EXAM # _____

Franklin Pierce Law Center
Patent Law Fall 2007
Professor Hawley
Final Examination

Instructions:

This is an "Open Book", "Open Notes" examination. You may use your textbook, statutes, slide presentations used by Professor Hawley in class and any notes and outlines which you have personally prepared. This includes notes and outlines prepared by a study group as long as you made a significant contribution to those notes or outlines. These materials can not be accessed via your laptop, they must be in paper form.

For those of you who are typing the exam, this document is available on TWEN and can be downloaded as a Microsoft Word® Document from the "Final Exam" assignment. Go to the "Assignment Dropbox". Click on the "Final Exam" in the "Course Assignment" column. A link to this document is there – click on the link to begin. The "Final Exam" assignment is timed and will be available at the start of the time for the exam. For the essay part, simply start typing after the essay question. For the short answer questions, where appropriate, indicate the correct answer in any way you would like: e.g. an "X" next to the correct answer; by highlighting in yellow, by deleting the incorrect answers etc. Just make it clear and unambiguous.

In keeping with the Registrar's instructions, this Final Exam document is the only document that should be on your screen except for the brief periods when you are downloading the document or uploading it after completion.

1.) You should immediately "Save As" the document and name it "Exam Number".doc, making sure that the file format is "Word 97-2003 Document". "Exam Number" should be your exam number and should be three digits, e.g. "001" (not simply "1") so that things sort properly.

2.) REMEMBER TO "SAVE" THE DOCUMENT REGULARLY.

3.) Before you post the document, make sure that you delete identifying information. The following is reproduced from the assignment drop-box instructions:

"**Note**: Your professor is using anonymous grading, so you should include only your identification number on your submissions. Please ensure that your name does not appear on the face of your work or in the file properties embedded within your submission. To remove identifying properties from a Microsoft® Word file, please follow these steps before submitting your work:

1. Open the Microsoft® Word file and click "Tools."
2. Click "Options."
3. Click the "Security" tab.

4. Select "Remove any personal information from file properties on save."
5. Click "OK."
6. Save the document.

If you have questions about removing potentially identifying properties from your file, please contact the manufacturer of the software you used to create the document."

If you are using Word® 2007, the process is different. Go to the upper left and the circular icon; select "Prepare" and "Inspect Document". Select: "Remove All" in "Document Properties and Personal Information".

4.) When you have finished the examination, go back into TWEN and the Assignment Drop-box and post the document.

Patent Law Fall 2007 Final Exam

Mr. Ivan Idea, comes to your office on November 27th, 2007 and describes his ideas. The problem he addresses is that children are prone to wander off and get lost in public places. His idea is to provide a battery operated wrist band that the child wears. The parent carries a transponder. The child's wristband sends out a signal that is picked up by the parent's transponder and is sent back to the child's wristband. He explains that the wristband includes an alarm and means for making cell phone calls. If the wristband gets too far from the transponder, the signal does not make it back to the wristband, the alarm sounds and at least one cell phone call is made, e.g. to the parent's cell phone number.

Ivan has anticipated that many parents will be using his device in roughly the same area, e.g. a shopping mall. Thus, Ivan has developed software to embed identification information, e.g. name, address, date of birth etc, into the signal that is sent from the wristband, coordinated with the parent responder and returned.

Ivan tells you that he has spoken with NewCell. They are interested in being the recipient of one of at least one of the calls made by the wristband and providing a service that will call law enforcement if the wristband is not reset within a specified time. Carmine Gumbatz, President of NewCell, has suggested that a GPS receiver be included in the wristband so that GPS data can be included in the cell phone call.

Part A

Based on these facts, state and discuss all of the potential patentable invention types that might be available. Assuming all of the inventions are patentable over the prior art, what would be your recommended application strategy?

Part B

Mr. Idea authorizes a patentability search. Your search reveals three patents. Patent 1 is based on an application made in May of 2002, published in November of 2003 and issued on July 1, 2004. This patent describes a child alarm device in which both the parent and the child wear a battery-powered wristband alarm that is connected one to the other by a detachable cord. If the cord is pulled from either wristband, that wristband sounds an alarm. Patent Publication No. 2 is based on an application made on Jan. 1, 2006 and published on July 1, 2007. That publication discloses an air traffic control system wherein a signal is sent from an air traffic control tower to an airplane transponder. If no signal is returned in response, an alarm in the tower sounds. Patent No. 3 shows a cell phone with a GPS receiver, issued July 1990.

Part B-1.

Based on the facts so far, prepare a list of questions that you would ask Mr. Idea and a brief description of the reason for each one.

Part B-2

Assuming answers in B-1 most favorable to patentability, analyze the patentability of at least two of Mr. Idea's inventions. As necessary, state the facts based on the assumed answers from Part B-1. Focus on the process, including issues raised and rules of law applicable. You need not come to a conclusion nor do you need to attempt to write a claim.

