

Patent Law

Fall 2017

Professor William Fisher

This examination has two parts. Part I is a three-hour in-class test, which will be administered from 9:00 a.m. to noon on December 12, 2017. Part II is an unlimited-time “take-home” essay, due at 4:30 p.m. on December 19, 2017. Your responses to the two parts will be given equal weight when determining your grade.

Instructions for Part I

Part I of the exam consists of ten questions designed to assess your knowledge of patent law in the United States. You must answer all of the questions. You have three hours to complete your answers. There is no word limit on this portion of the exam. The exam mode for this portion of the exam is CLOSED. This means that you will not have access to the hard drive of your computer or to the Internet. Nor will you have access to your answer once you have submitted it.

This portion of the exam is also “closed-book.” You may not bring into the exam room any written material, paper, or electronic devices other than your computer. (The only exception to this rule is that a student who is not a native speaker of English may bring into the exam room a paper copy of a dictionary enabling him or her to translate English words into his or her principal language.) The proctors will supply scrap paper that you may use to take notes during the exam. In preparing your answers, you may not consult in any way with your fellow students or with any other person.

Exam4 will automatically put your Anonymous ID and word count on the exam copy. Do not write your name on any part of your response. To preserve the anonymity of your response, avoid including any information that would enable the instructor to identify you.

DO NOT TURN TO PAGE TWO UNTIL THE PROCTOR TELLS YOU TO BEGIN.

Part I

All of the following ten questions pertain to patent law currently in force in the United States or to the multilateral agreements to which the United States is currently a party. You must answer all ten. The questions merit answers of varying length; some can be answered briefly; others deserve more extended treatment. In all of your answers, you should strive to be concise.

- (A) To what extent is computer software currently patentable in the United States?
- (B) Identify one commercially significant type of invention, currently patentable in the United States, that Congress could declare henceforth to be unpatentable without violating Article 27 of the TRIPS Agreement.
- (C) Is a patent applicant obliged to reveal in the application the best way of practicing the invention?
- (D) What, in your judgment, are the two most important differences between (i) the rules pertaining to novelty that apply to patents based upon applications filed before March 16, 2013 and (ii) the rules pertaining to novelty that apply to patent applications filed on or after that date and to patents based on such applications?
- (E) Describe the role played by the “secondary factors” in courts’ analyses of challenges to the validity of patents based on nonobviousness.
- (F) To what extent does patent law in the United States adhere to the principle of “peripheral claiming”? Support your answer by discussing two aspects of the way in which courts currently engage in claim construction.
- (G) Describe a scenario in which the defendant in a patent-infringement suit could successfully invoke the doctrine of prosecution history estoppel. Then describe a scenario in which a defendant might be inclined to invoke the doctrine, but would be unsuccessful.
- (H) What is a “paragraph 4 ANDA”?
- (I) Under what circumstances is a court likely to deny injunctive relief to a patentee who prevails in an infringement suit?
- (J) As you now know, the United States Supreme Court recently has repudiated several positions taken by the Court of Appeals for the Federal Circuit concerning the proper interpretation of the patent statute. Is there any pattern to the Supreme Court’s decisions? In other words, are there any recurring characteristics of the positions taken by the Federal Circuit that are especially likely to prompt repudiation by the Supreme Court? Support your answer with two examples.

Part II

This portion of the exam is open-book, and the exam mode is TAKEHOME. In preparing your answer, you may read any material you wish, but you should not feel obliged to read anything other than the relevant materials in the course syllabus. You are also free to discuss your answer with your classmates or other persons. However, you must indicate in your answer the sources of any ideas you have derived from others.

Answer one and only one of the following questions:

- (A) Apply the welfare theory of intellectual property to two major doctrines of patent law. Then discuss the lessons that might be drawn from your analysis concerning the strengths and weaknesses of the welfare theory.
- (B) How has your study of patent law informed your understanding of the nature and determinants of innovation? Conversely, what reforms of patent law would enable the law to stimulate and channel innovation more effectively?
- (C) How, if at all, should the multilateral treaties that currently constrain most countries in the world when adjusting their patent laws be modified?
- (D) To what extent should the doctrines of patent law differ with respect to the various types of patentable subject matter?
- (E) Should traditional knowledge enjoy more legal protection than it currently enjoys? If so, how should that protection be defined?
- (F) Should Congress modify the current doctrine of exhaustion?
- (G) Describe (and then assess the merits of) one way in which the law of the United States or other countries might be modified to help alleviate the global health crisis.
- (H) If the Seventh Amendment were repealed, how, if at all, should U.S. patent law be modified?
- (I) What principle(s) should be used to draw the boundary between patent law and antitrust law? How would adoption of your recommendation modify the rules currently governing standard-setting organizations and reverse-payment settlement agreements?

Your answer to Part II of the exam may not exceed 2000 words (including any footnotes or references). You must submit it before 4:30 p.m. on December 19, 2017, to the Registrar's Office using the Exam 4 software.

End of Exam