

Your personal identification number goes here _____

PATENT LAW FINAL EXAMINATION

PROF. GREG R. VETTER

SPRING, 2006

May 3, 2006

2:00 p.m. to 5:00 p.m.

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Examination Serial Number:

10

Turning in an examination answer to this final examination is deemed to be a pledge under the Law Center honor code that the exam taker has complied with the honor code in all respects in relation to this examination.

GENERALLY APPLICABLE EXAM INSTRUCTIONS

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I. EXAM INSTRUCTIONS

A. *Instructions Applicable to the Administration of My Exams*

1. *Conventions*

By convention, these instructions use the word “examination” to refer to this document. The word “exam” refers to the event of taking this test, as in “exam room” “exam taker” or “exam time.”

2. *Identification*

Identify yourself only by your personal identification number as set forth below. Do not identify yourself in any other fashion.

If you are an L.L.M. student, write “LLM” after your personal identification number.

a. Bluebook Exam Takers

- (i) write your personal identification number on the cover of **each** of your bluebooks; and
- (ii) write your personal identification number on the top right-hand corner of the cover page of this examination and on **the last** page of the examination problem itself.

In addition, write the examination serial number given on the cover page of this examination on the cover of **each** of your bluebooks.

GENERALLY APPLICABLE EXAM INSTRUCTIONS

b. Typing Exam Takers

- (i) type your personal identification number in a prominent place on the first page of the typed answer; and
- (ii) write your personal identification number on the top right-hand corner of the cover page of this examination and on **the last** page of the examination problem itself.

In addition, type the examination serial number given on the cover page of this examination in a prominent place on the first page of the typed answer.

3. *Prohibited actions: copying, reproducing, or memorializing this examination; or taking this examination from the exam room*

I have not determined whether I will make this final examination available to students in the future. Accordingly, I am prohibiting this examination from release. It is an honor code violation to take any action designed or intended to cause all or any portion of this examination to be released. **Copying, reproducing, or memorializing this examination or any of its contents in any form or fashion will be treated as a violation of the Honor Code and will be penalized accordingly. Taking notes about any portion of this examination is expressly prohibited under this rule.**

4. *Hand-Writing Your Answer*

Write legibly. I cannot grade what I cannot read. Skip every other line and write only on the right side of the page (i.e., skip every other page). You are only permitted to submit what you have written in the exam room during the exam time. Previously-drafted attachments of any sort may not be submitted for grading.

Number your bluebooks consecutively on the outside cover of the bluebook, i.e., “1” for the first bluebook, “2” for the second, and so on.

5. *Typing Your Answer*

You are permitted to type your answer to the examination. If allowed by the capabilities of the exam taking software, double space your answer. Also, type only on one side of the page. You may not use the memory capabilities of your typewriter or computer in any manner.

For students typing their answer on a computer, the student is responsible for compliance with the various technical requirements and mechanics for using the exam taking software, Examsoft. In particular, the student is presumed to be on notice of all information available under the links at the web page(s) maintained by the Law Center’s information technology department related to use of the exam taking software. Please realize that I am not undertaking any action to be in a position to provide any assistance with the exam taking software.

6. *Materials Allowed*

This is an “open materials” exam. You may use class notes or outlines (prepared by yourself or others), commercial outlines, and other similar materials. You may not communicate or collaborate with anyone during the exam about the examination or obtain direct or indirect information or assistance from any person; except for questions to the professor in the case of a severe discrepancy, defect, issue or similar problem with the examination. You may not receive any assistance from any live or electronic

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retrieval/computer source during the exam. You may not do any library research or access the internet once the exam has begun.

Students writing the exam by hand are not allowed to use their computers for any purpose during the exam. Students typing the exam using the Law Center's sponsored exam-taking software may only use their computers to run such software.

7. *Collection of Examinations and Materials – Via 8.5 x 11 Inch Envelopes*

The examinations, bluebooks, and scratch paper will be collected at the end of the designated time. **You will not receive a grade in the class unless you turn in:**

- (i) your entire examination with your personal identification number written on the top right-hand corner of the pages indicated above;
- (ii) your bluebooks with your personal identification number and examination serial number written on the cover of each bluebook, **or** your typed answer with personal identification number and examination serial number typed in a prominent place on the first page of the typed answer; and
- (iii) ALL scratch paper that you have used.

