

Exam Number: _____

**VILLANOVA UNIVERSITY SCHOOL OF
LAW**

**Patent Law
Risch
Spring 2018**

Final Exam

Exam Number: _____

**VILLANOVA SCHOOL OF LAW
EXAMINATION IN PATENT LAW
8 HOURS**

Professor Risch

Spring 2018

INSTRUCTIONS (READ THEM ALL)

1. **Materials Permitted:** This is an OPEN book exam, with OPEN HARD DRIVE/OPEN NETWORK. **You may not receive help from any person.**
2. This exam consists of 9 pages, including the cover page. Please check to be sure your exam is complete and contains all pages.
3. Time allotted for the entire examination is 8 hours. This is a take-home exam. Thus, 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.
4. 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.
5. **Note that the exam will be held until the 3L cutoff, 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 an announcement notifying you that you may do so.**
6. **Page three of this exam is a confirmation that you understand this – please print, sign, and turn in to Patty Trask at some point before May 9.**
7. **THIS EXAM INCLUDES A STRICT WORD LIMIT OF 4200 WORDS.** 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. **I will stop reading after the word limit is reached.**
8. Do not rely on page counts; you should count words using your word processor's "properties" menu item or in the bottom bar of your word processor. You may divide the word limit among the different questions however you wish.
9. Your exam must be typed, double spaced, in legible font, and on 8.5 x 11 paper size.
10. Use **only** your exam number. You may not use your name or anything else that might identify you on these materials, so check your document properties. You may not identify yourself in any way to the professor as the author of an exam until the grades are published. Make sure that your exam number appears on each page, which is most easily done with a header or footer.

Have a great summer!

Patent Law Final Exam, Spring 2018.

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: _____

Please return to Patty Trask in Room 260 by 5PM on May 9, 2018. I cannot give you a grade without it.

Patent Law Final Exam
Spring 2018

The questions are weighted as follows: Question 1, 8 points, Question 2, 49 points, Question 3, 28 points, and Question 4, 15 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.

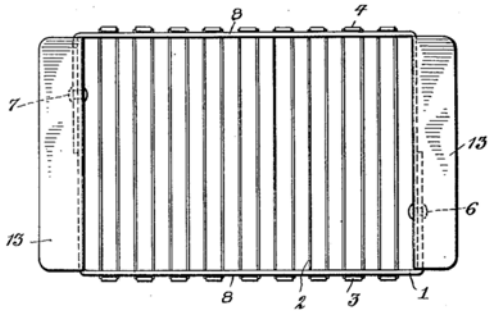
DO NOT ASSUME THERE IS ANY PRIOR ART OTHER THAN THAT DISCLOSED (IF ANY) IN THIS EXAM.

A Brief History of Slicing

People have needed to slice fruits and vegetables. Beginning with the iron age, they did so with a knife:



But cutting with a knife is hard, and so people invented other ways. In the 1930's, a British company sold 10,000 units of a hand slicer. However, even though it was about the length of a potato, it was expensive to make at the time; by 1940, the company that made it went out of business and the hand slicer was never made again. A picture of this hand slicer is below:



Later, other slicing methodologies were developed. For example, in the 1990's, the "EggCyclopedia" had the following entry about an egg slicer:

Slicer

A device which cuts a hard-boiled egg into neat slices with one swift stroke. An egg slicer has an indentec tray in which the egg rests and a cutting mechanism of parallel wires. To chop an egg, carefully rotate the sliced egg 90 degrees



Patent Holder

Patent "Pat" Holder is an amateur inventor and entrepreneur. On January 1, 2014, Pat thought of a new way to slice bananas: a banana slicer! The idea was a banana shaped

device with slats to slice a banana. Pat finished a prototype by April 1, 2014, and immediately put it into production. On July 1, 2014, the banana slicer debuted on Amazon.com:



The results on Amazon were...interesting. Some of the customer reviews are below:

“For decades I have been trying to come up with an ideal way to slice a banana. "Use a knife!" they say. Well...my parole officer won't allow me to be around knives. "Shoot it with a gun!" Background check...HELLO! I had to resort to carefully attempt to slice those bananas with my bare hands. 99.9% of the time, I would get so frustrated that I just ended up squishing the fruit in my hands and throwing it against the wall in anger. Then, after a fit of banana-induced rage, my parole officer introduced me to this kitchen marvel and my life was changed.”

