SPECIFIC EXAM INSTRUCTIONS TABLE OF CONTENTS

C. Instructions Specific to this Particular Exam

1. Structure

The final examination is designed to be three hours in length. It consists of one integrated fact pattern and an assignment relating to that fact pattern.

2. Suggested Time Allocation

The emphasis of this examination is roughly proportional to the emphasis of the areas of patent law covered in class.

3. Use a new BlueBook (or, if typing and allowed by the exam taking software, use its mechanisms to create a page break) before your analysis of each major area of law

Start a new bluebook before beginning your analysis of each major area or logical subdivision. Remember to put your personal identification number on the cover of the bluebook.

*4. Even if you do not read the "Background" and "Dispute" sections before starting, it is **strongly recommended** that you read the "Assignment" section before you begin*

No matter what you do, please read the "Assignment" section before you begin writing. Further, it is ***highly recommended*** that you read the "Assignment" section first before reading the "Background" and "Dispute" sections of the examination.

5. Starting and Stopping the Exam

The examination section containing the examination problem(s) is in pages numbered one (1) through six (6).

Without looking at the content of the examination problem(s), please count your pages now to ensure that your examination is complete. If not, notify the proctor immediately.

"Warning" that the end of the exam period is approaching will be given by the proctor writing on the blackboard in the exam room(s) the amount of time remaining at approximately the five minute mark.

When time is called, stop writing or typing immediately.

DO NOT TURN THE PAGE UNTIL YOU ARE INSTRUCTED TO DO SO.

II. PATENT LAW FINAL EXAMINATION

1. The Background

Phil has developed and patented (as described in the specification): "vandalism-resistant modular building wall panels [that] are useful in the field of prison construction because the panels exhibit desirable sound and fire resistance, impact resistance (i.e., against bullets, bombs), and load bearing qualities." Claim 1 of Phil's '120 U.S. patent is as follows.

1. Building modules adapted to fit together for construction of fire, sound and impact resistant security-barrier structures comprising: (a) an outer panel [11][1] of substantially rectangular shape in the vertical plane serving as an outer wall; (b) two steel-plate panel sections [12 is typical], of lesser exterior surface area than the outer panel, serving as an inner wall; (c) said outer and inner walls forming the structure when a plurality of the modules are fitted together; (d) sealant spacing the inner and outer panel sections from steel-to-steel contact with each other by a thermal-acoustical ~~compressible~~ compressible-seal barrier material;[2] and (e) means disposed inside the module for increasing its load bearing capacity comprising internal steel baffles [30 & 31 are typical] extending inwardly from the panel walls.

Fig. 1

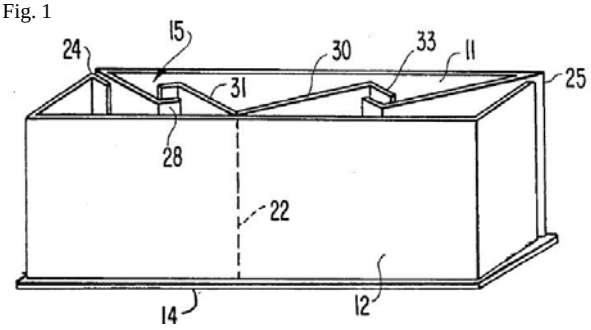
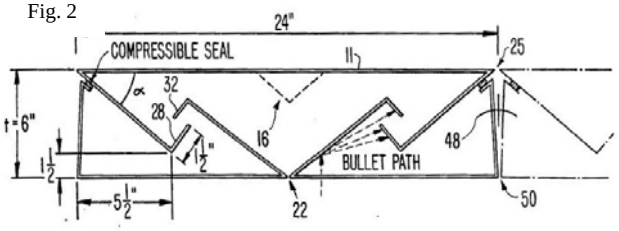


Fig. 2



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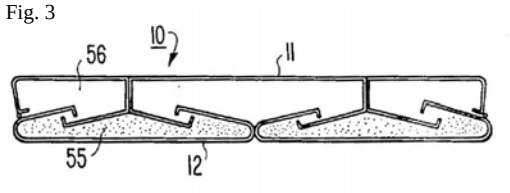
[1] The information in [brackets] throughout the claim is not in Phil's actual claim, but is only added for this description to help relate the claim to the figures.

