

QUESTION ONE

Utility

Under Section 101, an invention must be “useful”.

For operable utility, the invention must work; operability is presumed unless PHOSITA would believe that it is an inherently unbelievable undertaking. Here, operable utility is met. Unlike a fanciful idea like a perpetual motion machine; a PHOSITA would have no problem believing that such a contraption detailed in claims one and two could work as an additive holder.

For Moral/beneficial utility, both claims are beneficial because they let people carry additives and water in the same storage container (no more fumbling!) and it keeps fresh fruit longer. Although the device doesn't keep fruit fresh for long periods, and it wasn't a commercial success, that is fine – *Lowell* holds that an invention doesn't have to be the best out there, it just needs to not be frivolous or immoral. (though status of morality unclear post *juicy whip*).

For practical utility, there must be a specific and substantial benefit. For specific utility, both claims have a well defined and particular benefit to the public – they allow people to easily store food in their water bottle. *In re Fisher*. Additionally, both claims have substantial utility because the use is significant and presently available to the public – the invention can be used now by the public, as opposed to only being useful for further research. Notably, the method claim is useful because the end result (a liquid and food stored in the same container) is useful.

Enablement

Section 112 requires that the specification enable a PHOSITA to make and use invention. An invention is not enabled if a PHOSITA would be required to engage in undue experimentation in order to

make and use the invention (we look to see if can teach to make and use every substantiation of invention, not just preferred embodiment). *Incandescent Lamp*.

For Claim one, Pat has not described how to build an insert that fits within the opening of the vessel, or how to structure a cap so that it fits over both the insert and the cap. He provides a drawing, but the drawing again does not explain how the insert is sized to fit inside the bottle – there are no steps saying take measurements and then do x, y, and z. Also, no insert material disclosed. There is an argument that a PHOSITA would have to engage in undue experimentation (measuring the insert and figuring out the right insert material many times) until they found an insert and cap that fit into and over a bottle. Also, the drawing shows an insert placed into traditional screw top water bottle but there are other types of “vessels for liquid” and Pat hasn’t disclosed how to fit an insert into them. However, Pat can argue that gap filling is allowed for enablement and he doesn’t need to teach every nut and bolt. A phosita, who has ordinary skill in the art of container/bottle making, would be able to look at the specification drawing and ascertain how to measure and cut the insert to fit inside the bottle using known mathematical formulas. Also, container making is a very predictable art, so PHOSITAs can use the same measurement formulas they always have on whatever type bottle they have. Thus, Pat will argue that his drawing in the specification and preferred embodiment may only show the insert in a typical water bottle, but it would not take undue experimentation to make and use other substantiations of the invention (such as in the type of beverage container made by Novelty Brands (NB)). However, I think the complete lack of any disclosure on how to actually measure the insert so that it ‘fits within but doesn’t fall’ will weigh against enablement.

For Claim 2 (method claim), Pat seems to have enabled a PHOSITA to use this method. He mentions in the specification how you can add fruit or powder to the insert. It would not take undue experimentation for a PHOSITA to place fruit, powder, or another edible into the insert and placing the top on it. However, *in re wands* shows you need to enable the invention by showing how to access

starting materials if not known to PHOSITA. Here, the starting material is the insert. Pat will claim that a PHOSITA would know how to obtain this insert on the open market, or he will argue that his specification enables the PHOSITA to make the insert. However, if his first claim (the insert itself) fails for lack of enablement, then his second method claim will necessarily fail for lack of enablement because Pat has clearly not enabled the insert – aka the ‘starting material’.

Written Description

Under Section 112, the specification must clearly allow persons of ordinary skill in the art to recognize that the inventor possessed what is claimed as of the filing date. The test is subjective and looks from the perspective of a PHOSITA. *Gentry Gallery*. It seems clear that a PHOSITA would recognize that Pat was in possession of the first narrow claim, which is a vessel for liquid, an insert fitting within the opening of vessel but not falling within it, and a cap placed on top. Although his preferred embodiment is a water bottle, it seems obvious that he contemplated other types of bottles could be used. Thus, claim1 meets WD.