Scratch paper will neither be read nor graded. Nevertheless, you must turn in ALL of your scratch paper at the completion of the exam. You MAY NOT leave the exam room with any scratch paper that you used. You may mark on the examination itself.

I will provide 8.5 x 11 inch envelopes for exam takers. Use the envelope to turn in ALL your materials, including all of the examination, your answer, and any scratch paper.

a. Those Hand-Writing their Answer

Assemble your materials for collection by ordering your bluebooks sequentially, then place all scrap paper or other materials and the examination beneath the bluebooks. Place this stack inside the 8.5 x 11 inch envelope. Close the envelope with the metal clasp, but do not wet the adhesive. **Write your personal identification number on the outside of the 8.5 x 11 inch envelope.**

b. Those Typing their Answer

Place all scrap paper, the examination, and the floppy disk inside the 8.5 x 11 inch envelope. Close the envelope with the metal clasp, but do not wet the adhesive. **Write your personal identification number on the outside of the 8.5 x 11 inch envelope.**

c. I Perform a Post-Exam Inventory of the 8.5 x 11 Inch Envelope's Contents

As soon as practically possible after collecting the examinations, I cause administrative assistants to perform an extensive inventory process to ensure that all original examinations have been returned. If you discover that you have inadvertently kept some materials contrary to these instructions, get in touch with my administrative assistant immediately. Do not contact me personally because that creates the possibility of you losing your anonymity.

On the flip side, if in the inventory process we discover that a particular exam taker did not turn in the examination or some portion of it, this creates a potentially grave situation, especially if we cannot communicate with you to inquire about the situation. My administrative assistant would attempt to get in

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touch with you in this instance. Thus, it is important to pay attention to your regular communication channels even though you may be undertaking other exam preparation.

8. *Restroom*

You may leave the exam room to visit the restroom. If you leave the exam room, you must leave your examination, any scrap paper, and your bluebooks with the proctor. If the proctor is not present, you must leave your examination, any scrap paper, and your bluebooks on the desk at the front of the room. You may not discuss the examination with anyone or consult any materials while you are out of the exam room.

If you leave the exam room, you must exercise a very high standard of care in exiting and entering the room in order to minimize disruption and noise that will distract other students.

9. *Makeup Exams*

Because certain members of the class may be taking a makeup exam, it is a violation of the Honor Code to discuss this examination with any class member who has not yet taken it. Do not discuss this examination with any students not in this class until after the makeup exam period is over. Do not discuss this examination with any student in the class without first asking such student whether he or she has taken the exam. Abide by the Honor Code in this and in all other particulars.

10. *Compliance*

Failure to follow any of the directions provided with this examination will result in such penalty as I deem appropriate to the nature and degree of the violation. ***The spirit of these instructions will be enforced as well as their letter.***

11. *Pledge*

In placing your personal identification number on your bluebook covers or typed answer, and on the examination pages, and by writing and turning in an answer to this examination, you are pledging that you have not received or given any unauthorized aid in preparing for or taking this examination or violated any of the instructions given here. Such behavior is grounds for the imposition of a variety of sanctions, including expulsion from law school.

GENERALLY APPLICABLE EXAM INSTRUCTIONS

B. Instructions Generally Applicable to Writing Answers for My Examinations

1. Materials Needed

To take this examination, you may/will need a copy of the assigned casebook and any supplement. Bluebook exam takers will also need a pen and bluebooks.

Computer software typing exam takers should also have bluebooks and writing instruments as a backup mechanism in the case of technical difficulty.

2. Applicable Law

The law applicable to this examination is the law covered in this class from: the assigned reading from the casebook and any assigned supplement, and additional law (if any) provided in the class overheads (collectively, the “Materials”). In my upper level Intellectual Property classes the Materials also include the primary statutory, regulatory, or treaty-based provisions relating to the assigned reading materials. Be sure to answer all questions on the basis of the law provided in the Materials.

