

EXAMPLE ANSWER
COMPILED FROM STUDENT ANSWERS
FOR
PATENT LAW FINAL EXAMINATION
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NOTES:

The answers given below are compiled from several student answers. That is, the answer for the trade secret section may have been written by a different student than the answer written for the copyright section, etc.

The answers below were selected because they were the one of the highest point-obtaining answers for a specific area of law among a few of the student answers that earned a high grade on the examination. The answers are provided directly as written by the student, without any spelling or any other type of correction or editing.

These answers do not necessarily touch upon all point-obtaining issues, nor do they necessarily state all points of law and fact correctly. Moreover, they may discuss issues that are not point-obtaining. They are provided as a point of comparison, not as a suggestion that they are a perfect answer.

A. *Invalidity*

INVALIDITY

To be valid, a patent must meet the requirements of: statutory subject matter, utility, novelty, non-obviousness, and various technical requirements. As the patent is for an apparatus, the statutory subject matter is met as the invention is an article of manufacture. Additionally, both sides appear to agree that the invention is useful, so this element will not be discussed. However, there are implications that novelty, non-obviousness, and technical requirements have not been met, so these will be discussed below.

Invalidity - Novelty

To be patentable, the invention must be novel. Novelty is most often referenced to two types of prior art events. The first series are tied to the date of invention, while statutory bars are tied to the filing date of the US patent application. Anticipation occurs when any single enabling prior art reference discloses each and every claim limitation of the invention. TO determine if a claimed invention is novel requires that we:

- (1) assess the scope of the current art; and
- (2) check to see that the reference discloses each and every claim limitation. Additionally, each prior art reference must be enabling such that it teaches a POSITA the manner and process of making the claimed subject matter (but not how to use it). To assess the scope of the prior art,

I will first look at sec. 102 and 132 to determine what prior art is available as a reference. After determining whether a reference can be used as prior art, I will check to see if the reference discloses all the claim elements.

132 - New Matter & Priority

No amendment or addition to the claims or written description may introduce new matter that was not addressed in the initial application that was filed. Related is the idea that a patent applicant may obtain the priority date of a prior application if: (1) there is continuity of disclosure (no expansion beyond what was initially disclosed); (2) continuity of prosecution (co pending for at least 1 day with the earlier application); (3) a common inventor, and (4) reference to the earlier, parent application. There do not appear to be any problems with requirements 2-4, as Phil is the inventor and the '110 continuation was filed before abandoning the '100 application. However, Dan may assert that priority should not be granted because there was not a continuity of disclosure. Dan may argue that the 3rd claim was not in the '100 application, nor insulating matter disclosed in the specification. Instead, the '110 application added the 3rd claim and added to the written description a discussion of filing the modules with insulation. Thus, Dan contends that instead of a continuation application, which would get the priority date of the parent application, the application was instead a continuation in part application. Dan could try to assert that as a continuation in part application the priority date should be the actual filing date, but Phil will undoubtedly argue that even if it is new matter, only the new matter will have the benefit of the later application. Also, Phil may try to assert that the drawings disclose an empty space in the modules and that air can be an insulator. Thus he argues that no new matter was asserted. However, Phil's argument does not seem to have much merit. It is likely that the '120 application will be treated as giving claims 1, 2 a priority date of 6/7/99, and the 3rd claim a priority date of 2/5/01.

102(a) - Public Knowledge

An inventor is not entitled to a patent if the invention was publicly known in the US before the date of invention by the applicant. To be public, the knowledge must be reasonably accessible

to the public.

102(a),(b) - Public Use

An inventor is not entitled to a patent if the invention was in public use in the US prior to (1) the date of invention, or (2) 12 months prior to the filing date of the patent application. To be public use, the use must be reasonably accessible to the public. The public use requirement is met if the invention is given for use, w/o limitation or restriction or request for secrecy, even if only one person knew about it. An exception to public use exists if the use is experimental. To be experimental, the use must be under the direction or supervision of the inventor, for the purpose of demonstrating suitability for its intended purpose. In determining whether use is experimental, there are various factors to consider, but the most important is control exercised by the inventor. Additional relevant factors include confidentiality agreements, test period, progress reports and commercial use. Additionally, where a commercial use of the invention has been made, it can be a prior art bar whether or not the use was informing, if the commercial use was made by the applicant. If the commercial use was by a 3rd party and held secret, then it is not a prior art bar.