[2] Phil made the amendment indicated in this claim language during prosecution in response to the PTO examiner's indefiniteness rejection. The examiner did not think the role played by the sealant was clear. The original disclosure also mentioned that any shown embodiment could be made of aluminum. A potentially relevant meaning of the word "sealant" includes: "*n* 1. A substance, such as sealing wax, used to seal a surface to prevent passage of a liquid or gas."

Phil filed for the ’120 patent on February 5, 2001 in the U.S., claiming priority from an earlier application.[3] It issued on April 23, 2002. The detailed description section of the ’120 patent discloses several embodiments, including: (i) the embodiment shown in figures 1 & 2 on the previous page; and (ii) an embodiment as shown in figure 3.

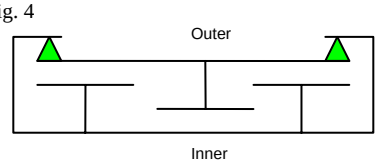
Fig. 3



When Phil amended part of claim subparagraph (d) he noted to the PTO: “the invention relies principally on the sealant’s compressible quality, thus the amendment indicates that while the barrier material has some sealing purpose, its more important function is compressibility.”

Dan manufactures and sells building modules used to build schools and county jails. His base-model 9110 product appears in cross-section in figure 4, showing one module, many of which can be interlocked into a building structure.[4]

Fig. 4



The ’120 patent also has dependent claim 2: “Modules as defined in claim 1 wherein the steel baffles are oriented with the panel sections disposed at angles for deflecting projectiles such as bullets able to penetrate the steel plates.”

[3] Phil filed the earlier application (the ’100 application) on June 7, 1999, but abandoned that application after properly filing the continuation application (the ’110 application) that ripened into the ’120 patent. While claims 1 and 2 were in the ’100 application, Phil added dependent claim 3 in the’110 application: “Modules as defined in claim 1 including insulating material disposed inside said modules to provide significant resistance to penetration and travel of projectiles that might penetrate the plates.” The ’100 application did not verbally mention insulating materials or discuss filling the modules. The only other addition to the ’110 application was a verbal discussion in the written description of filling the modules with insulation, suggesting using dense fiberglass-based insulation foam with R-values in the range of 22 to 38 (a higher R-value means more insulating power).

[4] The 9110 has an inner panel that wraps around its outer panel on the ends. Two load-bearing “T” structures extend into the interior from the inner panel, and one from the outer panel. The outer panel is of substantially rectangular shape in the vertical plane and serves as an

2. The Dispute

Phil sues Dan for patent infringement of claims 1-3, the only claims in the '120 patent. During the case the following additional facts are discovered and/or arguments, admissions and stipulations are made.

(i) Dan offers U.S. Pat. '510, issued on November 13, 2001 with an effective U.S. filing date of January 4, 2001. It discloses without claiming modular walls that meet the language of Phil's claim 1, and also have projectile-penetration-resisting insulation filling the interiors.

(ii) Dan offers a typed high school senior thesis paper describing: a wall module system for building prisons that discloses everything in claim 1, and also describes projectile-penetration-resisting insulation filling the wall's interiors. A footnote in the paper also mentioned using baffles[5] oriented at an angle from the walls to deflect penetrating bullets.[6]

(iii) Dan also discovers a U.S. patent to Axel. He offers related activity by Axel as a prior use bar under 102(b), and offers the patent for prior invention by another under 102(g). Axel's patent has two claims, one identical to claim 1 of the '120 patent, the other identical to claim 3. Axel conceived of his modular wall system on February 20, 1998. Working diligently, Axel completed an operational system on March 15, 1998. By the end of that month, using his new

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outer wall. The 9110's inner panel also serves as a wall. The inner and outer panels connect via contact spacing connecting-triangles made of thermal-acoustical barrier material that is compressible but non-sealing.

[5] Potentially relevant meanings of the word "baffle" include: "*v* . . . 2. To impede the force or movement of . . . *n* . . . 2. A partition that prevents interference between sound waves in a loudspeaker."

