Intellectual Property
Fall 2024
Midterm Exam Memo

Your grades are available on Canvas. The bullet points in the following outline do not precisely correspond to my grading rubric, but they do roughly reflect the overall weight I put on different parts of the analysis. I gave full credit for identifying an issue and analyzing it carefully even if you reached a different conclusion than I did. I gave partial credit for a wrong answer in the right ballpark; I gave extra credit for spotting an issue I missed, or for surprising me with an argument I had not thought of.

I will of course be happy to discuss your exams and your grades with you if you have any questions.

Behold the Invent-Inator!

The Media-Erase-Inator

- Magnets are physical objects, so a combination of them is patentable subject matter. Magnetic tapes are physical, so a method of erasing them is also patentable subject matter. They are not directed to an abstract idea.
- Erasing magnetic tapes is a useful result and the invention appears to work.
- The loss of the development log does not prevent DE from applying for a patent. DE employees still understand how the invention works, so they can adequately reconstruct the details and describe them to DE's patent counsel. Under a first-to-file system, priority of conception and reduction to practice is irrelevant.
- The danger that Flynn and Fletcher might apply for its own patent on a similar technology or bring one to market (thereby creating prior art) means that DE should apply for a patent as soon as possible. If necessary, DE should consider filing a provisional application to lock down its priority date while it finishes the application.

The Bread-Inator

- As described, there is nothing significantly inventive about the Bread-Inator itself (e.g., no novel arrangement of pressure and heading elements), so the only available patent would be on the method of baking bread at high pressure.
- Bread is a physical object, so a method of baking it is patentable subject matter. It is not directed to an abstract idea.
- Baking bread more quickly is a useful result. The rubbery texture is a trade-off, but it is one that some bakers might happily accept.
- The method of baking bread at high pressure may not be novel. Dr. D. has confirmed that there are no invalidating sales, but that is just one class of prior art. If it can be established that even a few home bakers used their pressure cookers at high pressure to bake bread,

that would be invalidating public use. The same is true if there is even one published recipe calling for high-pressure baking, which would be a printed publication.

- Similarly, given that people have been baking bread in pressure cookers for many years, it would probably be obvious to use them to bake bread at high pressure. The fact that pressure cookers can be set to high pressure provides a TSM to turn on that feature.

The Mustache-Inator

- Lasers and mustaches are physical, so a device containing lasers and a method of using them to grow a mustaches are both patentable subject matter. They are not directed to an abstract idea.
- The Mustache-Inator is not useful because it is inoperable.
- Any possible application that DE could currently submit on the Mustache-Inator would fail for lack of enablement, as not even DE knows how to make it work.
- DE should not sell the Mustache-Inator now, because it will create prior art against itself, potentially making it harder or impossible to get a patent. (Additionally, selling a product that DE knows doesn't work is consumer fraud and could get DE in other legal trouble, as well as being highly unethical.)
- DE should continue to test the Mustache-Inator in private, so as to maintain its patentability if and when it works successfully.

The Sculpt-Inator

- Drills and saws are physical, so a device containing them is patentable subject matter. Ice, wood, marble, and firm tofu are physical, so a method of carving them is also patentable subject matter. Customizing this device to only make an object of a particular design, however, may be an abstract idea if the only adaptation required is inputting the design.
- The combination of a drill and saw by itself is not be novel, but there may be features of how they are used and programmed that could be

novel. Similarly, while 3D printers and CNC machining have existed for years, there may be specifics of the use of drill and saw that are new. Further investigation is required.

- For the same reason, more details of how the Sculpt-Inator works are required to assess whether the methods it uses are nonobvious.
- There is an issue with the best scope of the claims, as in the Plastic Dye problem. A claim to the specific materials tested will be properly enabled, but runs the risk that competitors' sculpting machines for other materials will be non-infringing. A combination of broader and narrower claims is recommended.
- The Mount Rushmore design is non-infringing because the design of Mount Rushmore is in the public domain. It is a government work, and its sculptor, Gutzon Borglum, has been dead for more than 70 years.
- Designs created by artists will be copyrightable as sculptural works. As these artists are commissioned, rather than employees of DE, their designs will not be works made for hire. (Sculptures are not one of the categories of works eligible to be non-employee works made for hire.) DE should ensure that the contracts with all artists contain clauses assigning the copyright to DE.

Whale-Translator-Inator

- The Whale-Translator-Inator may implement an abstract idea because it functions entirely by processing information. That said, it likely adds "something more" by performing a function that is not simply the implementation of known methods on a computer—provided that works.
- The Whale-Translator-Inator is not useful for its described function of translating whale songs. It may, however, be useful for some other function, such as entertainment. Its consistency means that it has specific utility. It is doing something more than every device in its category could do; it is not just making up random translations.
- The OWCA break-in constitutes trade secret misappropriation. The Whale-Translator-Inator has some economic value and there is no ev-

idence that DE has failed to take reasonable measures to ensure secrecy. Physical trespass and theft are prototypical examples of improper means.

- If OWCA releases the documents publicly, that would create prior art that could limit the future patentability of the Whale-Translator-Iniator. DE could still make use of the one-year grace period, because OWCA would be "another who obtained the subject matter disclosed directly or indirectly from the inventor." 35 U.S.C. § 102(b)(1)(B).
- DE can seek an injunction against OWCA to prevent public release of the documents. While OWCA could argue that its releases are in the public interest, they do not fit within the whistleblower exception in the DTSA, which requires that the disclosures be made in confidence to government officials.

Evaporator-Inator

- The Evaporator-Inator is patentable subject matter because evaporating water is not an abstract idea.
- The Evaporator-Inator is useful. Sometimes people need to evaporate water to make the air more humid or to remove a puddle. The successful test means that the Evaporator-Inator is operable.
- DE should submit a patent application promptly to avoid the risk that Monogram files an application of his own or makes a public disclosure. DE should have no difficulty preparing an enabling application.
- Monogram, like Victor Desny, cannot sue for breach of contract. Dr. D.'s promise to pay was unsupported by consideration since it was made after the disclosure.
- Monogram, however, may be able to sue DE for breach of confidence if he can demonstrate that his technology was maintained as a secret. The circumstances of his conversation with Dr. D. suggest that the parties understood that the disclosure was made with an expectation of confidence, and Dr. D.'s statement reinforces that conclusion.
- Thus, the difficult part will be establishing that DE did not "use" Monogram's idea because it was already in possession of the work-

ing Evaporator-Inator that was not designed or built with any information that Monogram disclosed. DE should keep all of its development logs safe and far away from the Media-Erase-Inator.

There's a Platypus Controlling Me

- The song is copyrightable as a musical work and the video is copyrightable as an audiovisual work.
- Johnson is the author of the works. They are not works made for hire. Although she is a DE employee, it does not appear that creating music and videos is part of her job duties, so they were not created within the scope of her employment. There are no shop rights in copyright.
- If DE wants to use the song, it will need to obtain a license or assignment from Johnson.