

**IP SURVEY FINAL EXAMINATION**

**DAY SECTION**

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**FALL 2004**

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Examination No. \_\_\_\_\_

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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.

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### 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, Examssoft. 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

## GENERALLY APPLICABLE EXAM INSTRUCTIONS

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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

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### *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 designed to be two (2) 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 intellectual property law covered in class.

Our class coverage by time was approximately: ten percent (10%) trade secrets; thirty percent (30%) patents; thirty percent (30%) copyright; and thirty percent (30%) trademarks. For a two (2) hour final, if one takes 20 minutes to read the problem and plan the answer, then one would spend the remaining time as follows: 10 minutes writing the trade secret answer, 30 minutes for patent law, 30 minutes for copyright, and 30 minutes for trademark.

*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*

It is ***highly recommended*** that you read the “Assignment” section first, before reading the other sections of the examination, and before you begin. The “Assignment” section is the portion of the examination 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 four (4) pages, numbered pages 1 to 4.

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. IP SURVEY FINAL EXAMINATION

### 1. *The Background*

Andy's company sells a specially-formulated ink under the mark AfterDry<sup>®</sup>, but keeps the formula secret. His ink has common ingredients: (i) carbon black; (ii) varnish; and (iii) a drier. Andy mixes these in unique proportions, resulting in an environmentally friendly ink that consumers like. He buys each ingredient from a specific manufacturer, having discovered that this particular combination works best. Unbeknownst to Andy, each manufacturer chemically "signs" its ingredient. After combination in AfterDry, an expert using expensive equipment has a high probability of recognizing the "signatures" and deducing the proportions. Andy volunteers on an ink-industry trade-association committee for the environmental impact of ink. One day he accidentally emailed the wrong attachment to Nick, a competitor committee member. The attachment contained Andy's AfterDry ink ingredients and proportions, but was clearly marked confidential. The competitor, a company called NikCo (owned by Nick), posted the AfterDry ingredients/proportions table<sup>1</sup> on the trade association web site, thinking that Andy sent it as an example of an environmentally friendly ink.

Andy sells EverAfter<sup>®</sup>, a post-printing coating product that makes ink super-permanent. Andy's patent that covers EverAfter was originally filed with, and issued with, only one claim that reads: An ink-permanencing compound comprising: (i) ChloroPhonySubstance (CPS) at 20% to 40% by volume; (ii) soybean liquid extract at 10% to 20% by volume; and

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<sup>1</sup> The ingredients/proportions were presented in an identical 3-column by 4-row table in both Andy's document and on the web site. The left-most column held the three ingredient names, listed alphabetically down the page. The top row held labels: (i) ingredient; (ii) proportion; and (iii) manufacturer. Each succeeding row, highlighted in a different color for emphasis, lists the respective information for each ingredient.

(iii) PhenolHypoMaterial (PHM) for the remainder by volume.<sup>2</sup> NikCo sells an ink-permanentizing compound under the mark NeverAlter, made from PHM at 46% by volume, CPS at 36% by volume, and black bean liquid extract for the remainder by volume.

The attachment Andy inadvertently sent to Nick also contained a six-line poem Andy authored. Nick liked the poem, so he based a new NikCo company mission statement on it.

Andy: Let Mother Nature’s tears not be ink!	Nick: New NikCo Mission Statement
Only balanced ink is crème de la crème	The ink we make is crème de la crème
Humans and nature must each have their thing	Our customers and society deserve this theme
Proudly, ink lets the human spirit communicate	The best ink performs in almost any condition
But its use must allow nature to reinvigorate	But when its job is done, it leaves no rendition
Our heritage on earth deserves no less	Mother nature deserves no less
As we take of the bounty to speak & impress	Just as our customers deserve the best

NikCo used the new mission statement in typical places: it printed the statement in the company brochure available to the general public, and it included the statement in its print advertising. The new mission statement was very popular, and customers asked Nick how he arrived at such a profound and insightful statement. Nick decided to give credit where credit is due, so he posted Andy’s original six-line poem on the trade association web site. Then he would refer customers to that web site as his inspiration for the NikCo mission statement, and he would read aloud Andy’s poem to these customers, typically gathered around the NikCo booth at an ink-industry trade show.

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<sup>2</sup> The description section of Andy’s patent also mentions that lima, pinto and black bean liquid extract will work. The total ingredient percentages by volume must add up to 100%.

2. *The Dispute*

Andy sues NikCo for copyright infringement (after registering his table and poem), patent infringement, trademark infringement/dilution of the EverAfter mark, and trade secret misappropriation of the AfterDry formula. Additional items are discovered and/or arguments and stipulations are made:

(i) The only relevant art existing prior to Andy's date of invention for Andy's EverAfter patent discovered by NikCo is an article by Spencer discussing an ink-permanencing compound containing CPS at 25% by volume, soybean liquid extract at 15% by volume, PHM at 40% by volume, and OtherFakeIngredient (OFI) at 20% by volume.<sup>3</sup> NikCo got Andy's patent expert to admit that given the Spencer reference, it would be relatively simple for a POSITA (an ink-making engineer with a Bachelors degree) to think of the claimed compound.<sup>4</sup> So simple, in fact, that it would prompt a POSITA to do so. Andy, however, got NikCo's expert to admit that NeverAlter's black bean liquid extract performs a substantially similar function (SSF) in a substantially similar way (SSW) with a substantially similar result (SSR) compared to the relevant element/limitation in Andy's claim.

