

Patent Law  
Spring 2013 – Michael Risch  
Final Exam

This is a take-home exam. You have eight (8) hours from the time you download the exam to complete and upload the answer. If you experience technical difficulties, please follow registrar office directions or contact the registrar. I recommend that you do not download the exam at a time when the due time will be outside of business hours of the law school.

**You may use any written materials you desire for the exam, but you may not receive help from any person. Note that the exam will be held during the first week, but there may be make-up exam days. You must be careful not to disclose any details of the exam to your classmates, or discuss any aspect of the exam (or your answer!) until after I post a Blackboard announcement notifying you that you may do so. Page two of this exam is a confirmation that you understand this – please print, sign, and turn in to Safia Dias at some point before May 11.**

Make sure that your exam number appears on each page, which is most easily done with a header or footer.

This exam includes a strict word limit of 4200 words, which is approximately 13-15 pages of a proportionally-spaced font, or many fewer pages with smaller margins. I am grading each exam all at once, so feel free to refer to a prior answer if relevant. NOTE: You do not have to use all of the words available – the questions can be answered in less space than allotted.

Do not rely on page limits; you should count words using your word processor's "properties" menu item (word counts are sometimes in the bottom bar of the word processor as well). You may divide the word limit among the different questions however you wish, **but I will stop reading after the word limit is reached.**

Your exam must be typed, with double spacing on 8.5 x 11 paper size and reasonable font and margin size. Please begin the answer to each question at the top of a new page.

Patent Law Final Exam, Spring 2013.

I \_\_\_\_\_, confirm that I abided by the instructions of this exam and have obeyed and will obey the Villanova University School of Law Code of Conduct with respect to the above exam, and that I have not discussed and will not discuss any part of the exam, its contents, or my answer with any of my classmates until after I am notified that I may do so.

Dated: \_\_\_\_\_ Signed: \_\_\_\_\_

\_\_\_ Initial here if Prof. Risch may publicly post some or all of your answer (without your name associated with it)

Please return to Safia Dias in Room 260 by 5PM on May 11, 2013. I cannot give you a grade without it.

Patent Law Final Exam  
Spring 2013

The questions are weighted as follows: Question 1, 6 points, Question 2, 57 points, Question 3, 27 points, and Question 4, 10 points for a total of 100. If any of your answers depend on facts not stated in the problem, feel free to identify which facts would be helpful, and how they would affect resolution of the issue. You may refer to answers to prior questions. Remember your word limit. **I WILL STOP READING WHEN I REACH THE LIMIT.**

**ALL PEOPLE, WEBSITES, AND EVENTS ARE FICTIONAL, EXCEPT THOSE THAT ARE REAL, BUT EVEN THEN DO NOT LOOK OUTSIDE THE FACT PATTERN GIVEN. DO NOT RELY ON ANY CASES, STATUTES, CLAIMS OR OTHER ARGUMENTS THAT ARE NOT BASED ON ASSIGNED READINGS OR CLASS DISCUSSION – YOU DO NOT NEED TO DO RESEARCH TO COMPLETE THIS EXAM.**

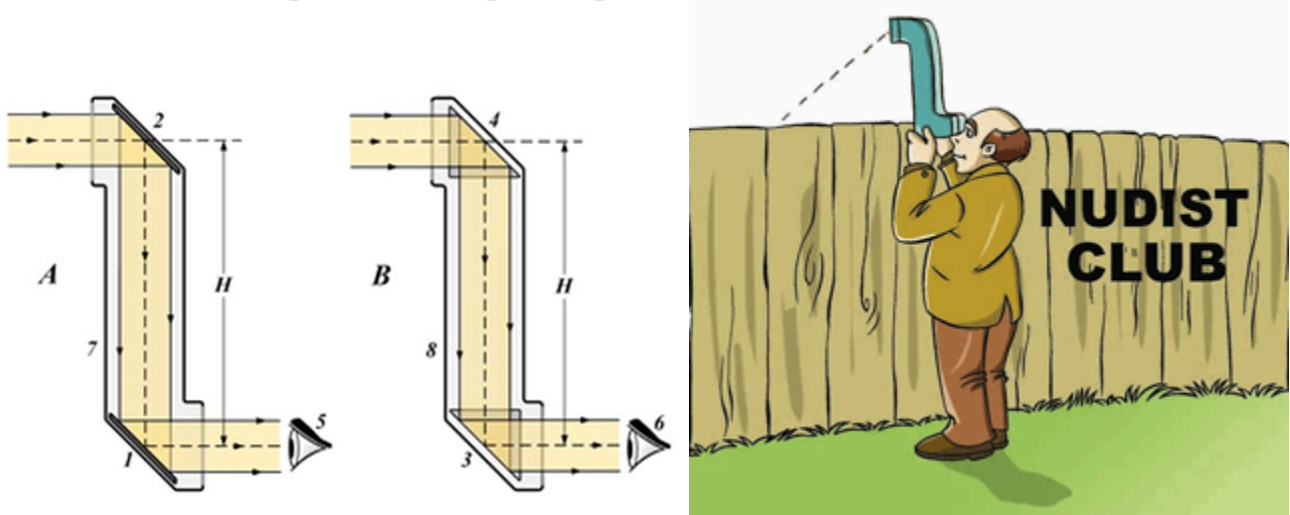
**DO NOT ASSUME THERE IS ANY PRIOR ART OTHER THAN THAT DISCLOSED (IF ANY) IN THIS EXAM.**

