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# WITNESS

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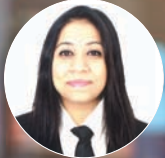
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# Decoding the 'Myth' behind the 2-Part Claim Drafting Format in the context of the Koninklijke Philips' Case

■ Mohit Goel & Sidhant Goel

**D**etermining the scope of claims of a patent is the first and foremost step before an infringement analysis or invalidity determination of a patent can be conducted in a patent litigation. Without a clear understanding of the scope of claims, determination of infringement or invalidity cannot be performed appropriately.

The Delhi High Court, in its recent judgement in Koninklijke Philips Electronics N.V vs. Rajesh Bansal, Sole Proprietor, Mangalam Technology [CS(COMM) 24/2016], which has the distinction of being India's first post-trial judgement on Standard Essential Patent (SEP), has shed some light as to the determination of scope of claims drafted in a European 2-Part form. Relying on the expert witness, Hon'ble Justice Mukta Gupta held that the scope of claims of the corresponding patents in both the European Union and in USA were equivalent to that of the claims of the patent in India. Specifically, claims of Indian Patent No. 184753 ("IN'753") are equivalent in scope to Claims 33 to 37 of US5696505 ("US'505") and EP0745254 ("EP'254").

On a reading of claims of IN'753 and corresponding claims of US'505 and EP'254, it is evident that the claims of IN'753 and EP'254 are drafted in a '2-Part form' or using a 'characterized by' clause, while the claims in US'505 do not contain such '2-Part form' claim format, which format is also known as the 'Jepson form' of claims in USA.

On a further reading of the claims, it is evident that the inventive step of EP'254 and

IN'753 resides not in the 'decoding device' as a whole but specifically in the "converting means (113,114,115), which are arranged for converting the "code". On the contrary, in the claims of US'505, the decoding device is claimed as a whole without the Jepson format of claims.

It is also noteworthy that the inventive step in US'505 is manifested by a 'wherein clause' in Claim 33 of US'505, which states as to how the converting means are arranged similar to the post-characterization portion of its European and Indian Counterpart.

The 2-Part form, as manifested in Article 43 of European Patent Convention, and which is followed in India as well, clearly states that the claim shall define the matter for which protection is sought in terms of technical features of the invention and a characterizing portion, beginning with the expression "characterized in that" or "characterized by" and specifying the technical features for which protection is sought.

Hence, it is evident that the features disclosed after the "characterizing" portion are the novel and inventive features and patentable weight or protection should be extended to only those features, and the features disclosed in the "pre-characterizing" portion are the prior arts or non-novel portions of the invention, to which protection should not be extended.

On a brief reading of the claims of IN'753 and EP'254, it appears that decoding devices that have converting means were known in the art, and therefore, the inventive concept was claimed in the 'way' the converting means are arranged, and the method of



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decoding is performed. Justice Gupta defines the claim scope to include the decoding device along with all the auxiliary components that are contained in the Printed Circuit Board, even though the auxiliary components are not claimed in the claims of IN'753, since the decoding device is an integral part of the DVD player.

In the opinion of the authors, this is the correct manner in which claims must be construed. When the inventive feature is so intrinsically connected to the other parts of the device, such that the inventive feature cannot have any existence without the other parts of such device, then a patent over such inventive feature must be deemed to cover the device as a whole, which contains the inventive feature. In other words, when features disclosed in the 'pre-characterizing portion' of a claim is an integral part of the claim, without which the novel technical features cannot work, then protection should be extended to the whole of the claim and not only to the technical features subsequent to the 'characterizing portion'.

To illustrate this better, take the example of a revolving chair that has wheels on its legs. Assume that the prior art taught a revolving chair that has four wheels. If a person invents a chair with six wheels, the claim of the inventor will have to be a 'chair' with six wheels, and not only to 'six wheels' per se. The reasoning for this is very simple – the wheels are irrelevant without the whole

chair, and therefore, the six wheels have no industrial application without the whole chair. This is a very basic example that encapsulates the thought process behind Justice Gupta's reasoning in the Koninklijke Philips' Case above.

In this regard, it must also be noted that the Indian Patents Act makes no distinction in scope of protection based on the manner in which the claim is drafted. In any case, unless a person invents a completely new device, which has no roots in existing knowledge, every machine, apparatus, process, and the like, would naturally be an "improvement" in some sense of what is already in the public domain. Therefore, the logic behind the '2-part' claim drafting mechanism cannot be said to mean that protection is only given to the 'post-characterization' portion of the claim.

Having said this, it is also obvious that only those devices that contain the inventive feature, which is contained in the post-characterization portion of the '2-part' claim, would be within the scope of protection of the patent. Therefore, in the above example of a chair, any person would be free to make a 'chair' that does not have six wheels. Similarly, in the context of the Koninklijke Philips' Case, any decoding device that used the pre-existing 'ways' in which the converting means were arranged would also not be covered by the scope of the patent in India. [\[w\]](#)



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