

**MODEL ANSWER  
PATENT LAW – FALL 2019**

**ESSAY – CLEAR-A-SKIN V. MUELLER AMERICA**

**VALIDITY**

**A. Pre-AIA 102**

Claim 1 is likely anticipated by the “Regency” wood treatment advertisement. The printed publication discloses each element of Claim 1 – a composition of equal or near equal parts of the same five ingredients. *In re Robertson*. Maria will argue that the publication fails to disclose the use of the composition for tattoo removal, but this limitation is not read into Claim 1. Rather, the use for tattoo removal within the preamble is non-limiting. Maria will also argue that the printed publication does not disclose the “near equal” aspect of Claim 1. Scientifically speaking, “equality” in weight necessarily involves a given amount of imprecision, however slight it may be. Therefore, a person of ordinary skill in the art would recognize that a teaching of “near equal” is inherent in the article’s teaching of “equal.” *In re Robertson*. Claim 1 is therefore anticipated.

Mueller America will assert a violation of 102(b) because members of Maria’s survivor group used Clear-a-Skin by September 2006, more than one year before Maria’s filing date. The argument would be that there was public use of the composition of Clear-a-Skin (Claim 1), the method of applying it (Claim 2), and the method of preparing it (Claim 3), even though Maria did not disclose how to make and apply it. Unlike the corset springs in *Egbert*, Maria imposed an obligation of secrecy on the composition of Clear-a-Skin. While there was no written confidentiality agreement, Judge Hand has previously indicated an explicit agreement is not necessary. Claim 1 was therefore not in public use. There was arguably no obligation of secrecy on Claims 2 and 3 because Maria never disclosed these methods. *Metallizing Engineering*. If a court takes that position, Claims 2 and 3 would be considered to be in public use.

Maria would argue that she made a good faith attempt to test whether the composition worked on someone other than herself and how much of it was required to be effective. However, Maria did not retain control of experimental methods or results. She provided no possible dosages and did not observe the effects directly. Instead, she waited for notes from her test subjects, like the

inventor did in *Brunswick*. The experimental use exception does not apply and Claims 2 and 3 are subject to the public use bar.

The on-sale bar of 102(b) does not apply here due to the \$1 exchange. While Clear-a-Skin's composition (Claim 1) and method of preparation (Claim 3) were ready for patenting through an actual reduction to practice, there was no commercial offer for sale. *Plaff*. The \$1 Maria received from each support group member was not consideration given in exchange for practicing the invention. Maria simply wanted to see who was serious about testing Clear-a-Skin for her. Note that the on-sale bar would not apply to the method of Claim 2 in any event because it was not ready for patenting.

Mueller America will argue that Mueller Beautiful was the first to invent under pre-AIA 102(g) because Maria concealed or suppressed her invention. But Mueller Beautiful's product was made outside of the United States. Mueller America will also argue abandonment under pre-AIA 102(C), but Maria's inactivity in filing the patent application did not evidence abandonment. In *Peeler*, an applicant's delay of four years amounted to suppression or concealment but not abandonment. Here, Maria's delay is far shorter than four years.

It would be helpful to know if any of Mueller Beautiful's products made it into the United States and were used or sold between October 15, 2006 and October 19, 2006, which would be more than one year before Maria's filing date. If so, this would affect the validity of Claim 2 under 102(b).

## **B. Pre-AIA 103**

Mueller America will argue that it would be obvious to apply the five-ingredient paste to the human body to remove tattoos (Claim 2). An analysis in accordance with the *Graham* framework will be helpful here. Obviousness will be determined with respect to the time of Maria's invention. An actual reduction to practice took place on December 15, 2006 because Maria knew her method worked for its intended purpose. Before this date of invention, the prior art included the wood treatment publication which disclosed the five-ingredient composition used in Claim 2. There does not appear to be a second prior art reference. Because Mueller Beautiful's products were on sale outside the country, they will not be considered prior references. Given that only a single prior art

reference is at issue, Claim 2 is likely not obvious. Assuming *arguendo* that the single reference was sufficient, Claim 2 adds a new use for the composition, as well as a new way of applying it. In determining the level of ordinary skill in the art, Maria would argue for a lower standard, similar to her limited education when she started experimenting. Mueller America would opt for a more skilled and educated person. A court will also ascertain the current technology for tattoo removal and how quickly it is progressing. Maria may argue that there are no painless tattoo removal methods in existence aside from her cream and her result was unexpected. There also appeared to be a long-felt need for painless tattoo removal. In addition, her invention was not a predictable use of the prior art elements. *KSR*. All in all, it is unlikely that a person having ordinary skill in the art would find it obvious to apply the composition disclosed in the wood treatment publication to the human body to remove tattoos. Moreover, it would not be obvious to use the composition with the specific dosages provided in Claim 2. Claim 2 is therefore non-obvious.