The Axel patent is asserted as a public use bar under 102(b), against Phil's '120 patent. For public use, Phil notes that the product was used in a super-secret room built in the plant where he worked, and completely enclosed to keep its secrecy. On one hand, it may be asserted that the use was experimental as the room was used to test experimental machinery where pieces would fly off. On the other hand, it can be noted that that it was machinery being tested, and not the embodied invention, and thus the experimental use exception should not apply. The latter argument is likely to prevail as there was not test of the invention to determine its suitability, but it was used precisely because it was suitable for that purpose. However, in assessing this argument, the supervision of Axel vs. his employer may become relevant, as well as any confidentiality agreements, and the length of the test period. Additionally, it can be argued, for Dan, that the test by Axel was commercial, and thus effected a prior art bar as of the date that the use. It could be commercial because machinery was being tested, employing the use of the claimed invention, and then possibly marketed or sold. Phil, on the other hand, notes that the invention is not a process, and the product of the claimed invention is not the machinery. Additionally, since the use was locked away in a cavern, where it was protected as a trade secret, it is likely a secret, non-informing use to the public. Accordingly, the court would likely find that no prior use bar existed under 102(b).

102(a),(b) - Printed Publications

An invention is not entitled to a patent if it was described in an enabling printed publication anywhere in the world (1) prior to the date of invention or (2) at least 12 months before the filing date of the patent application. Even a single, isolated publication qualifies as a printed publication prior art reference if that publication was reasonably accessible to the public.

As a printed publication, Dan points to the typed high school senior thesis paper which is conceded to be enabling. Whether the paper is prior art will depend on 102(a) and (b). The paper was written in 1993 well before either a date of invention or application filing date. However, the publication was housed in a high school library that did not have any indexing or cataloguing. Phil argues that as there was no index or catalog to find the publication, the thesis could not have been reasonably accessible to the public, despite being actually available. Dan argues that since it was available in what is likely a public library, it was reasonably available and a prior art bar as of 1993. However, in July 1997 the paper was moved to a University library and catalogued/indexed in August 1997. Where a date is uncertain, the date will be construed against the one with the burden of proof, and thus taken as the last possible date in the available range, or

August 31, 1997. This date puts the printed publication available after the conception by Phil on 8/15/97, but before the filing of the application. The application was filed on 2/5/01, but even with the earlier priority date possibly given to claims 1 and 2 of 6/7/99, the publication was available in the library more than a year before the filing date, and thus likely to be a prior art reference.

102(a),(b) - Patents

An invention is not entitled to a patent if it was patented anywhere in the world (1) prior to the date of invention or (2) 12 months before the filing date of the patent application. To be considered as prior art it must have been available to the public and offer full disclosure of the invention.

The '510 patent was issued on 11/13/01, which was after both the invention date and the filing date of the '120 application, so it cannot be a 102(a) or 102(b) bar.

A second patent is the Axel patent. The Axel patent has the exact claim language of '120 claims 1 and 3, and thus would clearly anticipate the claims if the reference is found to be prior art under 102(b). Unfortunately, Dan does not note the date the Axel patent was granted. As a 102 (b) bar is exists when the prior art patent exists more than a 1 year before the other's filing date, this is a critical issue. It is only known that the system was operational on March 15, 1998 and from fn. 7 that the patent was granted many months later. I assume that many months later does not mean only 3 months, and thus the patent could not be granted more than 12 months before the 6/7/99 priority date I earlier gave to claim 1. However, if claim 3 has a priority date of 2/5/01, it is conceivable that the patent issued earlier than 2/5/00, in which case the Axel patent could be a prior art reference for claim 3. More information is needed to determine whether the reference is in fact a prior art reference for assessing novelty. However, if it is found to be prior art to claim 3, then as the claims are identical, claim 3 would be invalid.

