Mock Argument – PTO Day

By Megan Raymond with Paul Weiss

Most or all of the concepts below will probably be new to you. Don't worry, we will talk more about all of this on PTO day! The purpose of this exercise is to make arguments about why an invention is patentable (valid) or not patentable (invalid). The invention relates to a "crustless sandwich."

Background

Intellectual property (IP) refers to creations of the mind, that is, inventions, books, art and symbols used to market, protect, or promote products and services. A patent is a type of IP granted by the U.S. government to an inventor that describes an invention in detail. At the end it contains "claims," which tell the world exactly what the inventor claims as the invention. If anyone makes or sells the exact thing in the "claims" before the patent expires, the inventor can sue them for patent infringement. .

The U.S. government will grant a patent for a machine, manufacture, process, or composition of matter if it meets three criteria: (1) novelty, (2) non-obviousness, and (3) utility. The non-obviousness requirement presents the biggest hurdle for most inventors. Our fact pattern below will focus on both the novelty and non-obviousness requirements.

The Invention

In 1995, two employees at the J. M. Smucker Company came up with a food product made by sealing peanut butter and jelly between two layers of bread using crimped edges. Once crimped, the bread crust was removed, creating a crustless sandwich. This invention solved a longstanding problem: having undesirable crust on peanut butter and jelly sandwiches.

Smuckers mass produced the product and sold it under the name "Uncrustables." It was a great commercial success as a result of this feature. Parents no longer had to fight with their children about crusts on sandwiches or spend time cutting the crusts off. In 2018, Smuckers sells more than $100 milllion per year of Uncrustables sandwiches. Smuckers filed for a patent in 1995, and the Patent Office awarded them one in 1999: U.S. Patent No. 6,004,596.

As mentioned above, a patent is a document that describes the invention, in detail. In this case, for the purpose of the exercise, the Smuckers patent claims as the invention the following:

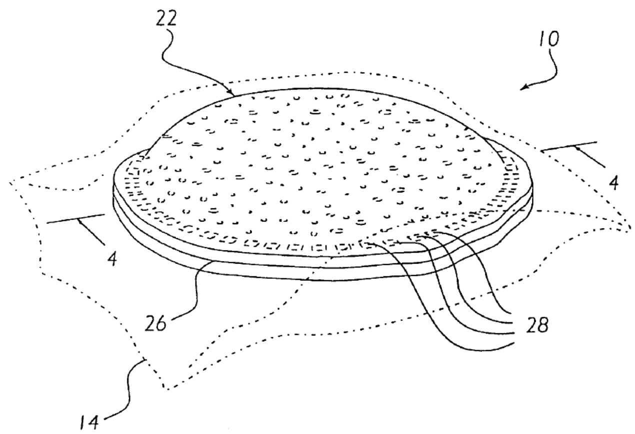
A sealed crustless sandwich, which includes:

a first piece of bread with a perimeter;

a second piece of bread with a perimeter and covered with peanut butter and strawberry jelly;

a crimped edge between the two perimeters of the two pieces of bread for sealing the peanut butter and jelly between the two pieces of bread where the crust of the bread has been removed.

This is a drawing in the patent showing what the Uncrustables sandwich looks like:



The Infringement

In 2001, a caterer in Michigan started selling "sealed crustless sandwiches" through a supermarket chain called Albie's. Smuckers found out that Albie's was selling sealed crustless sandwiches and sent them a letter arguing that Albie's was infringing Smuckers' patent. The letter told Albie's to stop selling the product immediately, or Smuckers would sue for patent infringement. Albie's fought back, arguing that pocket sandwiches with crimped, crustless edges were a traditional food in Michigan called a "pasty" or Danish (see below) that had been around since 1800.

What is Validity?

To get a patent, the claimed invention must have been new, and not "obvious" (different enough from what was already known) when Smuckers filed for a patent. In this example, if Smuckers' patent claims something that already existed or isn't different enough from what was already known, then the patent will be "invalid." If Smuckers' patent is invalid, then Smuckers cannot sue anyone for infringing it.

How do you know whether the claimed invention was "known" or different enough from what was known? In patent law, we look at documents and evidence from the past (called "prior art"). There are two types of arguments people make in patent litigation to argue that "prior art" makes a patent invalid.

One is that the exact thing the patent claims cover already existed before the patent was filed. The legal word for this is "anticipation." Looking at the claims, if there is document from before 1995 showing or describing the specific "sealed crustless sandwich" in the claim (quoted again below), then the claim is invalid for "anticipation" because Smuckers cannot have a patent for something someone else already invented.

> A sealed crustless sandwich, which includes:
>
> a first piece of bread with a perimeter;
>
> a second piece of bread with a perimeter and covered with peanut butter and strawberry jelly;
>
> a crimped edge between the two perimeters of the two pieces of bread for sealing the peanut butter and jelly between the two pieces of bread where the crust of the bread has been removed.

The other argument is that even if there is no single document showing the exact "sealed crustless sandwich" with the exact details in the patent claims, any differences between the claims and what already existed would have been "obvious." In other words, even if no one had made that exact sandwich before, the sandwich is close enough to what existed before that it's not an "invention" or the sort of breakthrough that deserves a patent.

So, in this example, Albie's argued that sealed, crustless sandwiches had been around since the 1800s (pioneer days), were the same product as that described in Smucker's patent claims, and therefore "anticipated" Smuckers patent claims.

