

Chapter 2100

Questions

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1. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following statements is most correct?

- (A) The same evidence sufficient to establish a constructive reduction to practice is necessarily also sufficient to establish actual reduction to practice.
- (B) Proof of constructive reduction to practice does not require sufficient disclosure to satisfy the “how to use” and “how to make” requirements of 35 USC 112, first paragraph.
- (C) A process is reduced to actual practice when it is successfully performed.
- (D) The diligence of 35 USC 102(g) requires an inventor to drop all other work and concentrate on the particular invention.
- (E) The diligence of 35 USC 102(g) does not impose on a registered practitioner any need for diligence in preparing and filing a patent application inasmuch as such the practitioner’s acts do not inure to the benefit of the inventor.

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4. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following presents a Markush group in accordance with proper PTO practice and procedure?

- (A) R is selected from the group consisting of A, B, C, or D.
- (B) R is selected from the group consisting of A, B, C, and D.
- (C) R is selected from the group comprising A, B, C, and D.
- (D) R is selected from the group comprising A, B, C or D.
- (E) R is A, B, C, and D.

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17. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following is true?

- (A) A claim to a process omitting a step in a disclosed process, where the step is disclosed in the specification to be essential to the invention, may not be properly rejected under 35 USC 112, first paragraph, for lack of enablement where the specification provides an enabling disclosure only for the process which includes the essential step.
- (B) Failure to disclose the best mode must rise to the level of active concealment or grossly inequitable conduct in order to support a rejection under 35 USC 112, first paragraph.
- (C) A claim failing to interrelate essential elements of the invention, as defined by the applicant in the specification, where the interrelation is critical to the invention may be properly rejected under 35 USC 112, second paragraph, for failure to properly point out and distinctly claim the invention.
- (D) Where the best mode contemplated by the inventor at the time of filing the application is not disclosed, a proposed amendment adding a specific mode of practicing the invention would not be new matter.
- (E) The best mode requirement is the same as the enablement requirement of the first paragraph of 35 USC 112.

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18. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following statements is true?

- (A) Where sole patent applicant Able claims his invention in a Jepson-type claim, and the specification discloses that the subject matter of the preamble was invented by Baker before applicant's invention, the preamble is properly treated as prior art.
- (B) Where the sole patent applicant Able claims his invention in a Jepson-type claim, and the specification makes it clear that the claimed invention is an improvement on Able's own prior invention, which Able discovered less than one year before the filing date of the application, the preamble in the claim is properly treated as prior art.
- (C) Where the sole patent applicant Able claims his invention in a Jepson-type claim, and the specification makes it clear that the claimed invention is an improvement on an invention that Able discovered and publicly used and commercially sold by Able in Texas for several years before the filing date of the application, the preamble in the claim cannot properly be treated as prior art.
- (D) Where the sole applicant, Baker, states that something is prior art, the statement can be taken as being admitted prior art only if corroborated by objective evidence proffered by Baker, or found by the examiner.
- (E) No claim, including a Jepson-type claim, carries with it an implied admission that the elements in the preamble are old in the art.

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20. During his summer vacation to the mountains, Eric discovered and isolated a microorganism which secretes a novel compound. Eric purified and tested the compound in tumor-containing control mice and found that the tumors disappeared after one week; whereas tumor-containing mice which did not receive the compound died. Eric was very excited about his results and so he did a few additional experiments to characterize the microorganism and the compound which it was secreting. Eric determined that the microorganism was an *S. spectacularis*, and that the secreted compound was so unlike any other compounds that Eric named it spectaculysem. Eric told his friend Sam about his discovery, who urged him to apply for a U.S. patent on the microorganism and the secreted product. Eric did so, but to his amazement, a primary examiner rejected all the claims to his inventions. Which of the following, if made by the examiner, would be a proper rejection in accordance with USPTO rules and procedures set forth in the MPEP?

- (A) The examiner's rejection of the claims to the microorganism under 35 USC 101 as being unpatentable because microorganisms are living matter and living matter is non-statutory subject matter.

- (B) The examiner's rejection of the claims to the compound under 35 USC 101 as having no credible utility because Eric has only tested the compound in mice and curing mice of cancer has no "real world" value. The examiner also states that Eric must demonstrate that the compound works in humans in order to show that it has a patentable utility.
- (C) The examiner's rejection of the claims to the compound under 35 USC 103, stating that it would have been obvious to one of ordinary skill in the art to test the by product of a newly-discovered microorganism for therapeutic uses.
- (D) The examiner's rejection of the claims to the microorganism under 35 USC 102/103 over a reference which teaches an *S. spectaculus* microorganism stating that Eric's claimed microorganism is the same as, or substantially the same as, the microorganism described in the prior art.
- (E) None of the above.

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21. Assuming that any rejection has been properly made final, which of the following statements is not in accordance with the USPTO rules and the procedures set forth in the MPEP?

- (A) An objection and requirement to delete new matter from the specification is subject to supervisory review by petition under 37 CFR 1.181.
- (B) A rejection of claims for lack of support by the specification (new matter) is reviewable by appeal to the Board of Patent Appeals and Interferences.
- (C) If both the claims and the specification contain the same new matter, and there has been both a rejection and objection by the primary examiner, the new matter issue should be decided by petition, and is not appealable.
- (D) If both the claims and the specification contain the same new matter, and there has been both a rejection and objection by the examiner, the new matter issue is appealable, and should not be decided by petition.
- (E) None of the above.

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22. On January 2, 2001, a registered practitioner filed a patent application with the USPTO for inventor Beck. The application includes a specification and a single claim to the invention which reads as follows:

1. Mixture Y made by the process Q1.

In the specification, Mr. Beck discloses that mixture Y has a melting point of 150° F. On June 2, 2001, the practitioner received an Office action from the primary examiner rejecting the claim. The claim is rejected under 35 USC 102/103 as being clearly anticipated by or obvious over Patent A. The examiner states "Patent A teaches mixture Y but made by a different process Q2." Beck believes he is entitled to a patent to mixture Y. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following would be the best reply to the rejection of his claim?

- (A) An argument that the claimed product has an unexpectedly low melting point of 150° F, supported by an affidavit showing that the mixture Y made by process Q2 exhibits a melting point of 300° F.
- (B) An argument that the processes used by applicant and patent A are different, supported by a third-party declaration stating only that the processes are different.
- (C) An argument that the claimed product has an unexpectedly low melting point of 150° F, supported by a third-party declaration stating only that the products are different.
- (D) An argument that the processes used by applicant and patent A are different, supported by an affidavit showing that the mixture Y made by process Q2 exhibits a melting point of 300° F.
- (E) An argument that the claimed product has an unexpectedly low melting point of 150° F because the claimed mixture Y has a melting point of 150° F and the mixture Y of patent A has a melting point of 300° F.

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30. A patent application includes the following Claim 1:

Claim 1. A method of making an electrical device comprising the steps of:

- (i) heating a base made of carbon to a first temperature in the range of 1875°C to 1925°C;
- (ii) passing a first gas over said heated base, said first gas comprising a mixture of hydrogen, SiCl₄, phosphorus, and methane, whereby said first gas decomposes over said heated base and thereby forms a first deposited layer of silicon, phosphorus and carbon on said heated base;
- (iii) heating said base having said deposited layer to a second temperature of approximately 1620°C; and
- (iv) passing a second gas over said base heated to said second temperature, said second gas consisting of a mixture of hydrogen, SiCl₄, AlCl₃, and methane, whereby said second gas decomposes over said heated base to form a second deposit layer adjacent said first layer, said second layer comprising silicon, aluminum and carbon.

Assuming proper support in the specification, which of the following claims, if presented in the same application, is a proper claim in accordance with the USPTO rules and the procedures set forth in the MPEP?

- (A) Claim 2. The method of claim 1, wherein said first temperature is in the range of 1800°C to 2000°C.
- (B) Claim 3. The method of claim 1, wherein said first gas further comprises an inert gas.
- (C) Claim 4. The method of claim 1, wherein said second gas further comprises Argon.
- (D) Claim 5. The method of claim 1, wherein said first gas is an inert gas such as Argon.
- (E) Claim 6. The method of claim 1, wherein said second gas consists of a mixture of hydrogen, SiCl₄ and AlCl₃ only.

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33. A claim in a pending patent application for an electric toothbrush is rejected under 35 USC 102 as being anticipated by a U.S. Patent, which was issued to Lancer, the sole name inventor, for a similar electric toothbrush. The Lancer patent was issued one day before the filing date of the application in question. The claim in the pending application contains a limitation specifying the location of an on/off switch. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following arguments, if true, would overcome the rejection?

- (A) The Lancer patent discloses and claims an electric toothbrush, but does not mention whether its toothbrush includes a power supply.
- (B) Evidence is submitted to show the electric toothbrush claimed in the application is commercially successful.
- (C) The Lancer patent teaches away from the bristles of the claimed toothbrush.
- (D) Lancer is one of the three named inventors of the claimed toothbrush in the pending application.
- (E) The on/off switch in the Lancer patent is on a different side of the body than that recited in the claim for the electric toothbrush in the patent application.

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34. Inventor files an application containing the following original Claim 1:

1. A widget comprising element A, and element B.

In a first Office action on the merits, a primary examiner rejects claim 1 under 35 USC 103 as being obvious over reference X. Reference X explicitly discloses a widget having element A, but it does not disclose element B. The examiner, however, takes official notice of the fact that element B is commonly associated with element A in the art and on that basis concludes that it would have been obvious to provide element B in the reference X widget. In reply to the Office action, the registered practitioner representing the applicant makes no amendments, but instead requests reconsideration of the rejection by demanding that examiner show proof that element B is commonly associated with element A in the art. Which of the following actions, if taken by the examiner in the next Office action would be in accord with the USPTO rules and the procedures set forth in the MPEP?

- I. Vacate the rejection and allow the claim.
 - II. Cite a reference that teaches element B commonly associated with element A in the art and make the rejection final.
 - III. Deny entry of applicant's request for reconsideration on the ground that it is not responsive to the rejection and allow applicant time to submit a responsive amendment.
- (A) I and II only.
 - (B) II only.
 - (C) II and III only.
 - (D) I, II, and III.
 - (E) I and III only.

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36. Mike and Alice, who are not related, are shipwrecked on a heretofore uninhabited and undiscovered island in the middle of the Atlantic Ocean. In order to signal for help, Mike invents a signaling device using bamboo shoots. Alice witnesses but does not assist in any way in the development of the invention. The signaling device works and a helicopter comes and rescues Alice. However, Mike remains on the island due to overcrowding on the helicopter. Unfavorable weather conditions have prevented Mike's rescue to date. Alice comes to you, a registered patent practitioner, to file an application for a patent and offers to pay you in advance. Which of the following, in accordance with the USPTO rules and the procedures set forth in the MPEP, is true?

- (A) Since Mike invented the invention, Alice cannot properly file an application for a patent in her name even though Mike is unavailable.
- (B) Since Mike is unavailable, you may properly file an application for a patent without his consent. You can accept the money from Alice as payment for the application.
- (C) Since Mike is not available and cannot be reached, Alice may properly sign the declaration on his behalf since she has witnessed the invention and knows how to make and use it.
- (D) Alice should file an application in her name since she has witnessed the invention and knows how to make and use it. Subsequently, when Mike becomes available, the inventorship may be changed to the correct inventorship.
- (E) Even though Mike and Alice are not related, Alice may properly file an application on Mike's behalf.

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41. A claim in a pending patent application is rejected under 35 USC 103(a) as being obvious over Barry in view of Foreman. The Barry reference is a U.S. Patent that was issued on an application filed before the date of the application in question. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following arguments, if true, would overcome the rejection?

- (A) The Foreman reference is nonanalogous art, but the reference may be reasonably pertinent to Barry's endeavor to solving the particular problem with which Barry was concerned.
- (B) The rejection does not address a claimed limitation, and neither of the references teaches the claimed limitation.
- (C) The Barry patent issued after the filing date of the pending patent application.
- (D) The original specification states that the results achieved by the claimed invention are unexpected. (The statement is unsubstantiated by evidence).
- (E) The Foreman patent issued 105 years before the filing date of the pending patent application.

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44. A claim in an application recites “[a] composition containing: (a) 35-55% polypropylene; and (b) 45-65% polyethylene.” The sole prior art reference describes, as the only relevant disclosure, a composition containing 34.9% polypropylene and 65.1% polyethylene. In accordance with USPTO rules and procedures set forth in the MPEP, the primary examiner should properly:

- (A) Indicate the claim allowable over the prior art because there is no teaching, motivation or suggestion to increase the amount of polypropylene from 34.9% to 35% and decrease the amount of polyethylene from 65.1% to 65%.
- (B) Reject the claim under 35 USC 102 as anticipated by the prior art reference.
- (C) Reject the claim under 35 USC 103 as obvious over the prior art reference.
- (D) Reject the claim alternatively under 35 USC 102 as anticipated by or under 35 USC 103 as obvious over the prior art reference.
- (E) None of the above.

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49. An examiner has advanced a reasonable basis for questioning the adequacy of the enabling disclosure in the specification of your client’s patent application, and has properly rejected all the claims in the application. The claims in the application are drawn to a computer program system. In accordance with the USPTO rules and the procedures set forth in the MPEP, the rejection should be overcome by submitting _____ .

- (A) factual evidence directed to the amount of time and effort and level of knowledge required for the practice of the invention from the disclosure alone.
- (B) arguments by you (counsel) alone, inasmuch as they can take the place of evidence in the record.
- (C) an affidavit under 37 CFR 1.132 by an affiant, who is more than a routineer in the art, submitting few facts to support his conclusions on the ultimate legal question of sufficiency, *i.e.*, that the system “could be constructed.”
- (D) opinion evidence directed to the ultimate legal issue of enablement.
- (E) patents to show the state of the art for purposes of enablement where these patents have an issue date later than the effective filing date of the application under consideration.

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50. Inventor files an application for a non-theoretical metal alloy. The application as originally filed contains the following Claim 1:

Claim 1. A metal alloy comprising at least 20% by volume of iron; at least 10% by volume of gallium, and at least 10% by volume of copper.

In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following claims would be properly held indefinite under 35 USC 112(2)?

- (A) Claim 2: The alloy of claim 1 containing 66% by volume of gallium and 14% by volume of copper.
- (B) Claim 2: The alloy of claim 1 containing at least 21% by volume of iron, 11% by volume of gallium, and 10.01% by volume of copper.
- (C) Claim 2: The alloy of claim 1 containing 20% by volume of iron, 10% by volume of gallium, and 10% by volume of copper.
- (D) Claim 2: The alloy of claim 1 containing 54% by volume of copper and 27% by volume of gallium.
- (E) Claim 2: The alloy of claim 1 containing at least 1% by volume of silver.

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2. A U.S. patent application discloses a first embodiment of an invention, a composition made of known materials in equal amounts by weight of A, B, and C. The application discloses a second embodiment of the invention comprising equal amounts by weight of A, B, and C, and an effective amount of D, a known material, to reduce excess moisture from the composition. The application also discloses a third embodiment of the invention comprising equal amounts by weight of A, B, and C, and an effective amount of D to reduce the acidity of the composition. The application fully discloses guidelines for determining an effective amount of D to reduce excess moisture from the composition, and determining an effective amount of D to reduce the acidity of the composition. The application discloses that the amount of D needed to reduce excess moisture from the composition differs from the amount of D needed to reduce the acidity of the composition. Which of the following claims, if included in the application, provides a proper basis for a rejection under 35 USC 112, second paragraph in accordance with the USPTO rules and the procedures set forth in the MPEP?

- (A) Claim 1. A composition comprising: equal amounts by weight of A, B, and C, and an effective amount of D to reduce the acidity of the composition.
- (B) Claim 1. A composition comprising: equal amounts by weight of A, B, and C, and an effective amount of D.
- (C) Claim 1. A composition comprising: equal amounts by weight of A, B, and C, and an effective amount of D to reduce excess moisture from the composition.
- (D) Claim 1. A composition comprising: equal amounts by weight of A, B, and C.
- (E) None of the above.

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3. In accordance with the USPTO rules and the procedures in the MPEP, in which of the following instances is the reference properly available as prior art under 35 USC 102(d)?

- (A) A U.S. patent application is filed within the one year anniversary date of the filing date of the foreign application. The reference is the foreign application.
- (B) The applicant files a foreign application, later timely files a U.S. application claiming priority based on the foreign application, and then files a continuation-in-part (CIP) application, and the claims in the CIP are not entitled to the filing date of the U.S. parent application. The foreign application issues as a patent before the filing date of the CIP application and is used to reject the claims directed to the added subject matter under 35 USC 102(d)/103. The reference is the foreign application.
- (C) The applicant files a foreign application, and later timely files a U.S. application claiming priority based on the foreign application. The examined foreign application has been allowed by the examiner and has not been published before the U.S. application was filed. The reference is the foreign application.
- (D) The reference is a defensive publication.
- (E) All of the above.

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15. Able conceived the invention claimed in a patent application. In conceiving the invention, Able used and adopted ideas and materials known in the art and invented by others. Ben, Able's employee, reduced the invention to practice at Able's request and totally pursuant to Able's suggestions. Being unable to afford a patent practitioner's fees to prepare and prosecute the application, Able convinced John to pay for the practitioner's services in return for an interest in the invention. John did nothing more than provide the funds for the practitioner. Which of the following is in accordance with the USPTO rules and the procedures set forth in the MPEP?

- (A) Able need not be the one to reduce the invention to practice so long as the reduction to practice occurred on his or her behalf. Able can be properly named as inventor in the application.
- (B) To be named an inventor, it is not necessary for John to have contributed to the conception of the invention. Ben, not Able, can be named as inventor in the application.
- (C) In conceiving the invention, Able may not consider and adopt ideas and materials derived from any sources, such as ideas of previous inventors. Able cannot be properly named as inventor in the application.
- (D) John and Able may be properly named as joint inventors of the invention in the application.
- (E) John, Ben, and Able may be properly named as joint inventors of the invention in the application.

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16. Claim 1 of an application recites “[a]n article comprising: (a) a copper substrate; and (b) a electrically insulating layer on said substrate.” The specification defines the term “copper” as being elemental copper or copper alloys. In accordance with USPTO rules and procedures set forth in the MPEP, for purposes of searching and examining the claim, the examiner should interpret the term “copper” in the claim as reading on:

- (A) Elemental copper only, based on the plain meaning of “copper.”
- (B) Copper alloys only, based on the special definition in the specification.
- (C) Elemental copper and copper alloys, based on the special definition in the specification.
- (D) Any material that contains copper, including copper compounds.
- (E) None of the above.

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19. In connection with the utility of an invention described in a patent application, which of the following conforms to the USPTO rules and the procedure set forth in the MPEP?

- (A) A deficiency under 35 USC 101 also creates a deficiency under 35 USC 112, first paragraph.
- (B) To overcome a rejection under 35 USC 101, it must be shown that the claimed device is capable of achieving a useful result on all occasions and under all conditions.
- (C) A claimed invention is properly rejected under 35 USC 101 as lacking utility if the particular embodiment disclosed in the patent lacks perfection or performs crudely.
- (D) To overcome a rejection under 35 USC 101, it is essential to show that the claimed invention accomplishes all its intended functions.
- (E) A claimed invention lacks utility if it is not commercially successful.

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27. On January 2, 2001, a registered practitioner filed a patent application with the USPTO for inventor Bock. The application includes a specification and a single claim to the invention, which reads as follows:

1. A new string consisting only of material Z that has the ability to stretch to beyond its initial unstretched length.

On June 2, 2001, the practitioner received an Office action from the primary examiner rejecting the claim. The claim is solely rejected under 35 USC 102 in view of Patent A, which discloses a string consisting only of material Z. The Office action states, “Patent A discloses a string consisting only of material Z. Patent A does not expressly teach the stretchability property of the string. Nevertheless, the recited stretchability is inherent in the string of patent A. Accordingly, patent A anticipates the claimed string.” Mr. Bock believes he is entitled to a patent to his new string and authorizes the practitioner to reply to the Office action by arguing that his string stretches to ten times its initial unstretched length, something

that patent A does not teach. Since this is not expressly taught in Patent A, the practitioner argues, Patent A cannot anticipate the claimed string. In accordance with USPTO rules and procedures set forth in the MPEP, is the practitioner's reply persuasive as to error in the rejection?

- (A) Yes.
- (B) Yes, but the claim should now be rejected again, this time under 35 USC 103 as obvious over Patent A.
- (C) Yes, because the stretchability property is expressly taught by Patent A.
- (D) Yes, examiner nowhere addresses the claimed limitation of stretching the string beyond its initial unstretched length.
- (E) No.

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29. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following statements regarding operability or enablement of a prior art reference is the most correct?

- (A) The level of disclosure required for a reference to be enabling prior art is no less if the reference is a United States patent than if it is a foreign patent.
- (B) A reference is not presumed to be operable merely because it expressly anticipates or makes obvious all limitations of an applicant's claimed apparatus.
- (C) A non-enabling reference may not qualify as prior art for the purpose of determining anticipation or obviousness of the claimed invention.
- (D) A reference does not provide an enabling disclosure merely by showing that the public was in possession of the claimed invention before the date of the applicant's invention.
- (E) All of the above are correct.

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32. On January 2, 2001, a registered practitioner filed a patent application with the USPTO for inventor Bloc. The application includes a specification and a single claim to the invention which reads as follows:

1. Compound Y.

In the specification, Bloc explains that compound Y is an intermediate in the chemical manufacture of synthetic Z. With respect to synthetic Z, the specification discloses its structural formula and further states that synthetic Z is modeled on the natural form of Z to give it the same therapeutic ability to alleviate pain. The specification goes on to state that synthetic Z is also a cure for cancer. On June 2, 2001, the practitioner received an Office action from the primary examiner rejecting the claim. The claim is rejected under 35 USC 101 as being inoperative; that is, the synthetic Z does not operate to produce a cure for cancer (*i.e.*, incredible utility). Bloc believes he is entitled to a patent to his compound Y. In accordance with USPTO rules and procedures set forth in the MPEP, how best should the practitioner reply to the rejection of the claim?

- (A) Advise Bloc that he should give up because a cure for cancer is indeed incredible and is unproven.
- (B) File a reply arguing that a cure for cancer is not incredible and he can prove it if given the chance.
- (C) File a reply arguing that whether or not a cure for cancer is incredible is superfluous since Bloc has disclosed another utility – alleviating pain, which is not incredible.
- (D) File a reply arguing that the claim is directed to compound Y, not synthetic Z.
- (E) File a reply arguing that synthetic Z is modeled on the natural form of Z.

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34. A first Office action on the merits rejecting Claim 1 under 35 USC 103 as being obvious in view of reference A set a three month shortened statutory period for reply. A registered practitioner files a timely response (without an extension of time) to the first Office action amending Claim 1 to include a limitation not found in reference A or any other prior art of record. However, the limitation also lacks support in applicant's original disclosure, *i.e.*, it is new matter. Which of the following courses of action, if taken by the primary examiner, would be in accord with the USPTO rules and the procedures set forth in the MPEP?

- (A) Hold the application abandoned after expiration of the three month shortened statutory period for reply because an amendment adding new matter to the claims is not a *bona fide* response.
- (B) Consider the new matter and reject Claim 1 under 35 USC 101 because a claim that recites new matter lacks utility.
- (C) Consider the new matter and treat Claim 1, determining whether the invention as claimed with the new matter, would have been obvious in view of reference A, and reject Claim 1 under 35 USC 112, first paragraph, for lack of support in the original disclosure for new matter.
- (D) Ignore the new matter and reject Claim 1 again under § 103 in view of reference A.
- (E) All of the above.

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39. An examiner has properly established a *prima facie* showing of no specific and substantial credible utility for the claimed invention in a patent application filed in February 2001. An applicant can sustain the burden of rebutting and overcoming the showing in accordance with the USPTO rules and the procedures set forth in the MPEP by:

- (A) Providing reasoning or arguments rebutting the basis or logic of the *prima facie* showing.
- (B) Amending the claims.
- (C) Providing evidence in the form of a declaration under 37 CFR 1.132 rebutting the basis or logic of the *prima facie* showing.
- (D) Providing evidence in the form of a printed publication rebutting the basis or logic of the *prima facie* showing.
- (E) All of the above.

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36. Which of the following is not a policy underlying the public use bar of 35 USC 102(b)?

- (A) Discouraging the removal, from the public domain, of inventions that the public reasonably has come to believe are freely available.
- (B) Favoring the prompt and widespread disclosure of inventions.
- (C) Allowing the inventor(s) a reasonable amount of time following sales activity to determine the potential economic value of a patent.
- (D) Increasing the economic value of a patent by extending the effective term of the patent up to one year.
- (E) Prohibiting the inventor(s) from commercially exploiting the invention for a period greater than the statutorily prescribed time.

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41. Evidence that a claim may not comply with the second paragraph of 35 USC 112 occurs in accordance with the USPTO rules and the procedure set forth in the MPEP where:

- (A) Remarks filed by applicant in a reply or brief regarding the scope of the invention differ and do not correspond in scope with the claim.
- (B) There is a lack of agreement between the language in the claims and the language set forth in the specification.
- (C) The scope of the claimed subject matter is narrowed during pendency of the application by deleting the originally much broader claims, and presenting claims to only the preferred embodiment within the originally much broader claims.
- (D) Claims in a continuation application are directed to originally disclosed subject matter (in the parent and continuation applications) which applicants did not regard as part of their invention when the parent application was filed.
- (E) All of the above.

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42. Paprika is a known product. A patent application discloses a composition which is made by subjecting paprika to processing steps X, Y and Z. The composition is disclosed to be useful in treating cancer. The application was filed June 1, 2002. A reference published May 1, 2001 discloses a food product made by subjecting paprika to processing steps X, Y and Z. The reference does not disclose that the resulting composition has any properties that would make it useful for treating cancer. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following claims is not anticipated by the reference?

- (A) A composition made by the process of subjecting paprika to processing steps X, Y and Z, wherein the composition is effective for treating cancer.
- (B) A composition for treating cancer, made by the process of subjecting paprika to processing steps X, Y and Z.
- (C) A method of making a cancer-treating composition, comprising subjecting paprika to processing steps X, Y and Z.

- (D) A method of treating cancer, comprising administering an effective amount of a composition made by subjecting paprika to processing steps X, Y and Z.
- (E) All of the above.

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46. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following is not a “printed publication” under 35 USC 102(b), with respect to a patent application filed June 1, 2002?

- (A) A paper that was orally presented at a meeting held May 1, 2001, where the meeting was open to all interested persons and the paper was distributed in written form to six people without restriction.
- (B) A doctoral thesis that was indexed, cataloged, and shelved May 1, 2001, in a single, university library.
- (C) A research report distributed May 1, 2001, in numerous copies but only internally within an organization and intended to remain confidential.
- (D) A reference available only in electronic form on the Internet, which states that it was publicly posted May 1, 2001.
- (E) A technical manual that was shelved and cataloged in a public library as of May 1, 2001, where there is no evidence that anyone ever actually looked at the manual.

April 15, 2003 PM

49. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following statements regarding claim interpretation during patent prosecution is incorrect?

- (A) A claim is to be given its broadest reasonable interpretation in light of the supporting disclosure in the specification.
- (B) Because a claim is read in light of the specification, the claim may properly be narrowed by interpreting it as including elements or steps disclosed in the specification but not recited in the claim.
- (C) If an applicant does not define a claim term in the specification, that term is given its ordinary meaning in the art.
- (D) When an explicit definition of a claim term is provided in an applicant’s specification, that definition controls the interpretation of the term as it is used in the claims.
- (E) Means plus function language in claims which defines the characteristics of a machine or manufacture includes only the corresponding structures or materials disclosed in the specification and equivalents thereof.

