

Patent Law & Policy
Law 677 | Spring Term
Professor Wagner

Sample Questions & Answers

Volume 1

The following pages (based on a fact pattern used in my Spring 2001 Patent Law Final Exam) are intended to be generally illustrative of what you might see on the Final Exam. I've included the instructions page for the 2003 Exam as well.

Answers and explanations are provided at the end of this document.

Exam #: _____

Exam Ticket Number: _____

PATENT LAW

Law 677 | Spring 2003

Professor Wagner

FINAL EXAMINATION

April 27, 2003

Time Limit: 2 hours.

(No extra time for LLM students.)

INSTRUCTIONS

1. The exam consists of 2 pages. **Stop now and check to see that you have all pages.**
2. The exam consists of 45 total questions – all in “multiple choice” format. A total of 100 points are available; each question is weighted equally.
3. Certain questions are associated with certain fact patterns. (For example, Questions 1 through 9 are associated with Fact Pattern A.) This is clearly marked on the exam, but be sure to keep track of which fact pattern you are considering.
4. **Mark all answers on the scan sheet only.** Answers marked on the exam will not be accepted. Use a #2 pencil.
5. **Be sure to mark your exam ticket number on your scan sheet.**
6. Be sure to read each question and the answers carefully and completely.
7. The exam is “open book” and “open notes”. The only restriction is that you may not get assistance from another person.
8. Good luck, and have a great break from school.

Fact Pattern X

The One with the Segway

FastScooters, Inc. owns US Patent No. '789, entitled "Personal Transportation Device," and generally directed to a motorized scooter-like vehicle, where a person stands on a small platform to ride. The '789 patent has two figures, as follows:



'789 Patent, Figure 1



'789 Patent, Figure 2

The '789 patent has a single claim, which as originally filed, stated:

1. A personal transportation device comprising:
 - a motor no greater than 100 cubic centimeters in displacement;
 - a platform disposed approximately parallel to the ground during normal operation;
 - wheels supporting said platform;
 - a rigid steering shaft connected to said platform; and,
 - a handlebar.

While generally describing the embodiments shown in Figures 1 and 2 above, the written description of the '789 patent does not provide any special definitions for the claim terms.

In the course of prosecution, the applicant amended the claim. The final claim as issued reads:

1. A personal transportation device comprising:
 - a motor no greater than 100 cubic centimeters in displacement;
 - a platform disposed approximately parallel to the ground during normal operation;
 - where the platform is of a size suitable to allow a person to stand;
 - two pairs of wheels supporting said platform;
 - where the axis of said wheels is disposed approximately parallel to the axis of the shoulders of the operator during normal operation;
 - a rigid steering shaft with a top and bottom end, wherein the bottom end is connected to said platform; and,
 - a generally-horizontal handlebar connected to said top end of said steering shaft.

These amendments were not prompted by any rejections by the examiner, and were accompanied by a statement by the patentee explaining that:

These amendments are made to more clearly describe what the applicant regards as his invention and are not intended to alter the scope of the claim.

Wheels, Inc., the primary rival to FastScooters in the market for small personal transportation vehicles, has begun to sell a scooter it calls the "Glider 3000." The Glider 3000 is a two-wheeled vehicle with a 95 cubic centimeter engine, shown in the figure below.

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The Glider 3000 vehicle, by Wheels, Inc.

FastScooters has filed suit in US District Court, alleging that the Glider 3000 device infringes claim 1 of the '789 patent.

[end of Fact Pattern A]

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SAMPLE EXAM QUESTIONS

1. FastScooters argues that Claim 1 of the '789 patent literally covers the embodiments of the invention shown in Figures 1 and 2 of the patent. Is this assertion correct?
 - [a] Yes. Under *Johnson Worldwide v. Zebco*, a claim construction that would exclude a depicted embodiment of the invention is strongly disfavored;
 - [b] Yes. Claim 1 is supported pursuant to 35 U.S.C. § 112 ¶ 1 by Figures 1 and 2;
 - [c] No. Under the rule allowing a patentee to be her own lexicographer, coverage of Figure 2 is excluded;
 - [d] No. Neither figure is described as the best mode, and thus cannot serve to inform claim scope;
 - [e] None of the above.

