

**DIRECTORATE OF DISTANCE EDUCATION
NALSAR UNIVERSITY OF LAW, HYDERABAD**

Post-Graduate Diploma in Patents Law (Batch 2021 – 2022)

**Take Home – Supplementary Examination (November, 2022)
Paper IV – Abuse / Infringement of Patents (Practical)**

TOTAL MARKS: 100

INSTRUCTIONS TO CANDIDATES

- a) *Read the instructions for Take Home Examination carefully and adhere to the same.*
 - b) *Please mention your name, ID No., subject name and total number of pages on the Answer Sheet.*
 - c) *Clearly indicate the question numbers while answering them.*
 - d) *The question paper to be interpreted as given and no additional clarification can be sought.*
 - e) *You should accept the facts given in the papers and not use any special knowledge you may have.*
 - f) *Assume also that the prior art given is exhaustive.*
 - g) *Marks are awarded more for the points selected for discussion and reasoning displayed than for conclusions reached.*
 - h) *All the candidates are required to submit only word / Pdf files containing the typed answers.*
 - i) *All papers will be uploaded on Turn-it-in for plagiarism check. Any paper with more than 15% similarity will be considered to be plagiarized attracting necessary action by the University.*
 - j) *Since this is a take home exam, we expect your answers to be analytical rather than straight answers.*
 - k) *Copying from any source including from other students is strictly prohibited. Plagiarism is considered as a serious academic mis-conduct and the University will take action as it deems fit*
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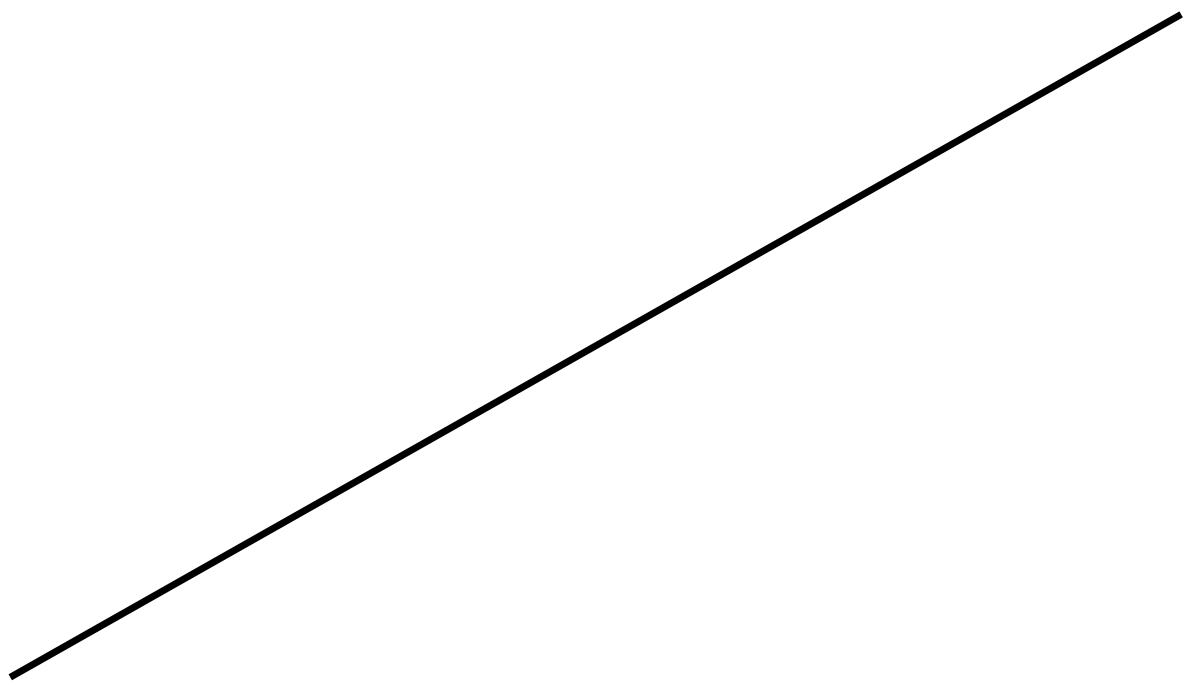
*You are an Indian registered patent agent. You received a letter on from one Mr. Client as follows:
Please respond to Mr. Client, advising him and explaining in detail addressing all the concerns raised by him highlighting on:*

- 1) claim construction,*
- 2) infringement,*
- 3) patent validity / revocation possibilities,*
- 4) other miscellaneous issues and*
- 5) your advice.*

(20+20+30+20+10 Marks).