April 15, 2003 PM

50. A registered practitioner files a nonprovisional utility application in 2000. In 2002, the practitioner files a continuation-in-part application and claims benefit of the filing date of the 2000 application for the 2002 application. Thereafter, the practitioner amends the 2002 application to include claims that were not present in either the originally filed 2000 application or the originally filed 2002 application. The primary examiner properly

concludes that the added claims are not supported by the original disclosure in either application. Which of the following is in accord with the USPTO rules and the procedures set forth in the MPEP?

- (A) The added claims are rejected for lack of written description under 35 USC 112, first paragraph.
- (B) The added claims are rejected as new matter under 35 USC 132.
- (C) The added claims are denied benefit of the filing date of the 2000 application.
- (D) (A) and (B).
- (E) (A) and (C).

October 16, 2002 AM

2. To satisfy the written description requirement of the first paragraph of 35 USC 112, an applicant must show possession of the invention. An applicant's lack of possession of the invention may be evidenced by:

- (A) Describing an actual reduction to practice of the claimed invention.
- (B) Describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.
- (C) Requiring an essential feature in the original claims, where the feature is not described in the specification or the claims, and is not conventional in the art or known to one of ordinary skill in the art.
- (D) Amending a claim to add a limitation that is supported in the specification through implicit or inherent disclosure.
- (E) Amending a claim to correct an obvious error by the appropriate correction.

October 16, 2002 AM

7. Paul, a registered patent practitioner and counsel for Superior Aircraft, Inc. ("Superior"), filed a patent application naming chief engineer Davis as sole inventor, and claiming a titanium and aluminum alloy designed for use in advanced gas turbine engines in aircraft. The application described the alloy as having unexpectedly excellent and improved room temperature ductility. The application was filed with an assignment document transferring all right, title and interest in the application to Superior. During prosecution of the application, the examiner had an interview with Paul and Davis of Superior. The examiner noted the existence of a prior art publication that disclosed test data demonstrating that the claimed alloys exhibited poor room temperature ductility, and stated that he had personal knowledge that the alloy was old and well known. Davis agreed with the examiner, and stated that such information was "old hat," but that they overcame the ductility problem by simply resorting to a 3-step process of microstructure refinement. Paul concurred and pointed to the fact that not only had they disclosed the process in the application, but that microstructure refinement of alloys to improve ductility was so well-known that the technique was even taught in metallurgy courses in college. Which of the following statements is false?

- (A) The examiner may reject the alloy claims on the basis of the prior art publication.
- (B) The examiner may not reject the alloy claims on the basis of the prior art publication, because the alloys of the application are characterized by unexpected, improved ductility properties.
- (C) The examiner may rely upon the chief engineer's statement as an admission against patentability.
- (D) The examiner may rely upon the patent counsel's statement as an admission against patentability.
- (E) The examiner, having facts within his or her personal knowledge, may rely on the facts in rejecting the alloy claims.

October 16, 2002 AM

13. Which of the following statements concerning reliance by an examiner on common knowledge in the art, in a rejection under 35 USC 103 is correct?

- I. An examiner's statement of common knowledge in the art is taken as admitted prior art, if applicant does not seasonably traverse the well known statement during examination.
- II. Applicant can traverse an examiner's statement of common knowledge in the art, at any time during the prosecution of an application to properly rebut the statement.
- III. If applicant rebuts an examiner's statement of common knowledge in the art in the next reply after the Office action in which the statement was made, the examiner can never provide a reference to support the statement of common knowledge in the next Office action and make the next Office action final.

- (A) I.
- (B) II.
- (C) III.
- (D) I and II.
- (E) None of the above.

October 16, 2002 AM

14. Claims in your client's patent application have been rejected as unpatentable over prior art. In accordance with proper USPTO practice and procedure, which, if any, of the following statements is true?

- (A) The prior art is a U.S. patent issued five years before the effective date of your client's application. The claims are properly rejected under 35 USC 102(b) of the disclosure in the patent that anticipates the claimed invention. Evidence of secondary considerations, such as unexpected results or commercial success, is relevant to the rejection and thus can overcome the rejection.
- (B) The prior art is a U.S. patent issued five years before the effective date of your client's application. The claims are properly rejected under 35 USC 102(b) over the disclosure in the patent that anticipates the claimed invention. The rejection can be overcome by arguing that the alleged anticipatory prior art is "nonanalogous art."

- (C) The prior art is a U.S. patent issued five years before the effective date of your client's application. The claims are properly rejected under 35 USC 102(b) over the disclosure in the patent that anticipates the claimed invention. The rejection can be overcome by arguing that the alleged anticipatory prior art teaches away from the invention.
- (D) The prior art is a U.S. patent issued five years before the effective date of your client's application. The claims are properly rejected under 35 USC 102(b) over the disclosure in the patent that anticipates the claimed invention. The rejection can be overcome by arguing that the alleged anticipatory prior art is not recognized as solving the problem solved by the claimed invention.
- (E) None of the above.

October 16, 2002 AM

20. There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." Which of the following are among the factors for determining whether necessary experimentation is "undue"?

- (A) The breadth of the claims.
- (B) The nature of the invention.
- (C) The state of the prior art.
- (D) The level of one of ordinary skill.
- (E) (A), (B), (C) and (D).

October 16, 2002 AM

23. Which of the following is the best way to recite a claim limitation so that it will be interpreted by the examiner in accordance with 35 USC 112, paragraph 6?

- (A) dot matrix printer for printing indicia on a first surface of a label.
- (B) dot matrix printer means coupled to a computer.
- (C) means for printing indicia on a first surface of a label.
- (D) printer station for printing indicia on a first surface of a label.
- (E) All of the above.

October 16, 2002 AM

27. Office policy has consistently been to follow *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), in the consideration and determination of obviousness under 35 USC 103. Each of the following are the four factual inquiries enunciated therein as a background for determining obviousness except:

- (A) Determining the scope and contents of the prior art.
- (B) Resolving any issue of indefiniteness in favor of clarity.
- (C) Ascertaining the differences between the prior art and the claims in issue.
- (D) Resolving the level of ordinary skill in the pertinent art.
- (E) Evaluating evidence of secondary considerations.

October 16, 2002 AM

32. A product-by-process claim is properly rejected over a reference under 35 USC 102(b). Which of the following statements is incorrect?

- (A) There is no anticipation unless each of the process steps recited in the claim is disclosed or inherent in the applied reference.
- (B) If the applied reference reasonably indicates that a product disclosed therein is the same or substantially the same as the claimed product, the burden shifts to the applicant to provide evidence to the contrary.
- (C) The rejection cannot be overcome by evidence of unexpected results.
- (D) The rejection can be overcome by evidence that the product in the reference does not necessarily or inherently possess a characteristic of the applicant's claimed product.
- (E) An affidavit or declaration under 37 CFR 1.131 cannot overcome a proper rejection under 35 USC 102(b) over a reference.

October 16, 2002 AM

36. A patent application filed in the USPTO contains the following dependent claim:

Claim 2. The method of Claim 1, further consisting of the step of cooling the mixture to a temperature of 32° F.

Following proper USPTO practices and procedures, from which of the following claims does Claim 2 not properly depend?

- (A) Claim 1. A method of making liquid compound A consisting of the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (B) Claim 1. A method of making liquid compound A comprising the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (C) Claim 1. A method of making liquid compound A including the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (D) Claim 1. A method of making liquid compound A characterized by the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (E) (C) and (D).

October 16, 2002 AM

43. Upon examination of your client's patent application, the patent examiner is considering whether and what rejections to apply to the claims. One or more of the limitations in the claims is indefinite or lacks supporting disclosure. The examiner may not properly take which of the following actions or inactions?

- (A) If the claim is subject to plural interpretations due to a limitation being indefinite, the examiner may disregard any possibility of multiple interpretations.
- (B) If a claim is subject to more than one interpretation due to a limitation being indefinite, at least one of which would render the claim unpatentable over the prior art, the examiner should reject the claim as indefinite under 35 USC 112, second paragraph, and should reject the claim over the prior art based on the interpretation of the claim that renders the prior art applicable.
- (C) If no reasonably definite meaning can be ascribed to certain claim language, the examiner should reject the claim as indefinite under 35 USC 112, second paragraph, and not reject the claim as obvious.
- (D) When evaluating claims for obviousness under 35 USC 103, all the limitations of the claims, including new matter lacking supporting disclosure in the originally filed specification, must be considered and given weight.
- (E) (C) and (D).

October 16, 2002 AM

47. An examiner has advanced a reasonable basis for questioning the adequacy of the enabling disclosure in the specification of your client's patent application, and has properly rejected all the claims in the application. The claims in the application are drawn to a computer program system. In accordance with proper USPTO practice and procedure, the rejection should be overcome by submitting _____

- (A) factual evidence directed to the amount of time and effort and level of knowledge required for the practice of the invention from the disclosure alone.
- (B) arguments by you (counsel) alone, inasmuch as they can take the place of evidence in the record.
- (C) an affidavit under 37 CFR 1.132 by an affiant, who is more than a routineer in the art, submitting few facts to support his conclusions on the ultimate legal question of sufficiency, *i.e.*, that the system "could be constructed."
- (D) opinion evidence directed to the ultimate legal issue of enablement.
- (E) patents to show the state of the art for purposes of enablement where these patents have an issue date later than the effective filing date of the application under consideration.

October 16, 2002 PM

3. Which of the following establishes a statutory bar under 35 USC 102 to patentability of Applicant's claimed invention?

- (A) To further develop the invention, Applicant's invention was tested and experimented with in the United States more than one year prior to applicant's effective U.S. filing date, but the invention at the time was not fit for its intended purpose and important modifications concerning the claimed features resulted from the experimentation. The first actual reduction to practice occurred after the effective U.S. filing date.
- (B) Applicant's invention was sold in a WTO member country outside the United States more than one year prior to applicant's effective U.S. filing date, and the sale was merely market testing of the invention to determine product acceptance.
- (C) Applicant's invention is rendered obvious by the combination of two U.S. patents, both of which were patented more than one year prior to applicant's effective filing date.
- (D) Applicant's invention was sold outside the United States in a non-WTO member country, more than one year prior to applicant's effective U.S. filing date, but the sale was merely an attempt at market penetration.
- (E) None of the above.

October 16, 2002 PM

6. An examiner has properly established a prima facie showing of no specific and substantial credible utility for the claimed invention in a patent application filed in February 2001. An applicant can sustain the burden of rebutting and overcoming the showing by:

- (A) Providing reasoning or arguments rebutting the basis or logic of the prima facie showing.
- (B) Amending the claims.
- (C) Providing evidence in the form of a declaration under 37 CFR 1.132 rebutting the basis or logic of the prima facie showing.
- (D) Providing evidence in the form of a printed publication rebutting the basis or logic of the prima facie showing.
- (E) All of the above.

October 16, 2002 PM

8. An application includes independent claims 1 and 2. Which of the following, in a reply to a non-final Office action, provides the proper basis for a rejection under 35 USC 112, first paragraph?

- (A) Applicant amends claim 2 of the originally filed application by adding a limitation which was previously written only in claim 1 of the originally filed application, and one of ordinary skill in the art is enabled by the original disclosure to make and use the invention as claimed in amended claim 2.
- (B) Applicant amends claim 1 of the originally filed application by adding a limitation that was written in the original disclosure of the application, but the original disclosure does not enable one of ordinary skill in the art to make or use the invention as claimed in amended claim 1.
- (C) Applicant amends and broadens claim 2 by removing a limitation which was written in the original disclosure of the application, and one of ordinary skill in the art is enabled by the original disclosure to make and use the invention as claimed in amended claim 2.
- (D) Applicant adds new matter to the disclosure, but does not amend the claims of the originally filed application, and one of ordinary skill in the art is enabled by the original disclosure to make and use the invention as described in each of the claims.
- (E) None of the above.

October 16, 2002 PM

9. In accordance with proper USPTO practice and procedure, which of the following statements is true?

- (A) Where sole patent applicant Able claims his invention in a Jepson-type claim, and the specification discloses that the subject matter of the preamble was invented by Baker before applicant's invention, the preamble is properly treated as prior art.
- (B) Where the sole patent applicant Able claims his invention in a Jepson-type claim, and the specification makes it clear that the claimed invention is an improvement on Able's own prior invention, which Able discovered less than one year before the filing date of the application, the preamble in the claim is properly treated as prior art.
- (C) Where the sole patent applicant Able claims his invention in a Jepson-type claim, and the specification makes it clear that the claimed invention is an improvement on an invention that Able discovered and publicly used and commercially sold by Able in Texas for several years before the filing date of the application, the preamble in the claim cannot properly be treated as prior art.
- (D) Where the sole applicant, Baker, states that something is prior art, the statement can be taken as being admitted prior art only if corroborated by objective evidence proffered by Baker, or found by the examiner.
- (E) No claim, including a Jepson-type claim, carries with it an implied admission that the elements in the preamble are old in the art.

October 16, 2002 PM

15. Independent claim 1, fully supported by the specification in a patent application states:

Claim 1. An apparatus comprising: a plastic valve; a copper pipe connected to the plastic valve; and an aluminum pipe connected to the plastic valve.

Which of the following claims, presented in the application, provide the basis for a proper rejection under 35 USC 112, second paragraph?

Claim 2. The apparatus of claim 1, wherein said pipe is statically charged.

Claim 3. The apparatus of claim 1, wherein the outer circumference of said copper pipe is statically charged.

Claim 4. The apparatus of claim 1, further comprising a thermostat connected to said plastic valve.

- (A) Claim 2.
- (B) Claim 3.
- (C) Claim 4.
- (D) Claims 2 and 3.
- (E) Claims 3 and 4.

October 16, 2002 PM

16. In which of the following situations, considered independently of each other, is the original, new, or amended claim supported in the application as filed?

- (A) An amendment to the specification changing the definition of “holder” from “is a hook” to “is a hook, clasp, crimp, or tong” and no amendment is made of the claim, which uses the term “holder.” The amendment is filed one month after the application was filed. There was no previous supporting disclosure in the specification of the holder being a clasp, crimp, or tong.
- (B) An amendment to the specification and claims changing the definition of “holder” from “is a hook” to “is a hook, clasp, crimp, or tong.” The amendment is filed one month after the application was filed. There was no previous supporting disclosure in the specification of the holder being a clasp, crimp, or tong.
- (C) Original claim 1 in the application refers to “a holder,” and original claim 2 depends from and refers to claim 1 stating, “said holder is a hook, clasp, crimp, or tong.” There is no disclosure in the specification preceding the claims in the application as filed for the holder to be a clasp, crimp, or tong.
- (D) An amendment is filed presenting a claim to an electrical insulating device, copied from a patent for the purpose of provoking an interference. The claim refers to “nonconductive plastic holder.” The application as filed contains a broad generic disclosure describing electrical insulating devices. The holder is described in the specification of the application as “conducting electricity.” There is no disclosure in the specification of the holder being “nonconductive.”
- (E) All of the above.

October 16, 2002 PM

19. In connection with the utility of an invention described in a patent application, which of the following conforms to proper USPTO practice and procedure?

- (A) A deficiency under 35 USC 101 also creates a deficiency under 35 USC 112, first paragraph.
- (B) To overcome a rejection under 35 USC 101, it must be shown that the claimed device is capable of achieving a useful result on all occasions and under all conditions.
- (C) A claimed invention is properly rejected under 35 USC 101 as lacking utility if the particular embodiment disclosed in the patent lacks perfection or performs crudely.
- (D) To overcome a rejection under 35 USC 101, it is essential to show that the claimed invention accomplishes all its intended functions.
- (E) A claimed invention lacks utility if it is not commercially successful.

October 16, 2002 PM

38. Which of the following is true?

- (A) A claim to a process omitting a step in a disclosed process, where the step is disclosed in the specification to be essential to the invention, may not be properly rejected under 35 USC 112, first paragraph, for lack of enablement where the specification provides an enabling disclosure only for the process which includes the essential step.
- (B) Failure to disclose the best mode must rise to the level of active concealment or grossly inequitable conduct in order to support a rejection under 35 USC 112, first paragraph.
- (C) A claim failing to interrelate essential elements of the invention, as defined by the applicant in the specification, where the interrelation is critical to the invention may be properly rejected under 35 USC 112, second paragraph, for failure to properly point out and distinctly claim the invention.
- (D) Where the best mode contemplated by the inventor at the time of filing the application is not disclosed, a proposed amendment adding a specific mode of practicing the invention would not be new matter.
- (E) The best mode requirement is the same as the enablement requirement of the first paragraph of 35 USC 112.

October 16, 2002 PM

40. Which of the following does not represent prior art?

- (A) The preamble of a Jepson claim.
- (B) A technical journal as of its date of publication which is accessible to the public as of the date of its publication.
- (C) A disclosure publicly posted on the INTERNET, but containing no publication or retrieval date.
- (D) A doctoral thesis indexed, cataloged and shelved in a university library.
- (E) Applicant's labeling of one of the figures in the drawings submitted with his application as prior art.

October 16, 2002 PM

43. A patent application filed in the USPTO claims a nylon rope coated with element E for the purpose of preventing breakage of the rope. In the first Office action, the examiner rejects the claim as obvious over P in view of a trade journal publication, T. P teaches a nylon rope coated with resin for the purpose of making the rope waterproof. T teaches a nylon tent fabric coated with element E for the purpose of making the tent waterproof, and suggests the use of element E for making other nylon products waterproof. Following proper USPTO practices and procedures, the combination of P and T:

- (A) cannot support a prima facie case of obviousness because T lacks a suggestion to combine with P for the purpose of preventing breakage in nylon rope.
- (B) cannot support a prima facie case of obviousness because P lacks a suggestion to combine with T for the purpose of preventing breakage in nylon rope.
- (C) cannot support a prima facie case of obviousness because T only contains a suggestion to combine with P for the purpose of waterproofing nylon rope.
- (D) can support a prima facie case of obviousness, even though T only contains a suggestion to combine with P for the purpose of waterproofing nylon rope.
- (E) can support a prima facie case of obviousness because the applicant is always under an obligation to submit evidence of non-obviousness regardless of whether the examiner fully establishes a prima facie case of obviousness.

October 16, 2002 PM

50. An applicant's claim stands rejected under 35 USC 103 as being obvious over Larry in view of Morris. Larry and Morris are references published more than one year before applicant's effective filing. Although the examiner cites no suggestion or motivation for combining the references, they are, in fact, combinable. Which of the following arguments could properly show that the claim is not obvious?

- (A) The inventions disclosed by Larry and Morris cannot be physically combined.
- (B) Neither Larry nor Morris provides an express suggestion to combine the references.
- (C) As recognized by businessmen, the high cost of Larry's device teaches away from combining it with the simpler device of Morris.

- (D) Absent a suggestion or motivation, the examiner has not shown that combining Larry's with Morris's device would have been within the level of ordinary skill of the art.
- (E) None of the above.

April 17, 2002 AM

1. Which of the following is the best way to recite a claim limitation so that it will be interpreted by the examiner in accordance with 35 U.S.C. § 112, paragraph 6?

- (A) dot matrix printer for printing indicia on a first surface of a label.
- (B) dot matrix printer means coupled to a computer.
- (C) means for printing indicia on a first surface of a label.
- (D) printer station for printing indicia on a first surface of a label.
- (E) All of the above.

April 17, 2002 AM

4. The specification in your client's patent application has been objected to for lack of enablement. To overcome this objection, your client may do any of the following except:

- (A) traverse the objection and specifically argue how the specification is enabling.
- (B) traverse the objection and submit an additional drawing to make the specification enabling.
- (C) file a continuation-in-part application that has an enabling specification.
- (D) traverse the objection and file an amendment without adding new matter in an attempt to show enablement.
- (E) traverse the objection and refer to prior art cited in the specification that would demonstrate that the specification is enabling to one of ordinary skill.

April 17, 2002 AM

9. Which of the following is not in accord with proper USPTO practice and procedure?

- (A) A written description as filed in a nonprovisional patent application is presumed adequate under 35 U.S.C. § 112 in the absence of evidence or reasoning to the contrary.
- (B) An examiner may show that a written description as filed in a nonprovisional patent application is not adequate by presenting a preponderance of evidence why a person of ordinary skill in the art would not recognize in the applicant's disclosure a description of the invention defined by the claims.
- (C) A general allegation of "unpredictability in the art" is sufficient to support a rejection of a claim for lack of an adequate written description.
- (D) When filing an amendment, a practitioner should show support in the original disclosure for new or amended claims.
- (E) When there is substantial variation within a genus, an applicant must describe a sufficient variety of species to reflect the variation within the genus.

April 17, 2002 AM

Questions 11 and 12 are based on the following factual background. Consider questions 11 and 12 independently of each other.

Applicant files a patent application in Japan on February 28, 1996. Applicant files a PCT international application designating the United States on February 27, 1997, based on the Japanese application. The international application is published in English on August 28, 1997. The international application enters the national stage in the United States on August 28, 1998. The USPTO publishes the application on June 7, 2001 at the request of the applicant. The application issues as a United States patent on December 4, 2001.

11. When examining an application filed on or after November 29, 2000 or any application that has been voluntarily published, what is its earliest possible prior art date, for the June 7th U.S. published application in view of 35 U.S.C. § 102(e) as amended by the American Inventors Protection Act of 1999?

- (A) February 28, 1996.
- (B) February 27, 1997.
- (C) August 28, 1997.
- (D) August 28, 1998.
- (E) June 7, 2001.

12. For the United States patent, what is the patent's earliest date, for prior art purposes as a patent, in view of the amendment to 35 U.S.C. § 102(e) by the American Inventors Protection Act of 1999?

- (A) February 28, 1996.
- (B) February 27, 1997.
- (C) August 28, 1997.
- (D) August 28, 1998.
- (E) December 4, 2001.

April 17, 2002 AM

18. To satisfy the written description requirement of the first paragraph of 35 U.S.C. § 112, an applicant must show possession of the invention. An applicant's lack of possession of the invention may be evidenced by:

- (A) Describing an actual reduction to practice of the claimed invention.
- (B) Describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.
- (C) Requiring an essential feature in the original claims, where the feature is not described in the specification or the claims, and is not conventional in the art or known to one of ordinary skill in the art.
- (D) Amending a claim to add a limitation that is supported in the specification through implicit or inherent disclosure.
- (E) Amending a claim to correct an obvious error by the appropriate correction.

April 17, 2002 AM

22. A patent application filed in the USPTO contains the following dependent claim:

Claim 2. The method of Claim 1, further consisting of the step of cooling the mixture to a temperature of 32° F.

Following proper USPTO practices and procedures, from which of the following claims does Claim 2 not properly depend?

- (A) Claim 1. A method of making liquid compound A consisting of the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (B) Claim 1. A method of making liquid compound A comprising the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (C) Claim 1. A method of making liquid compound A including the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (D) Claim 1. A method of making liquid compound A characterized by the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (E) (C) and (D).

April 17, 2002 AM

24. Mr. Brick, the inventor, files an application with the USPTO on January 2, 2001 containing a single claim for his invention: a new bouncing ball called “Y”. Brick receives a first Office action dated June 4, 2001 from the primary examiner handling Brick’s application. The examiner rejected Brick’s claim only under 35 U.S.C. § 103 on the grounds that Reference X teaches a bouncing ball called “Q,” and that although “Y” and “Q” are not the same, it would have been obvious to one of ordinary skill to make changes to the “Q” ball in order to obtain a ball just like Brick’s “Y” ball.

On August 2, 2001, Brick responds by stating that his new “Y” ball bounces unexpectedly higher than the “Q” ball described in Reference X. Brick includes a declaration, signed by Mrs. Kane, that includes extensive data comparing the bouncing results for the “Y” and “Q” balls and showing that the “Y” ball bounces unexpectedly higher than the “Q” ball. Brick argues that the rejection under 35 U.S.C. § 103 should be withdrawn because he has proven that, in view of the unexpectedly higher bounce of the “Y” ball as compared to the “Q” ball, it would not have been obvious to one of ordinary skill in the art to make changes to the “Q” ball to obtain Brick’s “Y” ball.

On October 2, 2001, Brick receives a final rejection from the examiner. The rejection states, in its entirety: “The response has been reviewed but has not been found persuasive as to error in the rejection. The claim is finally rejected under 35 U.S.C. § 103 for the reasons given in the first Office action.” Brick believes he is entitled to a patent to his new bouncing ball “Y.”

How should Brick proceed?

- (A) Brick should give up because the declaration did not persuade the examiner of the merits of Brick's invention.
- (B) Brick should timely file a Request for Reconsideration asking the examiner to reconsider the rejection on the basis of the Kane declaration and, as a precaution against the Request for Reconsideration being unsuccessful, also timely file a Notice of Appeal.
- (C) Brick should respond by submitting a request for reconsideration presenting an argument that Reference X does not provide an enabling disclosure for a new ball with the unexpectedly higher bounce of his "Y" ball.
- (D) Brick should respond by submitting a request for reconsideration presenting an argument that Reference X does not provide a written description for a new ball with the unexpectedly higher bounce of his "Y" ball.
- (E) Brick should respond by submitting a request for reconsideration presenting an argument the declaration data proves that the "Q" ball and the "Y" are not identical.

April 17, 2002 AM

32. Johnnie owns a supermarket store in Cleveland, Ohio, and is constantly frustrated when little children drop their chewing gum on Johnnie's clean floor in the supermarket. In her spare time, Johnnie develops an entirely novel type of coating material that she applies to floor tile. The coating material resists adhesion to chewing gum. In order to check out the effectiveness of the floor tile coating material, on December 31, 2000, she secretly covers the floor tiles in her supermarket with the new chewing gum resistant floor tile coating material. Johnnie is amazed at the results inasmuch as cleaning the floor was never easier. On January 30, 2001, Johnnie, satisfied with the experimental use results, ceased testing the use of the coating material. The ability of the coating material to withstand chewing gum adhesion continued unabated throughout the remainder of 2001. On January 1, 2002, one of Johnnie's many customers, James, remarked at how clean the floor looked. Johnnie then told James of her invention. James thinks for one moment and suggests that the floor tile coating material may be useful in microwave ovens, so that food will not stick to the interior sides of the microwave oven. James discusses getting patent protection with Johnnie. Which of the following is true?

- (A) Johnnie could never be entitled to a patent on a floor tile in combination with a coating material affixed to the outer surface of the tile.
- (B) James can be named as a coinventor with Johnnie in a patent application claiming a microwave oven wherein the internal surfaces of the oven are coated with the coating material.
- (C) Since for one year Johnnie told nobody that the floor tile in her supermarket contained the new chewing gum resistant coating material, she would never be barred from obtaining patent protection for the floor coating material.

- (D) Use of the floor tile coating material in microwave ovens would have been obvious to one of ordinary skill in the art, since James thought of it within seconds after first learning of the floor tile coating material, and James was not skilled in the art.
- (E) The floor tile having the coating material affixed to the outer surface of the tile, an article of manufacture, would not be patentable as of January 1, 2002 inasmuch as the article was in public use on the supermarket floor for one year.

April 17, 2002 PM

1. Mr. Block, the inventor, files an application with the USPTO on January 2, 2001 containing a single claim for his invention: a new bouncing ball called “O.” As part of his duty of disclosure, he also files a copy of a written agreement that he and Mrs. Cone signed on January 2, 1998. The agreement states, in its entirety, that “Mr. Block will transfer my new bouncing ball ‘O’ to Mrs. Cone for experimental uses only to perfect the ball’s bounce. Mr. Block retains full control over the new bouncing ball ‘O.’” The primary examiner has no evidence that the ball was ever actually delivered to Cone.

On June 2, 2001, Block receives an Office action dated June 4, 2001 from the primary examiner. The examiner has rejected Block’s claim only under 35 U.S.C. § 102(b). The examiner explains in the Office action that “the 1998 written agreement signed by Block and Cone proves that the new bouncing ball ‘O’ was in public use more than one year prior to the January 2, 2001 filing date of the application.” Block believes he is entitled to a patent for his new bouncing ball “O.” How should Block respond to the rejection of his claim?

