

Question 1:

The duct tape makers should not be able to be found liable for inducement (“whoever actively induces infringement of a patent shall be liable as an infringer,” §271), as inducement under *GlobalTech* requires knowledge of the patent’s existence or at least the duct tape makers’ willful blindness to the possibility that the induced acts constituted infringement (which requires the defendant must subjectively believe that there is a high probability that the fact that the ‘123 patent exists AND the duct tape makers must take deliberate action to avoid learning that fact); there is no indication that the duct tape makers would either know of the ‘123 patent, nor would they meet either factor for the willful blindness standard, which is almost impossible to prove anyway.

As to contributory infringement, the §271(c) standard requires that the duct tape makers would have to know that the duct tape they are selling or making was especially made or especially adapted for use in an infringement of the ‘123 patent, and not a staple article or commodity of commerce suitable for substantial non-infringing use; this is ludicrous as duct tape is easily suitable for other non-infringing uses (although *CR Bard* case indicates that’s a jury question) and was not especially made or adapted to infringe the ‘123 patent. Furthermore, under *Aro*, the duct tape makers would need to both know of the patent and of the infringing activity; it’s unlikely that both of these factors exist since there is no indication of notice or that the product embodying ‘123 was marked.

Question 2:

§101: Patentable subject matter

It is unlikely that Pat's patent is invalid for being unpatentable subject matter. Under §101, patentable subject matter includes processes, machines, manufactures, and compositions of matter (and improvements to these), into which Pat's lens device easily falls. He is not attempting to patent Bilski's "abstract ideas" exception to acceptable subject matter, nor is he patenting merely the laws of nature (which reflection of light would be, but he goes further) or physical phenomena, which are forbidden from patenting under Chakrabarty.

Under Prometheus, however, perhaps the bending of light is potentially a natural phenomenon. Pat can get around this by arguing that he added an application of the phenomenon, an inventive step or an unconventional activity (using lenses and mirrors to harness this phenomenon in a periscope) past what would be conventional, but he might run into trouble later on with the existence of the older periscope patent for submarines. That application of bending light using mirrors and lenses might be seen as conventional with that old patent; however, this is unlikely to be addressed under 101, as §103 obviousness is more likely to be applicable. Pat's patent is likely patentable subject matter.

§102: Novelty/Statutory bars

*Novelty analysis requires an establishment of the date of invention. While Pat conceived of the invention on February 1, 2012, the likely date of invention is probably December 1, 2012 based on reduction to practice (RTP). However, to the USPTO, the

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date of invention looks more like the filing date (March 2, 2013), as the filing date is the constructive RTP.

If Pat wants to secure the RTP date above as invention date (likely, as he'll want to show this with CC's March 1, 2013 sell time), however, Barbacid requires he have an authenticated document or a corroborating third party to establish RTP. Furthermore, if Pat wants the date of conception to be his invention date (considering the date AI began to sell), he will need the above corroborated evidence with the addition of showing he worked with reasonable diligence from just before the date the second party (AI) conceived through his RTP date (assuming he needs to do so if there is an issue with validity or enforceability against AI). Ultimately, these earlier dates depend on the evidence Pat offers.

102(a)

Under 102(a), Pat's patent can be rendered invalid if it was known by others or used in the U.S., or patented or described in a printed publication anywhere prior to the invention date. Anticipation under 102(a) requires that something be both a prior art reference and have every element of the claim in question (Robertson case).

First, what is the prior art? This depends on which date of invention is used for Pat's '123 patent and what evidence is available to corroborate earlier invention dates. Then the prior art reference and Pat's patent would have to be analyzed under the "all-elements" rule. The easiest piece of prior art to establish as such would be the '901 patent which issued in 1919 (which is well before any of the dates Pat could establish as his invention date, including the Feb. 1, 2012 conception date). This easily is prior art, but fails the "all-elements" rule if Pat's claims are examined in relation to '901. The

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periscope in '901 neither expressly nor inherently contains all elements of either claim 1 or claim 2, since it lacks either a means for connecting the lens to a camera or a connector for connecting the lens to a camera.

If Pat's RTP date is the date of invention, then AI's product might also represent prior art that needs to be addressed. AI's clamp, however, would fail the all-elements rule for both claim 1 and claim 2, as it does not have the "lens" portion of either claim, even if it satisfies the connecting means or connector portion.

If all Pat can show is the March 2, 2013 date for invention as constructive RTP, then the iPeriscope becomes prior art. As such, it does technically have all of the elements of both claims, either inherently or expressly. There are the series of lenses and mirrors, the parallel lenses as in a periscope, and the means for connecting/connector. The clamp in the iPeriscope is necessarily a means for connecting or a connector. Pat's opposition could argue that this meant every limitation or element was present in the CC device.

