

Exam No. _____

This examination consists of five short answer questions

2 hours

Computer users: Please use the **Exam4 software in take-home mode**. Answers may alternatively be hand-written.

Instructions: This is a short-answer examination. The best answers will accurately and clearly answer the questions asked. Cite to statutes and key cases when relevant. A statutory supplement is included. Unless otherwise stated, assume that all events occur within the United States.

Note – answers that go beyond the word limit will be penalized.

Materials allowed. This is an open examination. You may use class notes or outlines, commercial outlines, online material, or any other material. However, you may not rely on contemporaneous communications with any other person (either via local or remote communication). The honor code applies to this take-home examination. You must perform all work on your own and abide by the instructions on this page.

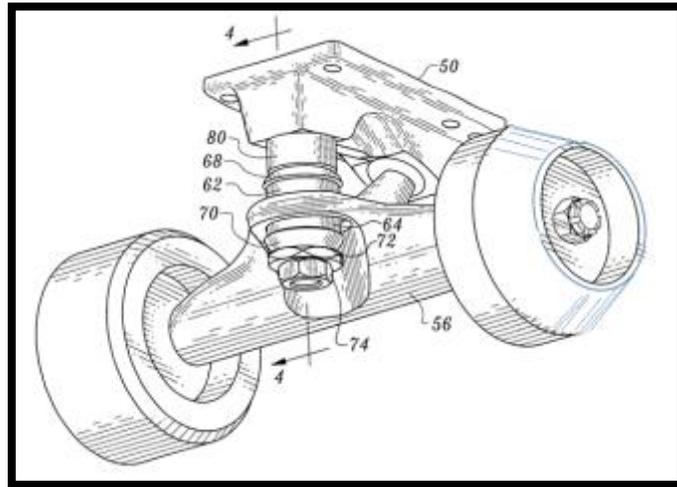
Avoid Plagiarism. Please take steps to avoid plagiarism or even the appearance of plagiarism. Thus, you should probably not work at the same table as someone else taking the same exam at the same time.

Write your blind examination number in the space indicated above on this page. Do not put your name on anything in connection with this examination. At the end of the exam, you must return this paper as well as your answers.

GOOD LUCK!!

Questions:

1. Johan is a skating champion. In January 2013 he came up with the idea for a wheel modification to his skateboard. Basically, the wheels were modified to add a sloped outer edge that better facilitates a new trick that he invented at the same time – the side-edge ride. One example of the wheel modification is shown in the first drawing below.



In a non-provisional utility patent application filed in June 2013, Johan claimed the new trick:

I claim, a method of edge-riding a skateboard comprising the steps of:

obtain the skateboard, wherein the skateboard is configured with at least a pair of edge-riding wheels each having a sloped outer edge, wherein each sloped outer edge is configured with at least two riding surfaces: a cylindrical flat-ride surface for riding on all four wheels, and a conical edge-ride surface for edge-riding; and

while flat-riding the skateboard, apply a pressure to the skateboard to cause two side-wheels to lift from the ground and so that the edge-ride and wherein the sloped edge-ride surface contacts the ground.

The question: Is Johan's claim subject-matter-eligible under 35 U.S.C. § 101? (does it matter if the wheel design is novel?) (120 words).

2. By February 2013, Johan had completed his designs and first performed the edge-riding trick in a competition (on a board with the new wheels). Because of its perceived novelty, a fan-video (a 'gif') of the competition went viral on the internet and was viewed over 100,000 times. Might the competition or video hamper Johan's ability to obtain patent protection? (100 words)

3. After obtaining the patent, Johan puts out a notice that anyone who uses his patented trick in a competition will be sued for patent infringement. Are there any preemptive steps that organizers of the X-Games can take to avoid this patent infringement scenario? (discuss up to three) (120 words).

4. It turns out that edge riding is tough, even with the modified wheels. While most professional skateboarders can master the trick with about 50 hours of practice. Many average boarders (those of ordinary skill?) simply do not have enough natural coordination to learn the move even with hundreds of hours of practice. Does this create an enablement problem for the patent? (60 words)

5. After the patent issued, a famous boarder (Anthony Falcon) files an *inter partes review* petition – alleging that the patent claim should be cancelled in light of the prior art. Falcon presents a picture of himself seemingly edge-riding back in 2004. Falcon’s board did not include the exact specialized wheels, but did include wheels with rounded edges as shown to the side here. Should the USPTO cancel the claim? (120 words)



End of Questions

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Statutory Supplement

The following are a set of Post-AIA statutes of relevance (applied to patent applications having at least one claim with an effective filing date on or before to March 16, 2013).

35 U.S.C. § 101

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.

35 U.S.C § 102

(a) Novelty; Prior Art.— A person shall be entitled to a patent unless—

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or

(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122 (b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

(b) Exceptions.—

(1) Disclosures made 1 year or less before the effective filing date of the claimed invention.— A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—

(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

(2) Disclosures appearing in applications and patents.— A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—

(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;

(B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

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(d) Patents and Published Applications Effective as Prior Art.— For purposes of determining whether a patent or application for patent is prior art to a claimed invention under subsection (a)(2), such patent or application shall be considered to have been effectively filed, with respect to any subject matter described in the patent or application—

(1) ... as of the actual filing date of the patent or the application for patent; or

(2) if the patent or application for patent is entitled to claim a right of priority [nationally or internationally] ... based upon 1 or more prior filed applications for patent, as of the filing date of the earliest such application that describes the subject matter.

35 U.S.C. § 103

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.

35 U.S.C. § 112

(a) In General — 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 or joint inventor of carrying out the invention.

(b) Conclusion — The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention. . . .

(f) Element in Claim for a Combination — 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.

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The AIA substantially changed the definition of prior art under 35 U.S.C. 102 and as applied in the obviousness context. However, the law did not otherwise substantively change the enablement, written description, indefiniteness, best mode, or obviousness.

Pre-AIA 35 U.S.C. § 102

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 . . .

(e) the invention was described in - (1) an application for patent . . . 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. . .

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

(g) . . . (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.

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Cases of note include

Nautilus, Inc. v. Biosig Instruments, Inc., 134 S.Ct. 2120 (2014) (indefiniteness).

Alice Corp. Pty. Ltd. v. CLS Bank Int'l, 134 S.Ct. 2347 (2014) (subject matter eligibility).

KSR International Co. v. Teleflex, Inc., 550 U.S. 398 (2007) (obviousness).

Graham v. John Deere Co., 383 U.S. 1 (1966) (obviousness).