Claiming Intellectual Property

Jeanne C. Fromer*

In this Article, I explore and analyze the comparative value of different American systems for claiming intellectual property. A claim to intellectual property not only describes the bundle of rights that the holder has but also attempts to convey the abstract thing protected by these rights. American patent law requires peripheral claiming, by which the patentee must delineate the bounds of his invention. In theory, only inventions that fall within the bounds of the category drawn by the patentee will be within the scope of the patent. By contrast, American copyright law implicitly requires central claiming by necessitating only that the creator fix a particular creation, such as a book or film, not that he expressly claim the full category of creations protectable under that copyright. These two intellectual-property claiming systems are less different than is typically imagined, in that the patent system incorporates elements of central claiming, while the copyright system encourages forms of peripheral claiming. This description of American patent and copyright law suggests that neither strict peripheral nor strict central claiming is fully useful for claiming intellectual property, but that the advantages of each need to be maximized. In that light, I compare how the choice of peripheral or central claiming affects the costs of claim drafting, efficacy of notice to the public of the extent of the set of protected embodiments, ascertainment of protectability, breadth of the set of protected embodiments, and ability to defer to the future decision of whether certain works (typically those that are technologically, commercially, or intellectually unforeseeable) fall within the set of protected works. In reliance upon this analysis, I argue that the claiming systems of both patent and copyright law would benefit from restructuring so as to stimulate overall innovation and creativity by simultaneously giving the incentive to create protected works and encouraging creation by others beyond the intellectual-property right.

* Associate Professor, Fordham Law School. For helpful discussions and comments, thanks to Arnaud Ajdler, Christopher Cotropia, Kevin Davis, Rochelle Dreyfuss, Sonia Katyal, Mark Lemley, Douglas Lichtman, and Anthony Reese.