There are some situations where the Materials provide alternative rules or tests for resolving a specific legal issue. In these instances, the “majority” rule is the rule or test relied on by the majority in a primary case in the casebook/supplement. Any other different tests or rules, (which could be multiple) whether mentioned by the majority opinion, offered in a dissent, described in the notes to the case, or given in the overheads, are alternative or “minority” rules. This instruction does not necessarily mean that issues exist in this examination requiring the application of alternative or minority rules. And, it may or may not be necessary to analyze any or all such alternative or minority rules depending on the specific examination instructions and/or the facts provided.

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C. Instructions Specific to this Particular Exam

1. *Structure*

The final examination is three (3) hours in length. It consists of one integrated fact pattern and an assignment to write an analysis for the issues arising from 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. *BlueBook Use*

Start a new bluebook before beginning your analysis of each major area or logical subdivision. This means that you should 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.

Remember to put your personal identification number on the cover of each bluebook.

4. *Read the Assignment Section in Advance*

Even if you do not read the “Background” and “Dispute” sections before starting, it is **highly recommended** that you read the “Assignment” section before you begin.

Further, it is **highly recommended** that you read the “Assignment” section **first**, before reading the “Background” and “Dispute” sections of the examination. The Assignment section is one of several portions of the examination that was made available before the exam date via the class web page.

5. *Notation 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”.

6. *Starting and Stopping the Exam*

The actual examination problem(s) section describing the case/dispute has six (6) pages, numbered pages 1 to 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.

A proctor will provide “warning” that the end of the exam period is approaching by writing on the board in the exam room(s) the amount of time remaining at approximately the five minute mark.

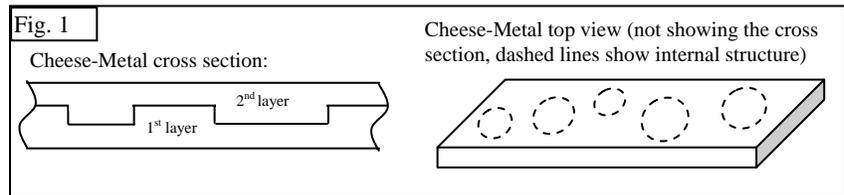
When time is called, stop writing immediately.

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

II. PATENT LAW FINAL EXAMINATION

1. *The Background*

Paul developed and patented what he calls



“Cheese-Metal.” Claim 1 of Paul’s ’150 U.S. patent is as follows.

1. A sheet material that snaps-back slowly to its original shape comprising: (a) a first layer made of a bendable metal with a substantially uniform thickness in the range of 0.1 to 0.3 inches; (b) said first layer having a plurality of circular indentations, each indentation having a depth of approximately half the thickness of said first layer; (c) said indentations being randomly scattered over one side of said first layer, with the circular indentation diameter in the range of 1 to 2 inches, and the surface area coverage of said indentations in the range of 35% to 50% of the surface area of said first layer;¹ (d) a second layer applied to the indentation side of said first layer where the second layer material provides snap-back action while remaining in cooperative adherence with substantially all of said first layer indentation side; and (e) said second layer fills said indentations; said second layer’s non-filling side having a substantially uniform surface; and said second layer’s non-filling thickness being approximately equal to said indentation depth.

The detailed description section of the ’150 patent discloses several embodiments, including the embodiment shown in Fig. 1. § 112, ¶¶1-2 are satisfied for the ’150 claims. When Paul amended claim subparagraph (c) he noted to the PTO: “the surface area coverage range

¹ During reissue filed about a year after the original issuance, Paul amended claim 1 in response to an indefiniteness rejection.

The ’150 patent also has dependent claim 2 from original issuance: “Sheet material as defined in claim 1 wherein said second layer material is at least 20% carbon nanotube.”

acknowledges the important inventive aspect of randomly scattering, without any order whatsoever, the circular indentations, realizing that it is difficult to get effective random scattering below a coverage range of about a third of the first layer surface area.”

Paul operates a web site, www.savebunny.org. A person can understand how the site operates by reading claim 1 of Paul’s ’225 U.S. patent, given below.