102(e) - Patent Applications

An invention is not entitled to a patent if, before the invention by the applicant, the claimed subject matter was described in (1) a US patent application by another that was printed according to statute; (2) a PCT application (not implicated but must be in english and designate the US); or (3) a patent granted from a US application.

The '510 patent may be introduced by Dan as a patent that resulted from a patent application and that should be a prior art reference to Phil's '120 patent. Phil asserts that his priority date should be on 6/7/99, which would place it before the filing date of the '510 patent and make the '510 patent inapplicable as prior art. Dan may, however, argue that the patent should not obtain the benefit of the prior filing date b/c it introduced new matter (see discussion below on new matter). If the application is found to have new matter, the CIP '120 patent will have two priority dates, 6/7/99 for claims 1 & 2, and 2/5/01 for claim 3. Accordingly, since invention must occur prior to the filing of a patent application, the '510 application could not be found to be prior art for claims 1 and 2 as it was filed more than a year after the '120 priority date. However, if claim 3 is indeed new matter, we must look to Phil's date of invention. Both sides apparently concede that the conception occurred on 8/15/97 (and at the latest 3/98). Since this date of invention is well before the application filing date for the '510 application, the patent cannot be treated as prior art under 102(e), and there would be no need to assess whether the limitations of '120 were all present in the '510 patent. However, if it is found to be prior art, then it is stipulated to meet the language of claim 1 in the '120 patent, and thus a court could invalidate claim 1.

102(g) - Priority

An invention is not entitled to a patent if (1) - interference stuff that isn't implicated; or (2) before the applicant's date of invention, the claimed invention was made in the US by another, and was not abandoned, suppressed, or concealed (ASC). This exception allows the second inventor to be the patentee if the first inventor did ASC the invention. ASC can occur if, w/i a reasonable time after completion, no steps are taken to make the invention publicly known. ASC must be shown by clear and convincing evidence (CCE), and disclosure to the public in sufficient detail for a to make the invention is prima facie evidence that ASC did not occur. Additionally ASC can be overcome by renewing activity or disclosing to the public prior to the earliest date of invention by the second inventor.

In a priority contest of this sort, the diligence of the first inventor becomes an issue. Generally put, the first to reduce the invention gets the patent, except where the first to conceive was reasonably diligent in reducing the invention to practice, but was the second to reduce the invention to practice. Thus, the inquiry on diligence only applies where an inventor is the first to conceive, but second to reduce the invention to practice. Diligence in this context is not required during the entire period between the conception and reduction to practice, but only during a time just prior to the earliest date of invention for the second party. Additionally, diligence is considered only for the first to conceive. Further, diligence requires corroborating evidence that is determined on a "rule of reason" analysis. Various factors are considered, including, inter alia, the relationship between the corroborating witness and alleged prior user, interest of the corroborating witness in the subject matter, and contradiction or impeachment.

The relevant dates for Phil are: Conception: 8/15/97 and Reduction to Practice: a few days before 6/7/99. The relevant dates for Axel are: Conception: 2/20/98 and Reduction to Practice: 3/15/98. We thus see that the Axel's conception and reduction to practice fall between the period between Phil's conception and reduction to practice, so Phil's diligence is relevant to the inquiry. Phil concedes that he was not diligent until at least 2/7/98, when his pimento fair was over. ON the other side, Dan asserts that Phil could not have been diligent until 3/98. As we can see, the difference in dates is important as Phil's date is before Axel's conception, but Dan's date is after. If Dan's date prevails, then Axel's patent prevails and Phil's invention (as to claims 1 and 3) are anticipated, as the claims are identical. It is stipulated that Phil's evidence is sufficiently corroborated. However, under the rule of reason analysis, there is also room to evaluate contradiction, and the impact of the invention on the industry. Since the impact on the industry is minimal, this fact is on Phil's side as he would have less reason to lie or produce false evidence. HOWEVER, the fact that Phil's production continued after the diligence date offered by Phil is contradictory. More evidence on this point will likely be necessary, but there are likely to be numerous reasons why this may occur. It is not apparent that Phil was the only employee at the farm, or that the fair was held during a non-optimal season that would create an unlikelyhood that Phil stopped working there. However, the contradiction does not seem to be sufficient, and thus it appears likely that Phil can establish priority and get the rights to the patent the invention over Axel.

