

Analysis of November 3rd 1999 PTO Exam

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General Comments: All in all a good exam in terms of difficulty and length. The same issues were tested again in the same ways. It seems the PTO wants you to know PTO procedure as set forth in the MPEP to a certain degree, then you'll get a number. Many more claim questions than in the April 1999 exam. Personally I am glad to see it. Claiming is the essence of being a patent agent/attorney and should be the skill which is tested the most.

I only found two or three bad questions, and two of those were repeats. The PTO itself threw out a few. All in all a good effort by the PTO.

NOTE: This analysis is to be read in conjunction with the answers provided by the US Patent and Trademark Office for this exam. The PTO explanations were quite good and there is no need to be redundant. On a few questions I have supplemented the PTO comments.

MORNING SESSION

- 1) Straightforward Design question. If you knew the difference between Utility and Design Patents, this one was easy.
- 2) The 103 question. You do not need to have the same motive as the inventor to combine references. You just need to have the same result.
- 3) Straightforward question of incorporation by reference. Simple reasonableness suggests that you can not incorporate "essential material" from references that are not reliably available.
- 4) Good trick question. Remember that product-by-process claims are almost never correct on this exam or in real life. In addition, this was a give away on the issue of using trademarks and tradenames in a claim. Claim 2 was wrong for many reasons and (B) and (D) set forth at least two of those reasons.
- 5) Classic After Final under rule 116 question. Of course (D) was the only thing Jack could do. Know the rule, know the answer.
- 6) Pretty funny. It was obviously meant to be an "antecedent basis" question. But it went awry.
- 7) A repeat of question 5. So, a repeat of the analysis. To Wit: know the rule, know the answer.
- 8) Can you ever add new matter to an application? NEVER! But you can move information from the original claims (a part of the specification) to the description portion of the specification.
- 9) A dependent claim must further limit a claim from which it depends. See both 112 and CFR 1.75. Claim 4 broadens Claim 1.
- 10) Kind of a fun one. Notice the claim numbering flaws and the answer jumps out at you. In addition, you have to know a proper from an improper multiple dependent preamble.
- 11) Wow! A question about professional conduct. Fortunately, you didn't have to know the rules to pick the answer. Remember, don't lie, cheat, or steal, or engage in conduct which seems like you should do any of these.

- 12) Remember, you can not antedate a 102(b) reference no matter if you have the dates. It is a bar which can not be overcome. 102(e), on the other hand, can be dispatched. Thus (C) is your only answer.
- 13) Understanding the distinction between 102 and 103 is essential to pass this exam. Anticipation means anticipation of everything. Close doesn't count under 102, only in horseshoes.
- 14) A) insufficient specificity. B) five word rule. C) antecedent basis. D) insufficient specificity. I covered all of these. This is easy.
- 15) Ah, the requisite "range" question. This time the issue of further limiting a parent claim is tested. Answer (C) jumps out at you.
- 16) A good question. I had no idea all of these things lead to a transfer of jurisdiction in the Patent Office. This was a look up if you had time or a "Sherlock" or a guess. All of them seemed reasonable to me.
- 17) You can never, ever, broaden claims in a Re-exam. Claiming an invention, in this case the method, not previously claimed is doing exactly that.
- 18) Be suspicious whenever "consisting" is used as the transitional phrase. It is terribly limiting, and nothing may be further added to the combination. Not even with a dependent claim.
- 19) This is a repeat of question 2. Thus the same analysis applies. The Patent Office needs to arrive at the same invention, not necessarily for the same reasons, to make a 103 rejection.
- 20) Our old friend "antecedent basis". I told you they would be picky and it would be a tedious question when this issue was tested in this way. I love to be right!
- 21) Prior patents and printed publications only. Everything else is an act or an affidavit and thus does not qualify for Re-exam rejections.
- 22) You can NEVER enlarge the scope of a claim in a Re-exam. Remember Re-issues which do enlarge the scope must be on file within two years of issue.
- 23) Everyone would hope that their initial failures would not be held against them. Sadly, even failures on sale more than one year prior to filing result in statutory bars against a later effort to claim an improvement. Claims 1 and 2 simply won't make it, and it certainly wasn't "experimental".
- 24) Ha Ha. This is too easy. Two for the price of one.
- 25) You can have as many as you can pay for. Like so many things in life, the PTO is also for sale!
- 26) The issue is the threshold decision of whether to grant a Re-exam. In this instance the prior art must be new. (B) is tricky because it speaks to an issue that is occurring after this threshold decision has been made.
- 27) (B) is the best of a group of truly lousy answers.
- 28) Product-by-process claims make great exam question fodder. Remember that these types of claims are not wrong, they are just unusual and almost always tricky. (C) and (D) are good product-by-process claims.
- 29) If you know 102, you know this answer. A sale is a sale is a sale, whether anyone else knows about it or not.