1. A method of soliciting funds comprising: (a) displaying on a web site pictures of a small, furry, companion animal, such as a pet bunny, such displays including descriptions of said animal’s endearing characteristics and informing a web site visitor that the animal owner plans to kill, cook and eat the animal soon because the owner is without funds and has hunger; (b) based on a web site visitor’s time spent viewing components of said web site, calculating a bleeding heart index (BHI) according to the `peta.min.max()` function; and (c) upon said visitor’s departure from said web site, displaying a message soliciting a payment from the visitor where the amount of the payment is calculated by the `toby.gotcha()` function based on BHI.²

Paul never eats “the” bunny. In fact, he currently has no bunny, but simply reuses a library of photos of earlier bunny pets. Paul collects \$10,000 to \$30,000 per month from the site.

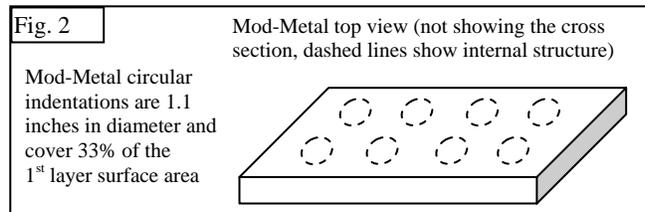
David makes and sells Fast-Metal™ sheet material, a product name that makes some POSITAs laugh because they think Fast-Metal’s snap-back action is a little on the slow side of

² A person of ordinary skill in the art (POSITA) would know the two referenced functions, `peta.min.max()` and `toby.gotcha()`, and how to apply them in this context. § 112, ¶¶1-2 are satisfied for claim 1 of the ’225 patent and there is no analogous art or prior art for it.

the average for the industry, although David (also a POSITA) thinks it is fast.³ David's other product is Mod-Metal™, shown in Fig. 2.⁴

2. *The Dispute*

Paul sues David for infringement of claims 1-2 of the '150 patent for sales of



Fast-Metal and Mod-Metal. The following additional facts are discovered and/or arguments, admissions and stipulations are made.

(i) David discovers that Sheet Material, Inc. (SMI) made a research product in its high-security U.S. based lab before Paul's date of conception for the '150 patent, and SMI's product satisfied the language of claim 2 of the '150 patent. SMI continued to experiment with the product in the lab. One year after SMI first made it, but one year before Paul's date of conception, SMI published, in a Mexican journal POSITAs would read, a drawing that looked the same as the drawing on the right side of Fig. 1. With the drawing there was text mentioning that: (A) the upper layer was mostly carbon nanotube material that filled indentations in the lower layer to give snap-back action of various speeds; and (B) surface area coverage, non-ordered placement of indentations, and layer thicknesses, were all important. Upon seeing

³ Fast-Metal has the dimensions and characteristics of subparagraphs (a), (b) and (e) in claim 1 of the '150 patent. Its randomly scattered circular indentations are all precisely 2.001 inches, and cover 40% of the first layer surface area. Its snap-action second layer which fills the indentations is 25% carbon nanotube and is always in full cooperative adherence with the entire first layer.

⁴ Mod-Metal has the dimensions and characteristics of subparagraphs (a), (b), (d) and (e) in claim 1 of the '150 patent, and POSITAs recognize Mod-Metal's slow, smooth snap-back action.

the drawing and text, it would immediately occur to a POSITA how the SMI sheet material was constructed, including the various dimensions and ranges involved. A year after Paul's date of conception, SMI published the full specifications and details for its product in an Australian journal of POSITA interest. Eleven months after that publication, SMI filed for a patent for its sheet material at the U.S. PTO.

(ii) Paul discovered that David operates a web site at www.saverabbit.net that does precisely what is stated in claim 1 of the '225 patent. Thus, Paul added that patent to the suit. David asserts that the claim is invalid with respect to statutory subject matter and utility. David also discovers that during Paul's prosecution of the application ripening into the '225 patent, the PTO examiner rejected claim 1 for indefiniteness, expressing the concern that the `peta.min.max()` function was ill-defined for web site visitor time. Paul sent the examiner copies of descriptions from two graduate-level course-books explaining how the function might be applied to web site visitor time, but the examiner was not convinced. Frustrated with the rigmarole, Paul merged and paraphrased the two book descriptions, emphasizing his notions of the predictability and known range of use for `peta.min.max()`. Then Paul had his cousin sign the document, which stated that it was authored by the cousin and that the cousin was a POSITA. This cousin was a university professor with a general title that would make it readily believable that she was a POSITA, but in fact she is not. Upon receipt of this document, the examiner removed the indefiniteness rejection. A month later, Paul sent his cousin a \$2,000 barbeque grill with a note: "Thanks for your help with that little problem last month."