However, he may face a written description challenge for claim two, which is a method of placing liquid in a bottle, placing a solid edible in an insert sized to fit within the opening, and placing a cap on the vessel. Here, similar to *Ariad*, this may fail written description because while Pat disclosed putting additives and fruit into the insert, he has claimed all solid edibles, which is much broader. However, pat will argue that he did possess the idea of all solid edibles or else he wouldn’t have added it to the claim in the first place. Furthermore, he will argue that claiming this broad genus is fine because there is a common thread – they are all edible.

Definiteness

Under 112, definiteness is required. A patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with

reasonable certainty, those skilled in the art about the scope of the invention. *Nautilus (rejects insolubly ambiguous test)*.

Here, there is a weak argument the term “sized to fit within the opening of the vessel, but not fall within it” is indefinite because a PHOSITA doesn’t know what size the insert should be. However, similar to *Orthokinetics*, the term here is as accurate as the subject matter permits (because there are different size bottles just like different sized cars). Thus, a PHOSITA might not know the size, but they know exactly what is claimed based on reading the specification. Thus, both claims seem to be definite.

Section 102 – Novelty and Statutory Bars

1. Date of Invention – Critical Date for Novelty

For novelty, the critical date is the ‘date of invention’. The date of invention occurs when there is a reduction to practice (RTP). Actual RTP occurs when the inventor has 1) practiced the embodiment of the invention encompassing all elements and 2) appreciated that the device worked for its intended purpose. Evidence of actual RTP must be corroborated; if not (or if the inventor does not achieve actual RTP), the RTP will be the filing date for the patent (constructive RTP). *Barbarcid*.

Here, Pat’s conception of the invention appears to be on January 1st, 2008. Pat’s actual RTP (the critical date) is June 1st, 2008, after he finishes his prototype. The prototype has all the elements (bottle, insert, and cap) and Pat appreciated that it worked for its intended purpose of holding fruit and water in one container. He will hopefully be able to corroborate the date of his actual RTP with the stranger’s testimony (assuming showed it to them near same time). If Pat’s actual RTP could not be corroborated, then the constructive RTP would be the date of filing, January 1, 2010.

Novelty Brand’s conception of Snackeez is May 1, 2008. Its actual RTP occurred on July 1, 2009, when prototype build. Its filing date is September, 1, 2009.

a. 102(a)

The '123 patent will be challenged for lack of novelty. Under 102(a), an invention is not novel if, before the date of the invention, 1) the invention was known or used by others in this country, or 2) patented or described in a printed publication anywhere. In order for prior art to anticipate the invention (and render non-novel), it must meet the all elements rule (every element of the claimed invention must be disclosed by a single reference either expressly or inherently), and it must be enabling (enable to make, not necessarily to use). *Robertson; In Re Halfner*.

Here, we must look and see if anything before Pat's critical invention date of June 1st, 2008 qualifies as anticipatory prior art.

Here, the Dannon's sale of yogurt in England does not constitute prior art. Although it may have been known and used in England at that time, it must be known and used by others in the U.S. to qualify as prior art under 102(a).

Furthermore, conception and development of Snackeez (from the period of May 1st 2008 until Pat's critical date of June 1st 2008) does not constitute publically known to others because it wasn't reasonably accessible to public. *National Tractor Pullers*. Thus, this is not prior art under 102(a).