- (A) Block should give up because the agreement is dated more than one year before the filing date of the application and that is enough to statutorily bar Block from getting a patent under 35 U.S.C. § 102(b).
- (B) Block should respond by arguing that although the agreement was signed more than one year prior to the filing date of the application, it was never published and therefore cannot be relied upon as a “printed publication” under 35 U.S.C. § 102(b).
- (C) Block should respond by presenting evidence by way of an oath or declaration of experimental use and arguing that any use of the ball by Cone would have been experimental use, not “public” use.
- (D) Block should respond by arguing the agreement was signed by him, the same person who filed the application, which means that the invention was not “known or used by others in this country.”
- (E) Block should respond by arguing that even though the agreement may suggest that the ball was in use more than one year prior to the filing of the application, it does not indicate that the ball was put on sale in this country.

April 17, 2002 PM

9. An applicant's claim stands rejected under 35 U.S.C. § 103 as being obvious over Larry in view of Morris. Larry and Morris are references published more than one year before applicant's effective filing. Although the examiner cites no suggestion or motivation for combining the references, they are, in fact, combinable. Which of the following arguments could properly show that the claim is not obvious?

- (A) The inventions disclosed by Larry and Morris cannot be physically combined.
- (B) Neither Larry nor Morris provides an express suggestion to combine the references.
- (C) As recognized by businessmen, the high cost of Larry's device teaches away from combining it with the simpler device of Morris.
- (D) Absent a suggestion or motivation, the examiner has not shown that combining Larry's with Morris's device would have been within the level of ordinary skill of the art.
- (E) None of the above.

April 17, 2002 PM

12. An applicant's claim stands rejected as being obvious under 35 U.S.C. § 103 over Lance in view of Barry. Lance and Barry are patents that issued and were published more than one year before applicant's effective filing date. Which of the following arguments could properly overcome the rejection?

- (A) Barry's device is too large to combine with Lance's device.
- (B) The Barry reference is nonanalogous art, because, although pertinent to the particular problem with which Lance was concerned, it relates to a different field of endeavor than the applicant's invention.
- (C) The combination of Lance and Barry would have precluded Lance's device from performing as Lance intended.
- (D) The Barry reference does not show all of the claimed elements arranged in the same manner as the elements are set forth in the claim.
- (E) All of the above.

April 17, 2002 PM

44. A U.S. patent application discloses an adhesive composition described as useful for causing a football to stick to human skin. The application discloses that the composition is made of known materials in equal amounts by weight of A and B. The application discloses that A must be at a temperature between 10 and 30 degrees Celsius, and that B can be either of known materials X or Y. The application discloses that by adding different effective amounts of known material C to the composition, the composition's stickiness or hardness can be changed. In one example, the application discloses an effective amount of material C that can be added to the composition to increase stickiness of the composition. The application also discloses in another example a different effective amount of material C that must be added to the composition to increase the composition's hardness. The effective amounts of material C used in the two examples differ, and the examples describe the effective amounts. Which of the following claims, included in the application, complies with

the requirements of 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 101?

- (A) Claim 1. A process for using a composition to cause a football to stick to human skin.
- (B) Claim 2. A composition comprising equal amounts by weight of A and B, wherein A is at a temperature between 10 and 30 degrees Celsius, and B is X or Y.
- (C) Claim 3. A composition comprising equal amounts by weight of A and B, and an effective amount of C, wherein A is at a temperature between 10 and 30 degrees Celsius.
- (D) Claim 4. A composition comprising equal amounts by weight of A and B, wherein A is at a temperature between 10 and 30 degrees Celsius, preferably between 15 and 20 degrees Celsius.
- (E) Claim 5. A composition comprising equal amounts by weight of A and B and a process of using the composition to cause a football to stick to human skin.

October 17, 2001 AM

1. Office policy has consistently been to follow *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), in the consideration and determination of obviousness under 35 U.S.C. § 103. Each of the following are the four factual inquiries enunciated therein as a background for determining obviousness except:

- (A) Determining the scope and contents of the prior art.
- (B) Resolving any issue of indefiniteness in favor of clarity.
- (C) Ascertaining the differences between the prior art and the claims in issue.
- (D) Resolving the level of ordinary skill in the pertinent art.
- (E) Evaluating evidence of secondary considerations.

October 17, 2001 AM

6. In connection with the utility of an invention described in a patent application, which of the following conforms to proper USPTO practice and procedure?

- (A) A deficiency under 35 U.S.C. § 101 also creates a deficiency under 35 U.S.C. § 112, first paragraph.
- (B) To overcome a rejection under 35 U.S.C. § 101, it must be shown that the claimed device is capable of achieving a useful result on all occasions and under all conditions.
- (C) A claimed invention is properly rejected under 35 U.S.C. § 101 as lacking utility if the particular embodiment disclosed in the patent lacks perfection or performs crudely.
- (D) To overcome a rejection under 35 U.S.C. § 101, it is essential to show that the claimed invention accomplishes all its intended functions.
- (E) A claimed invention lacks utility if it is not commercially successful.

October 17, 2001 AM

14. Which of the following is not in accord with proper USPTO practice and procedure?

- (A) A written description as filed in a nonprovisional patent application is presumed adequate under 35 U.S.C. § 112 in the absence of evidence or reasoning to the contrary.
- (B) An examiner may show that a written description as filed in a nonprovisional patent application is not adequate by presenting a preponderance of evidence why a person of ordinary skill in the art would not recognize in the applicant's disclosure a description of the invention defined by the claims.
- (C) A general allegation of "unpredictability in the art" is sufficient to support a rejection of a claim for lack of an adequate written description.
- (D) When filing an amendment, a practitioner should show support in the original disclosure for new or amended claims.
- (E) When there is substantial variation within a genus, an applicant must describe a sufficient variety of species to reflect the variation within the genus.

October 17, 2001 AM

18. Which of the following is in accord with proper USPTO practice and procedure?

- (A) Satisfaction of the enablement requirement of the first paragraph of 35 U.S.C. § 112 by the disclosure in a specification also satisfies the written description requirement of the second paragraph of 35 U.S.C. § 112
- (B) A claim to a process consisting solely of mathematical operations, *i.e.*, converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a process eligible for patent protection.
- (C) A claim for a machine can encompass only one machine, such as a single computer, for performing the underlying process.
- (D) A claim that recites nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, *per se*, and as such are statutory natural phenomena.
- (E) A composition of matter is a single substance, as opposed to two or more substances, whether it be a gas, fluid, or solid.

October 17, 2001 AM

19. Mr. Adams was touring the central Mexican highland desert when he came across a small tequila production facility. While touring the facility, Adams saw a unique machine for squeezing the sap from the blue agave plant and preparing the sap for fermentation. The machine, which had been in operation for more than three years, was highly efficient and helped produce excellent tequila from a minimal number of agave plants. The owner of the production facility had sold a number of identical machines to other local tequila producers over the past two years. All of the machines remained local and none of the producers sold their tequila outside the local area. Aware that the blue agave plant was becoming increasingly rare, Adams immediately recognized the commercial possibilities of such an

efficient machine. Adams returned to the facility under cover of night and took numerous photographs of the machine. Upon Adams' return to the United States, he worked from the photographs to make detailed technical drawings of the machine. He then promptly filed a patent application directed to the machine. Which of the following statements is correct?

- (A) Adams may not obtain a patent on the machine because it was known by others in a NAFTA country before Mr. Adams made technical drawings of the machine.
- (B) Adams may not obtain a patent on the machine because the machine had been sold more than a year before Adams' application filing date.
- (C) Adams is entitled to a patent because all sales of the machine and the tequila produced by the machine were in Mexico; a goal of the patent system is public disclosure of technical advances; and the machine likely would not have been disclosed to the United States public without Adams.
- (D) Adams may not obtain a patent on the machine because the machine was in public use more than a year before Adams' application filing date.
- (E) Statements (A), (B), (C) and (D) are each incorrect.

October 17, 2001 AM

21. An inventor, working with prior art subject matter, changes the subject matter, and thereafter files a patent application only claiming the changed subject matter. Which of the following changes might render the claimed subject matter patentable?

- (A) Where the only difference between the prior art device and the claim device was a recitation of relative dimensions of the claimed device and the claimed device would not perform differently than the prior art device.
- (B) Where the only difference between the prior art device and the claimed device is the configuration of the claimed device, and the configuration is a matter of choice without significance regarding the use of the device.
- (C) Where the difference between the prior art, an impure material, and the claimed subject matter, the purified form of the impure material, is the purity of the material and the utility of the purified material, which differs from the impure material.
- (D) Where the only difference between the prior art device and the claimed device is a reversal of the parts that move relative to each other, and without any unexpected results.
- (E) Where the only difference between the prior art device and the claimed device is elimination of an element and its function, and elimination of the function was desired, required, or expected.

October 17, 2001 AM

24. Able and Baker conceived an improved gas grille for cookouts. Using elements A, B, C, D, E and F found in their backyards, as well as elements G, H, I, J, K, L, M and N purchased at a local hardware store, they successfully constructed and used a gas grille conforming to their concept. The grille includes subcombination of elements K, L and M conceived by Able, and subcombination C, D, F, G and M conceived by Baker. Able and Baker conceived their respective subcombinations separately and at different times. Able and Baker retain you to prepare and file a patent application for them. You are considering whether and what can be claimed in one patent application. Which of the following is true?

- (A) For Able and Baker to properly execute an oath or declaration under 37 CFR 1.63 in a patent application claiming not only the grille, but also the two subcombinations, Able and Baker must be joint inventors of the grille, and each of the two subcombinations.
- (B) A characteristic of U.S. patent law that is generally shared by other countries is that the applicant for a patent must be the inventor.
- (C) If Able and Baker execute an oath or declaration under 37 CFR 1.63 as joint inventors and file an application claiming the grille (a combination of elements A, B, C, D, E, F, G, H, I, J, K, L, M and N), the existence of the claim to the grille is evidence of their joint inventorship of the individual elements.
- (D) Able and Baker may properly execute an oath or declaration under 37 CFR 1.63 as joint inventors and file an application containing claims to the grille (a combination of elements A, B, C, D, E, F, G, H, I, J, K, L, M and N), claims to the subcombination conceived by Able, and claims to the subcombination conceived by Baker.
- (E) Able and Baker could not properly claim the combination unless they successfully and personally reduced the grille to practice.

October 17, 2001 AM

25. Ada invented a computer memory retrieval system in the United States. In June 1999, at the request of MC Computer Corp. and with the benefit of an export license, Ada demonstrates her invention at a testing facility in England. MC Computer Corp. signs a confidentiality agreement and agrees not to disclose the invention to anyone. The test is conducted in a secluded area and the persons involved are sworn to secrecy. Unbeknownst to Ada, MC Computer Corp. installs the computer memory retrieval system on its MC computers and begins selling its computers in England in September 1, 1999, with Ada's memory retrieval system. The first sale in the United States of MC Computer Corp's computers with Ada's memory retrieval system occurs on October 1, 1999. On August 1, 2000, MC Computer Corp. publishes an advertisement in the United States, and files a U.S. patent application that discloses but does not claim the memory retrieval system invented by Ada. The MC Computer Corp.'s patent issues on October 1, 2001. On September 12, 2000, Ada files a patent application. On October 15, 2001, the examiner rejects all the claims in Ada's application based upon MC Computer Corp.'s advertisement published on August 1, 2000. Which of the following is true?

- (A) Since the MC Computer Corp. misappropriated the invention and since Ada did not authorize the sales in England on September 1, 1999, or the advertisement on August 1, 2000 in the United States, the rejection may be overcome by showing that the idea was misappropriated by MC Computer and the sales were not authorized by Ada.
- (B) Ada is not entitled to a patent since the invention was on sale more than one year prior to the date of the application for patent in the United States.
- (C) Ada may file a declaration pursuant to 37 CFR 1.131 to antedate MC Computer Corp.'s published advertisement.
- (D) Ada may file a request for reexamination of the MC Computer Corp.'s patent on the grounds that her idea was misappropriated.
- (E) The MC Computer Corp.'s patent is invalid for breach of the confidentiality agreement and disclosing the invention of another.

October 17, 2001 AM

34. A patent application filed in the USPTO contains the following dependent claim:

Claim 2. The method of Claim 1, further consisting of the step of cooling the mixture to a temperature of 32° F.

Following proper USPTO practices and procedures, from which of the following claims does Claim 2 not properly depend?

- (A) Claim 1. A method of making liquid compound A comprising the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (B) Claim 1. A method of making liquid compound A characterized by the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (C) Claim 1. A method of making liquid compound A including the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (D) Claim 1. A method of making liquid compound A consisting of the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (E) (B) and (C).

October 17, 2001 AM

37. An application includes independent claims 1 and 2. Which of the following, in a reply to a non-final Office action, provides the proper basis for a rejection under 35 U.S.C. § 112, first paragraph?

- (A) Applicant amends claim 2 of the originally filed application by adding a limitation which was previously written only in claim 1 of the originally filed application, and one of ordinary skill in the art is enabled by the original disclosure to make and use the invention as claimed in amended claim 2.
- (B) Applicant amends claim 1 of the originally filed application by adding a limitation that was written in the original disclosure of the application, but the original disclosure does not enable one of ordinary skill in the art to make or use the invention as claimed in amended claim 1.
- (C) Applicant amends and broadens claim 2 by removing a limitation which was written in the original disclosure of the application, and one of ordinary skill in the art is enabled by the original disclosure to make and use the invention as claimed in amended claim 2.
- (D) Applicant adds new matter to the disclosure, but does not amend the claims of the originally filed application, and one of ordinary skill in the art is enabled by the original disclosure to make and use the invention as described in each of the claims.
- (E) None of the above.

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40. Mike and Alice, who are not related, are shipwrecked on a heretofore uninhabited and undiscovered island in the middle of the Atlantic Ocean. In order to signal for help, Mike invents a signaling device using bamboo shoots. Alice witnesses but does not assist in any way in the development of the invention. The signaling device works and a helicopter comes and rescues Alice. However, Mike remains on the island due to overcrowding on the helicopter. Unfavorable weather conditions have prevented Mike's rescue to date. Alice comes to you, a registered patent practitioner, to file an application for a patent and offers to pay you in advance. Which of the following is true?

- (A) Since Mike invented the invention, Alice cannot properly file an application for a patent in her name even though Mike is unavailable.
- (B) Since Mike is unavailable, you may properly file an application for a patent without his consent. You can accept the money from Alice as payment for the application.
- (C) Since Mike is not available and cannot be reached, Alice may properly sign the declaration on his behalf since she has witnessed the invention and knows how to make and use it.
- (D) Alice should file an application in her name since she has witnessed the invention and knows how to make and use it. Subsequently, when Mike becomes available, the inventorship may be changed to the correct inventorship.
- (E) Even though Mike and Alice are not related, Alice may properly file an application on Mike's behalf.

October 17, 2001 AM

43. Which of the following establishes a statutory bar under 35 U.S.C. § 102 to patentability of Applicant's claimed invention?

- (A) To further develop the invention, Applicant's invention was tested and experimented with in the United States more than one year prior to applicant's effective U.S. filing date, but the invention at the time was not fit for its intended purpose and important modifications concerning the claimed features resulted from the experimentation. The first actual reduction to practice occurred after the effective U.S. filing date.
- (B) Applicant's invention was sold in a WTO member country outside the United States more than one year prior to applicant's effective U.S. filing date, and the sale was merely market testing of the invention to determine product acceptance.
- (C) Applicant's invention is rendered obvious by the combination of two U.S. patents, both of which were patented more than one year prior to applicant's effective filing date.
- (D) Applicant's invention was sold outside the United States in a non-WTO member country, more than one year prior to applicant's effective U.S. filing date, but the sale was merely an attempt at market penetration.
- (E) None of the above.

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50. Stan, through a registered practitioner, files an application for a patent. During the prosecution of Stan's patent, in an amendment, the practitioner admitted in his discussion as to "all the claims" of Stan's application, that "the most pertinent available prior art known to the Applicants and their representatives is the Acme Patent, cited by the examiner." Within one year after the patent issues, Stan comes to you and wants to file a reissue to broaden his claims, based on the fact that the Acme patent is not prior art. He has ample evidence to show that he conceived and reduced his invention to practice before the filing date of the Acme patent. Which of the following is true?

- (A) Stan should file a reissue application accompanied by a declaration under 37 CFR 1.131 to swear behind the date of the Acme reference. The statement by the registered practitioner, who formerly represented Stan, that the Acme patent was prior art constituted error without deceptive intent and may be corrected by reissue.
- (B) The explicit admission by the registered practitioner, who formerly represented Stan, that the Acme patent constituted prior art is binding on Stan in any later proceeding involving the patent.
- (C) Stan should file a request for reexamination and submit the Acme patent along with evidence in the form of affidavits or declarations showing that the Acme patent is not prior art.

- (D) Since the Acme patent was cited by the examiner and not by the registered practitioner, who formerly represented Stan, Stan can not be held accountable for the error. Moreover, the statement by the registered practitioner was directed to the pertinence of the prior art and not to the issue of whether the date of the Acme patent could be sworn behind. Accordingly, the statement has no binding effect.
- (E) (A) and (D).

October 17, 2001 PM

1. A U.S. patent application discloses a first embodiment of an invention, a composition made of known materials in equal amounts by weight of A, B, and C. The application discloses a second embodiment of the invention comprising equal amounts by weight of A, B, and C, and an effective amount of D, a known material, to reduce excess moisture from the composition. The application also discloses a third embodiment of the invention comprising equal amounts by weight of A, B, and C, and an effective amount of D to reduce the acidity of the composition. The application fully discloses guidelines for determining an effective amount of D to reduce excess moisture from the composition, and determining an effective amount of D to reduce the acidity of the composition. The application discloses that the amount of D needed to reduce excess moisture from the composition differs from the amount of D needed to reduce the acidity of the composition. Which of the following claims, if included in the application, provides a proper basis for a rejection under 35 U.S.C. § 112, second paragraph?

- (A) Claim 1. A composition comprising: equal amounts by weight of A, B, and C, and an effective amount of D to reduce the acidity of the composition.
- (B) Claim 1. A composition comprising: equal amounts by weight of A, B, and C, and an effective amount of D.
- (C) Claim 1. A composition comprising: equal amounts by weight of A, B, and C, and an effective amount of D to reduce excess moisture from the composition.
- (D) Claim 1. A composition comprising: equal amounts by weight of A, B, and C.
- (E) None of the above.

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2. Able conceived the invention claimed in a patent application. In conceiving the invention, Able used and adopted ideas and materials known in the art and invented by others. Ben, Able's employee, reduced the invention to practice at Able's request and totally pursuant to Able's suggestions. Being unable to afford a patent practitioner's fees to prepare and prosecute the application, Able convinced John to pay for the practitioner's services in return for an interest in the invention. John did nothing more than provide the funds for the practitioner. Which of the following is in accordance with proper USPTO practice or procedure?

- (A) Able need not be the one to reduce the invention to practice so long as the reduction to practice occurred on his or her behalf. Able can be properly named as inventor in the application.

- (B) To be named an inventor, it is not necessary for John to have contributed to the conception of the invention. Ben, not Able, can be named as inventor in the application.
- (C) In conceiving the invention, Able may not consider and adopt ideas and materials derived from any sources, such as ideas of previous inventors. Able cannot be properly named as inventor in the application.
- (D) John and Able may be properly named as joint inventors of the invention in the application.
- (E) John, Ben, and Able may be properly named as joint inventors of the invention in the application.

October 17, 2001 PM

6. An examiner has advanced a reasonable basis for questioning the adequacy of the enabling disclosure in the specification of your client's patent application, and has properly rejected all the claims in the application. The claims in the application are drawn to a computer program system. In accordance with proper USPTO practice and procedure, the rejection should be overcome by submitting _____

- (A) factual evidence directed to the amount of time and effort and level of knowledge required for the practice of the invention from the disclosure alone.
- (B) arguments by you (counsel) alone, inasmuch as they can take the place of evidence in the record.
- (C) an affidavit under 37 CFR 1.132 by an affiant, who is more than a routineer in the art, submitting few facts to support his conclusions on the ultimate legal question of sufficiency, *i.e.*, that the system "could be constructed."
- (D) opinion evidence directed to the ultimate legal issue of enablement.
- (E) patents to show the state of the art for purposes of enablement where these patents have an issue date later than the effective filing date of the application under consideration.

October 17, 2001 PM

9. Bill was working toward a Ph.D. in physics from a university in Japan. As part of his doctoral program, Bill prepared (in Japanese) a thesis directed to his work in the semiconductor field. Following approval of the thesis by his faculty advisor on December 21, 2000, the sole copy of Bill's thesis was placed on the shelves of the university library on January 29, 2001, where it was accessible to the faculty and students of the university as well as to the general public. At that time, the thesis was indexed in a general user's catalog maintained locally at the university library by author, title and subject. On March 4, 2001, the general user's catalog was made freely available on an Internet web page maintained by the university. Which of the following statements is most correct?

- (A) Bill's thesis may be used under 35 U.S.C. § 102(b) as a prior art printed publication against a United States application for patent filed January 4, 2002.

- (B) Bill's thesis may be used under 35 U.S.C. § 102(b) as a prior art printed publication against a United States application for patent filed February 19, 2002.
- (C) Bill's thesis may be used under 35 U.S.C. § 102(b) as a prior art printed publication against a United States application for patent filed March 6, 2002.
- (D) Each of statements (B) and (C) is correct.
- (E) Because the thesis was written in Japanese, it cannot be a prior art printed publication against a United States application for patent.

October 17, 2001 PM

13. Which of the following statements about the disclosure of the utility of an invention is true in accordance with proper USPTO practice and procedure?

- (A) A claimed utility invention that is disclosed to be neither a machine, an article of manufacture, a composition, nor a process is patentable in accordance with the patent law.
- (B) In a patent application claiming a compound, a disclosure by the applicant that the compound may be useful in treating unspecified disorders would be sufficient to define a specific utility for the compound.
- (C) In a patent application claiming a compound, a disclosure by the applicant that the compound has "useful biological" properties, would be sufficient to define a specific utility for the compound.
- (D) In a patent application claiming a compound, a disclosure by the applicant that the compound has a specific biological activity and reasonably correlates that activity to a disease condition would be sufficient to define a specific utility for the compound.
- (E) If a claimed invention does not have utility, the specification nevertheless can enable one to use it.

October 17, 2001 PM

17. There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." Which of the following are among the factors for determining whether necessary experimentation is "undue"?

- (A) The breadth of the claims.
- (B) The nature of the invention.
- (C) The state of the prior art.
- (D) The level of one of ordinary skill.
- (E) (A), (B), (C) and (D).

October 17, 2001 PM

19. In accordance with proper USPTO practice and procedure, which of the following statements is true?

- (A) Where sole patent applicant Able claims his invention in a Jepson-type claim, and the specification discloses that the subject matter of the preamble was invented by Baker before applicant's invention, the preamble is properly treated as prior art.
- (B) Where the sole patent applicant Able claims his invention in a Jepson-type claim, and the specification makes it clear that the claimed invention is an improvement on Able's own prior invention, which Able discovered less than one year before the filing date of the application, the preamble in the claim is properly treated as prior art.
- (C) Where the sole patent applicant Able claims his invention in a Jepson-type claim, and the specification makes it clear that the claimed invention is an improvement on an invention that Able discovered and publicly used and commercially sold by Able in Texas for several years before the filing date of the application, the preamble in the claim cannot properly be treated as prior art.
- (D) Where the sole applicant, Baker, states that something is prior art, the statement can be taken as being admitted prior art only if corroborated by objective evidence proffered by Baker, or found by the examiner.
- (E) No claim, including a Jepson-type claim, carries with it an implied admission that the elements in the preamble are old in the art.

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22. To satisfy the written description requirement of the first paragraph of 35 U.S.C. § 112, an applicant must show possession of the invention. An applicant's lack of possession of the invention may be evidenced by:

- (A) Original claims which recite an essential feature where the feature is not described in the specification or the claims, and is not conventional in the art or known to one of ordinary skill in the art.
- (B) A specification of a patent application that describes the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.
- (C) A specification of a patent application that describes an actual reduction to practice of the claimed invention.
- (D) An amendment to a claim seeking to add a limitation that is supported in the specification through implicit or inherent disclosure.
- (E) An amendment to a claim seeking to correct an obvious error by the appropriate correction.

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28. In which of the following instances is the reference properly available as prior art under 35 U.S.C § 102(d)?

- (A) A U.S. patent application is filed within the one year anniversary date of the filing date of the foreign application. The reference is the foreign application.
- (B) The applicant files a foreign application, later timely files a U.S. application claiming priority based on the foreign application, and then files a continuation in -part (CIP) application, and the claims in the CIP are not entitled to the filing date of the U.S. parent application. The foreign application issues as a patent before the filing date of the CIP application and is used to reject the claims directed to the added subject matter under 35 U.S.C. §§ 102(d)/103. The reference is the foreign application.
- (C) The applicant files a foreign application, and later timely files a U.S. application claiming priority based on the foreign application. The examined foreign application has been allowed by the examiner and has not been published before the U.S. application was filed. The reference is the foreign application.
- (D) The reference is a defensive publication.
- (E) All of the above.

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36. Upon examination of your client's patent application, the patent examiner is considering whether and what rejections to apply to the claims. One or more of the limitations in the claims is indefinite or lacks supporting disclosure. The examiner may not properly take which of the following actions or inactions?

- (A) If the claim is subject to plural interpretations due to a limitation being indefinite, the examiner may disregard any possibility of multiple interpretations.
- (B) If a claim is subject to more than one interpretation due to a limitation being indefinite, at least one of which would render the claim unpatentable over the prior art, the examiner should reject the claim as indefinite under 35 U.S.C. § 112, second paragraph, and should reject the claim over the prior art based on the interpretation of the claim that renders the prior art applicable.
- (C) If no reasonably definite meaning can be ascribed to certain claim language, the examiner should reject the claim as indefinite under 35 U.S.C. § 112, second paragraph, and not reject the claim as obvious.
- (D) When evaluating claims for obviousness under 35 U.S.C. § 103, all the limitations of the claims, including new matter lacking supporting disclosure in the originally filed specification, must be considered and given weight.
- (E) (C) and (D).

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37. Which of the following is true?

- (A) A claim to a process omitting a step in a disclosed process, where the step is disclosed in the specification to be essential to the invention, may not be properly rejected under 35 U.S.C. § 112, first paragraph, for lack of enablement where the specification provides an enabling disclosure only for the process which includes the essential step.
- (B) Failure to disclose the best mode must rise to the level of active concealment or grossly inequitable conduct in order to support a rejection under 35 U.S.C. § 112, first paragraph.
- (C) A claim failing to interrelate essential elements of the invention, as defined by the applicant in the specification, where the interrelation is critical to the invention may be properly rejected under 35 U.S.C. § 112, second paragraph, for failure to properly point out and distinctly claim the invention.
- (D) Where the best mode contemplated by the inventor at the time of filing the application is not disclosed, a proposed amendment adding a specific mode of practicing the invention would not be new matter.
- (E) The best mode requirement is the same as the enablement requirement of the first paragraph of 35 U.S.C. § 112.

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38. Your clients, Able and Baker, filed a patent application. In accordance with proper USPTO practice and procedure, in which of the following instances, absent additional facts, is the reference or event either prior art or an act that may not be properly applied to reject claims in your client's application?