**Pat Holder**

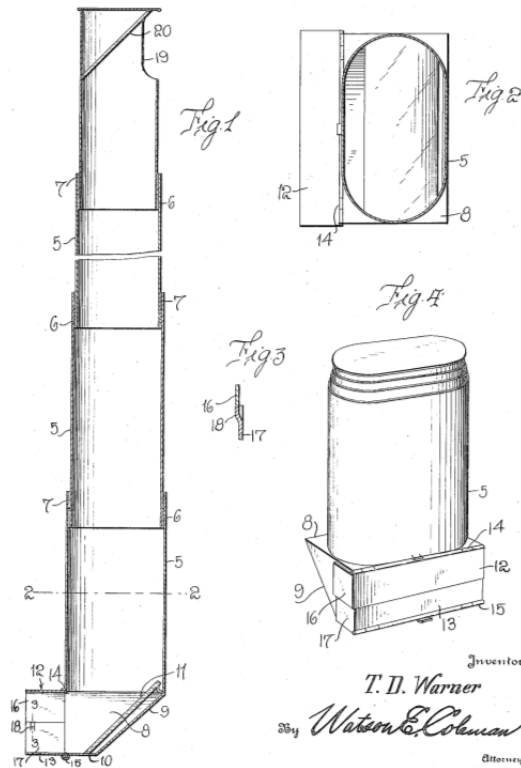
Patent “Pat” Holder is a big fan of live music, and attended many concerts. Lately, Pat has grown tired of taking photographs at such concerts with an iPhone. Most pictures wind up being pictures of the screen display and hand of the person directly in front.



At a concert on February 1, 2012, Pat had a great idea – why not make a “periscope” type of camera lens? After all, periscopes had been used on submarines for years, allowing those underwater to see above water through the reflection of light through a series of mirrors. The basic operation of a periscope is illustrated in the following images.



Patent number 1,300,901, filed on June 10, 1918 and issued on April 15, 1919 claims an expanding/collapsing periscope as shown in the following image.



A periscope would allow the lens of the phone to “extend” above the heads and hands in front, and take unobstructed pictures. Pat even thought that the idea would be useful for short people at sporting events. For example, at some football stadiums, the first row is so low that that the players on the sideline block the view of the field.

Pat went home that night and got to work. Pat was able to relatively easily create mirrored lens that bent the light from the top through to the bottom. The hard part, though, was figuring out how to connect the thing to the iPhone. Not being a materials expert, Pat finally decided to use the age old solution: duct tape. The following is a recent (NOT prior art) image showing a taped lens, though not a periscope lens.



On December 1, 2012, Pat finished a working prototype. It looked like the following:



On January 1, 2013, Pat put the device on a website, for \$49.99. The kit included the periscope lens (one that did not expand and collapse) and a mini-roll of duct tape to tape the lens to a phone. The product was a commercial failure. Only a few were sold, and Pat stopped selling within a few months.

## The Clamp Lens

Meanwhile, back on March 1, 2012, Another Inventor (AI) started selling a device to connect external lenses to camera enabled cell phones. This device uses a clamp to attach the lens to the back of the phone. AI sold both telephoto (zoom) and wide angle lenses on a website. The following image shows AI's clamp attached to a small lens. The clamp lens was also a commercial failure, with virtually no sales.



## The iPeriscope

On March 1, 2013, Competitor Company (CC) started selling iPeriscope for \$39.99. It is a periscope type camera lens that attaches to an iPhone (and only an iPhone, based on the lens size and clamp) using a clamp similar to that of AI. The product was wildly successful.

## The Patent

On March 2, 2013, Pat filed for a patent. Pat included drawings of the mirror assembly (assume it shows a proper periscope) and of the prototype pictured above, and also the specification and claims below, but nothing else:

I have invented a periscope camera lens. The lens is constructed like a traditional periscope, as shown in the drawings. Light enters the front, and is redirected to the camera end of the lens. The preferred embodiment of the invention connects to an Android phone through the use of duct tape, which securely connects the lens to the phone. However, other embodiments might connect to any type of camera (including standard cameras) through any connector that attaches the lens to the camera.

I claim:

1. A lens suitable for imaging, comprising:
  - a. A series of lenses and mirrors sufficient to bend light from an entry lens to an exit lens,
  - b. where such entry and exit lenses are parallel to each other but their center points are at least 4 inches apart
  - c. Means for connecting the lens to a camera
2. A lens suitable for imaging, comprising:
  - a. A series of lenses and mirrors sufficient to bend light from an entry lens to an exit lens,
  - b. where such entry and exit lenses are parallel to each other but their center points are at least 4 inches apart
  - c. A connector for connecting the lens to a camera

The '123 patent issued to Pat Holder without comment from the examiner on March 2, 2015.

On April 1, 2015, Pat sues CC for infringement based on the sales of iPeriscope.

### QUESTIONS:

Q1: In three sentences or less, describe whether the makers of duct tape could be liable for contributory or induced infringement, and why. (6 points)

Q2: You are counsel for Pat Holder. Please draft a memo describing the challenges to the validity of the '123 Patent that Holder might see, and the responses Holder has to such challenges. (57 points)

Q3: You are counsel for CC. Please draft a memo describing what claims of *direct* infringement that CC might see, and the responses CC has to such claims. Be sure to address any non-infringement and unenforceability related defenses CC might make. (27 points)

Q4: Assume for a moment that Pat filed on April 1, 2013, after the AIA first-to-file provisions were in effect. In 6 sentences or less, describe whether (and how, if appropriate) Pat's Jan. 1, 2013 offer for sale (assume it is public) bears any relevance to the prior art analysis that it did not have under the old system. You do not need to worry about transition issues; you can assume all actions and all prior art are governed by the AIA. (10 points)