****Known or Used in the U.S.****

Since both the '901 device and the AI product fail to meet the all-elements rule for anticipation, only the CC device needs to be analyzed under the "known or used in the US" provision of 102(a). Prior knowledge is "that which is reasonably accessible to the public," which is not satisfied by knowledge of a single person or only a few persons working together (needs to be known or disclosed to OTHERS, under National Tractor Pullers). If the selling of the CC device occurred the day before the established invention date, then Pat would have an issue under 102(a) IF THE SELLING OCCURRED IN

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THE UNITED STATES, as it would be publicly known at that point. Pat would not, however, have an issue if the selling occurred outside the United States.

This would also apply as well to the public use portion of 102(a). Rosaire established that “nonsecret use of a claimed process in the usual course of producing articles for commercial purposes is a public use.” However, this must still be in the US, and if it isn’t, Pat’s claims are safe. If the selling translated into public use on March 1, 2013, then his patent may be invalid under 102(a).

Patented or Described in Printed Publication Anywhere

If an applicant’s invention was patented or in a printed publication anywhere in the world prior to the invention date, then it’s invalid. Again, only CC’s device is worth analyzing (see above analysis of all-elements rule) if the date of invention is established as March 2, 2013. Patented includes most utility patents, every US patent, and foreign patents only for what is patented (i.e. CLAIMED, not what’s in specification, per Reeves) and for what is indexed and publicly available. This would only describe the CC device if it was patented, which is most likely the case, but if it is not, Pat’s patent would be safe. It wouldn’t matter what country the CC patent came from under this, if it existed, however.

As to printed publications anywhere in the world, this would occur if CC offered advertisement prior to March 2, 2013 as the invention date (like in Jockmus, as this is a physical thing that doesn’t need detailed instructions for enablement). The publication would need to be sufficiently publicly accessible under Klopfenstein, and could occur with indexing and distribution (but those aren’t the only factors to consider, as it doesn’t matter how it gets to the public). No indication is given, however, that CC offered a

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printed publication or advertisement. Pat's patent is likely valid under 102(a) regarding patent or printed publication.

102(b)

Under 102(b), Pat's patent would be invalid if his invention was patented or described in a printed publication anywhere, or in public use or on sale in the US, more than one year prior to filing for the patent. As above, the CC device was only sold one day before Pat's filing, and it's only speculation as to any patents or publications from CC regarding its device. There are no patents satisfying the all-elements rule or publications doing the same 1 year prior to the filing date.

Pat would not invalidate his own patent based on the statutory bar nature of 102(b). Pat offered his invention for sale (on sale) on Jan. 1, 2013, only two months before he filed for a patent (and well after his critical date of Mar 2, 2012). Pat's patent is presumably valid under 102(b).

102(c)

Pat's patent is fine under 102(c) as he didn't expressly abandon his invention to the public, nor did he practice the invention as a trade secret for less than one year and then file.

102(e)

Pat's patent would be invalid if every element of the claim was included in a patent or printed published application in the US or in a PCT application in English before Pat's date of invention. This again only applies to the CC device if the date of invention is the latest one as shown above, and only if CC applied for a patent or received one on that device prior to that latest date for Pat's invention date (since CC's patent or

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printed publication of the application would be backdated to the filing date...hence, secret prior art). No evidence suggests that CC applied for that patent or got one in any country (in English) prior to the date of invention. Pat's patent is likely valid under 102(e).

102(f)

Pat would not have a valid patent if he derived his idea from another. Pat did not get help from another (which alone does not constitute derivation), and there was nothing even close to getting help that encompassed the entire plan of the improvement or was fully enabling in any of the three proposed prior art examples (unless the CC device was early enough to provide that all-encompassing improvement help with enablement, which seems highly unlikely). Pat has a valid patent (for both claims) under 102(f) in all likelihood.

102(g)

102(g)(1) only applies in interferences, which is not at issue here, as there are no overlapping claims (no other patent involved here except Pat's). As to 102(g)(2), Pat's patent is invalid if his invention was made in the US by another inventor who had not abandoned, suppressed, or concealed (ASC) it before Pat's date of invention. As per the all-elements rule, only CC's device would pass muster to get to this test. This would come down to whether CC had made the device in the US and if CC abandoned, suppressed, or concealed its device prior to the latest possible date of Pat's invention (March 2, 2013). If CC did make in the US and did not ASC, and the date of invention could only be established as Pat's latest date above, then Pat's patent would be likely invalid.