- (A) The patent application was filed on Tuesday, June 26, 2001 in the USPTO. The reference is an article in a trade magazine published on November 10, 2000. Able, Baker and McGeiver are the authors of the article. The article fully discloses the claimed invention and how to make and use it.
- (B) The patent application was filed on Monday, June 25, 2001 in the USPTO. Able and Baker placed the invention on sale in the United States on Monday, June 26, 2000. The public came into possession and understands the invention the day it is placed on sale. Your clients have disclosed this information when they filed the application.
- (C) The patent application was filed on Monday, June 25, 2001, in the USPTO. McGeiver, a friend of Baker, publicly used the invention in Hawaii on April 15, 2000. The public use was not experimental and was without Baker's knowledge or consent. The public came into possession of the invention the day it was used by McGeiver.
- (D) The patent application was filed on Monday, June 25, 2001, in the USPTO. The invention became known to the public in the United States in April 2000 as a result of disclosure on the Internet by Wilson, a party unknown to Able and Baker. The invention was not placed on sale or in public use prior to the filing date of the application.

- (E) More than one year prior to the filing in the USPTO of a patent application on Monday, June 25, 2001, in the USPTO, the invention, a machine, was used secretly by John, another inventor, to make a product. The details of the invention are ascertainable by inspection or analysis of the product made by John that was sold and publicly displayed.

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43. A claim in your client's patent application has been rejected as being anticipated by a prior art reference. In which of the following instances is the claim not necessarily anticipated?

- (A) The prior art is a U.S. patent issued five years before the effective date of your client's application. In your client's application, the claim is a generic claim. The prior art clearly discloses a species falling within the claimed genus in your client's application.
- (B) The prior art is a U.S. patent issued two years before the effective date of your client's application. In your client's application, claim 4 is directed to a species. The prior art discloses forty-six species. The species claimed in claim 4 is clearly disclosed by name in the prior art. The remaining forty-five species disclosed in the prior art do not anticipate or render obvious any subject matter claimed in your client's application.
- (C) The prior art is a U.S. patent issued two years before the effective date of your client's application. In your client's application, claim 1 is directed to "composition comprising copper oxygen, and 10 to 20 mg of sulfur." The prior art discloses a composition "comprising copper, oxygen and 15 mg. of sulfur."
- (D) The prior art is a U.S. patent issued two years before the effective date of your client's application. Claim 1 in your client's application is drawn to a composition of gases, and contains a narrow range of the amount of oxygen. The prior art discloses composition of the same gases, and a broad range of the amount of oxygen that is inclusive of the claimed narrow range, but does not disclose specific examples falling within the claimed narrow range. Your client not only discloses a different utility for the claimed invention, but also unexpected results achieved within the narrow range.
- (E) (A), (B), (C) and (D).

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44. A condition for patentability is that an inventor is entitled to a patent unless he has abandoned the invention. Your client has engaged in conduct or omissions that may or may not be construed as abandonment of her invention. In which of the following situations would it be proper for a patent examiner to conclude, in an *ex parte* proceeding, that an inventor has abandoned the invention?

- (A) From the inventor's inaction, following conception, to do anything over a period of time to develop or patent his or her invention, the inventor's ridicule of another person's attempts to develop that invention, and the inventor's active show of interest in promoting and developing the invention only after successful marketing by another of a device embodying that invention.
- (B) When acts of another can be imputed to the inventor as an intent to abandon the invention.
- (C) From the inventor's delay alone in filing a first patent application for the invention.
- (D) From an inventor's delay in reapplying for patent after abandonment of a previous patent application.
- (E) From the inventor's act of disclosing but not claiming the subject matter in a previously issued patent, even though the inventor claims the subject matter in an another patent application that is filed within one year after the patent issued.

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47. Claims in your client's patent application have been rejected as unpatentable over prior art. In accordance with proper USPTO practice and procedure, which, if any, of the following statements is true?

- (A) The prior art is a U.S. patent issued five years before the effective date of your client's application. The claims are properly rejected under 35 U.S.C. § 102(b) of the disclosure in the patent that anticipates the claimed invention. Evidence of secondary considerations, such as unexpected results or commercial success, is relevant to the rejection and thus can overcome the rejection.
- (B) The prior art is a U.S. patent issued five years before the effective date of your client's application. The claims are properly rejected under 35 U.S.C. § 102(b) over the disclosure in the patent that anticipates the claimed invention. The rejection can be overcome by arguing that the alleged anticipatory prior art is "nonanalogous art."
- (C) The prior art is a U.S. patent issued five years before the effective date of your client's application. The claims are properly rejected under 35 U.S.C. § 102(b) over the disclosure in the patent that anticipates the claimed invention. The rejection can be overcome by arguing that the alleged anticipatory prior art teaches away from the invention.

- (D) The prior art is a U.S. patent issued five years before the effective date of your client's application. The claims are properly rejected under 35 U.S.C. § 102(b) over the disclosure in the patent that anticipates the claimed invention. The rejection can be overcome by arguing that the alleged anticipatory prior art is not recognized as solving the problem solved by the claimed invention.
- (E) None of the above.

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50. On February 15, 2000, Debbie conceived a new, useful and nonobvious improvement in saddles for horses. Debbie spent the next four months working regularly on the idea and she built a prototype that implemented the concept on June 17, 2000. The prototype worked perfectly for its intended purpose. The next day, Debbie visited a patent attorney, Ginny, and asked her to prepare a patent application on Debbie's behalf. Ginny explained that her workload would prevent her from working on the application for at least four months. Ginny therefore declined representation of Debbie and gave her the names of a number of other qualified patent practitioners. Debbie, however, did not contact any of the individuals recommended by Ginny. Debbie visited Ginny again on December 1, 2000. At that time Ginny agreed to represent Debbie. A patent application was filed in the Patent Office on December 11, 2000.

On May 15, 2000, Billie conceived an idea substantively identical to Debbie's. Billie immediately prepared a detailed technical description including drawings and visited a patent attorney. Billie filed a patent application on June 14, 2000. Later, on July 9, 2000, Billie built a prototype that implemented the concept and had fully and successfully tested it by August 11, 2000.

With regard to a priority contest between Debbie and Billie, which of the following statements is most correct?

- (A) Debbie will be awarded priority only if she can establish diligence for the entire time between May 14, 2000 and her actual reduction to practice in June 2000, and can establish that she did not suppress, abandon or conceal the invention.
- (B) Debbie will be awarded priority only if she can establish diligence for the entire time between her conception in February 2000 and actual reduction to practice in June 2000, and can establish that she did not suppress, abandon or conceal the invention.
- (C) Debbie will be awarded priority if she can establish diligence for the entire time between May 14, 2000 and her patent filing in December 2000, and can establish that she did not suppress, abandon or conceal the invention.
- (D) To encourage prompt disclosure of inventions to the public, priority is always awarded to the first to file an application, in this case Billie.
- (E) Billie must be awarded priority because his patent application established a constructive reduction to practice prior to Debbie's actual reduction to practice, even if Debbie was diligent in reducing her invention to practice.

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9. Which of the following is not in accord with proper USPTO practice and procedure?

- (A) A written description as filed in a nonprovisional patent application is presumed adequate under 35 U.S.C. § 112 in the absence of evidence or reasoning to the contrary.
- (B) An examiner may show that a written description as filed in a nonprovisional patent application is not adequate by presenting a preponderance of evidence why a person of ordinary skill in the art would not recognize in the applicant's disclosure a description of the invention defined by the claims.
- (C) A general allegation of "unpredictability in the art" is sufficient to support a rejection of a claim for lack of an adequate written description.
- (D) When filing an amendment, a practitioner should show support in the original disclosure for new or amended claims.
- (E) When there is substantial variation within a genus, an applicant must describe a sufficient variety of species to reflect the variation within the genus.

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10. Independent claim 1, fully supported by the specification in a patent application states:

Claim 1. An apparatus comprising: a plastic valve; a copper pipe connected to the plastic valve; and an aluminum pipe connected to the plastic valve.

Which of the following claims, presented in the application, provide the basis for a proper rejection under 35 U.S.C. § 112, second paragraph?

- Claim 2. The apparatus of claim 1, wherein said pipe is statically charged.
- Claim 3. The apparatus of claim 1, wherein the outer surface of said copper pipe is statically charged.
- Claim 4. The apparatus of claim 1, further comprising a thermostat connected to said plastic valve.

- (A) Claim 2.
- (B) Claim 3.
- (C) Claim 4.
- (D) Claims 2 and 3.
- (E) Claims 3 and 4.

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16. Stan, through a registered practitioner, files an application for a patent. During the prosecution of Stan's patent, in an amendment, the practitioner admitted in his discussion as to "all the claims" of Stan's application, that "the most pertinent available prior art known to the Applicants and their representatives is the Acme Patent, cited by the examiner." Within one year after the patent issues, Stan comes to you and wants to file a reissue to broaden his claims, based on the fact that the Acme patent is not prior art. He has ample evidence to show that he conceived and reduced his invention to practice before the filing date of the Acme patent. Which of the following is true?

- (A) Stan should file a reissue application accompanied by a declaration under 37 C.F.R. 1.131 to swear behind the date of the Acme reference. The statement by the registered practitioner, who formerly represented Stan, that the Acme patent was prior art constituted error without deceptive intent and may be corrected by reissue.
- (B) The explicit admission by the registered practitioner, who formerly represented Stan, that the Acme patent constituted prior art is binding on Stan in any later proceeding involving the patent.
- (C) Stan should file a request for reexamination and submit the Acme patent along with evidence in the form of affidavits or declarations showing that the Acme patent is not prior art.
- (D) Since the Acme patent was cited by the examiner and not by the registered practitioner, who formerly represented Stan, Stan can not be held accountable for the error. Moreover, the statement by the registered practitioner was directed to the pertinence of the prior art and not to the issue of whether the date of the Acme patent could be sworn behind. Accordingly, the statement has no binding effect.
- (E) (A) and (D).

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19. In early 1999, at the request of MC Motors, Eve demonstrated her reverse automobile heating system at a testing facility in Germany. MC Motors signs a confidentiality agreement and agrees not to disclose the invention to anyone. The test is conducted in a secluded area and the persons involved are sworn to secrecy. Unbeknownst to Eve, MC Motors installs the reverse heating system on its MC cars and begins selling its cars with the reverse heating system in the United States in September 1999. In August 2000, MC files a patent application in the United States for the reverse automobile heating system. In December 2000, Eve files a patent application claiming the automobile heating system. The examiner rejects all the claims in Eve's application based upon an MC Motors brochure advertising its cars in September 1999. Which of the following is true?

- (A) Eve is not entitled to a patent since the invention was on sale in this country, more than one year prior to the date of the application for patent in the United States.

- (B) Since the MC Motors misappropriated the invention and since Eve did not authorize the sale, the rejection may be overcome by showing that the sales by MC Motors were not authorized by Eve.
- (C) MC Motors is entitled to a patent since although it misappropriated the idea for the invention from Eve, the misappropriation was beyond the jurisdiction of the USPTO.
- (D) (A) and (C).
- (E) None of the above.

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20. A patent application filed in the USPTO claims a nylon rope coated with element E for the purpose of preventing breakage of the rope. In the first Office action, the examiner rejects the claim as obvious over P in view of a trade journal publication, T. P teaches a nylon rope coated with resin for the purpose of making the rope waterproof. T teaches a nylon tent fabric coated with element E for the purpose of making the tent waterproof, and suggests the use of element E for making other nylon products waterproof. Following proper USPTO practices and procedures, the combination of P and T:

- (A) cannot support a prima facie case of obviousness because T lacks a suggestion to combine with P for the purpose of preventing breakage in nylon rope.
- (B) cannot support a prima facie case of obviousness because P lacks a suggestion to combine with T for the purpose of preventing breakage in nylon rope.
- (C) cannot support a prima facie case of obviousness because T only contains a suggestion to combine with P for the purpose of waterproofing nylon rope.
- (D) can support a prima facie case of obviousness, even though T only contains a suggestion to combine with P for the purpose of waterproofing nylon rope.
- (E) can support a prima facie case of obviousness because the applicant is always under an obligation to submit evidence of non-obviousness regardless of whether the examiner fully establishes a prima facie case of obviousness.

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29. Which of the following do not represent prior art?

- (A) The preamble of a Jepson claim.
- (B) A technical journal as of its date of publication which is accessible to the public as of the date of its publication.
- (C) A disclosure publicly posted on the INTERNET, but containing no publication or retrieval date.
- (D) A doctoral thesis indexed, cataloged and shelved in a university library.
- (E) Applicant's labeling of one of the figures in the drawings submitted with his application as prior art.

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33. In which of the following situations, considered independently of each other, is the original, new, or amended claim supported in the application as filed?

- (A) An amendment to the specification changing the definition of “holder” from “is a hook” to “is a hook, clasp, crimp, or tong” and no amendment is made of the claim, which uses the term “holder.” The amendment is filed one month after the application was filed. There was no previous supporting disclosure in the specification of the holder being a clasp, crimp, or tong.
 - (B) An amendment to the specification and claims changing the definition of “holder” from “is a hook” to “is a hook, clasp, crimp, or tong.” The amendment is filed one month after the application was filed. There was no previous supporting disclosure in the specification of the holder being a clasp, crimp, or tong.
 - (C) Original claim 1 in the application refers to “a holder,” and original claim 2 depends from and refers to claim 1 stating, “said holder is a hook, clasp, crimp, or tong.” There is no disclosure in the specification preceding the claims in the application as filed for the holder to be a clasp, crimp, or tong.
 - (D) An amendment is filed presenting a claim to an electrical insulating device, copied from a patent for the purpose of provoking an interference. The claim refers to “nonconductive plastic holder.” The application as filed contains a broad generic disclosure describing electrical insulating devices. The holder is described in the specification of the application as “conducting electricity.” There is no disclosure in the specification of the holder being “nonconductive.”
 - (E) All of the above.
30. Which of the following is in accord with proper USPTO practice and procedure?
- (F) A utility application was filed in October 1999. Following a restriction requirement, the applicant elected claims 1-5, and the examiner withdrew non-elected claims 6-10. After a final rejection of claims 1-5 in January 2001, the applicant may submit an amendment canceling previously examined claims and present claims to the previously non-elected invention of claims 6-10 when filing a request for continued examination under 37 CFR § 1.114.
 - (G) Claims in an allowed application may be amended as a matter of right after payment of the issue fee inasmuch as the Office may not rule on amendment filed after a notice of allowance until after the period for payment of the issue fee has expired.
 - (H) If, at the time an application is allowed in January 2001, a corrected drawing is required or formal drawing is needed, the applicant is given a three month period in the notice of allowability to file the same, and is permitted to file corrected or formal drawings after payment of the issue fee upon filing a request of an extension of time and payment of the requisite fee.

- (I) Where, after a final rejection, a request for continued examination complying with 37 CFR § 1.114, is filed in April 2001 accompanied by a request to suspend action by the Office for a period not exceeding three months to provide time to submit an information disclosure statement, and the requisite fees, the Office may grant the requested suspension.
- (J) Where an examiner has finally rejected all the claims in a utility application in January 2001, and sets a three month shortened statutory period for reply, the Office may grant a request to suspend action by the applicant for a period not exceeding six months to provide time to gather and submit evidence, if the request and requisite fees are filed within the three month reply period.

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40. In June 1998, Jack and Jill, a married couple, are vacationing in Vietnam (not a WTO country) when they encounter a man selling bamboo knives for cleaning fish. The particular curvature of the bamboo both lends support to the knife to prevent it from bending and breaking and facilitates cleaning inside the fish. Jill takes a picture of Jack with the knife cleaning the fish. Subsequently, in November 1998, when Jack returns to the United States he begins to make and sell an identical knife to the one seen in Vietnam. In July 1999, he files a patent application claiming the nearly identical knife. Jack discloses no prior art during the prosecution of his application and fails to mention the knife he saw in Vietnam. The examiner finds no prior art similar to the claimed knife, and Jack is awarded a patent in December 2000. Meanwhile, Jill divorces Jack, and associates with Sam. Unfortunately, Sam is penniless. To raise cash, Sam and Jill begin selling a knife identical to the one Jack produces, only Sam and Jill make their knife out of plastic. The knives of Sam and Jill sell like hotcakes. Jack sues for infringement. Jill and Sam come to you for advice. Which of the following is not true?

- (A) Jack is entitled to patent protection since Vietnam is not a WTO country and evidence of the Vietnamese knife cannot be used against him to reject his patent claims.
- (B) Jack had a duty under 37 C.F.R. § 1.56 to disclose his discovery of the bamboo knife in Vietnam to the examiner during the original patent prosecution.
- (C) Since the use in Vietnam was not in this country, it does not constitute a public use bar under 35 U.S.C. § 102(b).
- (D) If Jill's attorney files a request for reexamination, it will be denied because the picture is not a patent or printed publication.
- (E) Although Jack marketed the invention before obtaining a patent, the patent claims cannot be invalidated under 35 U.S.C. § 102(a) since Jack's making and selling of the knife cannot be used against him under 35 U.S.C. § 102(a).

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47. An examiner has properly established a prima facie showing of no specific and substantial credible utility for the claimed invention in a patent application filed in February 2001. An applicant can sustain the burden of rebutting and overcoming the showing by:

- (A) Providing reasoning or arguments rebutting the basis or logic of the prima facie showing.
- (B) Amending the claims.
- (C) Providing evidence in the form of a declaration under 37 C.F.R. § 1.132 rebutting the basis or logic of the prima facie showing.
- (D) Providing evidence in the form of a printed publication rebutting the basis or logic of the prima facie showing.
- (E) All of the above.

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49. In regard to disclosure of a utility in a nonprovisional utility patent application filed in the Office in April 2001, which of the following is not in accord with proper USPTO practice and procedure?

- (A) For each claimed invention an applicant need only provide one credible assertion of specific and substantial utility to satisfy the utility requirement.
- (B) A patent examiner can properly support a rejection based on lack of utility by providing documentary evidence regardless of the publication date to show a factual basis for the prima facie showing of no specific and substantial credible utility.
- (C) Using a complex claimed invention as landfill is an example of a specific and substantial utility for the claimed invention.
- (D) An invention has a well-established utility if a person of ordinary skill in the art would immediately appreciate why the invention is useful based on the characteristics of the invention, and the utility is specific, substantial, and credible.
- (E) Where the asserted specific and substantial utility is not credible, a prima facie showing of no specific and substantial utility must establish that it is more likely than not that a person skilled in the art would not consider credible any specific and substantial utility asserted by the applicant for the claimed invention.

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50. An article in a popular scientific journal, dated January 13, 2000, fully discloses and teaches how to make a “Smart Shoe” wireless telecommunications device. The article discloses a shoe having a dialer in a rubber sole of the shoe. The article does not teach a metallic shoelace or suggest using the same as an antenna or for any other purpose. Which of the following claims in an application filed January 22, 2001 is/are anticipated by the journal article, and is/are not likely to be properly rejected under 35 U.S.C. § 112, second paragraph as indefinite?

- Claim 1. A telecommunication device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and a metallic shoelace.
- Claim 2. A telecommunications device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and optionally a metallic shoelace.
- Claim 3. A telecommunication device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and optionally a random access memory for storing telephone numbers.
- (A) Claim 1.
- (B) Claim 2.
- (C) Claim 3.
- (D) Claims 2 and 3.
- (E) None of the above.

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11. Which of the following is not in accord with proper USPTO practice and procedure?

- (A) If a claim limitation invokes the sixth paragraph of 35 U.S.C. § 112, it must be interpreted to cover the corresponding structure, material, or acts in the specification and “equivalents thereof.”
- (B) If means-plus-function language is employed in a claim, the specification must set forth an adequate disclosure showing what that language means.
- (C) A means-plus-function claim limitation satisfies the second paragraph of 35 U.S.C. § 112 if the written description links or associates particular structure, material, or acts to the function recited in a means-plus-function claim limitation.
- (D) A step-plus-function claim limitation satisfies the second paragraph of 35 U.S.C. § 112 if it is clearly based on the disclosure in the application that one skilled in the art would have known what structure, material, or acts perform the function recited in a step-plus-function limitation.
- (E) The invocation of the sixth paragraph of 35 U.S.C. § 112 exempts an applicant from compliance with the first and second paragraphs of 35 U.S.C. § 112.

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17. To satisfy the written description requirement of the first paragraph of 35 U.S.C. § 112, an applicant must show possession of the invention. An applicant’s lack of possession of the invention may be evidenced by:

- (A) Describing an actual reduction to practice of the claimed invention.
- (B) Describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.

- (C) Requiring an essential feature in the original claims, where the feature is not described in the specification or the claims, and is not conventional in the art or known to one of ordinary skill in the art.
- (D) Amending a claim to add a limitation that is supported in the specification through implicit or inherent disclosure.
- (E) Amending a claim to correct an obvious error by the appropriate correction.

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18. Which of the following is not required in order for a foreign application that has matured into a foreign patent to qualify as a reference under 35 U.S.C. § 102(d)?

- (A) The foreign application must have actually been published before the filing of an application in the United States, but the patent rights granted need not be enforceable.
- (B) The foreign application must be filed more than 12 months before the effective filing date of the United States application.
- (C) The foreign and United States applications must be filed by the same applicant, his or her legal representatives or assigns.
- (D) The foreign application must have actually issued as a patent or inventor's certificate before the filing of an application in the United States. It need not be published but the patent rights granted must be enforceable.
- (E) The same invention must be involved.

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27. Which of the following properly creates a statutory bar to patentability of applicant's claimed invention?

- I. Applicant's invention was sold in Tokyo and New York more than one year prior to the effective U.S. filing date, but the sales were merely attempts at market penetration.
- II. Applicant's invention was experimented with and tested to further develop the invention more than one year prior to the effective U.S. filing date, but important modifications resulted from the experimentation causing the invention to be reduced to practice after the effective U.S. filing date.
- III. Applicant's invention was sold in Tokyo more than one year prior to the effective U.S. filing date, but the sale was merely market testing of the invention to determine product acceptance.

- (A) I.
- (B) II.
- (C) III.
- (D) I and III.
- (F) None of the above.

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28. In December 1988, Molly invents a new potato cutter that cuts the potatoes into shapes having a star cross section. Because of the proximity of the star outer surface to the inter core of the potato, the shape achieves optimal cooking of the potato when fried without resulting in an overly cooked outer surface. Molly, thinking that the invention is important, has two people, Sue and Tom, both sworn to secrecy, witness a drawing of the invention. Molly then locks the drawing in a safe deposit box where it remains for the next twelve years. Neither Molly, Sue, or Tom discloses the invention to anyone for the next twelve years. In December 2000, Troy invents a new potato cutter which produces potatoes having a star cross section, and the potatoes are then fried. The invention becomes an overnight success. Troy files a patent application on February 1, 2001. Molly, after seeing the success of Troy's invention in the marketplace, decides to file an application, also on February 1, 2001. The examiner is unable to find any prior art and no other prior art is cited by either applicant. Which of the following is true?

- (A) Since Molly effectively concealed her invention, Troy is entitled to a patent since although Molly conceived of the idea prior to Troy, she effectively abandoned the invention by not filing for twelve years.
- (B) Since Troy conceived of the idea after Molly and because Troy did not file a patent application before Molly, he is not entitled to priority over Molly.
- (C) Since Molly disclosed the invention to Sue and Tom, the invention was known by others prior to the invention by Troy. Therefore, Troy is precluded by 35 U.S.C. § 102(a) from obtaining a patent on his idea.
- (D) Since Molly invented the cutter before Troy, she is entitled to a patent and not Troy.
- (E) None of the above.

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32. Your client, Bill, disclosed to you the following. While hiking, he found a natural specimen of tree sap that had bonded rock material to a log, and was impervious to water. Bill realized that the sap would be an excellent roofing material for bonding asphalt shingles to wooden sheathing. Bill performed a chemical analysis of the sap and determined it was 10% A, 30% B, and 60% C. Bill experimented and found that he could synthetically produce the sap by mixing one part A by weight and three parts B by weight at 20 degrees Celsius, heating the mixture of A and B to 100 degrees Celsius, adding six parts C by weight, and cooling the mixture of A, B, and C to 20 degrees Celsius. Bill further experimented and found that if he added an effective amount of D to the mixture of A, B, and C, prior to cooling, the viscosity of the product would decrease, making it easier for roofers to apply it to wooden sheathing. You draft a patent application with a specification having all the information disclosed to you by Bill, including guidelines that explained that an effective amount of D for decreasing the viscosity is between 1% to 2% of the total weight of the mixture of A, B, and C, after cooling. The guidelines also explained that an effective amount of D for brightening the color of the composition is between 3% to 4% of the total weight of the mixture of A, B, and C, after cooling. Which if any of the following claims, included in Bill's application, would not be properly rejected pursuant to 35 U.S.C. § 101?

Claim 1. A composition for bonding asphalt shingles to wood sheathing and a method, comprising: a mixture of 10%A, 30%B, and 60%C, and adding an effective amount of D to decrease the viscosity of the mixture.

Claim 2. A composition produced by the steps of: mixing one part A by weight with three parts B by weight at 20 degrees Celsius to form a mixture of A and B; heating the mixture of A and B to 100 degrees Celsius; adding six parts C by weight to form a mixture of A, B, and C; cooling the mixture of A, B, and C to 20 degrees Celsius; and adding an effective amount of D to decrease the viscosity of the composition.

Claim 3. A composition for bonding asphalt shingles to wood sheathing, comprising 10% A, 30% B, and 60% C.

- (A) Claim 1.
- (B) Claim 2.
- (C) Claim 3.
- (D) Claims 2 and 3.
- (E) None of the above.

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33. Which of the following statements concerning reliance by an examiner on common knowledge in the art, in a rejection under 35 U.S.C. § 103 is correct?

- I. An examiner's statement of common knowledge in the art is taken as admitted prior art, if applicant does not seasonably traverse the well known statement during examination.
- II. Applicant can traverse an examiner's statement of common knowledge in the art, at any time during the prosecution of an application to properly rebut the statement.
- III. If applicant rebuts an examiner's statement of common knowledge in the art in the next reply after the Office action in which the statement was made, the examiner can never provide a reference to support the statement of common knowledge in the next Office action and make the next Office action final.

- (A) I.
- (B) II.
- (C) III.
- (D) I and II.
- (E) None of the above.

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35. A patent application filed in the USPTO contains the following dependent claim:

Claim 2. The method of Claim 1, further consisting of the step of cooling the mixture to a temperature of 32° F.

Following proper USPTO practices and procedures, from which of the following claims does Claim 2 not properly depend?

- (A) Claim 1. A method of making liquid compound A comprising the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (B) Claim 1. A method of making liquid compound A consisting of the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (C) Claim 1. A method of making liquid compound A including the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (D) Claim 1. A method of making liquid compound A characterized by the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (E) (C) and (D).

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40. You filed a patent application for a client containing a claim to a composition consisting of X, water and plaster. In the claim X is defined as follows: “X is a member selected from the group consisting of elements A, B, and C.” The claim is properly rejected under 35 U.S.C. § 102(b) as being anticipated by a reference describing the composition made of A, water and plaster. The rejection may be properly overcome by:

- (A) Amending the claim by canceling elements B and C because the reference is concerned only with element A.
- (B) Amending the claim by canceling element A from the Markush group.
- (C) Arguing that the reference is not relevant because it lacks elements B and C.
- (D) Amending the claim by changing “consisting of” to “consisting essentially of.”
- (E) Amending the claim to redefine X as “being a member selected from the group comprising elements A, B, and C.”

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44. Which of the following is true?

- (A) A claim to a process omitting a step in a process, where the step is disclosed in the specification to be essential to the invention, may not be properly rejected under 35 U.S.C. 112, first paragraph, for lack of enablement where the specification provides an enabling disclosure only for the process which includes the essential step.
- (B) Failure to disclose the best mode must rise to the level of active concealment or grossly inequitable conduct in order to support a rejection under 35 U.S.C. 112, first paragraph.
- (C) The best mode requirement is the same as the enablement requirement of the first paragraph of 35 U.S.C. 112.
- (D) If the best mode contemplated by the inventor at the time of filing the application is not disclosed, a proposed amendment adding a specific mode of practicing the invention would not be new matter.