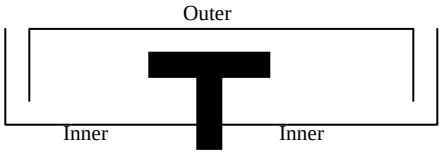
[6] The paper was written in 1993, but housed in the high school library in Hayseed, a small town in northwest Kansas. It enables a POSITA to make the invention. The high school library had no indexing or cataloging system. However, in July 1997, the paper was moved to Kansas University's engineering library and cataloged/indexed sometime in the month of August 1997.

modular wall system, he built a super-secret room deep in the bowels of a massive chemical plant where he worked.[7]

(iv) Phil testified that he conceived of the '120 invention on August 15, 1997. He was really busy, however, from that day until the first week of February 1998, growing pimentos for the state fair held that week. Starting the day after the fair he supposedly spent all his professional time, at least 40-50 hours per week, continuously working to perfect his idea up until a few days before he filed the '100 application, when he reduced his idea to practice.[8]

(v) Dan argues that the claims of the '120 patent are obvious in light of Xena in view of Yogyakarta ("Yoga") and Zack.[9] Xena, shown in cross section in figure 5, discloses a modular wall system with an outer wall meeting the language of subparagraph (a) of claim 1, where the outer wall fits within two inner wall pieces. The two inner wall pieces meet subparagraph (b), and they join to a sturdy "T" structure that provides increased load bearing capacity. Together, all this structure meets subparagraph (c). But, all the components of Xena are bolted together. Yoga discloses BatesAid™ sealant, used to seal cracks in leaky library basement walls. A POSITA would know that BatesAid™ sealant would also provide a compressible barrier. Yoga is a printed publication article. Included in the article is an

Fig. 5



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7 The room was used to test experimental machinery where pieces would often fly off at high speeds. Axel's room embodied both of Axel's claims and was completely enclosed by another structure to shroud it, and the company treated the testing room as a trade secret until the time Axel's patent issued many months later.

8 All Phil's testimony was sufficiently corroborated. However, from discovery Dan has Phil's pimento production records for February 1998, during which time Phil's pimento production remained very high. Dan alleges that Phil kept growing pimentos and did not start to develop his idea until early March 1998.

9 Phil admits that all three asserted references are prior to his date of conception for the '120 patent. He agrees that Xena is analogous art, but he disputes that the other two are.

inserted editorial discussing other uses for BatesAid™ sealant, noting that a great application for BatesAid™ would be to use it with the Xena structure for modular building construction, and that there may be a good market for this in the explosion-proof building category. The Zack reference discloses a bulletproof vest for law enforcement that uses internal baffles with overlapping lips similar to those shown in the interior of the structure in figures 1 and 2. The Zack baffles are more flat, since they must fit in a vest a person wears. The Zack reference discusses the tremendous advantages of overlapping lipped baffles for projectile deflection.

(vi) For the last three years Phil has spent millions of dollars to promote and market products based on his patent. Despite many customers saying that the features were beneficial and innovative, Phil has only been able to penetrate two percent of the market. His licensing efforts have been futile because the market wants to see Phil win a test-case first. Thus, Phil is near bankruptcy, but he attributes the problems to the virtual standstill in prison construction the last three years due to state budget problems.

(vii) Dan's base-model 9110 has been sold for the last two years as a number of specific models, described in this paragraph. These models are the devices Phil accuses of infringing. All models have the same structure as given in figure 4, and all have the contact spacing connecting-triangles made of thermal-acoustical barrier material that is compressible but non-sealing. Dan sells the 9110-S, which is made of stainless steel. The 9110-A is made of aluminum. The 9110-P has a hard-plastic outer wall. All three models have been sold with or without interior projectile-penetration-resisting insulation,[10] although Dan only sells modules with R-value insulation above 50. Dan admits that all versions meet the language of subparagraph (c) when sold to county jails, but not when sold to schools because for schools they are not used in the "construction of fire, sound and impact resistant security-barrier structures."

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[10] The model numbers use an extra letter to indicate whether they have insulation. For example: (i) 9110-A-f is the aluminum 9110 filled with the above-described insulation; (ii) 9110-A-u is the same, but without insulation. If there is no extra letter, it could be either.