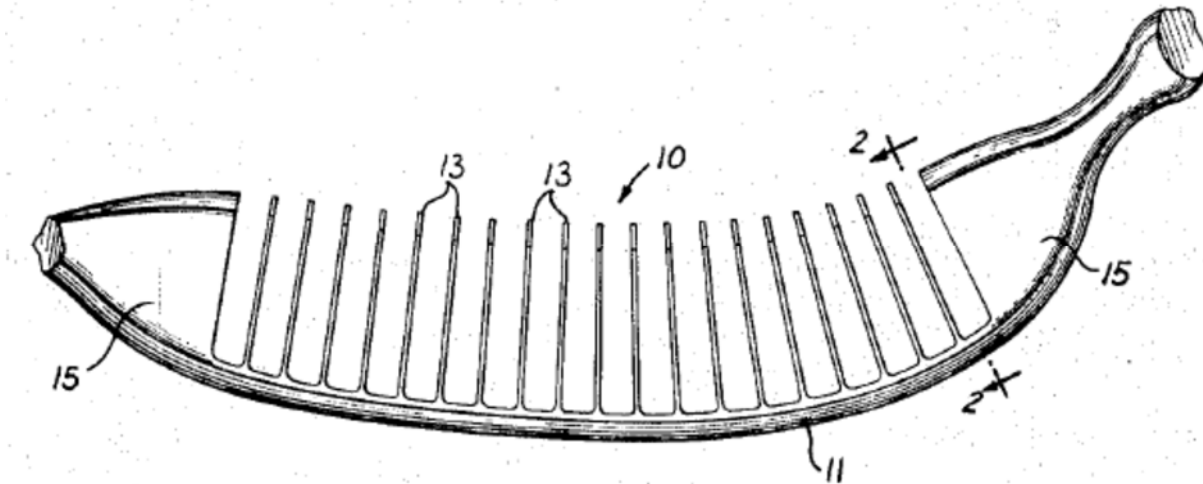
“What can I say about the 571B Banana Slicer that hasn't already been said about the wheel, penicillin, or the iPhone.... this is one of the greatest inventions of all time. My husband and I would argue constantly over who had to cut the day's banana slices. It's one of those chores NO ONE wants to do! You know, the old "I spent the entire day rearing OUR children, maybe YOU can pitch in a little and cut these bananas?" and of course, "You think I have the energy to slave over your damn bananas? I worked a 12 hour shift just to come home to THIS?!" These are the things that can destroy an entire relationship. It got to the point where our children could sense the tension. The minute I heard our 6-year-old girl in her bedroom, re-enacting our daily banana fight with her Barbie dolls, I knew we had to make a change. That's when I found the 571B Banana Slicer. Our marriage has never been healthier, AND we've even incorporated it into our lovemaking. THANKS 571B BANANA SLICER!”

“The only complaint that comes to mind is that I can only purchase a 10-inch slicer online when many of the bananas I encounter at my local grocer are much more varied in size- I'd love some smaller and larger slicers as well so that I can have more variation in my banana sizes at breakfast.”

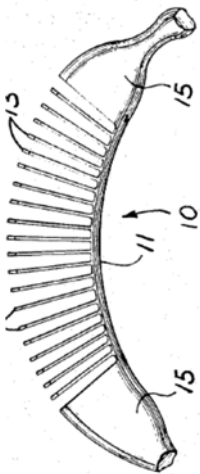
Sales were decent.

The Flexible Slicer

On September 1, 2014, Ripel (“Rip”) Ulysses Off filed a patent application for a flexible slicer. Rip had the idea for this slicer on August 1, 2013, and immediately started looking for investors by telling venture capitalists about the idea, though no investment was obtained. Rip experimented for the next year trying to determine how to attach cutters to the flexible piece of plastic. The slicer was loosely banana shaped, but it was open on one side, which allowed the other side to be straightened for cutting of cucumbers and the like.



