Toward an Infringement Continuum

Bernard Chao

For many years, patent law has struggled with the issue of permissible claim scope. A patent's specification and its claims often suffer from a surprising disconnect. The specification generally describes an invention in terms of one or more specific implementations; suggesting a relatively narrow invention. But claims are drafted far more broadly. They frequently encompass unforeseen variations and even cover after arising technology.

Although there are numerous existing doctrines that try to prevent claims from straying too far from their specification, these doctrines offer binary outcomes ill-suited for patent law. If a claim is too broad, it is found to be either invalid or not infringed. Thus, as a claim encompasses subject matter further and further away from what the specification describes, there is a point where the inventor suddenly loses all rights. These outcomes make sense when property boundaries are clear and all trespasses are considered equal wrongs. However, in patent law, claims are fuzzy and parties have difficulty assessing validity and infringement. What's more, using technology that falls within the core of what a patent describes should be treated far more seriously than infringement that was unforeseen at the time of the invention.

Consequently, I propose a new theoretical framework that ties patent disclosure doctrine to the remedies the law offers. Although I would continue to use the claims to determine infringement, I suggest that the specification be used to assess the remedy. Under this "infringement continuum", the patentee's remedy diminishes when the nature of the infringement looks less and less like what the specification describes. In different proposals, others have already suggested that the availability of injunctive relief should be based on the nature of the infringement. Standing alone these proposals all have merit, but they only offer piecemeal solutions. This paper describes a more comprehensive theory that explains how these proposals are points along a larger continuum. By way of example, this paper goes onto describe how money damages can fit into the continuum. I suggest replacing the current lost profits/reasonable royalty framework with one solely based on royalties that consider disclosure principles. If the infringement would hypothetically compete with embodiments described in the specification, the damages should be higher. However, if the infringement would not compete, the damages should be substantially lower.

In sum, this paper offers a theoretical basis for rethinking patent remedies in terms of disclosure principles. The proposed "infringement continuum" improves on existing doctrines that offer binary outcomes because this theory can tailor the remedy to address claims of vastly varying scope.