- (E) A claim failing to interrelate essential elements of the invention as defined by the applicant in the specification, where the interrelation is critical to the invention may be properly rejected under 35 U.S.C. 112, second paragraph, for failure to properly point out and distinctly claim the invention.

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6. Evidence that a claim may not comply with the second paragraph of 35 U.S.C. § 112 occurs in accordance with proper USPTO practice and procedure where:

- (A) Remarks filed by applicant in a reply or brief regarding the scope of the invention differ and do not correspond in scope with the claim.
- (B) There is a lack of agreement between the language in the claims and the language set forth in the specification.
- (C) The scope of the claimed subject matter is narrowed during pendency of the application by deleting the originally much broader claims, and presenting claims to only the preferred embodiment within the originally much broader claims.
- (D) Claims in a continuation application are directed to originally disclosed subject matter (in the parent and continuation applications) which applicants did not regard as part of their invention when the parent application was filed.
- (E) All of the above.

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10. Independent claim 1, fully supported by the specification in a patent application states:

Claim 1. An apparatus comprising: a plastic valve; a copper pipe connected to the plastic valve; and an aluminum pipe connected to the plastic valve.

Which of the following claims, presented in the application, provide the basis for a proper rejection under 35 U.S.C. § 112, second paragraph?

- Claim 2. The apparatus of claim 1, wherein said pipe is statically charged.
Claim 3. The apparatus of claim 1, wherein the outer surface of said copper pipe is statically charged.
Claim 4. The apparatus of claim 1, further comprising a thermostat connected to said plastic valve.

- (A) Claim 2.
- (B) Claim 3.
- (C) Claim 4.
- (D) Claims 2 and 3.
- (E) Claims 3 and 4.

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25. In June 1997, Jack and Jill, a married couple, are vacationing in Vietnam (not a WTO country) when they encounter a man selling bamboo knives for cleaning fish. The particular curvature of the bamboo both lends support to the knife to prevent it from bending and breaking and facilitates cleaning inside the fish. Jill takes a picture of Jack with the knife cleaning the fish. Subsequently, in November 1997, when Jack returns to the United States he begins to make and sell a identical knife to the one seen in Vietnam. In July 1998, he files a patent application claiming the nearly identical knife. Jack discloses no prior art during the prosecution of his application and fails to mention the knife he saw in Vietnam. The examiner finds no prior art similar to the claimed knife, and Jack is awarded a patent in December 1999. Meanwhile, Jill divorces Jack, and associates with Sam. Unfortunately, Sam is penniless. To raise cash, Sam and Jill begin selling a knife identical to the one Jack produces, only Sam and Jill make their knife out of plastic. The knives of Sam and Jill sell like hotcakes. Jack sues for infringement. Jill and Sam come to you for advice. Which of the following is not true?

- (A) Jack had a duty under 37 C.F.R. § 1.56 to disclose his discovery of the bamboo knife in Vietnam to the examiner during the original patent prosecution.
- (B) Jack is entitled to patent protection since Vietnam is not a WTO country and evidence of the Vietnamese knife cannot be used against him to reject his patent claims.
- (C) Since the use in Vietnam was not in this country, it does not constitute a public use bar under 35 U.S.C. § 102(b).
- (D) If Jill's attorney files a request for reexamination, it will be denied because the picture is not a patent or printed publication.
- (E) Although Jack marketed the invention before obtaining a patent, the patent claims cannot be invalidated under 35 U.S.C. § 102(a) since Jack's making and selling of the knife cannot be used against him under 35 U.S.C. § 102(a).

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27. If a *prima facie* case of obviousness is properly established by a primary examiner, how can an applicant effectively rebut the rejection in accordance with proper USPTO practice and procedure?

- (A) Rebuttal may be by way of arguments of counsel used in place of factually supported objective evidence to rebut the *prima facie* case.
- (B) Rebuttal may be by way of an affidavit or declaration under 37 C.F.R. § 1.132 containing objective evidence arising out of a secondary consideration related to the claimed invention.
- (C) No substantive showing is required by applicant. The burden remains on the examiner to maintain a *prima facie* case.
- (D) Rebuttal evidence must be found elsewhere than in the specification.
- (E) Rebuttal may be by way of arguing that the prior art did not recognize latent properties.

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31. Which of the following do not represent prior art?

- (A) The preamble of a Jepson claim.
- (B) A technical journal as of its date of publication which is accessible to the public as of the date of its publication.
- (C) A doctoral thesis indexed, cataloged and shelved in a university library.
- (D) A disclosure publicly posted on the INTERNET, but containing no publication or retrieval date.
- (E) Applicant's labeling of one of the figures in the drawings submitted with his application as prior art.

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32. A patent application filed in the USPTO claims a nylon rope coated with element E for the purpose of preventing breakage of the rope. In the first Office action, the examiner rejects the claim as obvious over P in view of a trade journal publication, T. P teaches a nylon rope coated with resin for the purpose of making the rope waterproof. T teaches a nylon tent fabric coated with element E for the purpose of making the tent waterproof, and suggests the use of element E for making other nylon products waterproof. Following proper USPTO practices and procedures, the combination of P and T:

- (A) cannot support a prima facie case of obviousness because T lacks a suggestion to combine with P for the purpose of preventing breakage in nylon rope.
- (B) cannot support a prima facie case of obviousness because P lacks a suggestion to combine with T for the purpose of preventing breakage in nylon rope.
- (C) cannot support a prima facie case of obviousness because T only contains a suggestion to combine with P for the purpose of waterproofing nylon rope.
- (D) can support a prima facie case of obviousness, even though T only contains a suggestion to combine with P for the purpose of waterproofing nylon rope.
- (E) can support a prima facie case of obviousness because the applicant is always under an obligation to submit evidence of non-obviousness regardless of whether the examiner fully establishes a prima facie case of obviousness.

October 18, 2000 AM

33. In which of the following situations, considered independently of each other, is the original, new, or amended claim supported in the application as filed?

- (C) An amendment to the specification changing the definition of "holder" from "is a hook" to "is a hook, clasp, crimp, or tong" and no amendment is made of the claim, which uses the term "holder." The amendment is filed one month after the application was filed. There was no previous supporting disclosure in the specification of the holder being a clasp, crimp, or tong.
- (D) An amendment to the specification and claims changing the definition of "holder" from "is a hook" to "is a hook, clasp, crimp, or tong." The amendment is filed one month after the application was filed. There was no previous supporting disclosure in the specification of the holder being a clasp, crimp, or tong.

- (E) Original claim 1 in the application refers to “a holder,” and original claim 2 depends from and refers to claim 1 stating, “said holder is a hook, clasp, crimp, or tong.” There is no disclosure in the specification preceding the claims in the application as filed for the holder to be a clasp, crimp, or tong.
- (F) An amendment is filed presenting a claim to an electrical insulating device, copied from a patent for the purpose of provoking an interference. The claim refers to “nonconductive plastic holder.” The application as filed contains a broad generic disclosure describing electrical insulating devices. The holder is described in the specification of the application as “conducting electricity.” There is no disclosure in the specification of the holder being “nonconductive.”
- (G) All of the above.

October 18, 2000 PM

6. You filed a patent application for a client containing a claim to a composition consisting of X, water and plaster. In the claim X is defined as follows: “X is a member selected from the group consisting of elements A, B, and C.” The claim is properly rejected under 35 U.S.C. § 102(b) as being anticipated by a reference describing the composition made of A, water and plaster. The rejection may be properly overcome by:

- (A) Amending the claim by canceling elements B and C because the reference is concerned only with element A.
- (B) Arguing that the reference is not relevant because it lacks elements B and C.
- (C) Amending the claim by canceling element A from the Markush group.
- (D) Amending the claim by changing “consisting of” to “consisting essentially of.”
- (E) Amending the claim to redefine X as “being a member selected from the group comprising elements A, B, and C.”

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Please answer questions 19 and 20 based on the following facts:

Your client, Bill, disclosed to you the following. While hiking, he found a natural specimen of tree sap that had bonded rock material to a log, and was impervious to water. Bill realized that the sap would be an excellent roofing material for bonding asphalt shingles to wooden sheathing. Bill performed a chemical analysis of the sap and determined it was 10% A, 30% B, and 60% C. Bill experimented and found that he could synthetically produce the sap by mixing one part A by weight and three parts B by weight at 20 degrees Celsius, heating the mixture of A and B to 100 degrees Celsius, adding six parts C by weight, and cooling the mixture of A, B, and C to 20 degrees Celsius. Bill further experimented and found that if he added an effective amount of D to the mixture of A, B, and C, prior to cooling, the viscosity of the product would decrease, making it easier for roofers to apply it to wooden sheathing. You draft a patent application with a specification having all the information disclosed to you by Bill, including guidelines that explained that an effective amount of D for decreasing the viscosity is between 1% to 2% of the total weight of the mixture of A, B, and C, after cooling. The guidelines also explained that an effective amount of D for brightening the color

of the composition is between 3% to 4% of the total weight of the mixture of A,B, and C, after cooling.

19. Which if any of the following claims, included in Bill's application, would not be properly rejected pursuant to 35 U.S.C. § 101?

Claim 1. A composition for bonding asphalt shingles to wood sheathing and a method, comprising: a mixture of 10%A, 30%B, and 60%C, and adding an effective amount of D to decrease the viscosity of the mixture.

Claim 2. A composition for bonding asphalt shingles to wood sheathing, comprising 10% A, 30% B, and 60% C.

Claim 3. A composition produced by the steps of: mixing one part A by weight with three parts B by weight at 20 degrees Celsius to form a mixture of A and B; heating the mixture of A and B to 100 degrees Celsius; adding six parts C by weight to form a mixture of A, B, and C; cooling the mixture of A, B, and C to 20 degrees Celsius; and adding an effective amount of D to decrease the viscosity of the composition.

- (A) Claim 1
- (B) Claim 2
- (C) Claim 3
- (D) Claims 2 and 3
- (E) None of the above.

20. Assuming that A, B, C, and D are known materials, which if any of the following claims, included in Bill's application, would not be properly rejected pursuant to 35 U.S.C. 112, second paragraph?

Claim 1. A composition produced by the steps of: mixing one part A by weight with three parts B by weight at 20 degrees Celsius to form a mixture of A and B; heating the mixture of A and B to 100 degrees Celsius; and adding six parts C by weight to the mixture of A and B.

Claim 2. A composition for bonding asphalt shingles to wood sheathing, comprising 10% A, 30% B, and 60% C.

Claim 3. A composition produced by the steps of: mixing one part A by weight with three parts B by weight at 20 degrees Celsius to form a mixture of A and B; heating the mixture of A and B to 100 degrees Celsius; adding six parts C by weight to form a mixture of A, B, and C; cooling the mixture of A, B, and C to 20 degrees Celsius; and adding an effective amount of D.

- (A) Claim 1.
- (B) Claim 2.
- (C) Claim 3.
- (D) Claims 1 and 2.
- (E) None of the above.

October 18, 2000 PM

25. Which of the following statements concerning reliance by an examiner on common knowledge in the art, in a rejection under 35 U.S.C. § 103 is correct?

- I. Applicant can traverse an examiner's statement of common knowledge in the art, at any time during the prosecution of an application to properly rebut the statement.
 - II. An examiner's statement of common knowledge in the art is taken as admitted prior art, if applicant does not seasonably traverse the well known statement during examination.
 - III. If applicant rebuts an examiner's statement of common knowledge in the art in the next reply after the Office action in which the statement was made, the examiner can never provide a reference to support the statement of common knowledge in the next Office action and make the next Office action final.
- (A) I
 - (B) II
 - (C) III
 - (D) I and II
 - (B) None of the above.

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26. In which of the following situations can the applicant overcome a rejection under 35 U.S.C. § 102(e) over a U.S. patent in accordance with proper USPTO practice and procedure?

- (A) An applicant can antedate the filing date of the patent used to reject claims under 35 U.S.C. § 102(e) by relying upon the filing date of applicant's prior abandoned nonprovisional patent application, which was filed before the effective date of the prior art. The abandoned application was not copending with the applicant's current patent application. The applicant did not file any other patent applications, and is not entitled to benefit of priority of the abandoned application.
- (B) An applicant can antedate the filing date of the patent used to reject claims under 35 U.S.C. § 102(e) if the applicant relies on the applicant's earlier foreign priority application, which conforms to the requirements of the first paragraph of 35 U.S.C. § 112 for all claims in the applicant's U.S. patent application, and all relevant provisions of 35 U.S.C. § 119 have been met. The foreign application has a filing date prior to the filing date of the patent.
- (C) An applicant can antedate the publication of his own invention more than one year before his first patent application was filed by showing that it is a publication of his own work.

- (D) An applicant can antedate the patent to a different inventive entity where the patent discloses but does not claim the applicant's invention, the patent describes the applicant's own work, and the applicant states that the different inventive entity derived the invention from him. The applicant files an affidavit disclosing the foregoing, but lacks evidence showing who invented the claimed subject matter.
- (E) (A), (B), (C) and (D).

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27. Which of the following properly creates a statutory bar to patentability of applicant's claimed invention?

- I. Applicant's invention was sold in Tokyo and New York more than one year prior to the effective U.S. filing date, but the sales were merely attempts at market penetration.
 - II. Applicant's invention was experimented with and tested to further develop the invention more than one year prior to the effective U.S. filing date, but important modifications resulted from the experimentation causing the invention to be reduced to practice after the effective U.S. filing date.
 - III. Applicant's invention was sold in Tokyo more than one year prior to the effective U.S. filing date, but the sale was merely market testing of the invention to determine product acceptance.
- (A) I
 - (B) II
 - (C) III
 - (D) I and III
 - (G) None of the above.

October 18, 2000 PM

35. A patent application filed in the USPTO contains the following dependent claim:

- 2. The method of Claim 1, further consisting of the step of cooling the mixture to a temperature of 32° F.

Following proper USPTO practices and procedures, from which of the following claims does Claim 2 not properly depend?

- (A) 1. A method of making liquid compound A consisting of the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (B) 1. A method of making liquid compound A comprising the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (C) 1. A method of making liquid compound A including the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (D) 1. A method of making liquid compound A characterized by the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (E) (C) and (D).

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40. Stan, through a registered practitioner, files an application for a patent. During the prosecution of Stan's patent, in an amendment, the practitioner admitted in his discussion as to "all the claims" of Stan's application, that "the most pertinent available prior art known to the Applicants and their representatives is the Acme Patent, cited by the examiner." Within one year after the patent issues, Stan comes to you and wants to file a reissue to broaden his claims, based on the fact that the Acme patent is not prior art. He has ample evidence to show that he conceived and reduced his invention to practice before the filing date of the Acme patent. Which of the following is true?

- (A) Stan should file a reissue application accompanied by a declaration under 37 C.F.R. 1.131 to swear behind the date of the Acme reference. The statement by the registered practitioner, who formerly represented Stan, that the Acme patent was prior art constituted error without deceptive intent and may be corrected by reissue.
- (B) Stan should file a request for reexamination and submit the Acme patent along with evidence in the form of affidavits or declarations showing that the Acme patent is not prior art.
- (C) The explicit admission by registered practitioner, who formerly represented Stan, that the Acme patent constituted prior art is binding on Stan in any later proceeding involving the patent.
- (D) Since Acme patent was cited by the examiner and not by the registered practitioner, who formerly represented Stan, Stan can not be held accountable for the error. Moreover, the statement by was directed to the pertinence of the prior art and not to the issue of whether the date of the Acme patent could be sworn behind. Accordingly, the statement has no binding effect.
- (E) (A) and (D).

October 18, 2000 PM

43. An article in a popular scientific journal, dated January 13, 1998, fully discloses and teaches how to make a “Smart Shoe” wireless telecommunications device. The article discloses a shoe having a dialer in a rubber sole of the shoe. The article does not teach or suggest using a metallic shoelace as an antenna or for any other purpose. Which of the following claims in an application filed January 20, 1999 is/are anticipated by the journal article, and is/are not likely to be properly rejected under 35 U.S.C. § 112, second paragraph as indefinite?

Claim 1. A telecommunications device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and optionally a metallic shoelace.

Claim 2. A telecommunication device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and a metallic shoelace.

Claim 3. A telecommunication device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and optionally a random access memory for storing telephone numbers.

- (A) Claim 1.
- (B) Claim 2.
- (C) Claim 3.
- (D) Claims 1 and 3.
- (E) None of the above.

October 18, 2000 PM

44. Which of the following is true?

- (A) A claim to a process omitting a step in a process, where the step is disclosed in the specification to be essential to the invention, may not be properly rejected under 35 U.S.C. 112, first paragraph, for lack of enablement where the specification provides an enabling disclosure for the process which includes the essential step.
- (B) A claim failing to interrelate essential elements of the invention as defined by the applicant in the specification, where the interrelation is critical to the invention may be properly rejected under 35 U.S.C. 112, second paragraph, for failure to properly point out and distinctly claim the invention.
- (C) The best mode requirement is the same as the enablement requirement of the first paragraph of 35 U.S.C. 112.
- (D) If the best mode contemplated by the inventor at the time of filing the application is not disclosed, a proposed amendment adding a specific mode of practicing the invention would not be new matter.
- (E) Failure to disclose the best mode must rise to the level of active concealment or grossly inequitable conduct in order to support a rejection under 35 U.S.C. 112, first paragraph.

April 12, 2000 AM

4. Buddy is a recent father and a machinist at a local machine shop that makes custom automotive parts. One day while driving to work, Buddy conceived an idea for an improved baby stroller. He quickly worked out many of the details of how to build such an improved stroller, but he still had questions. Buddy later explained his idea to his employer and showed the employer detailed preliminary drawings of the stroller without any agreement as to confidentiality. Buddy wanted use of his employer's machine shop to build a model. Buddy's employer was also excited about the stroller idea and its commercial potential, and the two quickly reached an oral agreement. Buddy would have free use of the machine shop equipment and supplies after regular business hours to work on his model. In exchange, Buddy agreed to assign any patent rights in his invention to the employer for \$1000.00. Only Buddy and, occasionally, his employer were ever present in the shop when Buddy was working on the stroller. Buddy finalized the design just over a year later, and a patent application was on file within a month of finalization along with a recently executed written assignment of the rights in the invention to Buddy's employer. During prosecution of the patent application, the examiner learned of the oral agreement between Buddy and his employer, and rejected the claims on the basis that the invention was on sale more than one year before the application filing date. Which of the following would provide the most reasonable basis for traversing the rejection?

- (A) The Examiner cannot properly make the rejection because it is not based on prior art patents or printed publications.
- (B) The oral agreement was a private transaction between Buddy and his employer and no private transaction can provide a basis for an on-sale bar.
- (C) An assignment or sale of the rights in an invention and potential patent rights is not a sale of "the invention" that would operate as a bar to patentability.
- (D) Because no one other than Buddy's employer was present in the shop when Buddy was working on the stroller and the oral agreement was not public, there can be no on-sale bar even though there was no express requirement of confidentiality.
- (E) Although the oral agreement to assign the patent to Buddy's employer was made more than a year before the filing date, the written assignment was less than a year before the filing date, and under the Statute of Frauds, sales for more than \$500.00 require a written agreement. A rejection based on the on-sale bar can never be made unless there is a binding contract for sale.

April 12, 2000 AM

5. A patent application includes the following Claim 1:

Claim 1. A method of making an electrical device comprising the steps of:

- (i) heating a base made of carbon to a first temperature in the range of 1875°C to 1925°C;
- (ii) passing a first gas over said heated base, said first gas comprising a mixture of hydrogen, SiCl₄, phosphorus, and methane, whereby said first gas decomposes over said heated base and thereby forms a first deposited layer of silicon, phosphorus and carbon on said heated base;

- (iii) heating said base having said deposited layer to a second temperature of approximately 1620°C; and
- (iv) passing a second gas over said base heated to said second temperature, said second gas consisting of a mixture of hydrogen, SiCl₄, AlCl₃, and methane, whereby said second gas decomposes over said heated base to form a second deposit layer adjacent said first layer, said second layer comprising silicon, aluminum and carbon.

Assuming proper support in the specification, which of the following claims, if presented in the same application, is a proper claim?

- (A) Claim 2. The method of claim 1, wherein said first temperature is in the range of 1800°C to 2000°C.
- (B) Claim 3. The method of claim 1, wherein said first gas further comprises an inert gas.
- (C) Claim 4. The method of claim 1, wherein said second gas further comprises Argon.
- (D) Claim 5. The method of claim 1, wherein said first gas is an inert gas such as Argon.
- (E) Claim 6. The method of claim 1, wherein said second gas consists of a mixture of hydrogen, SiCl₄ and AlCl₃ only.

April 12, 2000 AM

6. Which of the following statements is **true** regarding a product-by-process claim?

- (A) Product-by-process claims cannot vary in scope from each other.
- (B) Product-by-process claims may only be used in chemical cases.
- (C) A lesser burden of proof may be required to make out a case of prima facie obviousness for product-by-process claims than is required to make out a prima facie case of obviousness when the product is claimed in the conventional fashion.
- (D) It is proper to use product-by-process claims only when the process is patentable.
- (E) It is proper to use product-by-process claims only when the product is incapable of description in the conventional fashion.

April 12, 2000 AM

7. An application directed to hand shearing of sheep includes the following incomplete independent Claim 1 and dependent Claims 2-3.

- Claim 1. An apparatus for shearing sheep, said apparatus comprising:
- (i) a first cutting member having a first cutting edge at one end and a thumb loop at the other end;
 - (ii) a second cutting member having a second cutting edge at one end and a finger loop at the other end;
 - (iii) _____;
 - (iv) said second cutting member additionally including a pointer loop between said finger loop and said mid-point, said pointer loop having a pointer loop center, said finger loop having a finger loop center and said pointer loop having a pointer loop center such that a plane through said finger loop center and said pointer loop center is generally parallel to said second cutting edge for improved balance.
- Claim 2. The apparatus of claim 1, wherein said first cutting member includes a threaded aperture extending entirely through said first cutting member between said thumb loop and said mid-point, and an adjusting screw that extends through said threaded aperture to engage a bearing surface below the pointer loop on said second cutting member.
- Claim 3. The apparatus of claim 2, wherein said connector is a rivet.

Which of the following most broadly completes missing paragraph (iii) of Claim 1?

- (A) “wherein said first cutting member and said second cutting member are pivotally secured to each other at respective mid-points, and wherein said finger loop is padded; and”
- (B) “said first cutting member having a mid-point between its ends and said second cutting member having a mid-point between its ends, wherein said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points by a connector; and”
- (C) “said first cutting member including a reservoir for dispensing disinfectant solution and having a mid-point between its ends, said second cutting member having a mid-point between its ends, and wherein said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points by a connector; and”
- (D) “said first cutting member and said second cutting member being pivotally secured to each other by a connector; and”
- (E) “said first cutting member having a mid-point between its ends and said second cutting member having a mid-point between its ends, and said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points; and”

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13. The specification of a patent application contains limited disclosure of using antisense technology in regulating three particular genes in *E. coli* cells. The specification contains three examples, each applying antisense technology to regulating one of the three particular genes in *E. coli* cells. Despite the limited disclosure, the specification states that the “the practices of this invention are generally applicable with respect to any organism containing genetic material capable of being expressed such as bacteria, yeast, and other cellular organisms.” All of the original claims in the application are broadly directed to the application of antisense technology to any cell. No claim is directed to applying antisense technology to regulating any of the three particular genes in *E. coli* cells. The examiner rejects the claims under 35 U.S.C. § 112, first paragraph, for lack of enablement citing a publication that correctly notes antisense technology is highly unpredictable, requiring experimentation to ascertain whether the technology works in each type of cell. The publication cites the inventor’s own articles (published after the application was filed) that include examples of the inventor’s own failures to control the expressions of other genes in *E. coli* and other types of cells. The rejection is:

- (A) appropriate. The claims are not commensurate in scope with the breadth of enablement inasmuch as the working examples in the application are narrow compared to the wide breadth of the claims, the unpredictability of the technology, the high quantity of experimentation needed to practice the technology in cells other than *E. coli*.
- (B) appropriate. The claims are not commensurate in scope with the breadth of the enablement inasmuch no information is provided proving the technology is safe when applied to animal consumption.
- (C) inappropriate. The claims are commensurate in scope with the breadth of enablement inasmuch as the specification discloses that the “the practices of this invention are generally applicable with respect to any organism containing genetic material capable of being expressed.”
- (D) inappropriate. The claims are commensurate in scope with the breadth of enablement inasmuch as the claims are original, and therefore are self-supporting.
- (E) inappropriate. The claims are commensurate in scope with the breadth of the enablement inasmuch as the inventor is not required to theorize or explain why the failures reported in the article occurred.

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16. A patent specification discloses a personal computer comprising a microprocessor and a random access memory. There is no disclosure in the specification of the minimum amount of storage for the random access memory. In the disclosed preferred embodiment, the microprocessor has a clock speed of 100-200 megahertz. Claims 9 and 10, presented below, are original claims in the application. Claim 11, presented below, was added by amendment after an Office action.

9. A personal computer comprising a microprocessor and a random access memory including at least 1 gigabyte of storage.
10. The personal computer of Claim 9, wherein the microprocessor has a clock speed of 100-200 megahertz.
11. The personal computer of Claim 10, wherein the random access memory is greater than ½ gigabyte of storage.

Which of the following statements is or are **true** about the respective claims under 35 U.S.C. § 112, fourth paragraph?

- (A) Claim 9 is a proper independent claim, and Claims 10 and 11 are proper dependent claims.
- (B) Claim 9 is a proper independent claim, and Claims 10 and 11 are improper dependent claims.
- (C) Claim 9 is an improper independent claim, and Claims 10 and 11 are improper dependent claims.
- (D) Claim 9 is an improper independent claim, and Claims 10 and 11 are proper dependent claims.
- (E) Claim 9 is a proper independent claim, Claim 10 is a proper dependent claim, and Claim 11 is an improper dependent claim.

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17. Smith invented a laminate. In a patent application, Smith most broadly disclosed the laminate as comprising a transparent protective layer in continuous, direct contact with a light-sensitive layer without any intermediate layer between the transparent protective layer and the light-sensitive layer. The prior art published two years before the effective filing date of Smith's application included a laminate containing a transparent protective layer and a light-sensitive layer held together by an intermediate adhesive layer. Which of the following is a proper claim that would overcome a 35 U.S.C. § 102 rejection based on the prior art?

- (A) 1. A laminate comprising a transparent protective layer and a light-sensitive layer.
- (B) 1. A laminate comprising a transparent protective layer and a light-sensitive layer which is in continuous and direct contact with the transparent protective layer.
- (C) 1. A laminate comprising a transparent protective layer and a light-sensitive layer, but not including an adhesive layer.
- (D) (A) and (B).
- (E) (B) and (C).

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18. Which of the following is NOT a policy underlying the public use bar of 35 U.S.C. § 102(b)?

- (A) Discouraging the removal, from the public domain, of inventions that the public reasonably has come to believe are freely available.
- (B) Favoring the prompt and widespread disclosure of inventions.
- (C) Allowing the inventor(s) a reasonable amount of time following sales activity to determine the potential economic value of a patent.
- (D) Increasing the economic value of a patent by extending the effective term of the patent up to one year.
- (E) Prohibiting the inventor(s) from commercially exploiting the invention for a period greater than the statutorily prescribed time.

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26. Which of the following statements is most correct?

- (A) The same evidence sufficient to establish a constructive reduction to practice is necessarily also sufficient to establish actual reduction to practice.
- (B) Proof of constructive reduction to practice does not require sufficient disclosure to satisfy the “how to use” and “how to make” requirements of 35 U.S.C. § 112, first paragraph.
- (C) A process is reduced to actual practice when it is successfully performed.
- (D) The diligence of 35 U.S.C. § 102(g) requires an inventor to drop all other work and concentrate on the particular invention.
- (E) The diligence of 35 U.S.C. § 102(g) does not impose on a registered practitioner any need for diligence in preparing and filing a patent application inasmuch as such the practitioner’s acts do not inure to the benefit of the inventor.