Note:

The answer guidelines contain some points (non-exhaustive) that could be covered in the answer to the Paper.



(i) Construction

Claim	Feature	Meaning
Claim 1	inner threaded cylinder ... closed upper surface and opening at a bottom rim	What does cylinder mean? Must the sides be parallel or can be conical? In the fig, the outer cylindrical wall is not parallel, so cylinder should be given a wider meaning. What does threaded means? Screw type cap vs snap on type cap
	outer cylindrical wall	Does this definition include merely "an outer surface" of the measuring cap? Or must it be a separate outer wall from the inner threaded cylinder?
	an outer cylindrical wall coupled to the inner threaded cylinder	to construe " coupled to " - how it defines the positional relationship between the outer and inner cylindrical wall? Are they integrated or can be separated? At where is the outer wall coupled to? Repercussive effect to claim 3 (attached to the bottom rim), so the construction here should be wider.
	An opening at an outer rim	same position as "bottom rim"? Repercussive effect to claim 2 (outer rim is

		away from the bottom rim - opp position), the construction here should be wider. OR may also construe that the outer rim is away from bottom rim (similar to claim 2) because the other interpretation is not supported by the description. Candidate makes the argument that the broader interpretation is not supported by the description or not sufficiently enabling.
	having a second vertical height that is at least equal to the first vertical height	Second vertical height is the same or larger than the first vertical height
	the inner threaded cylinder forms a first fluid containing vessel and the outer cylindrical wall forms a second fluid containing vessel	What does fluid containing vessel mean? Does it need to actually contain fluid? Are "the first and second fluid vessel" the same or should they be different vessels?
Claim 2	<u>Upwards</u> to the outer, <u>away</u> from the bottom rim	What's the relative position of the outer rim and bottom rim? They are opposite direction from each other.
Claim 3	Outer cylindrical wall surrounds the inner threaded cylinder and the second fluid containing vessel is defined <u>between the inner threaded cylinder and the outer cylindrical wall</u>	discuss "...the outer cylindrical wall surrounds the inner threaded cylinder..." - what limit does claim 3 introduce into claim 2? What does it mean to surround?
		discuss "...the second fluid containing vessel is defined between ..." - and the repercussive effect to claims 1 and 2 The second fluid containing vessel is defined within the outer cylindrical wall, the bottom

		rim, the inner threaded cylinder. Any fluid would be contained in an area between the outer cylindrical wall and the inner threaded cylinder?
Claim 4	Top	Simply a cover / covering
	...attaches...	Is this integrally formed or a detachable cover? It should cover both embodiments.
Claim 5	Volumetric graduations	Markings to indicate volume May just be markings without any labels. Can the inner threads be considered as volumetric graduations? Possible.

(ii) Infringement Analysis

NB: If candidate makes a conclusion of the infringement which is inconsistent with the analysis, for claim 1, and for each dependent claim.

Claim 1	inner threaded cylinder... closed upper surface and opening at a bottom rim	Present – see bottom portion 12, threads 15 and Fig. 1. The portion which forms a watertight seal is closed at the upper end, and opens at the bottom end to seal the bottle.
	outer cylindrical wall	Present – page 2 line 19. Top portion 11 is a cylindrical liquid holding device.
	an outer cylindrical wall coupled to the inner threaded cylinder	Present – the top portion 11 and the bottom portion 12 are coupled together.
	An opening at an outer rim	Present – the top portion 11 is a shot glass and hence is open at the top (same conclusion even if the alt narrower view was taken).
	having a second vertical height that is at least equal to the first vertical height	Present – no explicitly mentioned, but the fig.1 shows the top portion 11 to be longer than the bottom portion 12.
	the inner threaded cylinder forms a first fluid containing vessel and the outer cylindrical wall forms a second fluid containing vessel	Present – it can be seen that the top portion shot glass can contain fluid, and the bottle cap bottom portion can also contain fluid when inverted.

