

Professor Crouch Spring 2015

This examination consists of five short answer questions

Instructions: This is a 2 hour essay examination. It will be available for pickup in Room 203 at any point during the exam period. 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 book, open note, and open computer examination. You may use class notes or outlines, commercial outlines, the Internet, or any other material. 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.

To be clear – you need to turn-in your answers on a separate paper. They may be hand-written or typed/printed.

GOOD LUCK!!

Questions:

1. An employee at Freya's small start-up company has come up with a new smartphone-app that helps cat-lovers meet. Essentially, the app causes the phone to "meow" when another user is nearby; "purr" when a good match is nearby; and "hiss" when an identified cat-hater or non-compatible is nearby. In her patent application, Freya claims:



A mobile device having a memory and a processor and operating as part of a social network, wherein the memory includes a stored program configured to:

cause the mobile device to emit a first sound based upon the proximity of a mobile device associated with a member of the social network;

cause the mobile device to emit a second sound based upon the proximity of a mobile device associated with a member of the social network who has been identified as a match; and

cause the mobile device to emit a third sound based upon the proximity of a mobile device associated with a member of the social network who has been identified as a bad match.

Is Freya's claim subject-matter-eligible under 35 U.S.C. § 101? (120 words).

2. Regarding back to Freya's claim above. Provide a concise argument that the claim fails for lack of definiteness. (60 words).

3. Sometime during the past decade, Thor invented a new metal alloy known as Midgardium that is extremely hard and exhibits boomerang-like properties when thrown. Thor would like to patent a hammer made from the alloy but keep the actual process of making the alloy a trade-secret. May he do this? (50 words).



4. Following your advice above, Thor does fully disclose the process of making the alloy in his patent application (claiming "A hammer comprising a hammer-head made of Midgardium and a handle"). After Thor created his hammer (but before he filed his patent application), Loki independently invents Midgardium and forms it into scepter that he uses publicly in New York City. Loki does not, however, file for patent protection.

Concisely explain how the dates of invention, public use date, and Thor's filing date may impact whether Loki's disclosure counts as prior art against Thor's patent application (250 words).

5. Assuming that Loki’s public-use counts as prior art against Thor’s patent application, can you make an argument that the scepter anticipates the aforementioned hammer claim? (60 words).

6. Still assuming that Loki’s public-use counts as prior art against Thor’s patent application, what can Thor do/argue in order in order to overcome the USPTO’s initial conclusion that the patent claim is obviousness based upon Loki’s use? (describe up to three approaches/arguments). (100 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).