(ii) Andy alleges that NikCo's use of his poem, as well as Nick's mission statement, infringe his copyright.<sup>5</sup> Andy says that a few weeks before his inadvertent email he received a \$100,000 offer of exclusive first publication for his poem. The offer has since been withdrawn because the poem now appears on the trade association web site. NikCo claims that any of its

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<sup>3</sup> NikCo disclaims any challenges to Andy's patent based on the first (subject matter), second (utility), and fifth (disclosure requirements) elements of patentability.

<sup>4</sup> Andy declined to offer any evidence of secondary indicia.

<sup>5</sup> Andy disclaims these rights: (i) derivative work; (ii) display; and (iii) distribution.

uses of Andy’s allegedly copyright protected materials are fair uses because these uses support the environmentally friendly message of Andy’s poem.

(iii) EverAfter’s federal trademark registration issued three years ago. The mark was famous before Andy applied for registration. NikCo began using NeverAlter after Andy’s registration application. NikCo asserts that EverAfter is descriptive. Each year Andy conducts a wholesale and retail survey asking people about the mark, and 32% of retail customers identify the mark EverAfter with Andy’s company, while 75% of wholesale customers similarly identify the mark. Andy’s customer hotline gets four calls a month from individuals who purchased NeverAlter, asking Andy’s company to help them apply the product.

(iv) Andy discovers that NikCo sells an outdoor grill cleaner under the mark AfterFry. Discovery produces Nick’s email where he gloats that the name will help him sell in the upscale retail market that purchases Andy’s environmentally sound ink. Andy asserts his incontestable AfterDry mark against NikCo under a likelihood of confusion, but disclaims dilution.

(v) Nick gives customers a fake silver dollar at trade shows. Most NikCo retail and wholesale customers also purchase ink-permanentizing compound (and ink) from Andy’s company. One side of the silver dollar has the word: “EverLafter”.<sup>6</sup> The other side has a picture of a couple with a lawyer between them, holding exaggerated, large papers that say “Divorce” on them. A few customers at the trade show always come to Andy’s booth, laughing over the fake silver dollar they just received, and tell Andy that it is now hard to take his company’s EverAfter product name seriously. Andy disclaims confusion for EverLafter compared to EverAfter.

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<sup>6</sup> Nick intends this to be pronounced: “ever-laughter.”

### 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 IP Survey class***. The analysis should communicate the following as briefly as possible based on the facts available: (i) discuss the arguments, positions and IP rights that the plaintiff should assert, or has asserted,<sup>a</sup> 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. For example, if there is a second copyright fair use issue, and you have already related the four fair use factors for an earlier issue, you can abbreviate your analysis by directly applying the law to the facts and concluding. 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.<sup>b</sup>

Organize your written answer logically by subdivisions within intellectual property law in the following order: (i) trade secret law; (ii) patent law; (iii) copyright law; and (iv) the law of marks. In addition, as a general matter, discuss any invalidity/protectability issues before any infringement issues. For example, in the patent law discussion, discuss any invalidity issues before any infringement issues.

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<sup>a</sup> 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.

<sup>b</sup> 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.<sup>c</sup>

***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. With respect to trade secret issues, the provisions of the Uniform Trade Secrets Act (“UTSA”) are the “majority” rule.<sup>d</sup> In addition, do not apply the Restatement factors to determine whether information is a trade secret; use the UTSA definition instead.

You should analyze clearly presented (either explicitly or by the facts) infringement issues 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. An example of this principle in trademark law is the assertion of product shape/design as a mark, but where the trademark defendant might have a functionality defense. In a real court opinion, if the court holds that the defendant wins on the functionality issue, the court would typically not analyze the likelihood of confusion test to determine if the accused product shape infringes the product shape/design allegedly functioning as a mark. Your analysis, however, should evaluate both the functionality defense and infringement if clearly presented: even if you conclude that the shape/design is functional and thus not the proper subject matter of protection as a mark, go on to analyze whether the likelihood of confusion test is met for infringement of the shape/design mark. Similar examples exist within other areas of IP.

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. Other areas of IP might also allow for multiple bases of invalidity.

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

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<sup>c</sup> Despite this jurisdictional orientation, the issues in this examination do not include jurisdictional and procedural issues, but rather focus on the substantive IP 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.

<sup>d</sup> Although the UTSA is the majority trade secret law, the common law trade secret cases studied in class are relevant to “fill gaps” in interpreting terms/concepts used in the UTSA.

element/limitation is met under a literal analysis,<sup>e</sup> 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.

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.<sup>f</sup> 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.”

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<sup>e</sup> 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.

<sup>f</sup> 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.