An additional consideration is whether Phil ASC'd the invention, or whether Axel did so. There appears to be some evidence that Phil was not diligent in making his invention public, as he filed the patent more than 12 months later, and claim 3 almost 3 years later. This may not be sufficient, but is relevant. Additionally, Axel may have ASC'd his invention because he held it in a secret room. If either is found to have ASC'd their invention, neither is entitled to the patent thereon.

Invalidity - Obviousness

Even if a single prior art reference does not disclose every element of a claimed invention, it may still be unpatentable if it is obvious in light of the prior art. An invention is obvious when the claimed invention, as a whole, would have been obvious to a POSITA at the time the invention was made. This obviousness standard is to prevent trivial advances in the art. To be obvious with reference to prior art references requires that there be:

- (1) a suggestion or motivation to combine;
- (2) A reasonable expectation of success; and
- (3) Prior art references that teach all the claim elements and are analogous art.

A suggestion or motivation to combine may be found in the nature of the problem, in the prior art, or in the knowledge of a POSITA, but must be more than a mere invitation to combine. Arts are analogous if: from the same field of endeavor (same problem or purpose to be solved) or if it is reasonably pertinent and would logically commend itself to the attention of the inventor in the particular problem. This analysis is contained in the framework and process of:

- (1) Determine the scope and content of the prior art;
- (2) Assess the Differences between prior art and the claimed subject matter;
- (3) Assess the ordinary skill in the art
- (4) Look at secondary considerations/objective indicia

Determine the Scope and Content of the prior art

Both parties admit that Xena, Yoga, and Zack are prior art for obviousness purposes, and even agree that Xena is analogous art. They likely dispute, however, that there was a suggestion or motivation to combine. Dan may argue that POSITA would know to combine a modular wall system with a sealant known to be a compressible barrier, and a bullet proof vest reference. Additionally, the Yoga reference specifically notes that it would be good to try the Xena structure with the Yoga BatesAid sealant. Further, Zack suggests using baffles and the benefit of overlapping baffles for projectile deflection. Phil argues, however, that the POSITA knowledge track is too attenuated. Additionally, the "suggestion" in Yoga is merely an invitation to combine and that it merely suggests possible value, not a reasonable expectation of success. Taken as a whole, the POSITA's knowledge and the clear suggestion may be sufficient.

Further, Phil argues that a bullet proof vest is too far removed from building walls to be of any assistance. In this same argument, Phil argues that neither Yoga nor Zack is analogous art. Phil may phrase the art as creating "walls that resist impacts." In such a characterization, a sealant for leaky walls to resist moisture, and bullet-proof vests would be non-analogous. Dan, on the other hand characterizes the art as creating "resistant walls". Accordingly, a sealant to resist moisture in walls would be analogous and solve the same problem. A bullet proof vest may not be a wall, but it would logically commend itself to the inventor of a particular problem since Phil specifically wanted to be bullet-resistant. Again Phil may disagree that since many vests are bullet proof because of their composition (e.g. Kevlar) and not their structure (e.g. baffles), it would not commend itself to a POSITA's attention. Much depends on the characterization, but Dan's analysis seems reasonable and it may be found to be analogous art.