Claim 2	Outer cylindrical wall extends... upwards to the outer, away from the bottom rim	Present – the cylindrical wall of the bottle cap top portion 11 extends upwards away from the bottom portion rim, to form a shot glass.
Claim 3	Outer cylindrical wall <u>surrounds</u> the inner threaded cylinder and the second fluid containing vessel is <u>defined between the inner threaded cylinder and the outer cylindrical wall</u>	Absent – the cylindrical wall of the bottle cap top does not surround the threaded portion 10. Also the second fluid vessel (shot glass) is defined between the cylindrical wall of the bottle cap top portion 11 and its base (top of the bottle cap bottom portion 12), not between them.
claim 4	Top	Present – Supplier 1 patent doesn't include a cover, but bartender bought it from another supplier separately.
	...attaches...	Present – doesn't need to be integrally formed.
Claim 5	Volumetric graduations	Absent. Unless candidate construed the “threads” as volumetric graduations. (for each outer and inner cylinder)

(iii)	Novelty Analysis	Prior Art 1
Claim 1	inner threaded cylinder ... closed upper surface and opening at a bottom rim	Present – see pg 1 lines 4-5 and the figs. Bottom rim is 23 of the cylindrical member 13.
	outer cylindrical wall	Present – outer chamber 19 and side wall 12.
	an outer cylindrical wall coupled to the inner threaded cylinder	Present – pg 1 lines 1-3, cylindrical portion 13 secured to the upper surface 14 of base 11.
	An opening at an outer rim	Present – the bottle cap 10. OR Absent if a narrower view was taken.
	having a second vertical height that is at least equal to the first vertical height	Present – can be seen from the figures the side wall 12 is longer than the cylindrical member 13.

	the inner threaded cylinder forms a first fluid containing vessel and the outer cylindrical wall forms a second fluid containing vessel	Present – it can be seen that both the cylindrical member 13 and the bottle cap 10 can contain fluid. <u>Claim 1 not novel in view of document 1. OR</u> <u>Claim 1 is novel if narrower view taken.</u>
Claim 2	Outer cylindrical wall extends... upwards to the outer, away from the bottom rim	Absent –the side wall 12 and the cylindrical member 13 extends in the same direction, not away from each other.
		<u>Claim 2 is novel in view of document 1.</u>
Claim 3	Outer cylindrical wall <u>surrounds</u> the inner threaded cylinder and the second fluid containing vessel is <u>defined between the inner threaded cylinder and the outer cylindrical wall</u>	Present – the side wall 12 surrounds the cylindrical member 13 as can be seen in figs. Liquid can be filled up in the region between them. <u>Claim 3 alone not novel in view of D1. but is novel as it is dependent on Claim 2.</u>
Claim 4	Top... attaches..	Absent – No cap is disclosed. <u>Claim 4 is novel in view of document 1.</u>
Claim 5	Volumetric graduations	Present – pg 11 lines 10-11. <u>Claim 5 is not novel in view of document 1.</u> <u>OR Claim 5 alone is not novel in view of D1. but is novel as it is dependent on Claim 1 if narrower view taken</u>

(iv)	Novelty Analysis	Prior Art 2
Claim 1	inner threaded cylinder... closed upper surface and	Absent. Uses cork instead of threads.

	opening at a bottom rim	
	outer cylindrical wall	Present.
	an outer cylindrical wall coupled to the inner threaded cylinder	Present – the whole bottle cap is integrated.
	An opening at an outer rim	Present – drinking glass.
	having a second vertical height that is at least equal to the first vertical height	Present – can be seen from the figure the integrated drinking glass is longer than the portion securing the cork.
	the inner threaded cylinder forms a first fluid containing vessel and the outer cylindrical wall forms a second fluid containing vessel	Absent – there is no inner threaded cylinder. Also only the drinking glass can contain fluid. <u>Claim 1 novel in view of document 2.</u>
Claim 2	Outer cylindrical wall extends... upwards to the outer, away from the bottom rim	Present. <u>Claim 2 alone is not novel in view of D2, but novel as it is dependent on claim 1.</u>
Claim 3	Outer cylindrical wall <u>surrounds</u> the inner threaded cylinder and the second fluid containing vessel is <u>defined between the inner threaded cylinder and the outer cylindrical wall</u>	Absent – drinking glass does not surround the lower portion (cork bottle cap). <u>Claim 3 is novel in view of document 2.</u>

claim 4	Top... attaches..	Absent – No cap is disclosed. <u>Claim 4 is novel in view of document 2.</u>
Claim 5	Volumetric graduations	Absent. <u>Claim 5 is novel in view of document 2.</u>

