

Fundamentals of Intellectual Property

Spring 2015

Prof. Ford

Take-home Midterm Exam

This take-home midterm exam is worth 20% of your course grade. It will be distributed on Monday, March 9, and is due back on **Monday, March 16, at 9:00 am**. By that time, you must return **two printed copies** of your exam responses to the Registrar's Office. Late exams will result in an automatic reduction of your course grade by **one-third letter grade per day**. Please do not put your name or any identifying information on your exam. Instead, place only your assigned exam number on the top right corner of your answers.

I expect all exam responses to be typed. Format your responses similarly to this document: **single-spaced, with 1.5-inch margins, and empty space between paragraphs**. Use 12-point Century, Palatino, Constantia, Book Antiqua, Cambria, or another high-quality proportionally spaced body-text font; please do *not* use Times New Roman. Number your pages.

Because you have flexibility within the week of when to complete the exam, other students may be completing this exam before or after you do so. Accordingly, you **must not discuss the exam with anyone, student or not**, until after March 16, 2015. Additionally, I will not be able to answer any questions about the exam while it is in progress. You may use any materials you wish while completing this exam.

This exam consists of **three short-answer questions**, each worth a third of the grade. This exam has strict time and word limits. You must not spend more than **four hours** completing this exam (I expect you will need less time than that), and you must not use more than **250 words per question**. Please list your word count for each question after your response to that question. Please also type at the top of your exam the following sentences:

I affirm that I have not discussed this exam with other students or anyone else during its administration. I further affirm that I understand and have complied with the word and time limits, and that I have not spent more than four hours completing this exam.

If any of the questions are unclear, or don't provide necessary information, state explicitly any assumptions you make and answer the questions given those assumptions.

Good luck!

Question 1 (250 words maximum)

Datamax, Inc. is a data broker, a company that compiles large databases of information about consumers. Datamax sells that information, or reports and assessments based on that information, to interested companies for use in marketing, market research, and so forth.

One of the products that Datamax provides is a consumer credit assessment, sometimes called a credit score. A consumer credit assessment uses the information that Datamax has collected about a consumer to predict the risk that the consumer will default on a debt obligation, such as a mortgage, car loan, or credit-card bill. Datamax makes these predictions using proprietary algorithms it has developed over its many years of experience in the business.

Erin McGathy, a data scientist at Datamax, has given notice that she plans to leave and join a competing data broker. You are a lawyer representing Datamax. Datamax would like to sue to prevent McGathy from joining the competitor, to prevent her from disclosing Datamax's proprietary algorithms.

I have not given you enough information to evaluate whether Datamax has a valid trade-secret claim. What information would you need to evaluate that question? Please list questions to which you would want to know the answers if you were the examiner. For each, give a short one-sentence explanation of why the information would be helpful.

Question 2 (250 words maximum)

U.S. Patent No. 2,192,525, issued to Esme Rosaire in 1940, describes and claims methods for predicting where oil will be found underground. Claim 1 reads:

The method of detecting subterranean deposits from which leakage of emanations occur which comprises
taking soil samples from selected points in a predetermined area,
confining the respective soil samples from air contamination,
removing said samples from confinement, and
analyzing the samples with respect to gases contained in the samples directly related to said deposits.

Does this claim constitute patentable subject matter under 35 U.S.C. § 101? Assume the claim is being evaluated under current law, not under the law that existed in 1940.

Question 3 (250 words maximum)

Dr. Lydia Rodarte-Quayle, a scientist at Madrigal Pharmaceutical GmbH, a German pharmaceutical company, filed for a patent on March 1, 2010, on a new formulation of the cancer drug docetaxel. (A pharmaceutical formulation is the combination of active and inactive ingredients used to administer a drug. A new formulation can be advantageous if, for example, it has fewer side effects than a previous formulation, or if it is shelf-stable for longer times.)

For each of the following, explain whether the reference qualifies as prior art to Dr. Rodarte-Quayle's application, for the purposes of (pre-AIA) 35 U.S.C. § 102(a) or § 102(b). (In other words, explain whether it falls into one of the categories of prior art covered by those subsections and whether the timing makes it relevant prior art; do not consider whether it discloses each element of a patent claim.) For each, explain why or why not.

- a. Dr. Rodarte-Quayle's article in the *Journal of Cancer Research and Clinical Oncology*, *Non-Polysorbate Infusion Formulations of Docetaxel*, published on August 15, 2009.
- b. A talk given by Dr. Rodarte-Quayle at the annual meeting of the American Association for Cancer Research, with slides that were posted on the Association's website, on January 8, 2009.
- c. A formulation of the drug paclitaxel, a similar drug to docetaxel, sold as a prescription drug in the United Kingdom starting on April 4, 1997, but never approved for sale in the United States.
- d. A formulation of a docetaxel derivative, TXL34B, that was tested by another pharmaceutical company, Grey Matter Inc., in a confidential clinical trial in Florida, New Mexico, and Texas that began on October 26, 2005, and was abandoned after the drug proved ineffective.