EXAM #_____

Final Exam
United States Patent Law
Pierce Law Fall 2006

Instructions:

- This exam is closed book. You should have no materials with you.
- The exam is multiple choice. Please read each question and select the **best** answer from the options provided. Mark your answer on the scan-tron sheet.
- Sections of the statue that may be helpful are reproduced below. You do not need to read them, they are just there for your reference.
- Good luck!

Statute:

Section 101. Inventions patentable

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Section 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or

(f) he did not himself invent the subject matter sought to be patented, or

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention

thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Section 103. Conditions for patentability; non-obvions subject matter

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

(b)(1) Notwithstanding subsection (a), and upon timely election by the applicant for patent to proceed under this subsection, a biotechnological process using or resulting in a composition of matter that is novel under section 102 and nonobvious under subsection (a) of this section shall he considered nonobvions if -

(A) claims to the process and the composition of matter are contained in either the same application for patent or in separate applications having the same effective filing date; and

(B) the composition of matter, and the process at the time it was invented, were owned by the same person or subject to an obligation of assignment to the same person.

(2) A patent issued on a process under paragraph (1) -

(A) shall also contain the claims to the composition of matter used in or made by that process, or

(B) shall, if such composition of matter is claimed in another patent, be set to expire on the same date as such other patent, notwithstanding section 154.

(3) For purposes of paragraph (1), the term "biotechnological process" means -

(A) a process of genetically altering or otherwise inducing a single- or multi-celled organisin to -

(i) express an exogenous nucleotide sequence,

(ii) inhibit, eliminate, augment, or alter expression of an endogenous nucleotide sequence, or

(iii) express a specific physiological characteristic not naturally associated with said organism;

(B) ecll fusion procedurcs yielding a cell line that expresses a specific protein, such as a monoclonal antibody; and

(C) a method of using a product produced hy a process defined by subparagraph (A) or (B), or a combination of subparagraphs (A) and (B).

(c)(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

(2) For purposes of this subsection, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if--

(A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;

(B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(3) For purposes of paragraph (2), the term `joint research agreement' means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

Section 112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Exam starts here:

1. The CAFC
    a. applies it's own precedent for matters involving it's area of exclusive jurisdiction.
    b. never considers other circuit court precedent persuasive.
    c. does not apply precedent from other circuits.
    d. can overrule the Supreme Court for patent matters.

2. A patent can generally be licensed with royalties payable
    a. for longer than it's term, so long as the parties agree.
    b. for longer than it's term if the party who suggested this arrangement should be estopped from arguing otherwise.
    c. for less than it's term and any anticompetitive behavior will be excused.
    d. for less than it's term with different royalty rates for different licensees.

3. Which of the following is not required to show equitable estoppel?
    a. Patentee, through misleading conduct, leads the infringer to reasonably believe he or she won't sue.
    b. Unreasonable delay.
    c. Due to reliance, infringer materially prejudiced.
    d. Reliance by the infringer.

4. The doctrine of patent misuse:
    a. Has been overruled by the 7th Circuit.
    b. Has been interpreted by the 7th Circuit to be coexistent with antitrust.
    c. Cannot properly be before the 7th Circuit because it is a patent matter within the Federal Circuit's exclusive jurisdiction.
    d. None of the above.

5. A licensee can
    a. not challenge a patent he or she has licensed because it would be inconsistent with the admission of value in accepting the license.
    b. challenge a patent because of the public interest in defeating bad patents and the ability of federal patent law to preempt state contract law.
    c. challenge a patent because contract and patent laws both encourage challenges to the underlying value of the contract.
    d. not challenge the patent because it would violate patent misuse.

6. There is a Reverse Doctrine of Equivalents
    a. True, it is a well-used doctrine.
    b. False, no court had held such.
    c. True, though no court has ever found non-infringement based on it.
    d. False, while there once was one, it has been overruled.

7. Who can enforce a patent?
    a. A exclusive licensee.
    b. An assignee in an undivided interest in the patent.
    c. Neither (a) nor (b).
    d. Both (a) and (b).

8. Patents are
    a. real property.
    b. personal property.
    c. cannot be assigned until they issue.
    d. rarely subject to the recording of ownership interests at the PTO.

9. *To get full access to damages a patentee*
    a. is fine as long as the infringer had actual notice.
    b. cannot rely on marking unless it can be shown to have put the infringer on notice.
    c. can rely on marking.
    d. can rely on a general letter to the industry about his or her patent.

10. Can an infringer who obtained an opinion of counsel of non-infringement and/or invalidity ever be found to be a willful infringer?
    a. Yes, if the opinion was objectively lacking.
    b. Yes, if its actions in litigation were egregious.
    c. No, it is entitled as a non-lawyer to rely on a lawyer's advice.
    d. No, opinions are no longer needed.

11. The so-called "DAMP" test
    a. is the only way for a patentee show it is entitled to recover profits on sales it would have made.
    b. is optional.
    c. does not consider demand.
    d. considers patentability.

12. Restrictions on first purchasers of a patented article
    a. are okay.
    b. are per se antitrust violations.
    c. generally render the patent unenforceable.
    d. are only allowed for public health and liability control.

13. A reasonable royalty
    a. is what you may be able to recover if you cannot show actual damages.
    b. is the amount which a person, desiring to manufacture and sell a patented article, as a business proposition, would be willing to pay as a royalty and yet be able to make and sell the patented article, in the market, at a reasonable profit.
    c. is set based on what would be reasonable when the infringement began.
    d. all of the above.

