

# PATENT LAW

LAW 677 | PROFESSOR WAGNER | SPRING 2002

## SAMPLE QUESTIONS

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These five multiple choice questions (based on a fact pattern used in the Spring 2001 Patent Law Final Exam) are intended to be generally illustrative of what you might see on the Final Exam. Answers are provided at the end of this document.

### Fact Pattern A 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;
  - two pairs of wheels supporting said platform;
  - a 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 axis of the shoulders of the operator during normal operation;
  - a steering shaft with a top and bottom end, wherein the bottom end is connected to said platform; and,
  - a 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.



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]***

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 *Vitronics v. Conceptronic*, 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 of *Maxwell v. J. Baker*, 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 are 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 steering shaft";
  - [c] "a platform";
  - [d] both [b] and [c], but not [a];
  - [e] None of the above
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 and import to the patentee (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.
- 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 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, IV, II;
  - [d] III, IV, II, I;
  - [e] None of the above.

4. Which of the following statements is an appropriate argument in response to assertions that the doctrine of equivalents is not available to the “two pairs of wheels” element under the rule of *Festo Corp. v. Shoketsu Kogyo Kabushiki Co.*?
- [a] The amendment, as shown by the patentee’s statement, was not intended to narrow the scope of the claims;
  - [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. Assume for the purposes of this question only that the accused device has been found to literally noninfringe the ‘789 patent – due to the “two pairs of wheels” element in Claim 1. Which of the following rules are likely to – as a matter of law – preclude infringement under the doctrine of equivalents?
- I. Prosecution history estoppel;
  - II. Function-way-result;
  - III. Disclosed-but-unclaimed subject matter;
  - IV. Vitiating;
  - V. Secondary considerations.
- [a] I only;
  - [b] I, II, III, IV;
  - [c] II, III, IV;
  - [d] I, III, IV;
  - [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 steering shaft.” As noted in the Spring 200 Sample Answers, whether the steering shaft is found in the Glider 3000 is a close question. Neither choice a or c is even close.
3. The correct answer is c , “III, I, IV, II.” Statement III is most important because it appears to show a special definition for the claim element which, under *Johnson Worldwide*, etc., is controlling. Statement II is least favorable to the patentee, as it implies that the claims are not defined by the specification *i.e.*, the embodiment of Figure 2 . Among the other choices, I is clearly more relevant under *Johnson Worldwide* as implying a broad construction of a claim term ; IV 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 b , “The amendment introduced a new element to the claim rather than amending a pre existing element.” None of the other arguments are relevant under *Festo* rules.
5. The correct answer is d , “I, III, IV.” Statements II and IV can be eliminated outright; the application of the function way result test is factual, and secondary considerations relate to obviousness, not the DOE. As noted in the Spring 2001 Sample Answers, all three theories in statements I, III, and IV will apply in this case.