(viii) Without making admissions on the rest of the claim language, Dan contends as against all of Phil's 3 claims: (*A*) that the 9110-P does not meet (literally or under DOE) a proper claim construction of some of the language of subparagraph (a); (*B*) that none of his models meet subparagraph (b); (*C*) that the 9110-A does not infringe; and (*D*) that subparagraph (e) is limited by means plus function format to the interior structures shown in figures 1, 2 & 3.

(ix) In response, Phil: (*A*) agrees that subparagraph (b) is not literally met, but asserts DOE for it; (*B*) asserts DOE for the 9110-A, admitting no literal infringement; (*C*) argues that under a proper claim construction subparagraph (d) is literally met, but asserts DOE in the alternative; and (*D*) argues that under a literal analysis subparagraph (e) is met, but reserves in the alternative a DOE analysis.

(x) Dan's expert, Derrick Posita2: (*A*) admits under cross-examination that the aluminum construction of 9110-A meets the tripartite test of substantially similar function, way and result ("SSF-SSW-SSR") as compared to the relevant language in Phil's claims; (*B*) but that, among other arguments, the 9110's inner wall performs a different function because the "T" structures protruding from it are not "baffles," and because, as a single-piece inner wall panel, its "way" is different; and (*C*) Posita2, however, admits that the result of "serving as an inner wall" is substantially similar.

(xi) Phil's expert, Paul Postia1, states that a POSITA would understand that the "T" structures in the 9110 are disposed at an angle for deflecting projectiles: the angle is 90º and the projectiles hit the wall in a fashion other than head-on, e.g., a bullet penetrates the wall with a path of entry at 45º to the wall's surface.

III. THE ASSIGNMENT

Write a short analysis for each of the issues raised by the facts enumerated in the examination question, ***based only on the law from the Patent Law class***. The analysis should communicate the following as briefly as possible based on the facts available: (i) discuss the arguments, positions and patent law rights that the plaintiff should assert, or has asserted,[1] against the defendant(s); (ii) evaluate the arguments and substantive merits from plaintiff's perspective and defendant(s) perspective, articulating defenses and counter-arguments each should/might assert; (iii) assess the strength of each party's arguments; and (iv) determine for each issue who is likely to prevail and explain why. Your written answer, however, should not be organized according to these four points.

Rather, for each issue, your analysis should communicate the issue, and then state/apply the law to the issue's facts (applying counterarguments as well), and then conclude on the issue. An exception to this is that there is no need to restate a legal test that has already been stated; simply refer to the previous statement of the rule. Another way to say this is that if a second issue arises where there is a need to apply a legal test already related and discussed, you may analyze the second issue by exception, i.e., discussing the differences in application and outcome.

If you believe that there are any additional critical yet unsupplied facts that would materially impact the outcome of a particular issue, you should note what such facts would be. In such case, ***briefly*** describe how such critical facts might impact the outcome, i.e., indicate ***at most one and only one*** differing result that would ensue from different reasonable factual assumptions about such unsupplied facts.[2]

Organize your written answer logically by subdivisions within patent law. In addition, as a general matter, discuss any invalidity/protectability issues before any infringement issues.

Your written answer does not need a general introduction. Proceed immediately to analyzing the issues. The location of final jurisdiction and/or venue for the expected case/dispute is unknown at this time, except that it will be in federal court.[3]

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[1] The examination question is written in such a way that certain issues are clearly "in" the case/dispute because they have been asserted by either plaintiff of defendant(s). You should analyze these issues, but there may be other issues to be analyzed as well that are not yet asserted by either side. In addition, the examination question may also indicate that certain other possible issues are "out" and not to be analyzed because the parties disclaim certain issues or protections.

[2] Please note that if you find yourself discussing alternative outcomes for supposedly critical yet unsupplied facts for every issue you analyze, you are probably engaging in too much analysis of such alternative outcomes.

[3] Despite this jurisdictional orientation, the issues in this examination do not include jurisdictional and procedural issues, but rather focus on the substantive law and rights from the class materials. In addition, you are to analyze and discuss the probable ultimate outcomes under the substantive law studied. Do not analyze any intermediate standards, such as likelihood of success in obtaining a preliminary injunction. In addition, we did not study the details of potential remedies or damages, so do not discuss these items.