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27. On February 8, 1999, you filed a patent application that you prepared for Mr. Bond. The application contains only one claim. The application disclosed a composition having 20%A, 20%B, and either 60%C or 60%D. Claim 1 is as follows:

Claim 1. A composition useful for bonding semiconductor materials to metals, comprising 20%A, 20%B, and 60%C.”

The examiner found a patent to Gold, dated March 8, 1998, which only disclosed and claimed a composition, having 20%A, 20%B, and 60%C, and also taught that the composition would only be useful for insulating metals from corrosion. The examiner rejected Claim 1 under 35 U.S.C. § 102(a) as anticipated by Gold, in an Office action dated August 9, 1999.

Which of the following is most likely to overcome the rejection, and comports with proper PTO rules and procedure?

- (A) Filing a reply, on March 9, 2000, with a petition for a three-month extension and the fee for a three-month extension, traversing the rejection on the ground that Gold does not disclose using the composition for bonding semiconductor materials to metals, and therefore does not disclose all the elements of Claim 1.
- (B) Filing a reply, on September 9, 1999, traversing the rejection on the ground that Gold does not disclose using the composition for bonding semi-conductor materials to metals, and therefore does not disclose all the elements of Claim 1.
- (C) Filing a reply on October 9, 1999, amending Claim 1 to state as follows: "Claim 1. A composition comprising: 20%A, 20%B, and 60%D." In the reply, pointing out why the amendment gives the claim patentable novelty.
- (D) Filing a reply on October 9, 1999, traversing the rejection on the grounds that the patent to Gold teaches away from using the invention in the manner taught in Bond's application.
- (E) Filing (i) a 37 C.F.R. § 1.132 affidavit objectively demonstrating the commercial success of the invention as claimed, and (ii) a reply containing an argument why the claimed invention is patentable, but no amendment to Claim 1.

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28. Which of the following three statements is(are) **true** ?

- (i) An applicant cannot use a patent to prove the state of the art for the purpose of satisfying the enablement requirement if the patent has an issue date later than the effective filing date of the applicant's application.
 - (ii) A publication dated after the effective filing date of an application may be properly used to demonstrate that an application is nonenabling if the publication provides evidence of what one skilled in the art would have known on or before the application's effective filing date.
 - (iii) The state of the art existing at the issue date of the patent is used to determine whether a particular disclosure in the patent is enabling.
- (A) (i), (ii) and (iii).
 - (B) (i) and (ii).
 - (C) (i).
 - (D) (ii) and (iii).
 - (E) None of the above.

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30. On February 8, 1999, you prepared and filed a patent application for Smith disclosing and claiming a new method for heating automobile windshields. The specification disclosed connecting a variable voltage source to a resistive heating element, connecting the heating element to the windshield, and adjusting the voltage of the voltage source to an effective amount. The specification stated certain advantages of heating automobile windshields by the invention's method, including protecting the internal structure of the glass from cracking, and defrosting the glass. The specification also fully disclosed guidelines adequately explaining that an effective amount of voltage to protect windshield glass from cracking was at least 0.5 volts, regardless of the outside temperature. The specification disclosed that an effective amount of voltage for defrosting windshields was at least 1.0 volt, regardless of the outside temperature. Claim 1 stated the following:

Claim 1. A method for heating an automobile windshield, comprising: connecting a variable voltage source to a resistive heating element; connecting the resistive heating element to the automobile windshield; and adjusting the voltage source to an effective amount of voltage.

You received a non-final Office action, dated February 4, 2000, rejecting claim 1 only under 35 U.S.C. § 112, second paragraph. The rejection stated that the use of the limitation, "an effective amount of voltage," rendered the claim indefinite. Which, if any, of the following actions, taken by you, comport with proper PTO rules and procedure, and will overcome the rejection?

- I. Filing an appeal with a brief, on August 3, 2000, arguing that the only remaining issue is the definiteness of claim 1, and that the claim is not rendered indefinite by the use of the limitation, "an effective amount of voltage," since guidelines in the specification fully disclosed what "an effective voltage" would be.
 - II. Filing a reply on May 4, 2000, traversing the rejection on the grounds that claim 1 is not rendered indefinite by the use of the limitation, "an effective amount of voltage," since guidelines in the specification fully disclosed what "an effective voltage" would be.
 - III. Filing a reply on May 4, 2000, amending the limitation, "an effective amount of voltage" to read, "an effective amount of voltage for defrosting the automobile windshield".
- (A) I.
 - (B) II.
 - (C) III.
 - (D) II and III.
 - (E) I, II, and III.

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31. A prima facie case of obviousness requires a suggestion, teaching, or motivation to modify the references to produce the claimed invention. The suggestion, teaching, or motivation is established:

- (A) only if the suggestion, teaching, or motivation to do so is found in the references themselves.
- (B) if the claimed invention is within the capabilities of one of ordinary skill in the art.
- (C) by the mere fact that the references can be combined.
- (D) if the suggestion, teaching, or motivation is found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.
- (E) (A), (B), (C) and (D).

April 12, 2000 AM

42. Which of the following can never properly be available as prior art for purposes of a rejection under 35 U.S.C. § 102(a)?

- (A) A drawing, labeled "Prior Art," submitted by the applicant.
- (B) Canceled matter in an application that matured into a U.S. patent where the matter is not published in the patent.
- (C) An abandoned patent application referenced in a publication available to the public.
- (D) The combination of two references, where one of the references is used merely to explain the meaning of a term used in the primary reference.
- (E) A reference authored only by applicant, and published less than one year prior to the effective filing date of applicant's patent application.

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45. Which of the following presents a Markush group in accordance with proper PTO practice and procedure?

- (A) R is selected from the group consisting of A, B, C, or D.
- (B) R is selected from the group consisting of A, B, C, and D.
- (C) R is selected from the group comprising A, B, C, and D.
- (D) R is selected from the group comprising A, B, C or D.
- (E) R is A, B, C, and D.

April 12, 2000 AM

50. On Saturday, February 6, 1999, in Texas, inventor Smith successfully tested a wireless telephone. On Sunday, February 7, 1999, Smith began testing the market place by offering to sell the wireless telephone in a variety of urban and rural regions, throughout Texas. On Tuesday, February 8, 2000, registered practitioner Bill filed a patent application for inventor Smith fully disclosing and claiming the same wireless telephone he tested on February 6, 1999, and offered for sale on February 7, 1999. Bill received a non-final Office action rejection of the claim under 35 U.S.C. § 102(b) based on Smith's activities in testing the wireless telephone, and testing the market place. Which, if any, of the following actions taken by Bill comport with proper PTO rules and procedure, and will overcome the rejection?

- (A) Filing a timely reply traversing the rejection on the grounds that February 7, 1999 was a Sunday, that Smith could not file an application on the one-year anniversary Sunday because the PTO is closed, so Smith's activities must be measured from Monday, February 8, 1999, which is not more than one year prior to the application date.
- (B) Filing a timely reply traversing the rejection on the grounds that Smith's activities were experimental only and therefore excepted from 35 U.S.C. § 102(b).
- (C) Filing a timely reply with an affidavit under 37 C.F.R. § 1.131 presenting statements by Smith that the activities were by Smith, himself, as opposed to another, and the activities were experimental.
- (D) Filing a timely reply with an affidavit under 37 C.F.R. § 1.132 demonstrating by objective evidence of the commercial success of the wireless telephone.
- (E) None of the above.

April 12, 2000 PM

4. A patent application includes the following incomplete Claim 1:

Claim 1. A shaving implement comprising

- (i) _____;
- (ii) a shaving head arranged perpendicular to said handle and including a razor, said shaving head being connected to said handle at said first end;
- (iii) a collapsible tube of shaving cream positioned in and substantially filling said dispensing chamber, said tube including a neck having a dispensing opening provided in proximity to said razor;
- (iv) a removable dispensing chamber plug provided at said second end such that when said plug is removed said collapsible tube of shaving cream may be replaced; and
- (v) a tube squeezing slide positioned within said channel and said dispensing chamber, said slide including opposed slots thereon, said slots being in sliding engagement with said longitudinal sides of said channel.

Which of the following, if included as paragraph (i) of Claim 1, properly completes the claim?

- (A) an elongated handle including a dispensing chamber and a channel formed in said handle, said channel being defined by longitudinal sides within said handle and communicating over substantially its entire length with said dispensing chamber;
- (B) an elongated handle having a first end, said handle including a chamber and a channel formed in said handle, said channel being defined by longitudinal sides within said handle and communicating over substantially its entire length with said chamber;
- (C) an elongated handle having a first end, said handle including a dispensing chamber and an elongated channel formed in said handle, said channel communicating over substantially its entire length with said chamber;
- (D) an elongated handle having a first end and a second end, said handle including a dispensing chamber and a channel formed in said handle, said channel being defined by longitudinal sides within said handle and communicating over substantially its entire length with said dispensing chamber;
- (E) an elongated handle having a first end and a second end, said handle including a channel formed in said handle, said channel being defined by longitudinal sides within said handle and communicating over substantially its entire length with said chamber;

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Please answer questions 16 and 17 based on the following facts. On February 15, 1999, Debbie conceived a unique system for humanely caging hunting dogs and automatically feeding them at appropriate times. Debbie told her husband, Ted, about her idea that night, and the two spent the next four months working regularly on the concept. Ted built a cage that implemented the concept on June 17, 1999, and tested it on his own dogs for a week. It worked perfectly for its intended purpose. The next day, Ted visited a family friend, Ginny, who happened to be a registered practitioner, and asked her to prepare a patent application on Debbie's behalf. Ginny declined representation, explaining that she was in the middle of trial preparation and would not be able to work on the application for at least four months. Ginny gave Ted the names of a number of qualified patent practitioners, suggesting he consider retaining one of them to promptly prepare the patent application, and explained that a delay in filing the patent application could prejudice Debbie's patent rights. Ted, however, felt uncomfortable going to a practitioner he did not know personally, and did not contact any of the individuals recommended by Ginny. After Ginny had completed her trial and was back in the office, Ted visited her on December 1, 1999. At that time Ginny agreed to represent Debbie. An application was filed in the PTO within 10 days.

On May 15, 1999, Billie conceived an idea substantively identical to Debbie's. Billie immediately prepared a detailed technical description including drawings and visited a registered practitioner. Billie filed a patent application on June 14, 1999. Later, on July 9, 1999, Billie built a cage that implemented the concept and had fully tested it by August 11, 1999.

16. Assuming Debbie's patent application is substantively identical to Billie's patent application, which of the following statements is most correct?

- (A) Nearly simultaneous invention by Debbie and Billie is proof that the invention is obvious and precludes patentability.
- (B) Nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention.
- (C) Nearly simultaneous invention by Debbie and Billie may be evidence of a long-felt need for the invention.
- (D) Nearly simultaneous invention by Debbie and Billie may be evidence of commercial success of the invention.
- (E) Statements (A), (B), (C) and (D) are each incorrect.

17. With regard to a priority contest between Debbie and Billie, which of the following statements is most correct?

- (A) To encourage prompt disclosure of inventions to the public, the PTO always awards priority to the first to file an application, in this case Billie.
- (B) Debbie will be awarded priority only if she can establish diligence for the entire time between May 14, 1999 and her actual reduction to practice in June 1999, and can establish that she did not suppress, abandon or conceal the invention.
- (C) Debbie will be awarded priority only if she can establish diligence for the entire time between her conception in February 1999 and actual reduction to practice in June 1999, and can establish that she did not suppress, abandon or conceal the invention.
- (D) Debbie will be awarded priority if she can establish diligence for the entire time between May 14, 1999 and her patent filing in December 1999, and can establish that she did not suppress, abandon or conceal the invention.
- (E) Billie must be awarded priority because his patent application established a constructive reduction to practice prior to Debbie's actual reduction to practice, even if Debbie was diligent in reducing her invention to practice.

April 12, 2000 PM

18. Which of the following statements regarding a registered practitioner is most correct?

- (A) An unsubstantiated argument by a practitioner that applicant discovered the problem is insufficient to show that applicant discovered the source of the problem.
- (B) An unsubstantiated argument by a practitioner that the invention provides a solution of a long-felt need is insufficient to show that the invention fills a long-felt need.
- (C) Where an examiner has advanced a reasonable basis for questioning the adequacy of disclosure, an argument by a practitioner that the application meets the requirements of 35 U.S.C. § 112, first paragraph, is entitled to little, if any weight, in the absence of facts supporting a basis for deciding that the specification complies with 35 U.S.C. § 112, first paragraph.

- (D) An argument by a practitioner that the prior art reference is inoperative is insufficient to show the claimed subject matter is unobvious in the absence of objective evidence demonstrating inoperability of the prior art reference.
- (E) Each of (A), (B), (C), and (D) is correct.

April 12, 2000 PM

23. In 1998, Chris invents an automobile or truck windshield wiper device that uses a transparent grid to automatically sense water drops on the windshield and wipe the window whenever a drop appears. The grid detects current variations when moisture impregnates the grid, and then activates the windshield wiper. In April 1998, Chris submitted an article for publication in Popular Scientist magazine disclosing the invention. The magazine edited the article to the extent that the article, published August 1, 1998, fails to enable one of ordinary skill in the art to make the invention. On August 31, 1998, Chris offers the automobile windshield wiper device for sale to the Ajax Motor Company, leaving a sample device for use in automobiles at the Ajax plant. Chris knew his device can be used with trucks only if the sensors are modified to accommodate the larger windshields, however no such modification has been made. Without Chris' knowledge, Ajax intends to use the device on its trucks. Ajax modifies and successfully tests the device using larger sensors for trucks on a public highway on September 1, 1998. Chris files a patent application with the PTO for the basic concept for automotive windshields on August 2, 1999. On August 30, 1999, Chris realizes that Ajax modified his invention to work with trucks on September 1, 1998, and that his claims do not cover the truck embodiment. There is no basis in the application supporting a claim directed to the embodiment for trucks, but the modification would have been obvious to one of ordinary skill in the art. Chris' application has not yet issued. He comes to you, a registered practitioner, for advise on the morning of August 30, 1999 as to whether he should file a new application for his windshield wiper directed to trucks and buses. What should you advice Chris to do in accordance with proper PTO practice and procedure?

- (A) The Popular Scientist publication is a bar under 35 U.S.C. § 102(b) since it was filed over a year before the application was filed.
- (B) Chris can still file a claim in the pending application directed to windshield wipers for trucks because the modification of the sensors would have been obvious to the artisan.
- (C) Chris must file a new application on or before September 1, 1999, to avoid the testing by Ajax from becoming a statutory bar to him obtaining a second patent directed to the windshield wiper for trucks embodiment.
- (D) Chris may file a continuation-in-part application anytime before the first patent application issues in which he can disclose and claim the windshield wiper device for use on trucks and buses since a continuation-in-part is entitled to the parent filing date for everything disclosed in the continuation-in-part application.
- (E) Since the Ajax use of the device on trucks was not discovered until August 31, 1999, Chris has one year from August 31, 1999, to file a new patent application directed to use of his invention on trucks.

April 12, 2000 PM

29. Which of the following is not a requirement of 35 U.S.C. § 102(d) to bar the granting of a patent in this country?

- (A) The foreign patent or inventor's certificate must have been published prior to the date of the application for patent in the United States.
- (B) The foreign application must have been filed more than 12 months before the effective filing of the application in the United States.
- (C) The foreign application must have been filed by the same applicant as in the United States or by his or her legal representatives or assigns.
- (D) The foreign patent or inventor's certificate must be actually granted before the U.S. filing date.
- (E) The same invention must be involved.

April 12, 2000 PM

31. You are drafting a patent application for your client's widget invention. The application discloses a widget consisting essentially of, in series, an amplifier having a power output of 100 to 300 amps, preferably 250 amps, and a woofer having a wattage of 400 to 450 watts, preferably 425 watts. The application satisfies the requirements of 35 U.S.C. § 112, and does not disclose the widget having any power output or wattage outside the foregoing limits set forth in the specification. The following independent claim will be Claim 1 in the application:

1. A widget consisting essentially of an amplifier having a power output of 100 to 300 amps, and woofer having a wattage of 400 to 450 watts.

Which of the following claims would not be a proper dependent claim if presented as an original claim in the application when the application is filed in the PTO?

- (A) 2. The widget of Claim 1 wherein the woofer has a wattage of 425 to 450 watts.
- (B) 2. The widget of Claim 1 wherein the amplifier has a power output of 300 amps and the woofer has a wattage between 430 and 450 watts.
- (C) 2. The widget of Claim 1 wherein the amplifier has a power output of 250 amps.
- (D) 2. The widget of Claim 1 wherein the woofer has a wattage of 425 watts.
- (E) 2. The widget of Claim 1 wherein the amplifier has a power output of up to 300 amps.

April 12, 2000 PM

33. A claim limitation reads “having 10 to 20 grams of iron, preferably 13-18 grams of iron.” The specification preceding the claim supports not only the limitation, but also the broader amounts of iron. Which of the following statements is correct?

- (A) The limitation may be indefinite.
- (B) Since the limitation properly sets forth outer limits, it is definite.
- (C) As long as the limitation is supported in the written description, it is proper.
- (D) The limitation is definite since the limitation sets forth a preferred range.
- (E) The applicant, having set forth a limitation in the claim, i.e., a range of 10 to 20 grams, is precluded by the doctrine of equivalents from expanding the claim coverage beyond the 10 to 20 grams of iron.

April 12, 2000 PM

38. Which of the following statements correctly describes current PTO practice and procedure?

- (A) A joint application by inventors Sam and Will, and a joint application by Will and Sam are different inventive entities.
- (B) A joint application by inventors Sam and Will, and a sole application by Sam are different inventive entities.
- (C) Where a patent is granted to Will, and later Will and Sam file a joint application, the presence of Will, a common inventor in the patent, prevents a determination that the patent entity is to “another” within the meaning of 35 U.S.C. § 102(e).
- (D) The fact that an application has named a different inventive entity (Sam and Will) than a patent reference (Will) makes the patent prior art, even where one of the inventors is common to both.
- (E) (A) and (C).

April 12, 2000 PM

42. Assuming that each of the following claims is in a different utility patent application, and each claim is fully supported by the disclosure in preceding claims or in the application wherein the claim appears, which of the claims properly presents a process claim?

- (A) A process of utilizing a filter having electrical components, said process comprising placing a plurality of electrodes on the human body, receiving electrical signals from the electrodes and passing the signals through said filter.
- (B) A process of polymerizing an organic compound comprising combining a catalyst, organic compound reactants, and solvent in a reaction vessel, heating the combination in the vessel to a high temperature to start the reaction, separating the organic layer from the remaining materials, and evaporating the solvent.
- (C) The use of a water repellant paint as a sealant for wooden patio furniture.
- (D) (A), (B) and (C).
- (E) (A) and (B).

April 12, 2000 PM

44. Which of the following statements best correctly describes current PTO practice and procedure?

- (A) Where a patent discloses subject matter being claimed in an application undergoing examination, if the patent's designation of inventorship differs from that of the application, then the patent's designation of inventorship does not raise a presumption of inventorship regarding the subject matter disclosed but not claimed in the patent so as to justify a rejection under 35 U.S.C. § 102(f).
- (B) The fact that a claim recites various components, all of which can be argumentatively assumed to be old, provides a proper basis for a rejection under 35 U.S.C. § 102(f).
- (C) A person can be an inventor without having contributed to the conception of the invention.
- (D) In arriving at conception, an inventor may not consider and adopt ideas and materials derived from other sources such as an employee or hired consultant.
- (E) It is essential for the inventor to be personally involved in reducing the invention to actual practice.

April 12, 2000 PM

48. Which of the following statements regarding 35 U.S.C. § 103 is most correct?

- (A) PTO classification of prior art references used to reject a claim under 35 U.S.C. § 103, and the similarities and differences in structure and function carry equal weight as evidence of whether the references are analogous or non-analogous.
- (B) The question of obviousness under 35 U.S.C. § 103 is resolved by determining whether the differences between the prior art and the claims would have been obvious.
- (C) Obviousness of an invention can be properly determined by identifying the "gist" of the invention, even where the "gist" does not take into regard an express limitation in the claims.
- (D) In delineating the invention, consideration is given not only to the subject matter recited in the claim, but also the properties of the subject matter which are inherent in the subject matter and disclosed in the specification.
- (E) Obviousness can be predicated on what is not known at the time an invention is made, where the inherency of the feature is later established.

November 3, 1999 AM

2. A patent application filed in the PTO claims a nylon rope coated with element E for the purpose of preventing breakage of the rope. In the first Office action, the examiner rejects the claim as obvious over P in view of a trade journal publication, T. P teaches a nylon rope coated with resin for the purpose of making the rope waterproof. T teaches a nylon tent fabric coated with element E for the purpose of making the tent waterproof, and suggests the use of element E for making other nylon products waterproof. Following proper PTO practices and procedures, the combination of P and T:

- (A) cannot support a prima facie case of obviousness because T lacks a suggestion to combine with P for the purpose of preventing breakage in nylon rope.
- (B) cannot support a prima facie case of obviousness because P lacks a suggestion to combine with T for the purpose of preventing breakage in nylon rope.
- (C) cannot support a prima facie case of obviousness because T only contains a suggestion to combine with P for the purpose of waterproofing nylon rope.
- (D) can support a prima facie case of obviousness, even though T only contains a suggestion to combine with P for the purpose of waterproofing nylon rope.
- (E) can support a prima facie case of obviousness because the applicant is always under an obligation to submit evidence of non-obviousness regardless of whether the examiner fully establishes a prima facie case of obviousness.

November 3, 1999 AM

8. In which of the following situations, considered independently of each other, is the original, new, or amended claim supported in the application as filed?

- (A) An amendment to the specification changing the definition of “holder” from “is a hook” to “is a hook, clasp, crimp, or tong” and no amendment is made of the claim, which uses the term “holder.” The amendment is filed one month after the application was filed. There was no previous supporting disclosure in the specification of the holder being a clasp, crimp, or tong.
- (B) An amendment to the specification and claims changing the definition of “holder” from “is a hook” to “is a hook, clasp, crimp, or tong.” The amendment is filed one month after the application was filed. There was no previous supporting disclosure in the specification of the holder being a clasp, crimp, or tong.
- (C) Original claim 1 in the application refers to “a holder,” and original claim 2 depends from and refers to claim 1 stating, “said holder is a hook, clasp, crimp, or tong.” There is no disclosure in the specification preceding the claims in the application as filed for the holder to be a clasp, crimp, or tong.
- (D) An amendment is filed presenting a claim to an electrical insulating device, copied from a patent for the purpose of provoking an interference. The claim refers to “nonconductive plastic holder.” The application as filed contains a broad generic disclosure describing electrical insulating devices. The holder is described in the specification of the application as “conducting electricity.” There is no disclosure in the specification of the holder being “nonconductive.”
- (E) All of the above.

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9. An application as originally filed contains the following Claim 1:

Claim 1. A doughnut making machine comprising:

- (i) an input conveyor that receives dough to be used in making said doughnuts;
- (ii) portioning means for portioning dough from said input conveyor into a plurality of dough balls, each of said plurality of balls containing dough sufficient to create a single doughnut;
- (iii) forming means for forming each of said dough balls into a ring of dough;
- (iv) a deep fat fryer which receives rings of dough from said forming means and cooks said rings of dough;
- (v) applying means for selectively applying a flavored coating on cooked rings of dough to produce doughnuts; and
- (vi) placing means for placing a plurality of said doughnuts on a flat sheet.

The specification adequately describes the claimed subject matter. Two different “means for selectively applying” are described in the specification: a sprayer and a brush. Which of the following original claims is an improper dependent claim?

- (A) 2. The doughnut making machine of Claim 1, wherein said placing means is a conveyor that extends from said applying means to said flat sheet.
- (B) 3. The doughnut making machine of Claim 1, wherein said forming means includes a cutter that removes a center portion of each of said dough balls to form a ring of dough.
- (C) 4. The doughnut making machine of Claim 1, wherein said applying means is omitted for making plain doughnuts.
- (D) 5. The doughnut making machine of Claim 1, wherein said applying means includes a sprayer which receives a sugar based flavored coating, wherein said sugar based flavored coating is sprayed on said cooked rings of dough.
- (E) 6. The doughnut making machine of Claim 1, wherein said applying means is a sprayer.

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15. You draft a patent application disclosing and describing an electrical chronometer containing a resistor having a resistance of 20-90 ohms, preferably 40 ohms. You draft the following independent claim:

- 1. An electrical chronometer comprising a resistor with a resistance of 20-90 ohms.

Which of the following would not be a proper dependent claim if presented as an original claim in the application when the application is filed in the PTO?

- (A) 2. The electrical chronometer of Claim 1 wherein the resistor has a resistance of 40 ohms.
- (B) 2. An electrical chronometer as in Claim 1 wherein the resistor has a resistance of 40-90 ohms.
- (C) 2. An electrical chronometer as in Claim 1 wherein the resistor has a resistance of about 20 - 90 ohms.
- (D) 2. The electrical chronometer of Claim 1 wherein the resistor has a resistance of between 50 and 90 ohms.
- (E) (C) and (D).

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18. A patent application filed in the PTO contains the following dependent claim:

- 2. The method of Claim 1, further consisting of the step of cooling the mixture to a temperature of 32° F.

Following proper PTO practices and procedures, from which of the following claims does the dependent claim not properly depend?

- (A) 1. A method of making liquid compound A consisting of the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (B) 1. A method of making liquid compound A comprising the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (C) 1. A method of making liquid compound A including the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (D) 1. A method of making liquid compound A characterized by the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (E) (C) and (D).

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19. If a claim has been properly rejected under 35 U.S.C. § 103 as being rendered obvious over a combination of prior art references, then in accordance with proper PTO practice and procedure:

- (A) it is not necessary that the prior art suggests the combination to achieve the same advantage or result discovered by the applicant, if the combination provides motivation to make the claimed invention.
- (B) the rationale to modify or combine the prior art must be found expressly set forth in the prior art.
- (C) in considering the disclosure of prior art it is proper to take into account the specific teachings of the reference. It is not proper to take into account the inferences that one skilled in the art could reasonably draw from the specific teachings.
- (D) it is improper for a patent examiner to take official notice of facts outside the record which are capable of instant and unquestionable demonstration as being “well known.”
- (E) it is proper to rely on equivalence in support of the rejection, the equivalence may be recognized in the prior art or in the applicant’s disclosure.

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20. An application is directed to novel and unobvious scissors for cutting hair having a pair of cutter blades and a pointer loop. The application includes the following partial independent Claim 1 and dependent Claims 2-5.

- Claim 1. An apparatus for cutting hair, said apparatus comprising:
- (i) a first cutting member having a first cutting edge at one end and the other end of said first cutting member terminating in a thumb loop;
 - (ii) a second cutting member having a second cutting edge at one end and the other end terminating in a finger loop having an arcuate finger brace extending therefrom;
 - (iii) _____
 - (iv) said second cutting member additionally including a pointer loop between said finger loop and said mid-point, said finger loop having a finger loop center such that a plane through said finger loop center and said pointer loop center is generally parallel to said second cutting edge in order for the apparatus for cutting hair to be generally balanced when held by a user.
- Claim 2. The apparatus of claim 1, wherein said first cutting member includes a threaded aperture extending entirely therethrough between said thumb loop and said mid-point, and an adjusting screw that extends through said threaded aperture to engage a bearing surface below the pointer loop on said second cutting member.
- Claim 3. The apparatus of claim 2, wherein said connector is a rivet.

Without regard to prior art, and in view of partial Claim 1, which of the following best completes missing paragraph (iii) of Claim 1 while maintaining the broadest scope of protection and complying with proper PTO practice and procedure?

