

Intellectual Property
Fall 2026
Midterm 1 Memo

I was pleased with your answers, which ranged from good to excellent. I will of course be happy to discuss your exams and your grades with you if you have any questions.

I will post to Canvas your per-question scores and your overall raw total. The point range was from 0 to 60 (one point per minute). I have included some statistics and a *rough* curve below. On an exam this short, differences of a few points are not statistically meaningful. Don't worry about falling just above or just below a cutoff line; when I compute the final grades I will add your raw totals together and then curve the results.

Curve

Range	Grade
00-10	F
10-15	D
15-20	C-
20-25	C
25-30	C+
30-35	B-
35-40	B
40-45	B+
45-50	A-
50-55	A
55-60	A+

Statistics

Median	39.0
Mean	40.0
Std. Dev.	5.2

1. Wylie Coyoté has developed a design for rocket-powered roller skates. Unfortunately, after a successful test, the prototype was destroyed in an explosion. True or false: *To obtain a patent, Coyoté will need to construct a new pair of skates, test them, and submit them as part of his application to the USPTO?*

False. There is no requirement that an inventor submit a working embodiment of the invention. (It is sufficient if the disclosure is enabling and the invention is operable.)

2. Emma Webster discovered that she could remove stains from clothes more effectively by ironing them with vinegar. She posted a video demonstrating the technique to Instagram in July 2023. True or false: *The video counts as prior art for purposes of novelty under § 102?*

True. The video is a “printed publication.” (We discussed online postings when talking about prior art.)

3. Eric Lorre is employed by the Acme Corporation as a geologist, working on a technique for extracting water from rock samples. After a laboratory breakthrough, he sends a company-wide email, distributed to all 20,000 Acme employees, announcing his success. True or false: *Acme cannot have a trade secret in the technique because too many people know about it?*

False or it depends. The technique is a trade secret as long as it is not known by competitors and Acme takes reasonable efforts, regardless of how well known it is inside Acme. (The email might be evidence against reasonable efforts, but the stated reason is wrong.)

4. Will Avery sells kits for building your own catapult, including all the necessary materials and detailed instructions. He receives a cease-and-desist letter from Acme claiming that the catapults infringe on one of their patents. True or false: *Avery can ignore the letter, because he sells only kits and not actual catapults?*

False. Avery could be liable for active inducement if his customers make and use catapults from the kits. (This is in the Plano Bait Shop problem.)

5. Martha Jones is at a job interview with Acme when the interviewer asks how she would improve its operations; she responds with a suggestion for better safety protocols during product testing. True or false: *Acme is free to use the idea without compensating Jones?*

True or it depends. Jones did not require Acme to sign an NDA and a job interview probably does not create a confidential relationship. (This is a variation on *Desny*.)

6. Tone Maltese has applied for a patent on a method of safely digging deep holes that claims, in part, “a rectangular support frame.” True or false: *This claim is indefinite because it does not specify the frame’s length or width?*

False or it depends. A claim is indefinite only if it cannot be subjected to claim construction, and parameters like these can often be understood by a PHOSITA from context. (This is much like *Freeny*, the “low power” case.)

7. The AMJ Company is a media-production company that works on integrating computer animation with live-action scenes. It is developing software that enables more realistic lighting effects when animated characters are added to scenes that have flickering or moving lights. AMJ has twenty employees, including five technologists and seven animators. Its executives believe that this software could be useful in movie productions that have hundreds of animators. *Should AMJ pursue patent protection for its software? Discuss the advantages and disadvantages.*

AMJ might not be able to get a patent if the software’s advances are considered an “abstract idea” under § 101. But I will assume that AMJ has made a sufficient advance that it passes *Alice*’s “something more” test.

If AMJ obtains a patent, it will be able to prevent competitors from using similar lighting techniques, even if they develop them on their own. The 20-year term is likely to be longer than the commercial viability of the software in the fast-changing media industry. But AMJ will have to disclose key details of how the software works, which will give important technical information to competitors, allowing them to devel-

op competing techniques while trying to avoid the specifics of the claims.

AMJ is far too small to use this software in-house. It will either have to provide the software to customers or license out the technology to someone in a position to develop the software. The licensing strategy is very risky without a patent because the crucial design details could leak out. But providing the software to them could work under trade secrecy—especially if it is provided as a cloud-based service rather than as a download they can reverse engineer.

(This question was easy to write long on because there are so many different strategy angles to discuss. I gave credit for any good points you raised, rather than looking for specific answers.)

8. Beauregard Leghorn has found that adding metal pellets to birdseed deters squirrels from eating the seeds. You have drafted a claim that reads, in relevant part, “a mixture of seeds and metal pellets in the ratio 20 parts seeds to 1 part metal pellets.” In your research, you have found the following pieces of potential prior art:

- Roadrunners sometimes drop small rocks in piles of seeds to deter other animals from eating the seeds.
- Leghorn began experimenting with adding pellets to birdseed in 2024, and settled on his current 20:1 ratio in 2025.
- Acme has been selling “decorative imitation birdseed” that consists of metal pellets painted to look like seeds since 1949.

If Leghorn applies for a patent, is his invention novel under § 102?

Yes. None of the pieces of prior art makes the claim not novel.

- **Roadrunners:** Rocks are not metal pellets, so they are not covered by “metal pellets” in the claim. In addition, there is no evidence that roadrunners have ever mixed seeds and pellets in a 20:1 ratio.
- **Leghorn:** Leghorn’s own experiments involved the claimed invention. But they are not “in public use” because there is no evidence that they were made public or that he commercialized the technology. In addition, his use at least until 2025 was experimental.

- Acme: Acme's imitation birdseed is not covered by the claim because it does not literally include "seeds." Also, it might not be analogous art because it is in a different field (decoration, not feeding birds) and is not directed to the same problem (deterring other animals).

(This question has a simple correct answer. I was looking for adequate reasoning to support the right conclusion for each of the three pieces of potential prior art.)