Smuckers could respond that prior sealed, crustless sandwiches were actually different from the Uncrustable product because (1) traditional Danishes were made with pastry not bread and (2) traditional Danishes were not filled with peanut butter and jelly, which is generally used in sandwiches. The claims require "bread," "peanut butter," and "strawberry jelly," so a Danish from the 1800s can't "anticipate" Smuckers' patent.

In response to this argument, Albie's could argue that even if Danishes were different for those reasons, Smuckers' patent is obvious, because (1) substituting pastry with sandwich bread would have been obvious and (2) substituting apple-filling with peanut butter and jelly would have been obvious. Because peanut butter and jelly sandwiches were well-known, it would have been obvious to combine what people like about peanut butter and jelly sandwiches with what people like about Danishes.

The Mock Problem

<u>Team Smuckers</u> will be arguing that the patent is novel and not obvious. <u>Team Albie's</u> will be arguing that the patent is not novel (anticipated) and/or is obvious. In this problem, you will make arguments based on the following four pieces of "prior art" (though you may make arguments as to whether the "art" (documents) below is really "*prior* art"):

(1) Document #1: A recipe book from 1963 explaining how to make empanadas filled with peanut butter and jelly.

(2) Document #2: An edition of Life Magazine from 1950 explaining that peanut butter and grape jelly sandwiches are a good and cheap source of protein.

(3) Document #3: An advertisement from 1970 for strawberry jelly.

(4) Document #4: A book from 1985 that describes a crimping machine for metal. The machine folds over the ends of two layers of metal like the seam of your jeans and then presses the edges together. This folding and pressing holds the two layers of metal together.

A. For this mock problem, you may argue:

Team Albie's: You may argue that Document #1 describes the Uncrustables invention. Take each element of the Uncrustables invention and explain how it was already known based on what Document #1 describes. You may also argue that the Uncrustables invention would have been obvious based on Documents # 2, 3, and 4 *in combination*. Explain how and why you would combine Documents #2, 3, and 4 to come up with the Uncrustables invention. You may also argue from the various questions presented below.

Team Smuckers: You may argue that Document #1 does not describe the Uncrustables invention. Identify a difference between Document #1 and the Uncrustables Invention. You may also argue that it would not have been obvious to combine Documents # 2, 3, and 4 to come up with Uncrustables Invention. Consider why no one thought of the Uncrustables invention before 1995. Consider the problems you might encounter when combining Documents # 2, 3, and 4. You may also argue from the various questions presented below.

B. Questions and Considerations

Do you think the Uncrustables product is inventive?

Did your opinion change after coming up with your arguments?

Do you have a sense of who should win the argument (e.g., based on fairness)?

What things did you consider when you were coming up with your arguments?

What gave you the most trouble in coming up with your arguments?

Which argument did you think was better: anticipation based on Document #1 or obviousness based on the combination of Documents #2, 3, and 4?

What evidence did you wish you had that was not part of the prior art?

How could Smuckers have claimed their invention to avoid the prior art?

Does it matter that the Uncrustables product was "commercially successful"?

Does it matter that the Uncrustables product solved a long-felt unmet need?

For anticipation, does it matter that the empanada describes jelly, but not strawberry jelly in particular?

For obviousness, the prior art has to be (1) from the same field as the claimed invention or (2) be relevant to the problem faced by the inventor. Does it matter that Document #4 involves metal, not bread or pastry? Is the metal crimping machine relevant to the problem faced by the inventor in sealing the Uncrustables sandwich? Would the crimping described for metal work on a peanut butter sandwich?

For obviousness, the art (4) is from the metal arts and (2) and (3) are related to food. For obviousness, where one is combining multiple pieces of art together, there has to be a reason to combine. You cannot start with the invention and work backwards. You have to put yourself in the place of what people thought back when the patent application was filed. Here, we are combing art (2), (3), and (4) for obviousness. Does it make sense to combine a piece of art about metal with art about food? Why or why not?

Does it matter that Document #3 only talks about strawberry jelly, as opposed to grape jelly? Does the claim from the '596 patent specify which type of jelly must be used?

What does "edge" mean in the patent claims? Can you come up with a way to define "edge" that makes the patent claim anticipated, not anticipated, obvious, or not obvious? (Imagine you can write your own dictionary definition. What would it be?)

What does "crimping" mean in the patent claim? Can you come up with a way to define "crimping" that makes the patent claim anticipated, not anticipated, obvious, or not obvious?

What does "covered" mean in the claims?

For obviousness, one has to consider the differences between the prior art and the invention. What are those differences?

For obviousness, it must be reasonable to expect the combination of art would to accomplish the invention described in the patent claim. Does the claim require the jelly not leak out? Would it be reasonable to expect the crimping described for the metal crimping machine to work on a peanut butter sandwich? Would it reasonably be expected to hold in the jelly?

If the patent claim is invalid, but you could change the patent claim and add more words, is there some language you might add to it to make the patent claim not anticipated or non-obvious?

Obviousness requires that one have a reason to change and combine the prior art to end up at the invention. Is there a reason that would have prompted one to change from using peanut butter and grape jelly to peanut butter and strawberry jelly in combining (2), (3), and (4)? (For instance, can you come up with an argument about taste or cost?)

For anticipation, what are the arguments for and against the empanada having two pieces of bread?

Prior art has to have been reasonably available to someone looking for it before the date of the invention. Are references (1)-(4) above actually prior art? You know the date stamped on the references, but does that mean it was available to someone looking for it? How would they have found it? If it has a date on it, does that mean someone could actually access it? What would you want to know?

What might you argue in terms of the crust being removed as it compares to the prior art?