier specification.

Explanation

If something that is sought to be brought in by way of amendment which merely clarifies or better explains some expression in the specification but does not change its meaning or context may be allowed by the Controller or the High Court.

However, where after the date of grant of patent any amendment of the specification or any other document related is allowed by the Controller or by the Appellate Board or the High Court:

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However, where after the date of grant of patent any amendment of the specification or any other document related is allowed by the Controller or by the Appellate Board or the High Court:

1. The amendment shall for all purposes be deemed to form part of the specification along with other documents.
2. The fact that the specification or any other document related thereto has been amended shall be published as expeditiously as possible.
3. The right of the applicant or patentee to make amendment shall not be called in question except on the ground of fraud.

WHO IS TO ALLOW THE AMENDMENT

An amendment if proposed to be made before the grant of the patent, has to have the approval of the Controller. If a specification is challenged in a revocation proceedings after the grant of the patent before the High Court, that Court would be the appropriate authority to allow the party to amend its specification or claims.

The amendments to the specification cannot be sought by the applicant or any person other than the applicant as a matter of right. The Controller, in case amendment is sought prior to the grant of the patent, and the High Court after such grant on revocation proceedings initiated before it, may grant the amendment in full or in part in exercise of their judicial discretion.