The May 1st, 2008 Dannon advertisements in U.S. constitute printed publications. To qualify as a printed publication, it must be reasonably accessible to the public. *In re Klopfenstein*. Here, the ad seems to be widely disseminated and accessible to the public so it's a PP. However, this prior art does not anticipate Pat's invention because it does not contain all the elements in claim one or claim 2. Although they have the cap that fits over the insert and the vessel, the Dannon ads (assuming it's a pic of the yogurt) don't have the vessel for liquid element – they have a vessel for yogurt. Additionally, they

don't have the "insert sized to fit within the opening of the vessel" element; instead, Dannon's container clearly rests on top of the opening – not within the opening.

b. 102(e)

Under 102e, an invention is not novel if the invention was described...in U.S. patent. Under 102e, these published patents/apps backdate to the time of filing. Although the Snackeez patent will backdate to September 1, 2009 (its filing date), this date is still after Pat's critical invention date of June 1st, 2008, so it won't become 102(e) prior art (even though definitely would be anticipatory if it did)

c. 102(f)

There does not seem to be any derivation problem here because Pat seemed to have independently created the idea, even though it's a very obvious idea.

d. 102(g)

102(g)(1) does not apply because the PTO has not declared an interference proceeding. Under 102(g)(2), an invention is not novel (and thus patent not granted) if before such person's invention thereof, the invention was made in this country by another who had not abandoned suppressed or concealed it. Usually the first to RTP wins. However, the first to conceive and last to reduce will win if they can show unbroken diligence from the other person's conception until their own reduction to practice (either constructive or actual). Here, Pat reduced to practice on June 1st, 2008, which was before Snackeez's RTP on July 1st, 2009. Furthermore, Pat conceived on January 1, 2008, which is before Snackeez's conception on May 1st, 2008. Because Pat was the first to RTP, he wins (his invention is considered to have been made before Snackeez). Also, Novelty Brands (NB) can't argue that it was diligent in bringing Snackeez to market because it conceived later than Pat – that argument only applies if NB conceived first and reduced later.

However, this analysis might change if Pat can't prove his conception date with corroborating evidence, which means that the conception date would fold into his reduction date. In that case, Pat would have RTP earlier than NB's RTP, but NB would have conceived earlier than Pat's new conception date of June 1st, 2008. In this case, if NB can show that it was diligent from June 1st 2008 (pat's conception date) until July 2009 (its own RTP), then it will render Pat's invention non-novel unless it was concealed suppressed or abandoned (this looks at the time after reduction to practice and before you file patent or make accessible to the public).

Pat does not need to worry about Dannon's conception or RTP because the invention was presumably made in England, not in the United States.

2. Filing Date minus 12 months– Critical Date for Statutory Bars

Here, Pat's filing date is January 1st, 2010. Thus, his critical date will be January 1st, 2009. Anything before that may bar him if it has all elements. Anything in between January 1st 2009 and January 1st 2010 will be in the grace period and will not bar him.

a. 102(B)

Section 102(b) denies patent protection, if more than one year prior to the application, the invention was 1) patented or described in a printed publication in this or a foreign country or 2) in public use or on sale in this country.

Dannon sale in Europe and u.s. ads were already analyzed in novelty. The Dannon product itself, which hit stores February 1st 2009, will not be prior art under this section. Although it was in public use in the U.S. at that time, it happened during the "grace period" – aka it happened after his critical bar date of January 1st, 2009.

Under the on-sale bar, Dannon's preorders in the U.S. count because, before January 1st, 2010, there was a 1) commercial offer for sale, and 2) the Dannon product was read for patenting. However, as stated before, they do not have all the elements of Pat's patent so he won't be barred under this.

Furthermore, NB's patent for snackeez will not bar him under 102(b) because the filing date is September 1st, 2009, which is during Pat's one year grace period.

However, there is an argument that Pat has barred himself under 102(b). Under 102(b), public use = non secret use (*Rosaire; eggbert v lipman*). Here, the facts indicate that before January 1st, 2009, Pat was using his invention, had let his friends see him use it, and had shown them how it works. There is an argument that the invention was no longer secret (and thus constitutes public use) because he let people see the device – there was no implicit confidentiality agreement because here they were strangers instead of coworkers or friends. (*beachcombers/eggbert*). However, Pat can argue that this is like *Moleculon* - Although he let people see it, he retained control over the device at all times and did not let people use it – there was no passing around of the invention like in beachcomber.

