

Succinctness of claims

Section 10(4) of the Patents Act 1953 very specifically requires that claims of a complete specification must be succinct and this is taken to apply to each claim individually and to claims when considered as a set.

This provision avoids the burden of a reader having to read over repetitive matter in claims.

To meet the requirement of succinctness, each claim should clearly express the intended content without prolixity or undue repetition.

The presentation of plural independent claims, each one of which defines a different category of the invention, such as:

- a product,
- method of making the product,
- use (or method) of using the product,
- and apparatus for making the product,

will not in itself draw an objection that the claims are not succinct.

When plural independent claims of the same category are presented one independent claim should not fall wholly within the scope of another independent claim.

Objection will be taken to claims which do not meet the statutory requirement of succinctness.

Even where independent claims of the same category and having different and substantial mutually exclusive features, so that one does not fall wholly within the scope of another, are presented, objection that the claims are not succinct will be taken if repetition of subject matter from claim to claim is considered excessive.

If there is deemed to be such an excessive number of independent claims with excessive repetition, objection will be taken that such a plurality of independent claims makes it difficult, if not impossible, to determine the common novel inventive concept, that is, the claims taken as a whole do not clearly define the invention.

Where objection is taken that an independent claim falling wholly within the scope of another independent claim is not succinct, the Applicant may overcome the objection by

- amending the offending claims into the form of one independent claim and one or more dependent claims with consequential amendments, such as re-numbering, as necessary.

Where objection is taken to prolixity or undue repetition the Applicant may overcome the objection by more succinctly expressing the content intended.

It is appreciated that New Zealand legislation may differ to that in other countries, which may not have a statutory requirement that patent claims be succinct.