Short Answer:

1) A US application is a reference as of its filing date if:
   (a) It is published
   (b) It is granted as a patent
   (c) Either (a) or (b)
   (d) Neither (a) nor (b)
   (e) It is never a reference as of its filing date

2) In KSR, it was determined that obvious-to-try:
   (a) Does not require absolute predictability, only reasonable expectation of success.
   (b) Must make a "teaching suggestion" about invention.
   (c) Must imply an obvious solution regarding prior art.
   (d) Is determined depending on the finite number of predictable solutions and if it leads to the anticipated result.

3) Under section 102 (b), a reference is a "printed publication" and therefore a bar to patentability:
   (a) If upon a satisfactory showing of actual viewing or dissemination it is clear that the reference was distributed to the public more than one year prior to the application for patent in the U.S.
   (b) If a summary of it was distributed or indexed more than one year prior to the application for patent in the U.S.
   (c) If a summary of it was recorded as an audio file in an MP3 format and was made available and accessible to persons skilled in the subject matter or art more than one year prior to the application for patent in the U.S.
   (d) If it was available and accessible to persons skilled in the subject matter or art more than one year prior to the application for patent in the U.S.
   (e) None of the above.
   (f) All of the above.

4) Dr. Equivalent, has invented a new polymer which he calls "polyfloatomer." Dr. Equivalent only claims the compound itself. In his specification, Dr. Equivalent states that "polyfloatomer," a plastic, solid-like composition, can float in the air with no assistance from wind or any other device. He further discloses that the polymer can be used to make plastic objects such as toothbrushes. Dr. Equivalent shows in his specification how a toothbrush can be made from the polymer and also discloses how to make the polymer itself. In an application for a patent, ignoring novelty and obviousness issues, Dr. Equivalent's patent application should be:

(a) Rejected under section 101 as not having utility because Dr. Equivalent has not demonstrated how "polyfloatomer" can float in the air.
(b) Rejected under section 101 as not being patentable subject matter because floating in air is a natural phenomena.
(c) Rejected under both section 112, 1st paragraph (not enabled) and section 101.
(d) Allowed because Dr. Equivalent has demonstrated a utility for "polyfloatomer" and has enabled his claimed invention by disclosing ways to make and use the polymer.

5) Which one of the following situations prevents an applicant from obtaining a patent:
(a) The invention was described in a patent filed by another, before applicant's date of invention, and such patent was granted.
(b) The invention was offered for sale, or placed in "public use" in the U.S. more than one year before the filing date of the patent application or patented and described in a printed publication anywhere in the world, one year before applicant's filing date.
(c) The applicant filed for a patent in a foreign country more than one year before filing in the U.S. and such patent issued in the foreign country.
(d) The same invention was made by another, before the applicant invented his invention and has not been abandoned suppressed or concealed.
(e) All of the above.
(f) All of the above except (c)

6) In order to be an inventor, a person must:
(a) Have contributed to the conception of at least one invention claimed in a patent application,
(b) Have contributed to both the conception and reduction to practice of at least one invention claimed in a patent application,
(c) Be able to show corroborated evidence of their contribution,
(d) (a) and (c),
(e) (a), (b) and (c)

7) Which of the following statements is NOT true:

(a) A narrowing amendment in response to a rejection, made to comply with any provision of the Patent Statute, including Section 112, may invoke an estoppel.

(b) A voluntary amendment, made before any rejection by the Examiner, does not give rise to an estoppel.

(c) If the intrinsic evidence does reveal the reason for the narrowing amendment, there is a presumption that it was made for substantial reasons related to patentability.

(d) A presumption of estoppel can be overcome by the patentee showing that the equivalent would have been unforeseeable at the time of the amendment.

(e) None of the above.

8) Mr X has a business for producing cardboard packaging. Over the past year, he investigated different suppliers of cardboard. He created a list of the proposed suppliers which included "advantages" and "disadvantages" for each one. He keeps the list in a locked file cabinet and has never shared his list with anyone. Everyone in the industry knows which supplier he chose. Which of the following statements is true:

(a) His list can not be a trade secret in any jurisdiction because it does not relate to technical information.

(b) His list can not be a trade secret in any jurisdiction because it does not provide an ongoing commercial advantage.

(c) Whether his list can be a trade secret is determined by the law of the state in which he resides.

(d) If his list is eligible subject matter for trade secret protection, he has adequately protected it.

(e) Both (c) and (d) are true.

9) List the John Deere steps for determining obviousness.

10) What are the equitable factors for determining whether a permanent injunction is available after eBay?

11) The Supreme Court in the KSR case stated that the "Teaching-Suggestion-Motivation" test:

(a) Is never appropriate.

(b) Is a useful but not exclusive test for obviousness.

(c) Is now replaced with an "obvious to try" test.

(d) None of the above.

12) What is the "Hilmer doctrine"?

13) To establish infringement under Section 271:

(a) All of the steps of a process must be practiced by (or practiced under the control of) a single actor.

(b) All of the steps of a process must be practiced after the patent has issued.

(c) All of the components of a combination must be shipped from the US for foreign assembly.

(c) None of a), b) or c).

(d) All of a), b) and c).

