WHITTIER LAW SCHOOL
Patent Law
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PARTIAL PRACTICE EXAMINATION

Notes and Instructions

1. Answer the questions based on United States patent law, rules, procedures, and cases as presented in class. Your goal is to show your mastery of the material presented in the course and your skills in analyzing legal problems. It is upon these bases that you will be graded.
2. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being in and of the United States, nonprovisional in nature, and of the utility kind (as opposed to plant or design).
3. All facts take place in the United States, unless otherwise noted.
4. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the United States Patent and Trademark Office.
5. You may write anywhere on the examination materials — e.g., for use as scratch paper. Only answers and material recorded in the proper places, however, will be graded.
6. Do not write your name on any part of the exam or identify yourself in anyway, other than to use your examination I.D. number appropriately. Self-identification on the exam will, at a minimum result in a lower grade and may result in disciplinary action as well.
7. During the exam: You may not consult with anyone – necessary communications with the proctors being the exception. You may not view, attempt to view, or use information obtained from viewing student examinations or materials other than your own.
8. **For PART ONE of the examination, comprising multiple-choice questions:**
   a. This section of the examination is "closed book." You may not use any materials at all other than writing instruments and the materials provided as part of the examination.
   b. Do not assume any additional facts not presented in the questions.
   c. Choose the most correct answer based on the materials assigned and presented in class. Each question has only one most correct answer. For example, where choices (a) through (d) are correct and choice (e) is "All of the above," the last choice (e) will be the most correct answer and the only answer that will be accepted. Where two or more choices are correct, the most correct answer is the answer that refers to each and every one of the correct choices.
9. **For PART TWO and PART THREE:**
   a. This portion of the exam is "open book." You may use any written material drafted before the exam's start by you or anyone else. Materials cannot be shared in any way with any other student once the exam begins.
   b. It is recommended that you divide your time among the sections on the exam roughly in accordance with their corresponding worth in terms of the overall examination grade.
   c. Note all issues you see. More difficult issues will require more analysis. Spend your time accordingly.
   d. Organization counts.
   e. Read all of the exam questions for Part Two and Part Three before answering any of them — that way you can be sure to put all of your material in the right place.
   f. Start your response to each section on a new page.
   g. Feel free to use abbreviations, but only if the meaning is entirely clear.
   h. <u>Bluebook users (not using a computer):</u> Make sure your handwriting is legible. I cannot grade what I cannot read. Skip lines and write on only on one side of the page. Start new answers on new pages. Put Part Two and Part Three in separate bluebooks.

PART ONE

(This part will count as 1/3 of the exam grade.)

Multiple Choice Questions

1. Which of the following is not within the scope of the term "on sale" for purposes of applying the statutory bar under 35 U.S.C. § 102(b)?

   (a) a commercial offer to sell the claimed invention
   (b) an offer to sell the patent rights in the claimed invention
   (c) a sale that did not result in a profit
   (d) a single sale of the claimed invention
   (e) a sale conditioned on buyer satisfaction

2. Note the following:

   Claim 1: In an electromagnetic energy shield having a volume resistivity to be effective as an electromagnetic shield comprising a resin matrix loaded with particles coated with silver in an amount of about 40 to 80 volume percent, the improvement being that the silver coated particles are of a maximum size in the range of from 0.5 to 40 mils and wherein the resin is compressible.

   Which of the following is a correct statement about the above claim?

   (a) This is an example of a Jepson claim.
   (b) This is an example of a Markush claim.
   (c) This is an example of a claim that has been limited by a terminal disclaimer.
   (d) This is an example of a product-by-process claim.
   (e) This is an example of a dependent claim.

3. Harvey conceived of the idea for a new showerhead on April 3, 2005. Harvey exercised reasonable diligence in attempting to reduce the showerhead to practice beginning on April 29, 2005 and continuing until he reduced the showerhead to practice on July 27, 2005. Kyoko conceived of the idea for an identical showerhead on May 5, 2005, and exercised reasonable diligence from the moment of conception until she reduced the showerhead to practice on May 16, 2005. Sven conceived of the same showerhead on April 19, 2005 and then did nothing at all with regard to actually reducing the showerhead to practice. Sven drafted and filed a application on the showerhead on April 25, 2005. Gilda conceived of the idea for the same showerhead on June 14, 2005 and proceeded with reasonable diligence to reduce the invention to practice, which she achieved on August 14, 2005. The new showerhead infringes the claims of the '555 patent, for which Gilda is the named inventor and sole owner. Who will win a priority contest under 35 U.S.C. § 102(g)?

(a) Harvey
(b) Kyoko
(c) Sven
(d) Gilda
(e) More than one of these people will win, because, on these facts, two or more inventors will hold the resulting patent to the new showerhead as tenants-in-common.

4. In which of the following situations could a defendant best make use of the first-inventor defense under 35 U.S.C. § 273, the "First Inventor Defense Act of 1999"?

(a) Plaintiff conceived of a new process for extracting malatyrin, a protein, from type-VII myelocytes on January 7, 2005, reduced the process to practice on January 9, 2005, and filed for a patent application on June 28, 2005, with the resultant patent being issued March 3, 2006. Defendant conceived of the same process on September 4, 2004, proceeded with reasonable diligence to attempt to reduce the process to practice, such reduction being achieved May 15, 2005. Defendant has never filed a patent application on the process.
(b) Plaintiff conceived of a new machine for removing mineral deposits in water-treatment equipment on March 30, 2004. After taking time off to finish her Ph.D., plaintiff reduced the invention to practice on January 10, 2005, filed a provisional patent application on January 12, 2005, and filed a nonprovisional patent application on January 11, 2006. Plaintiff's patent on the application was issued April 20, 2006. Defendant achieved actual reduction to practice of the same machine on August 11, 2002. Defendant has never filed a patent application on the process.