Section 103 – Obviousness

Pat's claims are likely invalid for obviousness. Under 103, a person is not entitled to a patent if a PHOSITA would consider the subject matter as a whole obvious at the time of invention. The phosita is deemed to know all of the pertinent prior art. *Winslow*. The five factor graham test requires that the court: 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 skill of the PHOSITA; 4) determine the obviousness or non obviousness; and 5) apply secondary conditions/indicia as may be relevant. An obviousness analysis only looks at pertinent prior art; Clay holds that prior art is pertinent if it is from the same field of endeavor, regardless of the problem addressed, OR if the reference is still reasonably pertinent to the particular problem with which the inventor was faced. Here, the potential prior art is the traditional

water bottle (sorry I am assuming that this must qualify as prior art even though not explicitly mentioned) and the Dannon yogurt printed publication. Although the Dannon ad is arguably not in the same field of art because it deals with yogurt storage and not liquid storage, it definitely addresses the same problem of easily affixing additives to food/water so it qualifies as pertinent art. Looking at the differences between the invention and the prior, we see that the traditional water bottle has no insert, and the Dannon has an insert but it is placed on top of the container, not within the container. The Phosita's skill is that of an average bottlemaker (probably). Here, similar to *Graham*, all Pat has done is shift the position of the insert from on top of the container to the inside of the container – this is not a non-obvious difference. Also, the PHOSITA has ordinary creativity and is not an automaton; faced with the same problem (of fumbling around for water additives) and looking at the prior art, it requires no leap of ingenuity to combine the elements of the Dannon cup with that of the traditional water bottle. *KSR*. However, Pat can try to argue that the shifting of the insert to inside the container was not obvious to *try*. He will say, similar to *Adams*, his shifting of the insert to the inside of the container created wholly unexpected benefits, such as the increased longevity of fruit. He can also argue that secondary considerations weigh in his favor, such that there has been a long felt but unmet need in the industry. However, because the slight shifting of the insert container seems trivial, Pat's claims will most likely be invalid for obviousness.

Subject Matter

Section 101 has been interpreted to prohibit patent protection for laws of nature, physical phenomena, and abstract ideas. *Chakrabarty; Bilski*. Claim 1 of Pat's patent involves a "machine" (the building of an insert itself), and does not deal with an abstract idea or law of nature. However, claim 2 will likely be invalidated because it is an abstract idea instead of a physical apparatus, and it has not been implemented in a non-conventional way. *Alice*. For the 2nd claim, there literally seems to be no

“inventive” concept/apparatus placed over and above the abstract idea (the abstract idea is the method of placing an edible food into an insert).

QUESTION 2

Pat will argue that Snackeez literally infringes claims 1 and 2 of the ‘123 patent under 271(a). Literal infringement requires that all elements in the claim be found in the accused infringer’s product. First, you must construe the claims as a matter of law. *Merrill*. When claim language is ambiguous, you look to the patent claims and specification, then to the patent prosecution history, and then if the claim is still ambiguous you can look to extrinsic evidence. *Phillips*.

Claim one of Pat’s patent includes the following elements: a vessel for liquid, an insert sized to fit within the opening but not fall within it, and a cap that covers both the vessel and the insert. Here, NB can argue that the first element is not met because “vessel” only contemplates bottles and doesn’t encompass NB’s cup, as contemplated by the preamble. However, Pat will argue that language in the preamble is not read as a claim limitation unless the claim relies on and derives meaning from it, which it doesn’t here (not like interactive system comprising golf ball hypo).

