

Patent Law Fall 2007 – Final Exam Memo

To: Patent Law Fall 2007 Students and Future Patent Law Students

From: Professor Risch

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This memo follows the grading (and release of grades) in Patent Law. It is intended to aid current students in understanding their grades, and to aid future students in preparation for class and the final exam in future years. This memo should be read in conjunction with the highest scoring exams, which will be available if the students with those exams permit. I am happy to meet with any of you individually to review your exam.

I was pleased with the performance of all of the students on the exam. This was not an easy class, and it was not an easy exam, but every student showed basic proficiency with the core validity elements. The primary differential in grading on Question 1 was missed issues and depth of analysis. The biggest differential in exam scoring came in Question 2 – there were big differences in the amount of analysis people put into the infringement and equivalents analysis, and few people focused on the contributory infringement issues.

Finally, I wanted to address grading methodology. I graded both for finding an issue and for your handling of the issue. Unless you applied the wrong rule or applied the right rule incorrectly, your conclusions had no effect on your grade. The questions were clear about which types of defenses should be discussed in which section. Some people put the right defenses as answers to the wrong question. I did give you credit for those answers (to the extent they were correct), but I did award fewer organization where this happened.

The following is a discussion of some key points from the exam – the “top and bottom” three. This section is directed primarily at future students to accentuate the point that despite the fact that the sample exams were quite good, there were still many issues in the exam to be found: the highest scoring exam scored 69 points out of a total of 92 available.

Top four: The following are four tricky points that most of the class handled quite well.

1. The notion that a fictional book might not be enabling anticipation;
2. The problem of corroboration in a “lost” television show; and
3. WSI’s prior conception and the 102(g) priority analysis that followed.
4. The discussion of remedies was quite good, especially given that we only spent one day on them.

Improvable four: The following are four points that could have been most improved.

1. Obviousness. Most people applied the Graham test well, but the “scope” portion was not handled well. Most people simply assumed that the “projector” was prior art, but almost no

one rigorously analyzed the potential prior art, and there was a very good argument that no projector prior art (use, sale, manual, patent, patent publication) predated the invention or was one year before the filing date under any 102 subsection. Without the projector the obviousness analysis is a completely different story.

2. Means plus function: Almost no one addressed the means plus function well. In question 1, the issue was whether the specifications statement that “any” force generator will do is sufficient structure to define the means. In question 2, the issue was of claim construction - the claim construction of the “means for...” is the structure plus equivalents and no one pointed that out.
3. Infringement analysis: Everyone in the class did a fair job on the literal infringement of the urban product (that is, comparing the claim to the product. However, on the whole, the infringement analysis could have been better. Few people spent much time on claim construction, even though we spent days on that issue. For example, the “room” preamble had a real effect on the analysis, but few explicitly looked at whether or not “room” should be an explicit limitation – most assumed one way or the other. Also, only half the class (or less) analyzed the differences between the Urban and Jungle products, and what effect that might have on the analysis. (On a side note, many people noted infringement because WSI used the same BPC projector described in the claims. This is a good argument in equivalents, but note that the brand is irrelevant in literal infringement – unless of course the claim requires a brand. In other words, the claims define the invention, and should not be limited to what is in the specification.)
4. Secondary liability: On the whole, the class did a good job flagging and discussing the secondary liability issues in both questions 2 and 3. However, few people clearly delineated the differences between 271(b) and (c), both in action and in scienter. The two sections have different requirements, and conflating them makes it hard to tell that you understood each.

The negatives above are intended to explain why your grade was not as good as you expected, and it is designed to aid future classes. Please do not take it as criticism; as I said above, I was very pleased with the quality of the exam answers and you all showed at least a basic understanding of patent law.

I also want to provide a couple final notes on exam taking – these notes are intended to aid you in future law school exams, but more importantly to aid you on the bar.

First, assuming you spotted the Issue, the Application (A) in IRAC is far, far more important than the Rule (R). It is important to know the rule, but many exams I read used valuable space quoting the statute rather than briefly stating the rule and spending time explaining how the rule might apply to the facts of the case. In many cases, there was no application at all, and on a take-home exam this will score you few points. For example (not from an actual test), some answers said something like: “There might be an issue of inequitable conduct. If Holder withheld or misstated material information, with an intent to deceive, then all of the claims would be unenforceable.” Though this is a concise (yet incomplete) statement of the rule, it would score almost no points. Why? First, you haven’t shown that you have spotted the issue – is there an argument for inequitable conduct or not? Second, you haven’t applied the facts to the standard, which makes it difficult to discern whether you really understand the rule, or whether you just copied it out of your notes.

Second, never assume a fact is irrelevant. Some professors include facts that are irrelevant to see if you can determine what is relevant and what is not. However, most professors include facts that could, somehow, be fit into the rules and themes of a class. As discussed above, few people distinguished the infringement analysis between the Urban and Jungle products. There was a reason there were two products, and that they were different. Those differences were there to test particular things, and should give you a clue as to what the important points might be (indoor v. outdoor). The bar exam will be no different – if a question has two defendants, ask yourself what the differences between the defendants are, and why those differences might be important.

Third, organization is critical. Taking a few minutes to put an outline together before you start writing can help you make sure you get the points out in a clear manner. This is important for two reasons: a) organization shows clarity of thinking and is thus rewarded, and b) perhaps more important, if an answer is disorganized, the grader is more likely to miss points that you made because they are buried in irrelevant sections.

I realize that all of the above tips are easier said than done. However, they are areas on which I suggest you focus as you prepare for exams and for the bar, as they will no doubt give you a leg up.