The content of the art is:

Phil = outer rectangular panel, steel inner plates as inner walls, sealant spacing inner and outer walls from steel-to-steel contact; Thermal acoustical seal-barrier, means for increasing internal load bearing capacity

Xena = Modular walls, outer wall, outer wall fits w/i 2 inner wall pieces, Inner wall pieces meet to form a T to be load bearing, Structure bolted together

Yoga = Sealant for use on a leaky basement wall; POSITA knowledge adds that it would be a compressible sealant

Zack = Bulletproof vest, overlapping baffles,

Assess the Differences in the Current and Prior Art

Xena = Steel not mentioned, means from disclosure in '120 may not be same as the T structure, No sealant, No thermal acoustical seal barrier

Yoga = No steel, no inner wall, no strengthening means

Zack = No outer walls

Assess the ordinary skill in the art

In this art, the skill likely could be high. To develop baffles at the proper angle to deflect bullets may require kinematic training. However, the use of steel as a barrier is indicative of a lower level of art as well

Secondary Considerations

Some secondary considerations/objective indicia to consider are: commercial success and prompt copying or licensing. Here, it is evident that neither secondary consideration helps, as both are minimal, despite millions of dollars spent to promote the technology. By showing that there is not commercial success or licensing leads to the conclusion that it was obvious in the art. But, there are defenses such as no prisions being met, which also shows there is not a long-felt need.

As a result, considering the secondary considerations, the differences in the art as a whole, and the suggestion to combine, among the other arguments, it is likely that the '120 claims would be obvious.

Invalidity - Technical Requirements

Enablement

To be enabled, the specification must contain the manner and proccess of making the invention in such clear, concise and exact terms to allow a POSITA to make and use the invention. It must be sufficient when combining the disclosure and the POSITA knowlege to make it w/o undue experimentation. Of concern in this area is the 2nd claim. The specification relies heavily on the drawings. HOwever, reference to drawings is not a bar as drawings themselves may be enabling. As the drawings show relative angles and there is no testimony to show undue experimentation, it is likely that the enablement standard is met.

B. *Infringement & Defenses*

Infringement

There are a few different pieces that will be looked at here with the claim models available. The difference is materials and insulations

Literal infringement

The first place to start is under literal infringement. I will address all versions and claims simultaneously. For literal infringement to occur there must be every element contained in the patent in the AID. The first place to look for literal infringement is to the plain meaning of the claims and the AID.

Claim 1 paragraph A

For paragraph A there seems to be literal infringement for claim 1. The first thing to look at for literal infringement is the claim language. Here the language of an outer panel of rectangular shape, in the vertical plane. If looking at the vertical plane of the AID there is a rectangular shape. This should be an easy one under literal infringement.

Paragraph b- Phil admitted no literal infringement.

Paragraph c - Dan argues in relation to c that it is not met since there isn't the same purpose for listed in the preamble. The preamble of a claim is designed to state the purpose of the invention. In this case a preamble is not limiting since the patentee defined a structurally complete invention in the claim body. (Catilina Can) The only purpose of the preamble here is to state a purpose of the intended invention.

Paragraph c is thusly infringed literally.

Paragraph d - This paragraph discusses the sealant used between the panels. There was a modification to this paragraph which might hurt Phil later. Here the facts state that there is a compressible barrier but not a sealing one. The dictionary definition also does not seem to help here. This might not meet the plain language requirement for literal infringement. The next place to look is the spec, drawings and extrinsic evidence. Nothing here really seems to take seal into a compressible barrier. The extrinsic evidence might help if POSITA's knowingly use these interchangeably.

Paragraph e - Paragraph e is argued by Dan as a means plus function element under 112(6). For a M+F claim to exist it is related to a process and not a structure. Phil could rebut this by showing that there is "substantial structure" involved in the element. Since the walls are described, I think this would work. There seems to be enough other structure to rebut a M+F element. The claim does not seem to be literally infringed by any of Dan's models except the original 9110 steel version. Since steel is specifically called out here there is a presumption that steel is what is being called for. There might be other evidence for this to dispute this but it is a better argument under DOE and not literal infringement. If the claim is held to be M+F then the infringer must meet identical function, SSW, SSR. Here the function of the other models seems to be identical and the SSW, SSR also seems to be met since the material difference is rather insignificant. Of course Dan will object to this for the materials especially for claim 2 since plastic would not serve the SSR for load bearing due to the strength. It is possible that this is a literal infringement.