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If CC made in the US and DID ASC, then Pat's patent would be safe. If CC made outside the US, then Pat's patent is safe. However, there is no indication as to where CC made the invention, nor is there any evidence suggesting ASC, so it is difficult to speculate as to the safety of Pat's patent.

§103: Obviousness

Pat does not have a valid patent if the differences between his patented subject matter and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was MADE to a PHOSITA. This focuses on technical triviality, and not economic triviality. The test for obviousness is encompassed by the Graham case, which is as follows: 1) determine the scope and content of the prior art; 2) ascertain the differences between the prior art and the claims at issue; 3) find the level of ordinary skill in the art (as per Winslow, the PHOSITA knows all the pertinent art); 4) determine the obviousness or nonobviousness of the subject matter; and 5) look at secondary considerations.

The possible prior art includes the '901 patent, the AI clamp, and the CC device (depending upon the date of invention as discussed above under Novelty/Statutory bars). Most if not all art that can be declared as 102 prior art qualifies for 103 obviousness analysis (see Hazeltine, Bass, OddzOn, Foster), and as long as one of the 102 sections is satisfied, it's 102 prior art (regardless of whether the all-elements rule or anticipation is satisfied).

After this, Pat must make sure the prior art is pertinent. Pertinence under Clay requires that the prior art be from the same field of endeavor, regardless of the problem addressed, OR if the reference is not within the field of the inventor's endeavor, the

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reference is reasonably pertinent to the particular problem with which the inventor is involved. The '901 patent and the '123 patent are both from the same field of "seeing above a certain level without obstruction." The AI clamp comes from the same field of endeavor in connecting external lenses to camera-enabled cell phones. The CC device a periscope type lens that connects to a phone camera, so it's from the same field of endeavor like each above.

As to step 2, there are several differences notable. The '901 patent lacks a connection means/connector as mentioned above. The AI clamp lacks the periscope lens as mentioned before, and the CC device has barely any differences at all from the claims of the '123 patent (though it's notable that it's only for the iPhone).

Ordinary skill in the art would probably encompass anyone familiar with constructing periscopic lenses for use and connection in different applications and devices, but they would have knowledge of all pertinent prior art (if the above pieces of art indeed qualify as 102 prior art).

As to Step 4 of the obviousness analysis, Pat's '123 patent is most likely obvious if each of the discussed art qualifies as prior art under 102. Under KSR, the periscope and the AI clamp for holding a lens to a camera enabled cell phone, along with the CC device would lead to an obvious combination that yields predictable results. The PHOSITA would have ordinary creativity and would be able to combine these elements. Pat could attempt to rebut by saying that the duct tape he used was unobvious compared to the clamps used, but that might be rebutted by the opposition using a doctrine of equivalents argument between the duct tape and the clamp element.

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The secondary factors do not seem to apply to rebut the '123 patent's obviousness. The facts as presented do not indicate Pat's invention showed a failure of others, a long-felt but unsolved need, or unexpected results under Adams. However, even though there was wild success for CC's device, there's no indication that it was from the device itself, as it could have been the marketing, and this shouldn't weigh in on Pat's invention's obviousness.

§112

Utility

Pat's periscope camera lens meets the standards for utility. It has operable utility, as in it works and a PHOSITA would believe it does not suggest an inherently unbelievable undertaking. It has practical utility, encompassing both specific and substantial utility (extends above heads and hands for unobstructed pictures), and a beneficial utility; it is not frivolous, injurious, or immoral (even though beneficial utility is barely hanging on in use by the courts).

Enablement

Pat's claim is valid under enablement if a PHOSITA could make and use the invention without undue experimentation. Pat's claims are likely valid for enablement as the PHOSITA could follow Pat's specification and easily use either duct tape or another connector/connection means (this is a PHOSITA with ordinary creativity) to apply the device. If Pat could apply the device using duct tape, the PHOSITA would presumably be able to use other means to do so as well.

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Pat's claims are not invalid if the PHOSITA would subjectively believe Pat possessed the invention at the time of filing. It is unclear if Pat truly possessed "any connector" prior to the CC device on sale (see analysis above), as this might be similar to Gentry Gallery in that he included "any connector" to pre-empt some of the prior art. However, it is likely that since it's his original disclosure, there would be no reason for the PHOSITA to believe he didn't have possession of what he claimed based on the specification/claims (for either claim, though the PHOSITA might find it odd that duct tape was the preferred embodiment and no other drawings for other connector embodiments were present).

Definiteness

Pat's claims are definite if they particularly point out and distinctly claim the subject matter which Pat regards as his invention. To be indefinite, Pat's claims must be insolubly ambiguous to a PHOSITA in light of the specification.

