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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 governing this exam.

1. Scenario A

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1 Pre-AIA law applies. Lydia's German patent filing is not prior art because 102(e) does not apply to foreign filings. Lydia's patent and application publication both fall under 102(a) or 102(b) prior art but their effective date—June 10, 2007—occurred after the critical date of Walter's patent. The critical date of Walter's patent is his invention date, which was no later than his reduction to practice—March 4, 2006.

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The on-sale bar of 102(b) applies if Walter's invention was on-sale in the United States more than one year prior to the filing date. Since Walter filed on March 28, 2007, the critical date is March 28, 2006. For the on-sale bar to apply, the invention must (1) be ready for patenting and (2) be a commercial offer for sale.

An invention is ready for patenting if it is reduced to practice. Walter's invention was ready for patenting on March 4, 2006—the date he reduced it to practice.

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Walter's invention was probably "on-sale" by March 18, 2006, when he started using the invention "to prepare substantial quantities of the pharmaceutical compound *for commercial sale*," assuming he had already made an offer to sell the drug. Since the drug was sold to the public within a week of production, it's likely that an offer for sale initiated the large-scale production between March 18-26. Since the invention was (1) ready for patenting and (2) was probably a commercial offer for sale prior to March 28, 2006, the "on-sale" bar applies and Walter cannot get his method patent.

Scenario B

"public use"?

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Post-AIA law applies. Kim's use of the cart in public is probably prior art under 102(a)(1) as "otherwise available to the public." However, this use was a disclosure under 102(b)(1)(A). Under 102(b)(1)(A), Kim had 1 year to file her invention after her disclosure. Kim's disclosure occurred in January 2016. She filed before January 2017. Thus, her use is carved out by 102(b)(1)(A).

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4 Jimmy's company's sales of the cart would be "on-sale" prior art under §102(a)(1) because it occurred before Kim's filing date and the cart is identical to Kim's cart. However, §102(b)(1)(A) and §102(b)(1)(B) carve out these sales because all disclosures occurred within a year of filing. §102(b)(1)(a) applies because Jimmy got the invention from Kim. §102(b)(1)(B) applies because Kim disclosed prior to Jimmy's company's disclosure.

Kim can receive her patent.

Nice job.

Word Count: 391

- 3 2. If the patent specification is not enough to enable a PHOSITA to implement the invention, without performing undue experimentation, the invention wasn't enabled. Thus, the relevant question is whether a PHOSITA would have to perform undue experimentation to implement Chris's invention, at the time of filing.

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Chris is claiming all nitrogen-rich chemical fertilizers and all nitrogen-fixation bacteria. There are twenty well-known fertilizers and twenty well-known bacteria—so there are at least 400 combinations. However, not all the combinations work and not all ratios work. By Chris narrowing her invention to certain ratio ranges she has reduced the amount of required experimentation. However, Chris's invention involves chemistry, which is an unpredictable art. Unpredictability requires more experimentation. However, the amount of necessary experimentation would be reduced if the PHOSITA already knows which fertilizers work best with certain bacteria (PHOSITA may already have knowledge from applying fertilizers and bacteria to the same plants).

- 6 good! Chris's specification will probably not help a PHOSITA because she doesn't know why different combinations did or didn't work. If Chris could specify certain fertilizer properties that are compatible with certain bacteria properties, it would help a PHOSITA match a fertilizer with a bacterium. Since Chris can't provide these characteristics, Chris should at least include her 22 experiments in her specification. The experimental results may aid a PHOSITA in determining which combinations of fertilizers and bacteria work. However, 22 experiments is small compared to 400 possible combinations. Thus, the question of enablement is still dependent on what the PHOSITA already knows about fertilizer and bacteria combinations, at the time filing.

3 The written description requirement is more demanding than the enablement requirement. The written description requirement ensures that the inventor possesses the invention at the time of filing. Chris conceded that she doesn't know why some fertilizer-bacteria pairings worked and why other pairings did not work. She also doesn't know why some ratios of fertilizer to bacteria worked and why other ratios did not work. She is claiming an entire genus of fertilizer-bacteria combinations, but can't specify any characteristics to distinguish working combinations from other combinations. So, even if Chris's patent passes the enablement requirement, it is unlikely that the written description requirement will be met.

Word Count: 366