(iii) David argues that the claims of the '150 patent are obvious in light of two items of prior art: Yorba in view of Zebulon ("Zeb"). Yorba is a prior art publication showing sheet material where the second layer is made from SnappyTM, a hardening-paste with no carbon

nanotubes but which provides snap-back action once hard. The sheet material disclosed in Yorba has the dimensions and characteristics of subparagraphs (a)-(e) in claim 1 of the '150 patent, except that: (A) the indentations are triangular rather than circular; and (B) the indentations are ordered in a grid pattern. The sheet material disclosed in Yorba is known by POSITAs to have the fastest snapping action available. Zeb is a prior art patent disclosing a golf ball with randomly arranged circular indentations in an underneath lower layer, with an outer layer filling these indentations with a coating having 18% carbon nanotubes. The novel use of a snap-action coating on golf balls increases length of travel by the ball. Trying to reduce his legal fees, David disclaims involving any other prior art beyond Yorba and Zeb in the obviousness analysis. The typical POSITA for sheet material is a materials engineer, not a golf-ball designer. Paul offers several POSITA articles published before his date of conception discussing the pervasive use of triangular indentations for snap-action sheet material and discussing the unpredictable results and uncontrollability of snapping action when using indentation shapes without corners or edges, such as elliptical shapes.

(iv) Paul discovers that Fast-Metal and Mod-Metal, and a third product, were all first made, used, sold, offered for sale, or exported after Paul's date of conception for claim 1 of the '150 patent. David's third product is Plastic-MetalTM, which has the dimensions and characteristics of claim 2 of the '150 patent, except that in subparagraph (a) it uses bendable plastic rather than bendable metal. Paul adds Plastic-Metal to the suit as another accused infringing device. David notes that the '150 patent discloses an embodiment with bendable plastic for the first layer, and that the '150 patent has only two claims.

(v) Weary of paying patent attorneys, for both claims of the '150 patent, Paul disclaims assertion of the DOE for subparagraph (d) and for the circular indentation diameter range in

subparagraph (c). Similarly, Paul disclaims any assertion of the third Festo presumption rebuttal criteria, “some other reason . . .”

(vi) Paul conceived of the '150 patent, filed the original application, and brought Cheese-Metal to market in a very short time, just a few weeks. A few weeks after Cheese-Metal appeared on the market, but before the '150 patent originally issued or its application published, several POSITAs published articles analyzing Cheese-Metal. They all remarked that once an artisan understood that randomly scattered circular indentations were important, that the surface area coverage would self-evidently need to be in the range of 33% to 50%. This is so self-evident, they remarked, that it could be considered long-standing latent knowledge in the technology field of sheet material. Moreover, these POSITAs realized that the randomly scattered circular indentations would function identically anywhere within this surface area coverage range, providing cooperative support toward the snap-back action in a similar way with a similar result regardless of the specific surface area coverage value selected within the 33% to 50% range.

(vii) About 18 months before Paul filed the original application for the '150 patent, a patent to Hughes issued in Brazil. It was indexed and cataloged in the local Brazilian regional patent office, and a printed Portuguese-language copy was deposited there. Nothing further happened for two years when finally the nationwide Brazilian patent office incorporated it into the nationwide index, and published a copy. Hughes satisfies the language of claim 1 of the '150 patent, and a POSITA, with Hughes in view, would think that a second layer with mostly carbon nanotubes is obvious. The regional patent office index and catalog of its holdings is available over the Internet.

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,^a 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.^b

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.

^a 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 or defendant(s). You should analyze these issues, but there may be other issues to be analyzed as well because the examination question is silent about whether they have been, will, or will not be 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.

^b 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.

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.^c

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,^d 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.

^c 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.

^d 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.^e 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 seat with a square-like shape but having rounded corners. Here, there is a reasonable question as to whether the accused infringing device 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.”

Finally, for any claimed inventions discussed on this examination, prior art does not come from real life. Prior art references come only from what is given in the examination.

^e 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.