

# Overclaiming is Criminal

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# CW: PTO alone is Responsible for Claim Scope

- Applicants can initially claim as broadly as they wish
- PTO has duty to cull invalid claims
- Pressure on PTO to police § 112

# Broad Initial Claiming is Dangerously Wrong

- Applicants have a duty to file claims that do not exceed what they invented.
- Knowingly & willingly overclaiming is a **felony**.

# 35 U.S.C. § 115: Oath

(a) NAMING THE INVENTOR; INVENTOR'S OATH OR DECLARATION.—An application for patent that is filed under section [111\(a\)](#) or commences the national stage under section [371](#) shall include, or be amended to include, the name of the inventor for any invention claimed in the application. Except as otherwise

(b) REQUIRED STATEMENTS.—An oath or  
(2) such individual believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application.

(i) ACKNOWLEDGMENT OF PENALTIES.—Any declaration or statement filed pursuant to this section shall contain an acknowledgment that any willful false statement made in such declaration or statement is punishable under [section 1001 of title 18](#) by fine or imprisonment of not more than 5 years, or both.

# How to Overclaim

- Unlikely with structural claims.
  - Claims provide §112 support
- Unlikely with §112(f).
  - §112(f) is an overclaiming safe-harbor
- Easy with pure functional lang.
  - Yes. *See* written description cases

# Implications for Patent Bar

- Applicants have duties wrt scope
- Analogy to Tax Ethics:
  - Planning & Avoidance / Evasion
- Patent Bar deserves clarification:
  - What was invented?
  - When/how can we use functional claiming?