14) An invention can be "on sale":

(a) Only if it has been successfully reduced to practice.

(b) Only if there is a contract meeting the requirements of the UCC.

(c) Only if the invention has been delivered to a customer.

(d) Only if the purchaser has agreed to a price.

(e) All of a) through d).

(f) None of a) through d).

15) Bill is a cabinet maker. He developed a new fastener for joining two boards at a right angle. The fastener allows him to quickly make a perfectly aligned joint, but he is not completely convinced of the strength of the joint. He has sold a few cabinets periodically, including the fastener, for a period of three years. He sees customers from time-to-time and asks about his cabinets but does not specifically inquire about the joints. The fasteners cannot be observed from the completed cabinet. He asks you if he can still file a patent application. You answer:

(a) No, because he sold the cabinets.

(b) No, because the cabinets were in "public use".

(c) No, because the cabinets were "publicly known in the US".

(d) Yes, because the public use was experimental.

(e) No, because of all of (a), (b) and (c)

16) Jane is the owner of a small flower shop. For years, Jane, working by herself, has been ordering flowers; receiving flowers; conditioning the flowers at a temperature just above freezing for 12 hours; storing the conditioned flowers until sale. Jane's business expanded so for the first time, she hired Fred. It turns out that Fred worked for HFC (Huge Flower Company) in the past. When Jane fires Fred, he goes back to HFC and discloses Jane's process to them. HFC has an "ordering – receiving – conditioning – storing- selling" patent that covers Jane's process. Jane has nothing to worry about because:

(a) Her process is a "business method" and she is entitled to a "prior user right".

(b) Her long time use of the method is a patent defeating public use.

(c) Maybe (a) but not (b).

(d) Jane should worry since HFC should be able to get an injunction.

17) What classes of invention does the Supreme Court consider to be nonpatentable under 35 USC 101?

18) Considering only 35 USC 101, Christopher Jeffrey is patentable subject matter.
(a) True.
(b) False.

19) ABC is a company operating out of Aruba. They export a kit which includes a variety of "off-the-shelf" components which, when assembled according to the enclosed instructions and combined with motor oil, purchased separately, infringes the claims of a patent owned by Alice. Alice will be successful in a patent infringement suit:
(a) Since ABC is inducing infringement.
(b) Since ABC is a contributory infringer.
(c) Since ABC is an infringer under the provisions of 271(f).
(d) Answer (a) provided Alice can also show that customers actually assembled the components and combined them with motor oil.
(e) Answer (b) provided Alice can also show that customers actually assembled the components and combined them with motor oil.

20) You are a company with headquarters and most of your manufacturing in Bermuda. You sued a US company for patent infringement. Your patent has been held to be valid and infringed. The defendant is a competitor in the same market and you would like to convince the court that you are entitled to lost profits. Most commonly, what showings must you make?

21) You are again the winning company in the previous question. In addition to selling your patented invention in the US, you also service the device covered by your patent. As a result of the infringement, you have lost sales of not only the device itself but also the service business. You can get lost profits on the service business if:
(a) You also have business method claims that cover the service process.
(b) The lost service business was "forseeable".
(c) The lost service business was "foreseeable" and you can make the showings from the previous question.
(d) None of the above.

22) Research shows that the most common cause of failure of cells phones, after battery problems, is that the display fails. Further, the economics of cell phones show that a) 80% of the manufacturing cost is a result of the display and b) the consumer only pays about 20% of the typical manufacturing cost since the service providers subsidize the cost of the phone from the fees charged each month. You establish a business of replacing cell phone displays. Your business constitutes "reconstruction" because:

(a) Since the screen is 80% of the manufacturing cost, it represents the "heart of the invention".

(b) Since the cellphone is useless without a working display, replacing the display "is a second creation of the patented entity."

(c) It takes over an hour to replace the display and insure that the phone is working.

(d) None of the above, your business constitutes "repair".

23) Regarding the interpretation of a claim after the Phillps v. AWH, which of the following statements is true:

(a) If the claim term is clear and unambiguous, the specification does not need to be consulted for that term's meaning.

(b) Expert testimony is never appropriate to interpret a claim.

(c) Live, expert testimony is more useful than a treatise.

(d) None of the above are true.

24) You are the patent counsel for BC (Big Company). You receive a letter from a VBC that you infringe a patent. You meet with your technical staff and study the file history and conclude a) that you do not infringe the patent and b) that they did not have support for the claims in the foreign application from which they claimed priority. You meet with VBC several times and do not get satisfactory answers to either a) or b). Because you continue to expect that VBC will give you their position on a) and b), you delay writing a complete freedom to use opinion. With respect to willful infringement:

(a) Since a competent opinion of counsel is needed to satisfy the due diligence obligation, BC could be held to be a willful infringer.

(b) BC's conduct will be evaluated under a "subjective carelessness" standard.

(c) If found to be a willful infringer, the Court must treble the proven damages.

(d) No adverse inference will be found if an opinion is not provided in defense to the willfulness charge.

(e) None of the above.