Apply only the majority rules from the applicable law. Thus, your memo can ignore any significant outcome-determinative differences in majority/minority rules and need not supply/apply minority rules. Probably the only way in which minority rules or dissents are relevant is that they sometimes provide inspiration for counterarguments.

In addition, however, in patent law we have a few instances of "contradictory" majority rules. These are cases where separate panel decisions have rendered arguably inconsistent holdings/approaches/determinations. One signal for these instances is dissents from a denial of an en banc petition. From the law studied in class, there are probably no more than a half-dozen instances of this, and perhaps only one or two. These variances in the law should be considered in the context of discussing/applying potential outcome-determinative differences in the law.

You should analyze clearly presented (either explicitly or by the facts) infringement issue(s) in the case/dispute even if your memo determines that the relevant item of intellectual property is invalid, unenforceable or not properly the subject matter of protection.

In this vein, some patent claims may have multiple issues of invalidity charged against them. Each invalidity issue raised by the problem's facts should be evaluated even if your analysis determines that a patent claim is invalid due to one of the raised issues.

A related problem exists for multiple types of infringement (and potentially for the predicate inquiry: claim construction). For example, in patent infringement, any particular element/limitation of a claim can be met by the accused infringing device/process either literally or under the Doctrine of Equivalents (DOE). Thus, you must make a determination whether to analyze only literal infringement for a claim element/limitation, or whether to analyze both literal infringement and DOE. Whether you additionally analyze DOE depends on the certainty of meeting the claim element/limitation under a literal analysis. If it is clear that the claim element/limitation is met under a literal analysis,[4] do not analyze DOE. If, however, the literal analysis is contestable, i.e., it is reasonably and legitimately disputable, the safe route to avoid missing a possible points-earning examination issue is to evaluate both literal and DOE infringement for the element/limitation in question.

[4] One way to think about whether a claim element/limitation is literally met is to ask whether a reasonable litigant (defendant) would admit that the element/limitation is satisfied by the accused infringing device/process. Parties to patent infringement suits regularly admit/stipulate that some claim elements/limitations are met in order to focus the issues to a small number of contested elements/limitations where the infringement count will be won or lost.

Here is a concrete example of this principle. A claim element/limitation on the examination says: "a nail made of steel or aluminum." The accused infringing device described in the examination includes a nail made of steel. This element/limitation is clearly met under a literal analysis and you should forego DOE analysis.[5] Even a diligent and prudent litigator would admit/stipulate that this claim/element is met.

An example going the other way is an examination claim element/limitation that says: "a square seat." The accused infringing device has a square seat with rounded corners. Here, there is a reasonable question as to whether the square seat with rounded corners literally meets the claim element/limitation. A diligent and prudent litigator would also assert and contest the DOE analysis for this situation.

Another version of this problem is with the DOE analysis itself. In discussing DOE, one might note that there are several doctrines limiting DOE. Whether the test for any such doctrines should be described and analyzed depends on whether there are any facts relevant to such DOE-limiting doctrines. If no such facts are given, the analysis should probably stop after relating that "no facts are present to raise any of the various limitations on the reach or applicability of DOE."

Notation used for patent claim amendments:

Some of my examinations will include issues related to patent law. Some of these issues may spring from facts surrounding an amendment of a patent claim during patent procurement or "prosecution." If the examination discusses an amendment to a patent claim, it will use the following notation to describe the amendment: additions are in double underline and deletions are in ~~strikeout~~. For example, assume a patent's claim one states: "a widget comprising: a green base and three legs". The inventor wants to amend the claim to cover a blue base with four legs. The amended claim would appear as follows: "a widget comprising: a ~~green~~ blue base and ~~three~~ four legs".

[5] If you undertook DOE analysis for the nail, it would only hurt you in the sense of opportunity cost. DOE for the nail was not a points-earning issue on the examination, so the time spent analyzing it takes away from time you could spend on actual points-earning issues. Also, please note that if you find yourself undertaking DOE analysis for every element/limitation in the claim, you are probably undertaking DOE analysis for some non-points-earning issues. This in essence means that the examination does not consider these to be actual, disputable issues. The patent issues on an examination are unlikely to contemplate application of DOE for every claim element/limitation.