An issue arises for Pat in that he uses means plus function language in claim 1. This means he only would get the disclosed structure (duct tape), and its equivalents for claim 1. However, this is likely resolved due to his including Claim 2 and the rest of the specification including other connectors as embodiments. The PHOSITA should not have issues construing the claims in light of the specification and drawings, as the PHOSITA's ordinary creativity should lead it to finding other connectors. Pat's claims are likely definite.

Question 3:

Direct Infringement

This would probably only apply if CC is not prior art per the analysis above.

Literal Infringement

CC infringes Pat's claims if every element in the claims (as construed under Markman) is found in CC's accused device. Each claim must be analyzed separately. As to Claim 1, CC likely does not infringe since Claim 1 is a means plus function claim, limited to cover only the connection means disclosed in the spec (duct tape) and its equivalents. Pat could say that the clamp in CC's device is an equivalent to duct tape, but CC could argue back that the clamp does not perform substantially the same function in the same way with the same result as per Winans.

As to Claim 2, CC's device likely infringes. Since the specification includes "any connector that attaches the lens to the camera" and the clamp in CC's device would fit that description, infringement is likely. The rest of CC's device, the periscopic camera lens, reads on Claim 2 for sure. Every element is essentially present. CC is unlikely to find another argument around this unless it can prove it was prior art to Pat's patent (in which case, Pat's patent would be invalid).

Doctrine of Equivalents

Since Claim 2 is likely infringed literally, CC's device could perhaps infringe Claim 1 under the DOE. Pat will say that the clamp infringes as an equivalent to his claim 1's "connection means," but this is questionable based on what the court allows as the equivalents to the specification's mean under literal infringement analysis. Pat would

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argue for this second round of determining equivalents, however. See literal infringement equivalent analysis above for how CC would respond.

If Pat argued that his invention was “pioneering,” and subject to a broad scope for means-function claim analysis as per Wright, CC could likely counter by saying this is anything but pioneering (periscopes and lens connectors existed before). Even so, a clamp versus duct tape is more similar than a human versus pulley ropes, so Pat could still prevail if successful on his pioneering argument.

Defenses

Prosecution History Estoppel

There is likely nothing here that CC could argue, as Pat did not relinquish subject matter during prosecution (no narrowing of claims nor amending them during prosecution). This would preclude CC from limiting Pat’s claims or applying the three-part test for prosecution history estoppel.

Inequitable Conduct

CC may be able to present an inequitable conduct defense against Pat, thereby negating any infringement claims and rendering Pat’s entire patent unenforceable as per Therasense. CC must prove that Pat had a specific intent to deceive by deliberately decided to withhold a KNOWN MATERIAL REFERENCE (or Pat’s willful blindness, a hard standard, of something known to be material). To show materiality, CC would have to point out that but for the action of Pat, he would not have gotten an issued claim.

This will be tough for CC to prove, as it must show both specific intent (or willful blindness) and materiality on Pat’s part. It appears that Pat failed to disclose any prior art, including the three mentioned (if each is presumed to be prior art). If his intent to do

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so can be proven, and each was material (which is likely), then CC might succeed. If, on the other hand, Pat was unaware of the duty to disclose, or did not know of the other art, then CC would not be able to prove specific intent and would lose on this defense. It is unlikely that Pat would have known about CC's device (if it is indeed prior art) as it might only have become prior art the day before filing.

If the art pieces mentioned above would qualify as prior art, it is likely that they were material. Pat would likely not have received a patent upon disclosure. But this is irrelevant without a showing of specific intent, which is hard for CC to show.

Invalidity

See Question 2 for this analysis (especially 102(g) and 103).

Question 4:

The prior sale by Pat was within 1 year of the effective filing date, so that is not at issue; nor is the requirement that the disclosure be by the inventor or joint inventor (as Pat did this himself). As this is public, this therefore changes the prior art analysis by negating the CC sales of its product; they would definitively no longer qualify as prior art under this analysis because they occurred after the original disclosure by Pat. Furthermore, as the AIA eliminates interferences, Pat's public disclosure beats CC's public disclosure and gets the patent, even if CC had invented first (doesn't matter anymore).

However, the public sale by Pat may still not overcome 103 obviousness analysis; the combination of the AI clamp sale (even with its low number of sales on a website, which is assumed to be public as it is public for Pat's device) with the '901 patent (public disclosure as well) could still very well negate Pat's claim for at least claim 2, which would need to be narrowed to avoid the clamp prior art of AI combined with the '901 patent. Pat's invention is probably still invalid even with the sale under 103 due to obviousness.