2. Which of the following elements of Claim 1 of the '789 patent is most likely to be closely contested during a hearing held pursuant to *Markman v. Westview Instruments*:
 - [a] “a motor no greater than 100 cubic centimeters in displacement”;
 - [b] “a rigid steering shaft”;
 - [c] “a platform”;
 - [d] “two pairs of wheels”;
 - [e] None of the above is likely to be contested.

3. The following numbered statements are related to the proper construction of the “two pairs of wheels” claim element. Rank them in order of their relevance (from most to least) regarding the claim construction issues presented by Fact Pattern A. Assume for the purposes of this question only that the statements are factually correct, and that the claim construction rules established by *Johnson Worldwide v Zebco* are in force.

- I The specification of the ‘789 patent describes and depicts multiple types of wheel configurations;
- II The specification of the ‘789 patent states “the descriptions and embodiments noted herein are for illustration purposes only, and are not meant to restrict the scope of the invention”;
- III The prosecution history of the ‘789 patent reveals that the patentee stated “By the way, I mean for the term ‘two pairs’ to mean any arrangement of wheels greater than two”;
- IV The inventor has filed a sworn affidavit with the court indicating that he has “always understood the phrase ‘two pairs of wheels’ to mean any arrangement of wheels greater than two.”

- [a] IV, II, I, III;
- [b] IV, III, II, I;
- [c] III, I, II, IV;
- [d] III, IV, II, I;
- [e] I, II, III, IV;

4. Which of the following statements is an appropriate argument, under the rule of *Festo Corp. v. Shoketsu Kogyo Kabushiki Co.*, to overcome the presumption that the doctrine of equivalents is not available to the “two pairs of wheels...” element?
- [a] The elimination of a pair of wheels (as in the accused device) was an unforeseen technological development at the time of the amendment;
 - [b] The amendment introduced a new element to the claim rather than amending a pre-existing element;
 - [c] The amendment was not prompted by a rejection or any requirement imposed by the patent examiner;
 - [d] The amendment was made to conform Claim 1 to the requirements of 35 U.S.C. § 112 ¶ 1, in light of Figure 2 of the ‘789 patent;
 - [e] None of the above.
5. Assuming for the purposes of this question only that each element of Claim 1 of the ‘789 patent—aside from the “two pairs of wheels” limitation—is present in the Glider 3000. Considering only the “two pairs of wheels” limitation, which of the following statements is correct?
- I The Glider 3000 does not literally infringe Claim 1 of the ‘789 patent;
 - II The Glider 3000 infringes Claim 1 of the ‘789 patent pursuant to the doctrine of equivalents;
 - III The Glider 3000 literally infringes Claim 1 of the ‘789 patent;
 - IV The Glider 3000 does not infringe Claim 1 of the ‘789 patent pursuant to the doctrine of equivalents;
- [a] I and II;
 - [b] I and IV
 - [c] III and IV;
 - [d] III and II
 - [e] None of the above.
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Answers to Sample Questions

1. The correct answer is [e], “None of the above.” The literal language of Claim 1 will not cover the embodiment of Figure 2; but neither choice [c] or [d] offers a correct explanation of why.
2. The correct answer is [b], “a rigid steering shaft.” Among the choices available, only the ‘rigid steering shaft’ limitation presents a remotely close case in terms of claim construction—due what appears to be a ‘hinge’ in the corresponding structure of the Glider 3000 accused device.
3. The correct answer is [c], “III, I, II, IV.” Statement III is clearly the most relevant to the issue because it appears to show a special definition for the claim element – which, under *Johnson Worldwide*, is controlling. As between answers [c] and [d], statements I and II are clearly more relevant under *Johnson Worldwide* than statement IV, which is barely relevant at all, unless everyone agrees that the inventor is somehow illustrative of one of skill in the art (which was not stated).
4. The correct answer is [a], “The elimination of a pair of wheels (as in the accused device) was an unforeseen technological development at the time of the amendment.” None of the other arguments are relevant under the *Festo* presumption. (*Note that this argument, while an ‘appropriate’ response in the Festo context, is exceedingly unlikely to be a winner.*)
5. The correct answer is [b], “I and IV.” Statement III is clearly false, as the Glider 3000 contains a single pair of wheels. And given the *Festo* presumption against allowing DOE coverage where an amendment has been made, statement IV is a far better choice than statement I.

Note: The Exam timing assumes about 2-3 minutes per question on average. Thus, this sample exam should have taken you 10-15 minutes total.