(v)	Inventive Step	
Claim 1	It is not novel because of Document 1	Not inventive.
Claim 2	Since claim 1 is not novel over D1, but claim 2 is, can a PSA combines it with D2 to render claim 2 to be obvious? With this conclusion, candidate needs to evaluate the inventive step using D1 alone, and D2 alone.	<u>Combined document 1 and 2</u> Starting with D1, a PSA would not amend the outer wall to extend in the opposite direction as taught by D2, as doing so would go against the object of D1. If we start with D2, a PSA would not change the cork bottle cap to threaded cap as taught by D1, as doing so would forfeit the advantages of D2. Hence a PSA would not combine D1 and D2 together. <u>Document 1</u> The 2 downward extending outer and inner walls were designed to allow both chambers to contain liquid at the same time. If the outer wall extends in the opposite direction from the inner wall, this will not be possible. Hence doc 1 teaches away from the subject matter of claim 2. <u>Document 2</u> The use of cork as bottle cap has its advantages of maintaining the desired air-wine ratio. Hence a PSA will not amend that to a threaded bottle cap to arrive at the invention. <u>Therefore Claim 2 is inventive.</u> Alternate: If candidate provides reasonable arguments that D1 and D2 can be combined. Same marks awarded as above. <u>Therefore Claim 2 is not inventive</u>

Claim 3		Yes – but this will not catch the infringing product. So no marks given for this analysis
Claim 4		Yes - Marks given for reasonable analysis of this as a possible fall back if claim 2 fails (and as choice of amendment if the alternative view above is reached). Neither D1 nor D2 provides any teaching that a cover is to be provided. Also for D1, it is impossible to provide a cover for the cap, otherwise the bottle cannot be sealed/closed
Claim 5		No – and this will not catch the infringing product. So no marks given for this analysis

	Alternatively, if candidate took a narrower view of Claim 1.	
Claim 1	Since claim 1 is novel over D1 and D2, is claim 1 inventive over D1 and D2 taken alone or combined?	<u>Same analysis above for claim 2</u> <u>Therefore claim 1 is inventive.</u>
Claim 2		Yes – conclusion the same since the same interpretation was taken for Claim 1 and Claim 2.
Claim 4		Yes - Marks given for reasonable analysis why this is inventive. Neither D1 nor D2 provides any teaching that a cover is to be provided. Also for D1, it is impossible to provide a cover for the cap, otherwise the bottle cannot be sealed/closed.

(vi)	Miscellaneous	
	Summary of the analysis	Summary of whether patent covers infringing product, whether it is valid over prior art. Proposal of strategies for post-grant amendments to overcome validity objections and still cover infringer. Explanation on why this will improve the situation for Mr. Client.
	Is the patent in force?	Need to check if patent is still in force; ensure renewal fees are paid
	Sending patent to bartender	Explanation whether this is a threat? Just passing the patent only or there is a threat of proceedings? Is the bartender making or importing the infringing product?
	Who can client sue?	Bartender/boss – Yes since this is “using” and “importing”. Supplier of the bottle cap – yes since this is “importing”. Note: Only one of boss and Supplier can be importer. Can sue the supplier of the cover? Is there a possibility of contributory infringement? Maybe under joint tortfeasor. Did the supplier acted in concert with the primary tortfeasor pursuant to a common design?
	Available remedies?	- Declaration - Damages - Account of profits - Injunction - Delivery up Explain which of the available remedies are relevant.
	Client possible strategies/actions	Reasonable suggestions such as collecting evidence, warning letter (but avoid threat), negotiating a license, etc.