

Dear current and future patent law students:

It's been six years since I wrote an exam memo in Patent Law. I decided to write one this year for two reasons. First, this was the first exam I've done that included two defendants, and that merits some discussion. Second, I thought that the answers were all really good, but even collectively they left out some important points that I think deserve mention.

This is now the seventh year since we transitioned to AIA primary in this course. In general, the transition is complete. Every student did a good job of identifying and analyzing prior art under AIA principles. And the basic infringement analysis went well, too. Nobody got a C or below. Even the lowest score in the class was very good in what it answered (and had one of the better infringement answers) – it just missed some issues.

That said, there were some bigger things that were missed. Here are some of the bigger items broken down by question, which I include a little for this year's students, but mostly for future students studying from this exam:

#### Question 1.

As noted above- the answers here were generally very good. But there were a couple of points that were missed.

1. Indefiniteness (and claim construction): The ducts are a “means for allowing heat to travel.” How do we interpret means plus function? We look to the structure described (stiff supports) and equivalents. But here's the wrinkle – claim 2 says that the means are stiff supports. Maybe one person commented that something seems wrong with this. They are redundant. Why do we need claim 2 if the means are already defined as stiff supports? And if they aren't redundant, then what comprises the “means” in claim 1? Is it indefinite? Why can't for example, the wires in the electric coil be a stiff support?
2. To mix things up, at the very last minute I threw in the Dec. sale date for the coil gloves and the Nov. use in practice by Pat. Most of you noted that Pat's use may have been public, but it was not really an issue because either (or both): a) experimental use or b) within 1 year of filing. So far, so good. But here is a point that no answer picked up on, even though we did many slides on this (maybe we need more!): Pat **wants** Nov. use to be public, because it is not invalidating, and it puts a stake in the ground that **disqualifies** the coil glove as prior art because it is after Pat's prior public use that came within the grace period. An even more advanced discussion would consider whether the coil gloves are the same subject matter (which is what the statute says) and if not then maybe it's not disqualified (which would be ironic, given that you'd still want to use it for obviousness).

#### Question 2.

Answers were generally very good here. There were a couple of key areas I wish the answers had explored more.

3. Claim construction. There were many, many opportunities for claim construction analysis. I did not expect students to hit all of them, but few hit any of them in any kind of detail. Examples: is a handwarmer required to infringe? It's only in the preamble – is that limiting or not? How many

ducts? One for each finger, or can one big duct suffice? What is inner material? Mitten World is “fingerless” but the pic shows at least some of the fingers covered. Is that enough under the plain language of the claim (“placed around a hand and fingers”)? What’s a support member? This is the one most folks focused on, but few considered what the term actually meant.

4. Infringement difference. I included two defendants to highlight the claim construction issue: is a handwarmer required? And secondarily the inner layer. Most focused on the inner layer, though a couple of exams talked about the handwarmer difference.

Question 3.

Everyone did pretty well on the indirect liability question.

5. My only comment is that a couple people talked about “offer for sale” with contributory infringement. That’s not really a thing. Well, it is because liability comes if one offers something for sale, but it was used more in the Pfaff sense (not ready for patenting because it doesn’t include all components), and that doesn’t work.

Question 4.

The 1952 Act Question was easier than in prior tests (no 102(g)), but answers still missed a few points.

6. Most people flagged that the new date was the invention date, and commented that the Amazon Ad and the Chinese Publication were both before Pat’s RTP.
7. Not many flagged that the coil gloves are no longer on sale because they were within one year of Pat’s filing
8. Nobody flagged that the Amazon Ad is no longer on sale because it was within one year of Pat’s filing
9. Nobody flagged the potential 102(f) derivation issue (Pat saw the Amazon ad). Was it enabling?

To be clear, everyone got a couple of these 1952 Act points. Nobody got most of them all at once, which is why I am flagging here.

None of these were huge points losses, but the overall totals were lower this year than in other years, which means that points were definitely left on the table.

One last point to address – how do you cover all of this given the word limits? Most of you went right to my expanded word limit this year. The answer (for this exam) is to spend way less on statement of rules. Some of you used like half a page or more describing a rule to write one sentence saying how it barely applied. This is just not a good use of your time or word space on this exam. I noted in class that IrAAAAAAAc is what is important, and many exams were IRRRRAAAAC. As I noted in class, I will know if you understand the rule by how you apply it.

I hope that is helpful.