

Ex Post Claiming

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According to the conventional wisdom, claims are the most important part of a patent, defining the patentee's right to exclude and informing the public of its scope. My goal is to challenge this conventional wisdom.

In practice, the claims provide no meaningful measure of the patentee's rights. This is because claims can be *changed* after filing and throughout the patent's lifetime, through pre-issuance amendment, reissue, reexamination, and continuation applications. Patent law permits moving the fence to enclose the neighbors' new house, and then evicting the neighbors for trespassing.

The common justifications for all the methods of *ex post* claiming are that (1) patentees do not fully appreciate the nature of their invention until later insights arise, and (2) that patentees will inevitably make claim drafting mistakes. These rationales, however, represent the precise *problems* with *ex post* claiming, not its redemption.

First, permitting patentees to cover later insights is equivalent to permitting patentees to obtain monopoly rights over something they did not actually invent. This results in a windfall gain to the patentee. Windfalls only minimally increase the incentive *at the time of filing*—which is the only relevant incentive because invention and disclosure both occur by that time. This is because the inherent uncertainty of future windfalls requires a high rate of risk discounting.

Second, even when *ex post* claiming is used only to correct mistakes, the retroactivity of *ex post* claiming effectively shifts the risk of loss from claim drafting mistakes from patentees to competitors. Taking insights from tort law, a patentee is clearly the cheaper loss avoider who should bear the burden of avoiding mistakes and the consequent loss. Placing the onus of detecting and avoiding claim drafting mistakes on competitors increases the transaction costs of the patent system.

Accordingly, *ex post* claiming should not be permitted where (1) the patentee is capturing later insights; or (2) competitors rely on the written claim. I propose a solution where claim amendments should be permitted only before a patent issues, and only when the patentee can demonstrate that an amendment covers a feature that was subjectively regarded as novel at the time of filing. This solution reduces the risk of abuse by patentees, while providing limited room for correcting mistakes (in the absence of detrimental reliance) avoids inefficient over-investment in claim drafting.