On the diagram, 11 is the flexible plastic, 13 are the cutting ribs, and 10 signifies the missing side. An example of the flexibility is shown in the following figure, where the same slicer is bent the other direction:



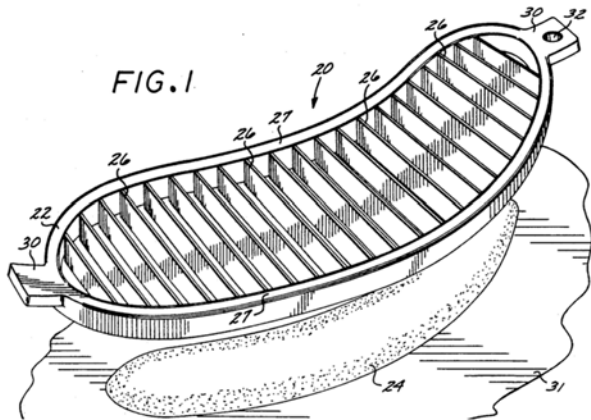
The specification notes the importance of the flexibility:

[I]t is to be clearly understood that the slicing device may also be used in slicing sausage type meats, such as frankfurters, baloney etc; block cheeses, and the like. In this connection it is to be noted that the elongated solid food as used herein is intended to cover the aforementioned foods and the shapes associated therewith.

This application published in due course, on March 1, 2016.

The '123 Patent

On January 1, 2015, Pat filed a patent application on the banana slicer. Relevant portions of the specification are below:



Although people often slice bananas in connection with preparation of fruit salads, dishes containing cereals and other culinary items, people usually have to use a knife for cutting the banana slices one by one. The present inventor is unaware of the existence of slicing utensils or tools specially adapted for bananas.

Thus, the preferred embodiment comprises a substantially flat frame which circumscribes an area sufficiently large to contain a typical banana, even a large banana, laid to rest on its side. The foregoing is shown on the exploded perspective view of FIG. 1. Preferably, as it is revealed by the drawing figures which depict the preferred embodiment of the invention, the frame of the banana slicer conforms to the curvature of a typical or ordinary banana. Thus, the banana slicer is elongated and the frame is curvilinear so that the slicer fits on top of a typical banana, as is specifically shown on FIG. 1.

A plurality of spaced, substantially parallel disposed blades or ribs interconnect two elongated sides of the frame. The positioning of the blades or ribs is such that when the banana slicer is laid to rest on a substantially horizontal flat support surface, the blades or ribs are disposed substantially vertically. In accordance with the invention, the blades or ribs must be sufficiently thin so as to be able to serve as cutting tools capable of cutting through a banana, without having a specially sharpened wedge shaped cutting edge. On the other hand, because the blades are preferably made from plastic, they cannot be so thin or narrow that their structural integrity would be compromised, or so thin that they could not be manufactured by suitable manufacturing processes, such as plastic molding. For these reasons, the blades or ribs of the preferred embodiment are approximately 1 mm wide, although it should be understood that their width can vary for as long as the foregoing requirements are met.

I claim:

1. A utensil for slicing bananas comprising:

an elongated plastic frame conforming to the shape and area of a typical banana, the frame having curvilinear opposite longitudinal sides,

and

multiple substantially evenly spaced, substantially parallel disposed cutting ribs interconnecting the curvilinear longitudinal frame, each of the ribs being sufficiently thin to form means for cutting transversely through a banana, the spaces between the ribs defining thickness of banana slices cut by the utensil.

2. The banana slicing utensil of claim 1 wherein each rib is approximately 1 mm thick and the distance between the ribs is 4 mm.

The application published in due course on July 1, 2016 and the '123 Patent issued a year later, on July 1, 2017.

Rip is selling the flexible slicer (it looks like the figure in the patent, its cutting ribs are 1.2mm thick, and the ribs are spaced 4.3mm apart where they connect to the side), and on August 1, 2017, Pat sues for patent infringement.

ASSUME THAT THE AMERICA INVENTS ACT APPLIES UNLESS THE QUESTION STATES OTHERWISE

QUESTIONS:

Q1: Rip U. Off files a motion to dismiss claim 1 based on indefiniteness (Section 112(b)) because a) bananas come in different shapes and sizes, b) the slice width is not defined, and c) the cutting rib width is not defined. Please write a memo to the judge assessing the substantive merits (and drawbacks) of this motion. You may skip procedural issues (e.g. is a motion dismiss proper for this question). Answer in 10 sentences or less. (8 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. There is no need to address any issues you considered in Q1. (49 points)

Q3: You are counsel for Rip. Please draft a memo describing the infringement claims by Pat that Rip will likely see on the Banana Slicer, and the responses Rip has to such claims. There is no need to address contributory or induced infringement. There is no need to address any defense of invalidity from Q1. (28 points)

Q4: Assume that this case fell under the 1952 Act. How would the analysis in Question 2 change? Answer in 20 sentences or less. (15 points)