- 30) Remember that you can get a filing date without paying any money at the time you file. You can always pay later, even if that circumstance arose through a mistake. Here you simply have to pay money to atone for your error. This payment of money to atone for mistakes is a common theme at the Patent Office.
- 31) The requisite claim counting question. Of course, you are claim counting machines, so this was easy.
- 32) If all of the stuff you propose to call an application arrives on the same day, then it can all count as being a part of the same disclosure. You can arrange all of the “stuff” later into a more usual format for an application.
- 33) I guess they really want you to know that you can NEVER broaden claims in a Re-exam. This is the third question in this section that tests this issue.
- 34) This is a lousy question. But the answer is one of those “direct quote” factual scenarios out of Chapter 2100 which I told you to read three times (at least) and to highlight and dog-ear. As a result of this thorough reading, you doubtless got this question correct.
- 35) They test this every other year or so. Repeat after me, “No maintenance fees are due for Design Patents or Plant Patents.”
- 36) Ah, the interpretation of the range question. If you could do this you could see that (C) is correct and all the others have some defect.
- 37) The old “fill-in-the-blank” antecedent basis question. Picky, picky, picky. I told you to be ready for this.
- 38) A simple look-up of the requirements for a retroactive filing license petition. If you could use the index to your MPEP, you got this question correct.
- 39) Polyol always shows up somewhere. Product-by-process is almost always wrong as it was here. If you could distinguish product-by-process from method, you also got this one right.
- 40) This question is a repeat from 1997 or 1998. If you remembered the question, you should have remembered the answer. (A) has an improper preamble. (B) adds a “step” to an apparatus. (C) attempts to add something to a claim that has a transitional phrase using “consisting essentially of”. (D) does the same thing as (C). In a past analysis I said this was a lousy question because “consisting essentially of” didn’t strictly eliminate the addition of the aluminum. However, since it is a repeat question, you can’t really complain that they changed the standard on us. Just like last time, it has the same lousy answer.
- 41) Repeat after me, “Exemplary language in a claim is indefinite.”
- 42) If you don’t need a drawing, you do not have to have one.
- 43) This is a straightforward factual scenario for a petition to revive.
- 44) This question is unclear with respect to what it asks. However, Sherlock gives you a chance to answer because (A), (B), and (D) are all essentially the same, leaving (C) as the answer.
- 45) You can NEVER recapture what you have given up to avoid prior art.

- 46) Ah, the “amendment format” question disguised with other issues. The other issues dominated the question, but the answer would have been the same anyway. Also, a preamble is not given any weight unless it breathes meaning into the claim.
- 47) A gift. The PTO has two such gifts in this section.
- 48) The drawings are a part of the disclosure. If you remembered that this question was easy.
- 49) The “best mode” has to be present but it does not have to be identified as such.
- 50) This is a repeat question. If you underlined “must” you got this question right because (D) was the only answer corresponding to this “must” combination of elements.