(c) On May 1, 2004, plaintiff conceived of a new method of doing business involving assignment of rewards points to customers based on purchasing decisions. Plaintiff filed a patent application on December 20, 2005, and the patent was granted on April 13, 2006. Defendant conceived of the same method on February 3, 2004, actually reduced the method to practice on March 15, 2004, and made commercial use of the invention on October 17, 2005. Defendant has never filed a patent application on the method.

(d) On February 28, 2003, plaintiff conceived of a new process for the manufacture of artificial diamonds yielding better quality diamonds at lower cost. Plaintiff reduced the invention to practice on December 8, 2003, filed a provisional patent application on December 10, 2003, and filed a nonprovisional patent application on December 7, 2004. Plaintiff's application matured into an issued patent on March 18, 2005. Defendant reduced the same process to practice on December 9, 2004 and filed a patent application on the process on February 25, 2004.

(e) On April 5, 2004, plaintiff conceived of a new iron/chromium/nickel alloy for use in load-bearing flanges on salt-water exposed drilling rigs. Plaintiff filed a patent application on November 23, 2005, and the patent was granted on March 9, 2006. Defendant conceived of the same iron/chromium/nickel alloy on January 1, 2004, actually reduced the alloy to practice on February 19, 2004, and made commercial use of the invention on September 14, 2005. Defendant has never filed a patent application on the invention.

NOTE THE FOLLOWING FOR QUESTIONS 5 AND 6:

Having worked on the problems of achieving zanfrination through non-mechanical means for more than eight years, on February 2, 2005, Carol conceived of a magnetic zanfrinator that could achieve zanfrination of a substrate through oscillation of the magnetic field. Carol did nothing on the project until May 5, 2005, when she began trying to build a working model of the magnetic zanfrinator. Carol then worked on the invention at least a couple of hours each day, six days a week. Beginning on July 10, 2005, Carol began working at least 14 hours a day every single day on the magnetic zanfrinator. Carol did not have success in building a working magnetic zanfrinator until September 19, 2005, when Carol tried tying the frequency of the oscillations to the temperature of the substrate. On the same day, Carol achieved perfect zanfrination through magnetic means. Carol filed a provisional application on the magnetic zanfrinator on October 1, 2005, and she filed a nonprovisional application on the magnetic zanfrinator on November 11, 2005. The patent issued on April 5, 2006.

5. Assuming Carol pays her maintenance fees, the patent term will expire 20 years from which of the following dates?

(a) May 5, 2005
(b) July 10, 2005
(c) October 1, 2005
(d) November 11, 2005
(e) April 5, 2006

6. Assuming Carol could make the required factual showing, which of the following would not be helpful for Carol in establishing that her magnetic zanfrinator is nonobvious under 35 U.S.C. § 103?

(a) After its introduction into the marketplace, Carol's magnetic zanfrinator quickly grabbed a substantial market share at the expense of competitors.
(b) The magnetic zanfrinator had unexpected advantages in solving longstanding problems of breakage and incomplete zanfrination, problems associated with mechanical zanfrinators.
(c) Before Carol's invention of a working magnetic zanfrinator, virtually all firms in the zanfrination industry had tried but failed to build a zanfrinator that worked on magnetic principles.
(d) Carol's conception of the magnetic zanfrinator came to her through hard work and laborious experimentation, rather than "in a flash of genius."
(e) Before Carol's magnetic zanfrinator, experts said that zanfrination could not be achieved magnetically.

7. Which of the following is not specifically and expressly embraced as patentable subject matter according to the language of 35 U.S.C. § 101?

(a) a process
(b) a phenomenon of nature
(c) a machine
(d) a composition of matter
(e) regarding one of the other categories of patentable subject matter, an improvement thereof

8. Note the following:

I. damages as measured by reasonable royalties
II. damages as measured by plaintiff's lost profits
III. damages as measured by defendant's wrongful gains
IV. an injunction prohibiting further manufacture and use of a claimed invention

Which of the following describes remedies available for patent infringement among those identified in the above statements?

(a) I and II only
(b) I and IV only
(c) I, II, and III only
(d) I, II, and IV only
(e) I, II, III, and IV

[Further questions omitted from these practice materials.]

PART TWO

(This part will count as 1/3 of the exam grade.)

[Question omitted from these practice materials.]

PART THREE

(This part will count as 1/3 of the exam grade.)

<u>Question One</u> (approximately 7% of overall exam grade)

"Patent law rewards first inventors." Provide examples, with brief explanations, of how this statement is and is not true.

<u>Question Two</u> (approximately 12% of overall exam grade)

There are three new vacancies on the United States Court of Appeals for the Federal Circuit. You are an advisor to the president. Draft a memo describing how these nominations could be used to affect Federal Circuit jurisprudence and patent law for the better. Make specific reference to doctrines, cases, etc., that you perceive as problematic, and provide theoretical underpinnings that support your contentions.

[Further questions omitted from these practice materials.]