DOE

There is infringement for DOE if the equivalence between the AID and the claims have a SSW, SSW, SSR. DOE is done on a per element basis.

Paragraph a - No need for DOE - Literal is obvious.

Paragraph b - The big issue on paragraph B is whether steel is equivalent to aluminum or plastic. Dan's

expert admitted that aluminum is an equivalent under SSF, SSW, SSR. This one seems to be clear since different metal would be obvious equivalent in this type of structure. A POSITA would recognize this type of material as a clear equivalent under SSF, SSW, SSR. Dan has an argument that the aluminum version was given up (forgot the correct term). This is because the specification discloses aluminum but doesn't claim it. This might also apply to plastic. This is a valid point but I don't think it will work. The function and result are clear and the way is almost exact which meets the test. The real question here is whether the plastic meets the same test. For plastic walls to serve a SSF they must be interchangeable. It is not clear whether this is true. Plastic might not be as good for the purpose and not considered by POSITA's. I think that most structural material would be considered if it could achieve the same result. There are plastics out there with almost the same properties as metals strengthwise so a POSITA might consider them also. I think the plastic meets it also. Element b might also not be met since there are not two inner surfaces for an inner wall. The AID only shows one wall here. This could be met if the tests are met. Here two walls seem to serve the same function as 1. It does it in a slightly different (although still SS) way but the result is still the same. This part of the test should also be met.

Paragraph d - This might be the trickiest to show due to the PHE. This gets into PHE since this is a change from the original claim. For PHE to exist the patentee must change the limitation for a RR2Pat.

Here the claim was amended after an indefiniteness rejection under 112. For Phil to get past this he must show that the change was either:

1. Bore no more than a tangential relation to the equivalent
2. The equivalent was unforeseen,
3. There is another reason why the patentee could not describe the equivalent.

Here the equivalent was originally described in the claim prior to the amendment. The amendment killed it. I think that the change ruined the chance at DOE for this element. Under *Festo* and alike there is likely a problem with DOE on this element due to the amendment.

Paragraph e - There is a question whether the elements are met in this situation either. The elements says that the baffles are steel extending inwards to increase load bearing capacity. This should not be held to be a M+F claim anyway but that is irrelevant here. The question is whether the AID has the same elements in a SSF, SSW, SSR, I think that this is met since the AID uses other walls for load bearing and the walls extend inward. The dispute Dan proposes is whether the walls are "baffles" as described in the 120 patent. Phil's expert seems to agree that the function and way is not the same here. The question is what is the claim actually claiming here. Is the purpose for deflection or for load bearing. The element seems to claim for the purpose of load bearing which is met by the "T walls". The auxiliary purpose outside the claim for deflecting bullets is not really as relevant. Thus the "T walls" serve a SSF, in a SSW, with a SSR.

DOE for Claims 2 and 3

For claims 2 and 3 the addition of insulation and angled baffles is more important. The element of baffles for deflecting bullets that wasn't important in claim 1 is important in claim 2. Here the function of "T walls" is different than that of claim 1. The function is to deflect bullets which isn't the function of the "T walls" DOE is not met for Claim 2. In addition the other material might not also meet the requirements for deflecting bullets. Plastic is not likely a good deflecting material known to POSITA's. Claim 3 is dependant off of claim 1 and adds insulation. The dispute here is whether the insulation factor of 22-38 is an equivalent of "above 50". This really comes down to what the purpose is of the limitation. This is so similar to the case we read about the 6.0-9.0ph level. I think that an equivalent would be found here unless the function is vastly different. If the higher insulation produces a better result by some fluke then the function would seem similar. Once again the SSW, SSF, SSR test appears to be met by claim 3.

Claim 2 should not be found to have been infringed and a possibility on element d and e of claim 1.