AFTERNOON SESSION

- 1) If you understand 112, 2nd paragraph, this question answers itself. (B) uses exemplary language. (C) uses a composition which is not as broad as in (A) and likewise for (D) and (E).
- 2) This is a tricky question because none of the answers are very appealing. The correct answer (D) involves conduct that is so obviously wrong that it will, of course, not succeed at Patent Office. After this action, the answer then describes remedial steps to correct the incorrect first action. Altogether an unsatisfying answer.
- 3) An examiner can only make a second rejection of the same issues final. In this case the material in claims 11-20 had only been rejected once. Thus the finality of the rejection in a first office action is improper.
- 4) After Final practice is controlled by rule 116. You can always place the case in condition for allowance along with a showing required under the rule. Be careful, though, with respect to the timeframe you try to file a response within. If the case has already gone to the Board, you’re out of luck.
- 5) This question tests both Re-issue practice and the presence of a “must” phrase in the specification. Even in a Re-issue, you can not exceed the scope, or antecedent support, that your specification provides.
- 6) The formula for a method (process) claim is: a destination set forth in the preamble followed by active (“ing”) steps that take you to a destination. (A) and (B) follow the formula, (C) does not.
- 7) I thought we said that Interference practice was not tested. Well, it is. (To a very small degree.) You should really know that the steps to start an Interference include copying the claim of another and telling the Patent Office that you have done exactly that.
- 8) In this question, the correct answer (A) could have been a little clearer. In addition, it is unusual for such a long gap in time to occur between the completion of an invention and the filing. (In this case it was almost five years!) However, you must pick’em as you see’em in 131 affidavit situations. If you have the necessary dates, you win.
- 9) See - you can not really practice Patent Law on behalf of a client unless, of course, you actually are a Registered Patent Attorney. That’s why you’re taking this test.
- 10) Our friend Markush. “Consisting” coupled with “and” or “the element is this, this, or that”. (B) is the only one to meet the formula.

- 11) Calculating response dates from mailing dates and recognizing the good Certificate of Mailing are vital on this test. This question illustrates why. The fact that it was mailed in February made no difference since it was a calendar month calculation.
- 12) The standard of 112 , 2nd paragraph, is that one of ordinary skill should understand the claim. If this person can not, the claim is indefinite regardless of whether the term was used in the specification in the same indefinite way.
- 13) Once again, calculating response dates and understanding that if a response falls due on a Saturday it rolls to the following Monday is essential on this exam. No tricks in this question.
- 14) This is repeat subject matter from a past “afternoon section” exam. If you recognized it, the answer was obvious. If you didn’t, the answer rested on the following: (A) has an improper preamble, (B) broadens the scope of the parent claim, (C) mixes claim types (that is, method and apparatus). That leaves (D).
- 15) You’re doomed. That’s the whole point of a statutory bar.
- 16) Great question! It combines the suspicious use of “consisting” with “range” tricks and careful specification checking. You just had to apply the rules and not be tripped up. However, if all the questions were this tough, we’d have no chance.
- 17) An amendment format question that requires rigorous checking between the instructions and the original claim language. Picky, picky, picky.
- 18) This is the fourth question on this exam which tests the is sue that you can NEVER broaden claims in a Re-exam and that a Re-issue which does broaden has to be filed within two years. They must really want you to know this!
- 19) Tough question. If you had a chance to look it up you got it right. Your only other chance was to know Design Practice cold.
- 20) What a mess! And, even after the solution; still a mess.
- 21) A pending application, regardless of its origin (that is, CIP, CPA, divisional, or substitute) is not open to the public. All the other answers are.
- 22) If you carefully read the call of the question, this was straightforward. The second multiple dependent claim is improper and takes out any claims depending therefrom.
- 23) Phrases used in the claims must be supported by the specification. There are no exceptions.
- 24) This question pulls many issues from 1.75 together and is a good question. Claim 4 fails because of antecedent basis issues and claim 5 fails because it is broader than its parent claim.
- 25) To get a filing date you need a specification and drawings (where necessary) and at least one claim. Everything else can be supplied later. In this case, you needed the drawings to get a filing date. The earliest date is the date the drawings arrived, namely, September 15, 1999.
- 26) This is a repeat question. I didn’t like it the first time and haven’t warmed up to it yet. I do not agree with the “negative limitations” in (C). But since it is a repeat, at least they haven’t changed signals on us. It has the same lousy answer as last time. So pick it and be done with it.
- 27) Great question! It turns on the call of the question, ie, who signs the oath. Of course it is the inventor who signs the oath. The others are owners, not inventors.

