

Professor Crouch Spring 2016

This examination consists of six short answer questions

Instructions: This is a 2-hour short-answer essay examination. It will be available for pickup in Room 203 at any point during the exam period after December 6, 2016.

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 on or after March 16, 2013.

Each question has a word limit. Answers that go beyond those word limits 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!!

Introduction: Although not a poultry expert, Prof Crunch recently designed and built his own back-yard chicken coop (Coop) (started and completed in August 2016). Among its special features, the coop includes a *translucent roof* to allow additional wintertime light, a *hinged trap-door* in the floor for removing waste and debris, a *vertically sliding door* opening to the chicken-run. The vertically sliding door is operated by a pulley system and can be controlled by someone standing next-to the *nesting box door*. Thus, a user can provide access to the chicken-run at the same time as collecting eggs. The coop is also designed to be long-and-narrow in order to fit through a standard 40-inch fence gate while also providing at least 21 square feet of floor area. While Crunch expects that many of these features are not unique, he expects that the combination is unique. Crunch is an idea-man. Rather than production is looking to sell *plans and instructions* for making his Coop.

Crunch drafts the following two patent claims in his patent application filed December 5, 2016:

I claim:

1. A poultry coop having a length, width, and height, said poultry coop comprising:
a roof made of a translucent material with at least 50% light transmission;
a floor having a hinged trap door and an area of at least 21 square feet;
a first side wall housing a nesting box with an externally hinged door; and
a second side wall housing a vertically sliding door operated via a pulley system; wherein said pulley system is operable by a user standing near said nesting box and wherein said coop is configured with a width of less than 40-inches.
2. A set of instructions comprising, instructions for making the poultry coop of claim 1.

Question 1. (120 words). Crunch had considered adding an additional limitation that precisely defines the configuration of the pulley system and its components. What are major pros and cons of adding these additional limitations to claim 1 (considering primarily the doctrines of patentability and infringement)?

Question 2. (200 words) Are these claims patent eligible subject matter?

Question 3. (60 words) Provide a concise argument that claim 1 fails for lack of definiteness.

Question 4. (80 words) Should Crunch be concerned that his back-yard prototype constitutes prior art?

Question 5. (240 words) Assume the following for this question: (a) the back-yard prototype is *not* prior art; (b) Crunch's expectations are correct that while many of the patented elements are known in the prior art, the combination as a whole is unique. What can we say about the novelty/nonobviousness of the claims.

Question 6. (25 words) Assuming claim 1 is patented but not claim 2. Does Crunch have an infringement claim against a third party who begins teaching others how to make the coop?

End of Questions

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 after March 16, 2013).

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.

35 U.S. Code § 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.

35 U.S.C § 102 - Conditions for patentability; novelty

(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 - Conditions for patentability; non-obvious subject matter

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 - Specification

(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.

35 U.S.C. § 271 - Infringement of patent

(a) Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

(b) Whoever actively induces infringement of a patent shall be liable as an infringer.

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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

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).

Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc., 574 U.S. ____ (2015) (claim construction)

Commil USA, LLC v. Cisco Systems, Inc., 575 U.S. ____ (2015) (holding that a defendant's good-faith belief that a patent is invalid is not a defense to a claim of inducing infringement.)