NB can argue that the second element is not present in Snackeez because its insert is not located ‘within the vessel’ as the plain language of claim two requires – instead a large portion of its insert remains outside on the lip of the cup. In Response, Pat will argue that for the second element, an “insert sized to fit within the opening” necessarily means that part of it will remain on the lip. He will also say that the plain language of the claim does not contemplate that *all* of the insert must fit within the opening. He would point to the specification drawing where it seems like a little bit of the insert is on the lip. Also, he will argue that the PHOSITA would recognize that the ordinary meaning of sized to fit within the opening does not mean that the whole insert must fit in the opening.

NB can argue that the third element is not present in Snackeez because its cap only covers the insert itself (the cap and insert can be removed together) – it does not cover both the insert AND the vessel as the third element requires. To support its argument, it can look to the claim differentiation of claims one and two – claim two only requires the cap to be on the vessel, while claim 1 requires it to be on both the insert and vessel, so they must be given separate and distinct meanings. It could also make the more strained argument that a “cap” is not the same as the “lid” that it has on its product. For the third element of claim one, Pat will argue that a PHOSITA would understand “cap” to include any covering (including a lid). He would argue that you shouldn’t read limitations into the claim from the specification; although the drawing was of a traditional screw on water bottle cap, other types of ‘caps’ can be used, such as a sealable cap like Snackeez’s covering. *Phillips*. In regards to the cap covering both the lid and the vessel, if the court fails to find literal infringement Pat will argue that the doctrine of equivalents satisfies the third element because Snackeez’s cap performs substantially the same function, the same way, for the same result. *Warner Jenkinson* However, NB can use Pat’s own specification against him and say that it is not the same result because Pat’s invention keeps fruit fresher because the vessel and insert can be sealed with the cap, which NB’s cap does not do. Additionally, NB can argue that it is not the same function because NB’s cap just keeps the snacks from falling out while Pat’s prevents liquid and additive from falling out. However, it does seem that Snackeez has all the elements (inherently and through DOE) of claim one, and is thus infringing.

For the second method claim, the above arguments can be used for the first two elements. The third element is placing a cap on the vessel. Here, NB will once again argue that its cap goes on the insert, not the lid. It will argue that even if its product ends up functioning the same way (because its insert acts as a defacto lid), this is an all-elements analysis. Pat will once again argue that NB’s lid satisfied the third element through the DOE. If he succeeds, NB will be infringing on both claims

QUESTION THREE

Pat's contributory infringement claims

Under 271(b), whoever actively induces infringement of a patent shall be liable. The manufacture of the device induces end users to infringe by using it. However, it requires knowledge of patent and that acts of its end users constitute patent infringement (willful blindness also counts as knowledge). Here, NB might know of Pat's patent, but it may think that its product does not contain all the elements of Pats, and thus might not know that its end users are infringing.

Under 271©, whoever offers a component of a patented machine...constituting material part of invention, knowing same to be especially made/adapted for an infringing use, and not a staple article or commodity of commerce capable of substantial noninfringing use shall be liable. If the end users are indeed infringing, NB will be liable if pat can show that they had knowledge of his patent and knowledge of the activity that constitutes infringement (they don't need to know the activity = infringement), and that NB's product is not a staple product capable of non-infringing use. *Aro* However, NB can argue that its product is capable of substantial non-infringing use because the insert can be removed and it can be used as a regular cup. However, Pat can argue that we should focus on the insert itself, which has no substantial non-infringing use (similar to bike/usb hypo).

QUESTION FOUR

Under the AIA, novelty is determined at the date of filing rather than the RTP date. Thus, the NB patent filed on September 1st 2009 would now be considered prior art because it was published in a patent prior to Pat's effective filing date (it would invalidate Pat's patent on novelty grounds because it seems to anticipate). Also, the one year grace period would only save him if he had publically disclosed

his invention before NB's filing (but his disclosure would still have to be after Jan 1st 2009 or else he would bar himself), which here he did not do. Also, European Dannon sales would now be considered as there are no more geographical limitations to known/used. Also, AIA has changed obviousness analysis prior art to include art all the way to filing date, which means the NB patent would now be considered in an obviousness analysis (pat's patent would be found to be obvious based on it).