- (A) “said first cutting member having a mid-point between its ends and said second cutting member having a mid-point between its ends, and said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points by a connector; and”
- (B) “wherein said first cutting member and said second cutting member are formed entirely of metal and are pivotally secured to each other at respective mid-points; and”
- (C) “said first cutting member including a reservoir for dispensing disinfectant solution and having a mid-point between its ends; and”
- (D) “and said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points; and”
- (E) “said first cutting member and said second cutting member being pivotally secured to each other by a connector; and”

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23 and 24. Answer Questions 23 and 24 based on the following facts.

Your client, Homer, invented a new system for laying underground pipes for in-ground sprinkler systems utilizing a tunneling tool he calls “the Mole.” The Mole is placed in a small hole is dug in the ground at a starting location. A target is placed in the ground at the desired ending location. The Mole automatically tunnels through the ground to the target. The Mole has a clamp to pull flexible pipe behind it as it tunnels. A high-pressure air source is connected to the Mole to remove dirt as the Mole progresses toward the target. Homer informs you that he has continuously used this original system for three years in his commercial landscaping business, displayed the system to his numerous customers, and handsomely profited from his original system. In the original system, the Mole sensed and moved toward the target emitting electromagnetic signals. Recently, the Mole sometimes gets confused due to interference from ferromagnetic underground pipes and overhead power lines. Two months ago Homer modified the system to utilize ultrasonic signals emitted from the target. The ultrasonic signals are encoded with location information derived by the target from a Global Positioning System (GPS) satellite. The modified system decodes the location information and tunnels toward the specified location. The use of ultrasonic signals in the modified system is new and unobvious. Homer has reduced the modified system to actual practice, and kept it confidential. Homer prepared a draft patent application fully describing both the original system and the modified system. He wants you to review the draft application, make sure it meets all requirements, and revise it as necessary prior to filing. The draft application prepared by Homer includes the following draft claims:

- Claim 1. A system for laying underground flexible pipe in the ground, said system comprising:
- (i) a target placed in the ground at a target location and including a transmitter which emits target signals;
 - (ii) a tunneling device including a clamp operable to connect one end of said flexible pipe to said tunneling device, said tunneling device further including a sensor which detects said target signals and steers said tunneling device to move toward said target; and
 - (iii) a source of high pressure air connected with said tunneling device for removing dirt as said tunneling device moves toward said target.
- Claim 2. The system of claim 1, wherein said transmitter emits electromagnetic signals.
- Claim 3. The system of claim 1, wherein said transmitter emits ultrasonic signals.
- Claim 4. The system of claim 3, wherein said ultrasonic signals include encoded position information that is decoded by the decoder portion of said tunneling device sensor.
- Claim 5. The system of claim 1, wherein said transmitter emits signals having encoded position information.
23. Which of the following would not be reasonable advice to Homer?
- (A) Claim 5 is not indefinite even though it is not limited to ultrasonic target signals and the only disclosed embodiment that utilizes encoded position information utilizes ultrasonic target signals.
 - (B) Claim 1, as presently written, is statutorily barred, and the claimed invention should be limited to the modified system.
 - (C) Because the original system had a drawback in that it sometimes got confused by ferromagnetic underground pipes or power lines, and because Homer continued to develop the system to overcome these drawbacks, the original system was experimental and does not constitute prior art against the modified system.
 - (D) Claim 4 is indefinite.
 - (E) The language in Claim 1 reciting the “target” should be reworded to clarify that the ground is not part of the claimed combination, *e.g.*, by adding the words “adapted to be” before “placed”.

24. Claims 1 and 2 are unpatentable under which of the following statutory provisions?
- (A) 35 U.S.C. § 102(b).
(B) 35 U.S.C. § 102(c).
(C) 35 U.S.C. § 102(d).
(D) 35 U.S.C. § 102(e).
(E) None of the above.

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27. Which of the following statements explains why Claim 1 below does recite subject matter eligible for protection under the Patent Statute?

Claim 1. A top soil for retaining water comprising:
about 10% of material X;
about 60% of material Y;
balance of material Z.

- (A) The subject matter is eligible if the top soil occurs in nature, and M was the first to find the topsoil on a remote tropical island.
- (B) The subject matter is eligible if M developed the top soil through extensive research and experimentation with various materials, including materials X, Y, and Z.
- (C) The subject matter is eligible because all inanimate objects are subject matter eligible for protection under the patent statute.
- (D) The subject matter is eligible because the claim is sufficiently broadly written as not to exclude the inclusion of a living organism.
- (E) (A) and (B).

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29. Which of the following statements is in accordance with proper PTO practice and procedure?
- (A) Unlike questions of public use, there is no requirement that “on sale” activity be “public.”
 - (B) Sales to toy stores throughout the United States of a claimed rocking horse by an independent third party more than one year before the filing date of applicant’s patent application without the applicant’s consent will not bar applicant from obtaining a patent for the rocking horse.
 - (C) An offer for sale of a claimed invention, where the offer originates in the United States and is communicated to a potential buyer in Europe, more than one year before the filing date of applicant’s patent application, cannot be sufficient activity to bar applicant from obtaining a patent for the invention.
 - (D) Delay alone in filing a patent application is sufficient to infer any required intent by the inventor to abandon the invention.
 - (E) “Patented” in 35 U.S.C. § 102(e) includes the publication of German applications as printed documents called Offenlegungsschrift.

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34. If a claim has been properly rejected under 35 U.S.C. § 103 as being rendered *prima facie* obvious over a combination of prior art references, then the rejection can be rebutted in accordance with proper PTO practice and procedure by:

- (A) showing the criticality of the claimed range where the range in the claim overlaps the range disclosed in one or both prior art references.
- (B) arguing that the client has recognized latent properties in the prior art which were not recognized by the prior art references.
- (C) arguing that a combination would not be made by a businessman for economic reasons.
- (D) contending that each of the prior art references, taken individually, does not teach or render obvious the claimed invention.
- (E) (A), (B), and (C).

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36. Following proper PTO practices and procedures, which of the following reference(s) anticipates Claim 1:

- 1. A composition consisting of:
 - 60-80% cellulose;
 - 16-18% nylon;
 - up to 0.5% fiber;
 - and at least 6% cotton;
 - said composition being capable of absorbing water in the amount of not more than 45% by weight of the composition.
- (A) A reference disclosing a sponge having 69% cellulose, 16% nylon, 0.4% fiber, 7% cotton, and 7.6% silk.
- (B) A reference disclosing a sponge having 78% cellulose, 17% nylon, 0.2% fiber, 4.8% cotton, and a water content of 30% by weight.
- (C) A reference disclosing a sponge having 76% cellulose, 16% nylon, 8% cotton and containing no water.
- (D) A reference disclosing a sponge having 61% cellulose, 18% nylon, 0.6% fiber, 20.4% cotton, and a water content of 45% by weight.
- (E) (B) and (D).

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37. A patent application includes the following partial Claim 1:

Claim 1. A shaving implement comprising

- (i) _____
- (ii) a shaving head including a razor, said shaving head being connected to said handle at said first end;
- (iii) a collapsible tube of shaving cream positioned in and substantially filling said chamber, said tube including a neck having a dispensing opening;
- (iv) a tube squeezing slide positioned within said channel and said chamber, said slide including opposed slots thereon, said slots being in sliding engagement with said longitudinal sides of said channel; and
- (v) a tube closure connected to said neck of said collapsible tube.

Which of the following, if included as paragraph (i) of Claim 1, best completes the claim while giving the client the broadest protection?

- (A) a substantially rigid handle including a chamber and a channel formed in said handle, said channel being defined by longitudinal sides within said handle;
- (B) a substantially rigid handle having a first end, said handle including a chamber and a channel formed in said handle, said channel being defined by longitudinal sides within said handle;
- (C) a substantially rigid handle having a first end, said handle including a chamber and an elongated channel formed in said handle;
- (D) a substantially rigid handle having a first end, said handle including a chamber and a channel formed in said handle;
- (E) a substantially rigid handle having a first end, said handle including a channel formed in said handle, said channel being defined by longitudinal sides within said handle;

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39. Applicant filed a patent application claiming a polyol. The application discloses that the claimed polyol is used to form rigid polyurethane foam having a structural formula. The examiner properly rejected the claimed polyol as unpatentable over prior art disclosing the claimed polyol and its use to form rigid polyurethane foam having the same structural formula. Given the fact that applicant's specification discloses that the polyol may be produced by a process comprising steps A, B, C, and D, and the process is novel and unobvious, which of the following claims, if introduced by amendment, would overcome the rejection?

- (A) A polyol having the property of forming rigid polyurethane foam having structural formula Z, the polyol being produced by the process comprising the steps A, B, C, and D.
- (B) A polyol produced by the process comprising the steps A, B, C, and D, said polyol having the property of forming rigid polyurethane foam having structural formula Z.

- (C) A polyol produced by the process comprising the steps A, B, C, and D.
- (D) A polyol comprising the resultant product of steps A, B, C, and D.
- (E) A polyol-producing process comprising steps A, B, C, and D, said process resulting in a polyol capable of forming rigid polyurethane foam having structural formula Z.

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40. In the course of prosecuting a patent application before the PTO, you receive a non-final Office action allowing Claim 1, and rejecting Claims 2 through 6, the remaining claims in the case. Claim 1 reads as follows:

1. A ship propeller exhibiting excellent corrosion resistance, said ship propeller consisting essentially of a copper base alloy consisting of 2 to 10 percent tin, 0.1 to 0.9 percent zinc, and copper.

The specification of the application teaches that the copper base alloy made with the addition of 2 to 10 percent aluminum increases the alloy's wear resistance without detracting from its corrosion resistance. However, adding aluminum to the surface of the propeller does not increase wear resistance. Which of the following claims, if any, if added by amendment would accord with proper PTO practice and procedure?

- (A) 7. A copper base alloy according to Claim 1 wherein said alloy includes 2 to 10 percent aluminum.
- (B) 7. A ship propeller according to Claim 1 including the step of adding 2 to 10 percent aluminum to the copper base alloy.
- (C) 7. A ship propeller according to Claim 1 including 2 to 10 percent aluminum.
- (D) 7. A ship propeller according to Claim 1 wherein said alloy includes 2 to 10 percent aluminum.
- (E) None of the above.

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41. A claim limitation reads "a pH range between 7 and 12, preferably between 9 and 10." Which of the following is correct?

- (A) Since the limitation properly sets forth outer limits, it is definite.
- (B) As long as the limitation is supported in the written description, it is proper.
- (C) The limitation is indefinite.
- (D) Since the limitation sets forth a preferred range, it is definite.
- (E) An applicant is precluded from expanding the claim coverage beyond a pH range of 7-12 under the doctrine of equivalents.

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44. A practitioner should consider whether information presented during prosecution of an application may be used by the examiner as evidence against the applicant. What evidence may an examiner not use to demonstrate that a claim fails to correspond in scope with that which an applicant regards as his or her invention?

- (A) Arguments, containing admissions, advanced in a reply filed by the practitioner representing the applicant.
- (B) Admissions contained in a brief.
- (C) The lack of agreement between the claims and the specification.
- (D) Affidavits, containing admissions, filed under 37 CFR § 1.132.
- (E) All of the above.

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46. You filed a patent application for Sam, who invented an apparatus for labeling and identifying baseballs. In the application, the apparatus is described as including means for marking baseballs; an ultraviolet light source; and a computer coupled to both the means for marking baseballs and the ultraviolet light source. The only means for marking baseballs set forth in the application was a commercially available invisible ink stamper, also known as a marker. The specification described the invention as being useful for identifying home run baseballs. The application was filed with one claim, which stated:

Claim 1. An apparatus, comprising: an invisible ink stamper; an ultraviolet light source; and a computer coupled to said invisible ink stamper and to said ultraviolet light source.

Claim 1 was properly rejected under 35 U.S.C. §102(b) as being anticipated by a patent issued to McGoo, which disclosed an apparatus having only an invisible ink stamper, an ultraviolet light source, and a computer coupled to the invisible ink stamper and to the ultraviolet light source. The McGoo patent did not mention identifying baseballs, but described the invention as useful for labeling and identifying baseball bats. Which of the following amendments, if any, avoids anticipation of Claim 1 by the McGoo patent?

- (A) 1. (amended once) An apparatus intended to be used to identify home run baseballs, comprising: an invisible ink stamper; an ultraviolet light source; and a computer coupled to said invisible ink stamper and to said ultraviolet light source.
- (B) 1. (amended once) An apparatus, [comprising] consisting of: an invisible ink stamper, an ultraviolet light source, and a computer coupled to said invisible ink stamper and to said ultraviolet light source.
- (C) 1. (amended once) An apparatus, comprising: [an invisible ink stamper] a marker; an ultraviolet light source, and a computer coupled to said means for marking baseballs and to said ultraviolet light source.
- (D) (B) and (C).
- (E) None of the above.

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48. An original claim in a patent application to a mechanical arts invention recites the limitation of “a clip,” which is shown in an original application drawing as being one of several elements of the invention. The “clip” is well known in the mechanical arts. However, “a clip” does not appear in the original written description part of the application. Which of the following is correct?

- (A) The written description may not be properly amended to include “a clip”
- (B) The claim is indefinite with respect to “a clip.”
- (C) The application lacks an enabling disclosure as to “a clip.”
- (D) The claim is definite with respect to “a clip.”
- (E) The application fails to set forth the best mode for “a clip.”

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49. A nonprovisional patent application has been filed for inventor Alton disclosing and claiming an alumino-silicate catalyst for oxidizing organic compounds. Which of the following statements, considered separately, about the best mode contemplated by Alton for the aluminosilicate catalyst is not true?

- (A) The best mode must be designated as the best mode in the application if the application contains several embodiments, one of which is the best mode.
- (B) The presence of one specific example in the specification is evidence that the best mode has been disclosed.
- (C) The best mode need not be updated if, between the time of filing the non-provisional patent application and a continuation application, Alton discovered a better catalyst than the best mode disclosed in the non-provisional application.
- (D) A failure to disclose the best mode in the application as filed cannot be cured by first introducing into the application by amendment a specific mode of practicing the invention.
- (E) There is no statutory requirement for the best mode being disclosed in the specification as a specific example.

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50. You are drafting a patent application disclosing and describing a door assembly wherein a door, a door frame, and a pair of hinges are separate elements which must be included in a claim to the assembled combination of a door secured to a door frame by a pair of hinges. The application discloses that it is essential to the invention that the door is secured to the doorframe in the described manner to permit the door to be readily opened and closed. The application further discloses that it is also essential to the invention for the assembly, in a closed relationship, to keep out exterior elements, while providing privacy and permitting quick egress in an emergency. Which of the following claims properly sets forth the combination?

- (A) An assembly having a door capable of being hingedly connected to a doorframe.
- (B) An assembly having a door and means for securing the door.
- (C) An assembly having a door and a pair of hinges for securing the door.
- (D) An assembly having a door, and a doorframe, said door being secured to said doorframe with a pair of hinges.
- (E) An assembly having a door adapted to be secured to a doorframe with a pair of hinges.

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1. Your client, Smith, invents a composition for adhering metal to glass. You prepare a patent application including a specification and several claims of varying scope. Your specification includes a detailed description of Smith's invention, which sets forth the following: the composition is made from, among other things, a combination of A, B, and C; the composition is at least 20% A but can be up to 30% A; the composition works best if it is 24% to 26% A; and the composition contains substantially equal portions of B and C. Your specification also includes guidelines for determining what would constitute substantially equal portions of B and C in the composition. Furthermore, your specification includes a detailed explanation of why it is preferable to use 24% to 26% A. Among the following claims drawn to Smith's invention, which is the broadest claim that is unlikely to be properly rejected under 35 U.S.C. 112, second paragraph?

- (A) A composition comprising 20 to 30% A, and substantially equal portions of B and C.
- (B) A composition comprising 20 to 30% A, preferably 24% to 26% A.
- (C) A composition comprising 20 to 30% A, 30% B, and 30% C.
- (D) A composition comprising 24% A, and substantially equal portions of B and C.
- (E) A composition comprising 20 to 30% A, and equal portions of B and C.

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6. If each of the following claims is in a different utility patent application, and each claim is fully supported by the disclosure in preceding claims or in the application in which the claim appears, which claim properly presents a process claim?

- (A) A process of utilizing a filter comprising electrical components, placing a plurality of electrodes on the human body, receiving electrical signals from the electrodes, and passing the signals through the filter which comprises electrical components.
- (B) A process of polymerizing an organic compound by combining in a reaction vessel a catalyst and reactants dissolved in a solvent, heating the mixture in the vessel to a high temperature to start the reaction, separating an upper organic layer from the remaining materials, and evaporating the solvent.
- (C) The use of a water repellant paint as a sealant for wooden patio furniture.
- (D) (A) and (B).
- (E) (A), (B), and (C).

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10. Which of the following claim phrases may be used in accordance with proper PTO practice and procedure?

- (A) R is selected from the group consisting of A, B, C, or D.
- (B) R is selected from the group consisting of A, B, C, and D.
- (C) R is selected from the group comprising A, B, C, and D.
- (D) R is selected from the group comprising A, B, C, or D.
- (E) R is A, B, C, and D.

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12. Which of the following statements is true concerning terms of degree (relative terms, e.g., such as, “hotter”) used in claim language?

- (A) Definiteness of claim language using terms of degree should not be analyzed using a claim interpretation that would be given by one possessing the ordinary level of skill in the art, and only the specification should be used to interpret the claim.
- (B) A claim may be rendered indefinite even if the specification uses the same term of degree as the claim language, if the term of degree is not understandable by one of ordinary skill in the art when the term of degree is read in light of the specification.
- (C) If the specification includes guidelines which would enable one of ordinary skill in the art to determine the scope of a claim having a term of degree, then the language of the guidelines must be included in the claim in order to render the claim definite.
- (D) If the original disclosure does not include guidelines which would enable one of ordinary skill in the art to determine the scope of a claim having a term of degree, then as long as the term of degree in the claim was part of the original disclosure, the claim will be properly rendered definite by amending the specification to provide guidelines concerning the term of degree which would enable one of ordinary skill in the art to determine the scope of the claim.
- (E) None of the above.

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14. Claim 1 in a patent application states the following:

1. A modular telephone plug crimping tool comprising:
 - (i) a pair of body parts comprising first and second body parts, each having a fixed length;
 - (ii) a flexible member connecting an end of the first body part to an end of the second body part;
 - (iii) a hand lever;
 - (iv) a pivot pin connecting the hand lever to the first body part;
 - (v) an interchangeable crimping punch removably seated in the first body part and guided relative to an interchangeable crimping anvil removably seated in the second body part;
 - (vi) a roller mounted on the pivot pin for engaging the crimping punch; and
 - (vii) a guide pin being fixed in said second body part and extending in aligned bores in said pair of body parts.

Which, if any, of the following claims, if presented in the application, is a proper dependent claim in accordance with PTO rules and procedure.

- (A) 2. The modular telephone according to claim 1, wherein said crimping punch comprises integral contact and strain relief punch portions.
- (B) 2. The modular telephone plug crimping tool according to claim 1, wherein said second body part has an adjustable length.
- (C) 2. A process for using the modular telephone plug crimping tool of claim 1 to connect a telephone to a telephone line.
- (D) 2. The modular telephone plug crimping tool according to claim 1, further comprising: a free end on each of said first and second body parts; first and second stripping blades adjustably and detachably provided at said free ends of said first and second body parts, respectively; and at least one severing blade held in cooperating relationship with a severing anvil, said severing blade and severing anvil being provided on said first and second body parts, respectively.
- (E) None of the above.

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19. Which of the following requirements of 35 U.S.C. § 112 does not apply to design patent claims?

- (A) The written description requirement of the first paragraph.
- (B) The best mode requirement of the first paragraph.
- (C) The requirement in the second paragraph to distinctly claim the subject matter which the applicant regards as his invention.
- (D) The requirement in the third paragraph for an independent claim.
- (E) None of the above.

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22. You are preparing a patent application for filing in the PTO. The application describes a microcomputer having several components. You have drafted the following independent claim:

1. A micro-computer comprising:
 - (i) a central processing unit for processing information;
 - (ii) a memory unit for storing information;
 - (iii) an input device for entering information characterized by a keyboard;
 - (iv) an output device for viewing information consisting of a video monitor; and
 - (v) a bus for interconnecting the central processing unit to the memory unit, the input device and the output device.

In the absence of issues of supporting disclosure, and following proper PTO practices and procedures, which of the following dependent claim(s) is (are) an improper dependent claim?

- Claim 2. The micro-computer of Claim 1, wherein the memory unit contains random access memory.
- Claim 3. The micro-computer of Claim 1 or 2, wherein the input device includes a light pen.
- Claim 4. The micro-computer in any one of the preceding claims, wherein the output device is a printer or a video monitor.
- Claim 5. The micro-computer of Claim 4, wherein the memory unit contains read-only memory.

- (A) Claim 2.
- (B) Claim 2 and Claim 3.
- (C) Claim 3.
- (D) Claim 5.
- (E) Claim 4 and Claim 5.

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23. To avoid a proper rejection of a claim for being indefinite, which of the following expressions in the claims must be supported by a specification disclosing a standard for ascertaining what the inventor means to cover?

- (A) “relatively shallow.”
- (B) “of the order of.”
- (C) “similar” in the following claim preamble: “A nozzle for high-pressure cleaning units or similar apparatus.”
- (D) “essentially” in the following phrase following the claim preamble: “a silicon dioxide source that is essentially free of alkali metal.”
- (E) All of the above.

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24. Claims 1 through 5 in a patent application read as follows:

1. A computer comprising:
 - (i) a microprocessor having a maximum clock rate of 350 megahertz;
 - (ii) a random access memory chip coupled to said microprocessor;
 - (iii) a read only memory chip coupled to said microprocessor; and
 - (iv) a case enclosing said microprocessor, said random access memory chip, and said read only memory chip.
2. The computer of claim 1, wherein said case has an outer surface comprised of plastic.
3. The computer of claims 1 or 2, further comprising a peripheral controller chip coupled to said microprocessor.
4. The computer of claim 1, wherein said memory chip has eight million storage locations.
5. The computer of claim 2, wherein said microprocessor has a maximum clock rate of 400 megahertz.

Which of the following is/are proper dependent claims(s) in accordance with 37 CFR §1.75?

- (A) Claims 2 and 3.
- (B) Claim 4 only.
- (C) Claims 2 and 5.
- (D) Claim 2 only.
- (E) None of the above.

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26. X invented a laminate which is most broadly disclosed in a patent application as containing a transparent protective layer and a light-sensitive layer, without an intermediate layer. The prior art included a laminate containing a transparent protective layer and a light-sensitive layer held together by an intermediate adhesive layer. Which of the following claims would overcome a 35 USC § 102 rejection based on the prior art?

- (A) 1. A laminate comprising a transparent protective layer and a light-sensitive layer.
- (B) 1. A laminate comprising a transparent protective layer and a light-sensitive layer which is in continuous and direct contact with the transparent protective layer.
- (C) 1. A laminate comprising a transparent protective layer and a light-sensitive layer, but not including an adhesive layer.
- (D) (A) and (B).
- (E) (B) and (C).

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40. Which of the following factors would **not** be indicative of an experimental purpose for testing a utility invention?

- (A) Testing is conducted over a substantial period of time to determine the operativeness of the invention.
- (B) Testing is conducted under the supervision and control of the inventor.
- (C) Testing to determine product acceptance or market testing.
- (D) The nature of the invention was such that any testing had to be, to some extent, public.
- (E) The inventor regularly inspected the invention during the period of experimentation.

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41. Your client has invented a miniature vacuum tube comprising a capacitor having a capacitance of 0.003 to 0.012 μf , preferably 0.006 μf . You draft a patent application directed to your client's invention and satisfying the requirements of 35 U.S.C. § 112. You draft the following independent claim:

1. A miniature vacuum tube comprising a capacitor having a capacitance of 0.003 to 0.012 μf .

Which of the following would not be a proper dependent claim if presented as an original claim in the application when the application is filed in the PTO?

- (A) 2. The miniature vacuum tube of Claim 1 wherein the capacitor has a capacitance of 0.006 μf .
- (B) 2. A miniature vacuum tube as in Claim 1 wherein the capacitor has a capacitance of 0.006 to 0.012 μf .
- (C) 2. A miniature vacuum tube as in Claim 1 wherein the capacitor has a capacitance of about 0.003 to 0.011 μf .
- (D) 2. The miniature vacuum tube of Claim 1 wherein the capacitor has a capacitance of between 0.005 and 0.012 μf .
- (E) (C) and (D).

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43. In which of the following situations, considered independently of each other, does the event described below not constitute a statutory bar to the granting of a patent on an application filed August 30, 1999, claiming a bottle cap?

- (A) The inventor reduced the invention to practice in June, 1998, and sold the claimed bottle caps to a bottling company on July 30, 1998. The sale was conditioned on the bottling company's satisfaction. The inventor and the company are located in New York.

- (B) The inventor reduced the invention to practice in June, 1998, sold the claimed bottle caps to bottling companies beginning on July 30, 1998. Although the inventor sold the bottle caps to commercially exploit his invention, the inventor's manufacturing and overhead costs exceeded his income from the sales and the inventor did not profit from the sales. The inventor and the companies are located in New York.
- (C) The inventor reduced the invention to practice in June, 1998, and on July 30, 1998, assigned to Company X his patent rights to the claimed bottle cap invention for good and valuable consideration. The inventor and Company X are located in New York.
- (D) The inventor reduced the invention to practice in June, 1998, and on July 30, 1998, the inventor offered to sell his inventory of the claimed bottle cap to a bottling company. The sale was not consummated until September 3, 1999. The inventor and the company are located in New York.
- (E) The inventor reduced the invention to practice in June, 1998, and the inventor's offer, on July 30, 1998, to sell the claimed bottle caps to a bottling company was delayed in the mail and not received by the company until September 10, 1998. The inventor and the company are located in New York.

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48. Which of the following statements is in accordance with proper PTO practice and procedure?

- (A) A claim to a computer which recites that various components, such as motherboard and RAM, which are old in the art, as well as a novel disc drive, is unpatentable under 35 U.S.C. § 102(f) inasmuch as the inventor derived one or more components, and did not himself invent each of the components of the claimed computer.
- (B) Where a patent granted to Able discloses subject matter being claimed in an application filed by Baker undergoing examination, the designation of Able as the sole inventor in Able's patent raises a presumption of inventorship with respect to the subject matter disclosed but not claimed in the patent.
- (C) A terminal disclaimer overcomes a rejection under 35 U.S.C. § 102(e).
- (D) When Able's patent application, filed on June 2, 1999, is rejected based on unclaimed subject matter of a patent granted to Smith on July 6, 1999, on Smith's application filed on February 18, 1997, and the unclaimed subject matter is Able's own invention, Able may overcome a prima facie case by showing that the patent discloses Able's own previous work.
- (E) All of the above.

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50. Prior art references have been combined to show obviousness of the claimed invention under 35 U.S.C. § 103. Which of the following most correctly completes the statement: “In establishing obviousness, _____

- (A) a suggestion to modify the art must be expressly stated in one of the references used to show obviousness.”
- (B) a suggestion to modify the art must be expressly stated in all the references used to show obviousness.”
- (C) a suggestion to modify the art may be inherently or implicitly taught in one of the references used to show obviousness.”
- (D) a suggestion to modify the art is unnecessary unless the patent applicant presents evidence or argument tending to show unobviousness.”
- (E) a suggestion to modify the art can come from recent nonanalogous prior art references.”

