Regulating Patent Claiming

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Standard patent theory says that patentees are the masters of their own patent claims, and should have broad freedom to choose their own claim language, subject only to the requirements of clarity and accuracy in describing the invention. Yet patent law in fact imposes numerous hard and soft limitations on how patentees may write their claims. PTO rules require claims to be written as a single sentence. Claims must be formatted so that they begin with a preamble and follow with a main body. And, although not strictly required, patentees have strong incentives to use the word “comprising” in their claim, rather than synonyms such as “consisting of.” If the only policy goal is to encourage the patentee to clearly and accurately state his invention, then these artificial rules on patent claim format and language make very little sense. And no one has provided an account for why patent law has these seemingly-silly rules governing claim form.

This Article provides a theory, by borrowing from the numerus clauses principle in property law. As Tom Merrill and Henry Smith have explained in other contexts, people are not allowed to infinitely tailor property rights, because esoteric new forms of property rights increase information and transaction costs to the rest of society. Rather, people must transact property using a few standard templates, such as conveying a fee simple, leasehold estate, life estate, etc. By the same logic, forcing patentees to delineate their patent property rights according to standard templates helps reduce information costs. As the Article will discuss, this insight does not only explain a few seemingly-trivial PTO rules governing patent claim format, but helps inform debates on claim interpretation as well as patentable subject-matter. The Article will argue that debunking the standard theory’s emphasis on patentees’ freedom to claim, and imposing more structure and uniformity on patent claiming, would likely increase efficiency.