14. Which of the following is not a factor in determining whether a permanent injunction should be granted under the EBay case?
    a. Inadequate remedy at law.
    b. Balance of hardships in favor of injunction.
    c. Irreparable injury pendente lite.
    d. Public interest not disserved.

15. Which of the following factors must be found to support a finding of shop rights
    a. Employee-employer relationship.
    b. Employee consented to use.
    e. Employee induced, acquiesced or assisted in use.
    d. None of the above.

16. Best mode can be cleverly placed among alternatives in a patent without compromising validity.
    a. True.
    b. False.
    c. Only if the inventor was intentionally lying.
    d. Only if the best mode is claimed.

17. Which of the below are differences between laches and equitable estoppel?
    a. Laches requires contact between the parties and equitable estoppel does not.
    b. Equitable estoppel also bars injunctive relief.
    c. There is none.
    d. Both (a) and (b).

18. The purchaser of a patented article cannot:
    a. Build a replacement article.
    b. Modify the article.
    c. Preserve the useful life of the article.
    d. All of the above.

19. The correct test for determining infringement under the Doctrine of Equivalents is
    a. the function/way/result test.
    b. the insubstantial differences test.
    c. neither of the above.
    d. either of the above.

20. Equivalence under the Doctrine of Equivalents is a question of
    a. Fact.
    b. Law.
    c. Mixed question of fact and law.
    d. None of the above.

21. *If infringement is found to be willful*
    a. enhanced damages are mandated.
    b. damages are automatically tripled.
    c. attorney fees are awarded as a matter of course.
    d. none of the above.

22. Claim interpretation if a question of:
    a. Fact.
    b. Law.
    e. Mixed question of fact and law.
    d. None of the above.

23. Best mode differs from enablement in that:
    a. It cannot be supplied by mute reference to general knowledge in the art.
    b. It depends on the subjective view of the inventor.
    c. None of the above.
    d. Both of (a) and (b).

24. You determine claim meaning from:
    a. Specification.
    b. Prosecution history.
    c. Expert testimony including evidence of how those skilled in the art would interpret.
    d. All of the above.

25. Which of the following best addresses the fact that there may not be adequate language to explain an invention at the time of invention?
    a. The Doctrine of Eqnivalents.
    b. A patentee's ability to be his or her own lexicographer.
    c. A Markman hearing.
    d. None of the above.

26. The scope of the claims is determined
    a. always well before trial.
    b. always just before trial.
    c. at a Markman hearing.
    d. at an ANDA review.

27. A court _____ patent claims.
    a. Amends.
    b. Examines.
    c. Interprets.
    d. Allows.

28. Which of the following is typically the first recourse before the PTO in rebutting a prima facie case of obviousness:
    a. arguing objective indicia of non-obviousness.
    b. arguing that the art is non-analogous.
    c. attacking the motivation to combine.
    d. appealing.

29. In the language US constitution, copyrights are intended to promote:
    a. Industry
    b. Science
    c. Writing
    d. Arts

30. The entire market value rule
    a. allows a patentee to recover for the entire profit for a lost sale of a device where the patent only covered some part of the device so long as the patented feature is the basis for consumer demand.
    b. extends to unpatentable devices, but only when the patentable and unpatentable devices are considered components of a single assembly or together constitute a functional unit.
    c. Neither (a) nor (b).
    d. Both (a) and (b).

31. Which section of the patent law is intended to answer the fundamental question of what level of advance over the art deserves a patent?
    a. 102
    b. 103
    c. 112
    d. 271

32. If a claimed invention is described in a patent can be practiced by one of skill in the art without undue experimentation, then
    a. there is sufficient written description.
    b. best mode is satisfied.
    c. it is enabled.
    d. all of the above.

33. What treaty is commonly used to delay the cost of national filings by more than 2 years?

a. TRIPS
b. PCT
c. Oslo Accord
d. Paris Convention

34. Which of the following is most relevant to the determination of whether priority to a foreign filing is proper?

a. 101.
b. 102.
c. 103.
d. 112.

35. To find inequitable conduct based on a withheld reference where evidence of intent is not strong

a. it may not be inferred based in the high materiality of the reference.
b. is not relevant.
c. it is sufficient as a matter of law even if not strong.
d. it may be inferred based in the high materiality of the reference.

36. A sale of a product produced by a secret process more than a year before the filing of a patent by the one who made the sale will invalidate the patent to the process.

a. True.
b. False.
c. Only if it relates to a business method.
d. Impossible to tell.

37. What is the cornerstone of inventorship?

a. Contribution.
b. Diligence.
c. Sweat of the brow.
d. None of the above.

38. To count as conception, the idea must:

a. include each and every feature of the claimed invention.
b. include the feature the relevant inventor conceived.
c. be clear and convincing.
d. include the essence of the invention.

39. Whether written description is adequate is a question:

a. of law.
b. of fact.
c. of law and fact.
d. not relevant to patent validity.

40. If you are assessing whether art is analogous to your application and you determine it is not from the same field of endeavor:

a. It is analogous.

b. It is non-analogous.

c. You must determine whether the reference is still reasonably pertinent to the problem.

d. You must determine whether the applied reference can be reasonably described as arising from the same industry.

End of Exam. Happy Holidays!