Mueller America will also argue that Claim 3 is obvious. We once again revisit the *Graham* inquiries. The date of invention for Claim 3 appears to be August 30, 2006, the day that Maria actually reduced to practice each and every aspect of the method of Claim 3. Before this date, the prior art included the wood treatment publication—which disclosed the five-ingredient composition in a field outside of tattoo removal—and the British journal article—which disclosed fine particle grinding of pastes in no specific field of art. Claim 3 does not differ from the wood treatment publication in terms of composition, but it teaches additional steps involving a liquid nitrogen bath and fine particle grinding. Similarly, Claim 3 differs from the British journal article disclosure through the liquid nitrogen bath and the five-ingredient paste. A person having ordinary skill in the art may think it obvious to subject the five-ingredient composition to fine particle grinding method. However, it is not readily apparent whether he or she would find it obvious to implement a liquid nitrogen bath. It would be helpful to know whether the state of the art in fine particle grinding involved cooling the mixture prior to grinding. Perhaps use of the liquid nitrogen bath yielded a predictable and expected result. After all, cooler materials are easier to break into smaller pieces. If so, Claim 3 may be obvious. While a court will consider secondary factors, the only relevant one is Maria's commercial success. A court will probably find that Claim 3 is obvious.

## **INFRINGEMENT**

### **A. DIRECT INFRINGEMENT**

Mueller's Miracle Cream appears to literally infringe Claim 1 of Maria's patent. It encompasses each and every element of Claim 1: a composition of equal or near equal parts of the same five ingredients. Note that "near equal" will have to be construed by a court, and the composition of Miracle Cream will be compared to said construction. Assuming the compositions are exactly equal, Claim 1 is literally infringed. The claim is open-ended, so the addition of aloe vera does not change the outcome.

Mueller America will argue that it does not directly infringe Claim 2 because its consumers use the product. But Mueller America may have tested Miracle cream before selling it. If the testing involved applying ½ teaspoon 5 times per day for 3 days, Mueller America would not literally infringe Claim 2. However, by using more frequent dosages over a shorter span of days, Miracle Cream arguably performs the same function as Clear-a-Skin and achieves the same result as Maria. It also does so in substantially the same way—application of the substance in a given dosage per 3 inch square area. The differences here are insubstantial. *Winans*.

Mueller America will assert that Maria is estopped from claiming the differences are immaterial because of the amendments she made to Claim 2. A court will presume that the amendment was related to patentability and she will have to rebut the presumption. Unfortunately for Maria, the amendment she made to Claim 2 was not cosmetic. She made the change to secure the patent and actively chose to narrow the scope. *Festo*. If Maria disagreed with the examiner's finding of indefiniteness, she could have explained her disagreement in the response, and she may have appealed a final office action. She is therefore estopped from claiming that the application amount of Claim 2 is an immaterial difference. Mueller America consequently did not directly infringe Claim 2.

Maria will correctly assert that Mueller America literally infringes Claim 3 by producing Miracle Cream. Mueller America's preparation of Miracle Cream encompasses every element of Claim 3: equal combination of the five ingredients, a liquid nitrogen bath, fine particle grinding, and creating a creamy mousse-like texture (cream). Mueller America's argument that it uses a different preparation heat and time does not change this analysis because these limitations are not read into Claim 3. Mueller America literally infringes Claim 3.

## **B. SECONDARY INFRINGEMENT**

Maria will claim that Mueller America actively induced infringement of Claim 1 and Claim 2. This would require Mueller America to have actual knowledge that its actions would induce actual infringement. *SEB*. Mueller America knew about Maria's patent by November 15, 2009 when it received a copy. Mueller America also know that consumers would literally infringe by using a composition that encompasses every element of Claim 1. Consumers would also literally infringe Claim 2 if they failed to follow Mueller America's application instructions and instead followed the application method of Claim 2. If Mueller America argues they did not have actual knowledge of consumers using the method of Claim 2, a court will find there was knowledge under the doctrine of willful blindness. Mueller America believed there was a high probability that consumers used the method of Claim 2 and deliberately avoided learning about it. Maria can therefore claim Mueller America actively induced infringement.

Maria will also assert contributory infringement of Claims 1 and 2. In other words, she will argue that Mueller America imported and sold Miracle Cream in the U.S. knowing it was adapted for use in infringement. As discussed above, there was direct infringement of Claims 1 and 2. As of November 15, 2009, Mueller America knew that Miracle Cream could be used by consumers to infringe Claims 1 and 2. Mueller America would argue there was a lack of intent to infringe the patent because Miracle Cream was imported and sold before Maria's patent issued and thus not *adapted for use in infringement*. But after Mueller America learned of Maria's patent, Miracle Cream continued to be sold and was adapted for use in infringement. It was also not a staple article. Maria can therefore claim contributory infringement.

Note that there is no secondary liability for Claim 3 because Mueller America does not enable consumers to prepare the composition themselves.

Mueller America will be unsuccessful in arguing that it had a good faith belief of non-infringement. The addition of aloe vera does not amount to a non-infringement of Claim 1. Additionally, given that consumers do not always follow instructions, Mueller America did not have

a good faith belief of non-infringement for Claim 2. Lastly, Mueller America's belief regarding the validity of Maria's patent does not change this analysis. *Commil*.