- 28) The inventor can make minor adjustments at the time of signing of the oath. But the changes must be initialed. If you practiced or examined this was an easy one, if you didn't it was a toughie.
- 29) Not a very good question. Terms are given their ordinary meaning in most instances. This suggests a rather complex and far fetched situation. (A) is the best answer, because the others are obviously wrong. But it isn't a very satisfying answer.
- 30) A repeat from long ago. PTO staff are the only ones that can be stopped. I personally, and based on historic principle, would like to see British subjects declared ineligible. (Just kidding!)
- 31) Our friend PCT. 102(E) = fee, oath, translation. That date is August 3, 1998, since the oath and translation followed the fee, that was paid earlier on June 2, 1998.
- 32) This is a text-book use of a Re-exam proceeding.
- 33) These facts are interesting in that you expect a "same invention double patenting rejection" but because the first application doesn't make the claim it can be overcome by a terminal disclaimer with all the usual requirements (common ownership and expiration).
- 34) Great question! Naturally occurring substances, mixing claim types, silly claims (hoped for results), mathematical formulae. Sometimes they really use their imagination! None of this stuff is patentable.
- 35) Second question on this exam on this subject. The original claims are a part of the original specification and can be relied on as such, even if the answer expresses this awkwardly, it is correct.
- 36) Tough topic awkwardly posed. If you claim too broadly you have exceeded what your specification will support. That is a 112, 1st paragraph, issue. 112, 2nd paragraph, is directed to whether the claim is clear and understandable in light of the specification. Tough to see these issues on these facts. But if you narrow it down to a choice between (C) and (D), (D) is clearly better.
- 37) This question reminds me of the soldering iron questions on my Chapter 2100 practice exam. Stick to what you know. Aside from any electrical circuit intrigue at all, claim 3 tries to broaden a range for whatever it is that is being ranged. Hence, it is wrong. Stick to what you know, and win! I love this stuff!
- 38) They even use the same subject matter as my examples in class. Painting! I love it! Follow the formulae: method = destination in preamble followed by active ("ing") words which take you to the destination. (B) is the only one to follow the formulae.
- 39) Another gift.
- 40) A repeat from a Chapter 2100 question that I went over in class. No excuses here unless you were asleep. We all had great fun laughing at this question; remember?
- 41) Repeat range question. "About" enlarges the scope of the claim compared to the parent claim.
- 42) Too easy. Both in 112 and in rule 1.75. (C) jumps out at you.
- 43) A good question and one that is close to what you'll be doing in practice. Short factual scenarios that test your knowledge of statutory bars. Happens weekly in an average practice. Assignments of rights are not sales of the invention. (C) is the only answers which picks up on that issue.

- 44) Tricky. You have to pick up on the fact that it is G who is being rejected based on H. For that to happen, somehow the PTO has to believe H did something earlier in time. H does in (D), namely he files first thus giving the PTO some basis, as well as common ownership, to make the rejection. Before you pick up on the need for H to have done something earlier, it is tough to distinguish (C) and (D).
- 45) The official PTO answer is not helpfully worded. Of course the claims have to correspond to the specification. Read the claims carefully and you'll see that the preamble of (A) directs it to a toy building element. This element is made up of just two things, the open container and the bottom. But this claim really ought to be unacceptable since the bottom is not connected to the container and nothing in the specification describes a "kit". Hence, the claim really exceeds, on a 112, 1st paragraph basis, the scope of the specification. (B) and (C) are fine claims. In light of this, (E) is really wrong, but no better alternative is available since you can't really pick between (B) and (C).
- 46) Wow, probably the last question on transitional After Final practice we'll see. Pretty much a text book application of the applicable rules. The Appeal Brief is the key here. Once that is filed you're stuck. As for (C), come on, no one would try it after six months has passed. Right? Right?
- 47) Our friend Markush. Remove the offending (rejected) member from the group and you regain the novelty of the remaining members.
- 48) Bizarre series of facts. (A) and (B) are silly if you read them carefully. (C) is just plain wrong, which leaves (D).
- 49) Basically you've got to erase the evidence of your mistake in order to keep the filing date for the rest of the subject matter in the claims. Or, failing that, somehow convince the PTO that the drawing figure really didn't matter and the numerous references to it throughout the specification don't matter either.
- 50) (C) is the best of the lot, and even this answer is not perfect.