Chapter 2100

Answers

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1. ANSWER: (C) is the most correct. *Corona v. Dovan* 273 U.S. 692, 1928 CD 252 (1928); MPEP § 2138.05 under the heading “Requirements To Establish Actual Reduction To Practice.” (A) is incorrect. MPEP § 2138.05, under the heading “Requirements To Establish Actual Reduction To Practice.” The same evidence sufficient to establish a constructive reduction to practice is not necessarily sufficient to establish actual reduction to practice, which requires a showing of the invention in a physical or tangible form containing every element of the count. *Wetmore v. Quick*, 536 F.2d 937, 942 190 USPQ 223 227 (CCPA 1976). (B) is incorrect. MPEP § 2138.05, under the heading “Constructive Reduction To Practice Requires Compliance With 35 U.S.C. 112, First Paragraph.” *Kawai v. Metlesics*, 489 F.2d 880, 886, 178 USPQ 158, 163 (CCPA 1973). (D) is incorrect. *Keizer v. Bradley*, 270 F.2d 396, 397, 123 USPQ 215, 216 (CCPA 1959) (the diligence of 35 U.S.C. § 102(g) does not require “an inventor or his attorney to drop all other work and concentrate on the particular invention involved”); MPEP § 2138.06. (E) is incorrect. The diligence of a practitioner in preparing and filing an application inures to the benefit of the inventor. See MPEP § 2138.06, under the heading “Diligence Required In Preparing And Filing Patent Application.” *Haskell v. Coleburne*, 671 F.2d 1362, 213 USPQ 192,195 (CCPA 1982) (six days to execute and file application was acceptable).

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4. ANSWER: (B) is the most correct answer. See MPEP § 2173.05(h). A Markush group is an acceptable form of alternative expression provided the introductory phrase “consisting of,” and the conjunctive “and” are used. (A) and (D) are incorrect because the conjunctive “or” is used. (C) and (D) are incorrect because the introductory phrase “comprising” is used. (E) is incorrect because R must simultaneous be A, B, C, and D, as opposed to being a single member of the group, i.e., no language provides for the selection of one of the members of the group of A, B, C, and D. MPEP § 2173.05(h).

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17. ANSWER: (C) is the most correct answer. As stated in MPEP § 2172.01, “a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968).” (A) is incorrect. As stated in MPEP § 2172.01, “A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. § 112, first paragraph, as not enabling. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976); MPEP § 2164.08(c). (B) is incorrect. As stated in MPEP § 2165, “Failure to disclose the best mode need not rise to the level of active concealment or grossly inequitable conduct in order to support a rejection or invalidate a patent. Where an inventor knows of a specific material that will make possible the successful reproduction of the effects claimed by the patent, but does not disclose it, speaking instead in terms of broad categories, the best mode requirement has not been satisfied. *Union Carbide Corp. v. Borg - Warner*, 550 F.2d 555, 193 USPQ 1 (6th Cir. 1977).” (D) is incorrect. MPEP § 2165.01, under the heading “Defect In Best Mode Cannot Be Cured By New Matter,” indicates that if there is no disclosure of the best mode contemplated by the inventor at the time the application is filed,

such a defect cannot be cured by submitting an amendment seeking to put into the specification something required to be there when the patent application was originally filed. *In re Hay*, 534 F.2d 917, 189 USPQ 790 (CCPA 1976). Any proposed amendment of this type should be treated as new matter. MPEP § 2165.01. (E) is incorrect. As stated in MPEP § 2165.02, “The best mode requirement is a separate and distinct requirement from the enablement requirement of the first paragraph of 35 U.S.C. § 112. *In re Newton*, 414 F.2d 1400, 163 USPQ 34 (CCPA 1969).

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18. ANSWER: (A) is true, and thus the most correct answer. As stated in MPEP § 2129, and see *In re Fout*, 675 F.2d 297, 300-01, 213 USPQ 532,535-36 (CCPA 1982). (B) is not true, and thus not correct. MPEP § 2129, and see *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 650, 223 USPQ 1168, 1172 (Fed. Cir. 1984). (C) is not true, and thus not correct because the admitted foundational discovery is a statutory bar. See the reasons discussed for answer (B). (D) is not true, and is thus incorrect. MPEP § 2129, and see *In re Nomiya*, 184 USPQ 607, 610 (CCPA 1975) (figures in the application labeled “prior art” held to be an admission that what was pictured was prior art relative to applicant’s invention.). (E) is not true. MPEP § 2129; and see *In re Ehrreich*, 590 F.2d 902, 909 – 910, 200 USPQ 504, 510 (CCPA 1979); *Sjolund v. Musland*, 847 F.2d 1573, 1577, 6 USPQ2d 2020, 2023 (Fed. Cir. 1988); *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 315, 227 USPQ 766, 770 (Fed. Cir. 1985); and *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 650, 223 USPQ 1168, 1172 (Fed. Cir. 1984).

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20. ANSWER: (D) is the most correct answer. See MPEP §§ 2112.01 and 2131. MPEP § 2112.01, under the heading “Product and Apparatus Claims – When the Structure Recited in the Reference is Substantially Identical to that of the Claims, Claimed Properties or Functions are Presumed to be Inherent” states that “[w]here the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).” Here, the claimed microorganism and the prior art microorganism appear to be the identical. (A) is an incorrect choice. MPEP § 2105, under the heading “Patentable Subject Matter – Living Subject Matter,” states “...the question of whether or not an invention embraces living matter is irrelevant to the issue of patentability.” The Supreme Court has held that biological materials such as microorganisms, and non-human animals, is patentable subject matter, provided it is made by man. Here, Eric’s isolation and purification the microorganism from its natural state (environment) makes it a product of human ingenuity, as opposed to a product of nature. *Diamond v. Chakrabarty*, 447 U.S. 303, 206 USPQ 193 (1980). (B) is an incorrect choice. MPEP § 2107.01, under the heading “III. Therapeutic or Pharmacological Utility,” states that the “courts have found utility for therapeutic invention despite the fact that an applicant is at a very early stage in the development of a pharmaceutical product or therapeutic regimen based on a claimed pharmacological or bioactive compound or composition.” See, *Cross v. Iizuka*, 753 F.2d 1040, 1051, 224 USPQ 739, 747-48 (Fed. Cir. 1985). See also, *In re Brana*, 51 F.3d 1560,

34USPQ2d 1436 (Fed. Cir. 1995). Citing *Brana*, MPEP § 2107.01 states, “Accordingly, Office personnel should not construe 35 USC 101, under the logic of ‘practical’ utility or otherwise, to require that an applicant demonstrate that a therapeutic agent based on a claimed invention is a safe or fully effective drug for humans.” See also, MPEP § 2107.03, under the heading “Special Considerations for Asserted Therapeutic or Pharmacological Utilities, I. A Reasonable Correlation Between the Evidence and the Asserted Utility is Sufficient,” which states “As a general matter, evidence of pharmacological or other biological activity of a compound will be relevant to an asserted therapeutic use if there is a reasonable correlation between the activity in question and the asserted utility. *Cross v. Iizuka*, 753 F.2d 1040, 224 USPQ 739 (Fed. Cir. 1985); *In re Jolles*, 628 F.2d 1322, 206 USPQ 885 (CCPA 1980); *Nelson v. Bowler*, 626 F.2d 853, 206 F.2d 881 (CCPA 1981). An applicant can establish this reasonable correlation by relying on statistically relevant data documenting the activity of a compound or composition, arguments or reasoning, documentary evidence (e.g., articles in scientific journals), or any combination thereof. The applicant does not have to prove that a correlation exists between a particular activity and an asserted therapeutic use of a compound as a matter of statistical certainty, nor does he or she have to provide actual evidence of success in treating humans where such utility is asserted. Instead, as the courts have repeatedly held, all that is required is a reasonable correlation between the activity and the asserted use.” Since mice are routinely used to test anti-cancer drugs for their tumoricidal activity, it is reasonable to assume that the compound, spectaculysem, may be useful as a therapeutic agent. (C) is an incorrect choice. MPEP § 2145, under the subheading “X. Arguing Improper Rationales for Combining References. A. Impermissible Hindsight.” If, as acknowledged by the examiner, a novel microorganism has been discovered, then any product which it makes could not have been anticipated by, or obvious over, the prior art. The examiner’s rejection is based purely on hindsight derived from his or her reading of the applicant’s specification.

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21. ANSWER: (C) is the most correct answer. MPEP § 2163.06, under the heading “Review Of New Matter Objections And Rejections,” states “[a] rejection of claims is reviewable by the Board of Patent Appeals and Interferences, whereas an objection and requirement to delete new matter is subject to supervisory review by petition under 37 CFR 1.181. If both the claims and specification contain new matter either directly or indirectly, and there has been both a rejection and objection by the examiner, the issue becomes appealable and should not be decided by petition.” Answer (C) is not in accordance with the USPTO rules and the procedures set forth in the MPEP. (A), (B) and (D) are incorrect. They are in accord with proper USPTO procedure. See MPEP § 2163.06, under the heading “Review Of New Matter Objections And Rejections.” (E) is not correct because (C) is correct. MPEP § 2163.06.

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22. ANSWER: (A) is the most correct answer. MPEP § 2113, under the heading “Product-By-Process Claims Are Not Limited To The Manipulations Of The Recited Steps, Only The Structure Implied By The Steps,” states “‘even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.’ In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).” The issue is whether the claimed mixture Y is the same as or obvious over the patented mixture Y. MPEP § 2113, under the heading “Once A Product Appearing To Be Substantially Identical Is Found And A 35 U.S.C. 102/103 Rejection Made, The Burden Shifts To The Applicant To Show An Unobvious Difference,” states “[o]nce the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983).” Evidence that the two processes produce different properties is germane to the issue of patentability of the product-by-process claim. Accordingly, a comparison of the results obtained by conducting the process recited in the claim versus the process used by patent A and which shows that the claimed product exhibits an unexpectedly lower melting point would be a persuasive demonstration that, although the products would appear to be substantially identical, in fact, they are patentably different. Ex parte Gray, 10 USPQ2d 1922 (Bd. Pat. App. & Inter. 1989). Therefore, the best reply to the outstanding rejection would be to argue that the claimed product has an unexpectedly lower melting point and to support that argument with evidence showing that the result of the patent A process is a mixture with higher melting point as compared to the claimed product. (B) is not the most correct answer. The patentability of a product-by-process claim is determined on the basis of product characteristics, not process steps. (C) is not the most correct answer. The declaration is conclusory, as opposed to being factual. Thus, the argument is not supported by facts. As stated in MPEP § 716.02(c), under the heading “Opinion Evidence,” “Although an affidavit or declaration which states only conclusions may have some probative value, such an affidavit or declaration may have little weight when considered in light of all the evidence of record in the application. In re Brandstadter, 484 F.2d 1395, 179 USPQ 286 (CCPA 1973).” Thus, the reply in (A) is the most correct answer vis-à-vis (C). (D) like answer (B), is not the most correct answer for the same reason discussed for (B). (E) is not the most correct answer. Like answer (C), this reply rightly focuses on product properties. But without the comparative factual evidence to support it, this reply is weaker than one described in answer (A).

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30. ANSWER: (B) is the most correct answer. 37 CFR § 1.75(c). Answers (A) and (E) are incorrect because they improperly seek to broaden the parent claim. 37 CFR § 1.75(c). Answer (A) broadens the range by going below the stated limit. Answer (E) broadens by trying to remove a recited component of the second gas, and covering subject matter that is not covered by the parent claim. Answer (C) is incorrect because claim 1 uses the close ended claim term “consists” in connection with the second gas, which precludes the addition

of further components to the second gas in claim 4. Answer (D) is incorrect because the use of the exemplary language “such as” is improper under 35 U.S.C. § 112, second paragraph, and because it is inconsistent with claim 1. See MPEP § 2173.05(d).

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33. ANSWER: (A) and (E) are accepted as correct answers. Regarding (E), see MPEP § 2131. To anticipate a claim, the elements of a reference “must be arranged as required by the claim....” See MPEP § 2131, citing *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). In (E), the on/off switch of Lancer’s toothbrush is arranged differently than that of the claimed toothbrush. (A) is accepted as correct because the given facts do not specify the location of the power supply as being included within the toothbrush. Though the description of the toothbrush as being electric can imply an inherent source of power, it may also imply an external power source for the electric toothbrush. Accordingly, (A) is also accepted as a correct answer in the circumstances. (B) is incorrect because evidence of secondary considerations, such as commercial success, is irrelevant to a 35 U.S.C. § 102 rejection. See MPEP § 2131.04. (C) is incorrect. “‘Arguments that the alleged anticipatory prior art...‘teaches away from the invention’...[are] not ‘germane’ to a rejection under section 102.’” MPEP § 2131.05 (quoting *Twin Disc, Inc. v. United States*, 231 USPQ 417, 424 (Cl. Ct. 1986)). (D) is incorrect. “The term ‘others’ in 35 U.S.C. 102(a) refers to any entity which is different from the inventive entity. The entity need only differ by one person to be ‘by others.’ This holds true for all types of references eligible as prior art under 35 U.S.C. 102(a) including publications....” MPEP § 2132. Here, because Lancer is only one of three inventors of the claim, the patent is by others.

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34. ANSWER: (A) is the most correct answer. MPEP § 2144.03 provides that when an applicant seasonably traverses an officially noticed fact, the examiner may cite a reference teaching the noticed fact and make the next action final. Here, applicant did seasonably traverse the noticed fact by demanding proof in response to the rejection. It is therefore an appropriate action by the examiner. It is also an appropriate action because the examiner should vacate a rejection based on official notice if no support for the noticed fact can be found in response to a challenge by the applicant. See *In re Ahlert*, 424 F.2d 1088, 1091 (C.C.P.A. 1970) (“[a]ssertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work” and “[a]llegations concerning specific ‘knowledge’ of the prior art, which might be peculiar to a particular art should also be supported”). (B) is incorrect because (A) is correct. (C), (D), and (E) are incorrect because action III is improper. An applicant is entitled to respond to a rejection by requesting reconsideration, with or without amending the application. 37 CFR § 1.111(a)(1). Applicant is also required to timely challenge a noticed fact in order to preserve the issue for appeal. MPEP § 2144.03.

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36. ANSWER: (A) is the most correct answer. (A) is true since only the inventor may file for a patent. 35 U.S.C. § 101. As to answers (C) and (E), since Alice is not a joint inventor and she does not have sufficient proprietary interest in the invention, she may not file a patent

application on Mike's behalf. 35 U.S.C. § 116; 37 CFR § 1.47(b). As to (B), you ordinarily may not accept payment from someone other than your client. 37 CFR § 10.68(a)(1). As to (D), inventorship cannot be changed when there is deceptive intent. MPEP § 2137.01

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41. ANSWER: (B) is the most correct answer. See MPEP § 2143.03. To establish prima facie obviousness of a claimed invention, all of the claimed limitations must be taught or suggested by the prior art. (A) is incorrect. See MPEP § 2141.01(a). Although an argument that the reference is nonanalogous art may be appropriate, it is overcome by the acknowledgment that the reference may be reasonably pertinent to the applicant's endeavor to solving the particular problem with which the inventor was concerned. As discussed in MPEP § 2141.01(a), under the heading "To Rely On A Reference Under 35 U.S.C. 103, It Must Be Analogous Prior Art," which quotes *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992), to rely on a reference as a basis for rejection of the applicant's invention, "the reference must either be in the field of the applicant's endeavor or, if not, be reasonably pertinent to the particular problem with which the inventor was concerned." Here, the argument acknowledges that reference may be reasonably pertinent to the applicant's problem solving endeavor. (C) is incorrect. U.S. patents may be used as of their filing dates to show that the claimed subject matter is anticipated or obvious. See MPEP § 2136.02 under the heading "The Supreme Court Has Authorized 35 U.S.C. 103 Rejections Based On 35 USC 102(e)." (D) is incorrect. MPEP § 716.01(c), under the heading, "To Be Of Probative Value, Any Objective Evidence Should Be Supported By Actual Proof," states "Objective evidence which must be factually supported by an appropriate affidavit or declaration to be of probative value includes evidence of unexpected results...." It also quotes from *In re De Blauwe*, 736 F.2d 699, 222 USPQ 191, 196 (Fed. Cir. 1984), "It is well settled that unexpected results must be established by factual evidence. Mere argument or conclusory statements in the specification does not suffice." *De Blauwe*, 736 F.2d at 705, 222 USPQ at 196. Here, the conclusory statement in the specification does not suffice. (E) is incorrect. MPEP § 2145, subsection VIII (under the heading "Arguing About The Age Of References"), quoting from *In re Wright*, 569 F.2d 1124, 193 USPQ 332, 335 (CCPA 1977), states "The mere age of the references is not persuasive of the unobviousness of the combination of their teachings, absent evidence that, notwithstanding knowledge of the references, the art tried and failed to solve the problem." Here, the mere fact that the Foreman patent issued 105 years before the filing date of the pending patent application is unpersuasive of the non-obviousness of the applicant's claim.

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44. ANSWER: (C) is the most correct answer. A prima facie case of obviousness exists where the claimed ranges and the prior art are close enough that one of ordinary skill in the art would have expected them to have the same properties. See MPEP § 2144.05. In *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 783, 227 USPQ 773, 779 (Fed. Cir. 1985), a claim recited a titanium base alloy consisting essentially of 0.8% nickel, 0.3% molybdenum, up to 0.1% maximum iron, and the balance titanium. A prior art reference described two similar alloys: (i) one with 0.25% molybdenum, 0.75% nickel, and balance titanium; and (ii) another with 0.31% molybdenum, 0.94% nickel, and balance titanium. The court held: As admitted by appellee's affidavit evidence from James A. Hall, the Russian article discloses two alloys having compositions very close to that of claim 3, which is 0.3% Mo and 0.8% Ni, balance titanium. The two alloys in the prior art have 0.25% Mo-0.75% Ni and 0.31% Mo-0.94% Ni, respectively. The proportions are so close that prima facie one skilled in the art would have expected them to have the same properties. Appellee produced no evidence to rebut that prima facie case. The specific alloy of claim 3 must therefore be considered to have been obvious from known alloys. *Id.* Thus, (A) is incorrect. (B) and (D) are incorrect because a claim is anticipated by a prior art reference only when the prior art discloses, either expressly or inherently, every limitation of the claimed invention. (E) is incorrect because (C) is correct.

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49. ANSWER: (A) is the most correct answer. See MPEP § 2106.02 under the heading "Affidavit Practice (37 CFR 1.132)." Factual evidence directed to the amount of time and effort and level of knowledge required for the practice of the invention from the disclosure alone can rebut a prima facie case of nonenablement. See *Hirschfield v. Banner*, Commissioner of Patents and Trademarks, 200 USPQ 276, 281 (D.D.C. 1978). (B) is not correct. MPEP § 2106.02, under the heading "Arguments of Counsel," and see *In re Budnick*, 190 USPQ 422, 424 (CCPA 1976); *In re Schulze*, 145 USPQ 716 (CCPA 1965); and *In re Cole*, 140 USPQ 230 (CCPA 1964). (C) is not correct. MPEP § 2106.02, under the heading "Affidavit Practice (37 CFR 1.132)," and see *In re Brandstadter*, 179 USPQ 286 (CCPA 1973). (D) is not correct. MPEP § 2106.02, under the heading "Affidavit Practice (37 CFR 1.132)," and see *Hirschfield v. Banner*, Commissioner of Patents and Trademarks, 200 USPQ 276, 281 (D.D.C. 1978). (E) is not correct. MPEP § 2106.02, under the heading "Referencing Prior Art Documents," and see *In re Budnick*, 190 USPQ 422, 424 (CCPA 1976); and *In re Gunn*, 190 USPQ 402, 406 (CCPA 1976).

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50. ANSWER: (D) is the most correct answer. See MPEP § 2173.05(c), under the heading "Open-Ended Numerical Ranges." Paraphrasing the explanation therein, when an independent claim recites a composition comprising "at least 20% iron" and a dependent claim sets forth specific amounts of non-iron ingredients which add up to 100%, apparently to the exclusion of iron, an ambiguity is created with regard to the "at least" limitation unless the percentages of the non-iron ingredients are based on the weight of the non-iron ingredients. On the other hand, a composition claimed to have a theoretical content greater than 100% (i.e., 20-80% of iron, 20-80% of gallium, and 1-25% of copper) is not necessarily indefinite simply because the claims may be read in theory to include compositions that are

impossible in fact to formulate. Here, because the invention is a non-theoretical alloy, the sum of the claimed constituents cannot exceed 100% unless the percentage is based on weight. In (D), the sum of elements (B) and (C) is 81% by volume, leaving only 19% for iron. Claim 1, however, requires “at least 20% iron,” rendering Claim 2 ambiguous as to the percentage of element A. (A) is incorrect. The sum of gallium and copper components is 80%, leaving a possible 20% of the composition for element iron. Claim 1 requires “at least 20% iron,” which includes 20% iron. Therefore, the sum of iron, gallium and copper components in Claim 2 is 100%. (B) is incorrect. “At least 20% iron” includes 21% iron, “at least 10% gallium includes 11% gallium, and “at least 10% copper includes 10.01% copper. (C) is incorrect. “At least 20% iron” includes 20% iron, “at least 10% gallium includes 10% gallium, and “at least 10% copper” includes 10% copper. (E) is incorrect because Claim 1 uses the open transition phrase “comprising,” which permits additional elements to be added to the composition. Nothing in the problem indicates that an additional component, silver, cannot be added to the composition.

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2. ANSWER: (B) is the most correct answer. 35 U.S.C. § 112, second paragraph, and MPEP § 2173.05(c), under the heading “III. Effective Amount.” The claim presented in (B) is improper as “an effective amount” has been held to be indefinite when the claim fails to state the function that is to be achieved and more than one effect can be implied from the specification. *In re Fredericksen* 213 F.2d 547, 102 USPQ 35 (CCPA 1954). It is unclear whether “an effective amount” in (B) is an effective amount to reduce acidity or an effective amount to reduce moisture. The claims presented in (A) and (C) find support in the disclosure, which provides guidelines for determining “an effective amount” for each of the claims in (A) and (C). See MPEP § 2173.05(c) under the heading “III. Effective Amount.” The claim presented in (D) is not indefinite, given that A, B, and C are known materials as set forth in the question and the composition can be determined by the claim language. (E) is incorrect because (B) is correct.

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3. ANSWER: (B) is the most correct answer. See 35 U.S.C. § 102(d); MPEP § 2135.01, under the heading “A Continuation - In - Part Breaks The Chain Of Priority As To Foreign As Well As U.S. Parents.” If an applicant files a foreign application, later files a U.S. application claiming priority based on the foreign application, and then files a continuation - in - part (CIP) application whose claims are not entitled to the filing date of the U.S. parent, the effective filing date of the CIP application is the filing date of the CIP. The applicant cannot obtain the benefit of either the U.S. parent or foreign application filing dates. *In re van Langenhoven*, 173 USPQ 426, 429 (CCPA 1972); *Ex parte Appeal No. 242 - 47*, 196 USPQ 828 (Bd. App. 1976). (A) is incorrect. 35 U.S.C. § 102(d). (C) is not correct. 35 U.S.C. § 102(d); MPEP § 2135.01, under the heading “An Allowed Application Can Be A ‘Patent’ For Purposes Of 35 U.S.C. 102(d) As Of The Date Published For Opposition Even Though It Has Not Yet Been Granted As A Patent,” citing *Ex parte Beik*, 161 USPQ 795 (Bd. App. 1968). An application must issue into a patent before it can be applied in a 35 U.S.C. 102(d) rejection. *Ex parte Fujishiro*, 199 USPQ 36 (Bd. App. 1977). (D) is not correct. 35 U.S.C. § 102(d); MPEP § 2136, under the heading “Defensive Publications Are Not Prior Art As Of Their Filing Date,” citing *Ex parte Osmond*, 191 USPQ 334 (Bd. App.

1973). (E) is not correct inasmuch as (A), (C) and (D) are not correct.

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15. ANSWER: (A) is the most correct answer. See MPEP § 2137.01, under the heading “The Inventor Is Not Required To Reduce The Invention To Practice,” citing *In re DeBaun*, 214 USPQ 933, 936 (CCPA 1982). (B) is not correct. MPEP § 2137.01, under the heading “An Inventor Must Contribute To The Conception Of The Invention,” citing, *Fiers v. Revel*, 25 USPQ2d 1601, 1604 - 05 (Fed. Cir. 1993); and *In re Hardee*, 223 USPQ 1122, 1123 (Dep. Asst. Comm'r Pat. 1984). (C) is not correct. MPEP § 2137.01, under the heading “As Long As The Inventor Maintains Intellectual Domination Over Making The Invention, Ideas, Suggestions, And Materials May Be Adopted From Others,” citing *Morse v. Porter*, 155 USPQ 280, 283 (Bd. Pat. Inter. 1965); and *New England Braiding Co., Inc. v. A.W. Chesterton Co.*, 23 USPQ2d 1622, 1626 (Fed. Cir. 1992). (D) and (E) are not correct. 35 U.S.C. § 116; MPEP § 2137.01, under the heading “Requirements For Joint Inventorship.”

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16. ANSWER: (C) is the most correct answer. When the specification expressly provides a special definition for a term used in the claims, the term must be given that special meaning. See MPEP § 2111.01. (A) is incorrect because a term is given its plain meaning only when the specification does not provide a definition for the term. See MPEP § 2111.01 (B) is incorrect because the specification defines the term as being inclusive of elemental copper. See MPEP § 2111.01. (D) is incorrect because it does not take into account the definition of copper found in the specification. See MPEP § 2111.01.

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19. ANSWER: (A) is the most correct answer. As stated in MPEP § 2107.01 under the heading “IV. Relationship Between 35 U.S.C. 112, First Paragraph, And 35 U.S.C. 101,” “A deficiency under 35 U.S.C. § 101 also creates a deficiency under 35 U.S.C. § 112, first paragraph. See *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995); *In re Jolles*, 628 F.2d 1322, 1326 n.10, 206 USPQ 885, 889 n.11 (CCPA 1980); *In re Fouche*, 439 F.2d 1237, 1243, 169 USPQ 429, 434 (CCPA 1971) (‘If such compositions are in fact useless, appellant’s specification cannot have taught how to use them.’).” (B) is not correct. MPEP § 2107, under the heading “II. Examination Guidelines For The Utility Requirement,” and see *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1571, 24 USPQ2d 1401, 1412 (Fed. Cir. 1992); and *E.I. du Pont De Nemours and Co. v. Berkley and Co.*, 620 F.2d 1247, 1260 n.17, 205 USPQ 1, 10 n.17 (8th Cir. 1980). (C), (D) and (E) are not correct. MPEP § 2107, under the heading “II. Examination Guidelines For The Utility Requirement,” and see *E.I. du Pont De Nemours and Co. v. Berkley and Co.*, 620 F.2d 1247, 1260 n.17, 205 USPQ 1, 10 n.17 (8th Cir. 1980).

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27. ANSWER: (E) is the most correct answer. MPEP § 2112, under the heading “Something Which Is Old Does Not Become Patentable Upon The Discovery Of A New Property,” states that “claiming of a new use, new function or unknown property which is inherently present in

the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).” The issue is whether the argument has persuasively rebutted the examiner’s *prima facie* case of anticipation. The argument does not rebut the *prima facie* case. The claim is directed to a string consisting only of material Z. Patent A teaches each every element of that string; *i.e.*, the string shape, material Z, and the string only consists of material Z. There is nothing different between the string of the claim and that of patent A. Under those circumstances, examiner correctly stipulated that the stretchability of the claimed string; *i.e.*, the ability to stretch the string beyond its initial unstretched length, would be an inherent property of the disclosed string. Whether or not patent A teaches the stretchability of its string is not defeating. Even if Mr. Bock had discovered a new property for the string, it would still not render the claim patentable. *In re Best, supra* . Here all the product elements are the same and examiner made out a proper *prima facie* case of anticipation. The burden now shifts to the practitioner to show that the patent string is not the same. The reply, which seeks to establish a difference in properties without showing a concomitant difference in product material and shape is not persuasive as to error in the rejection. All the other answers are wrong. (A) is not the most correct answer. See MPEP § 2112. (B) is not the most correct answer. The anticipation rejection was correctly established and was not rebutted by the argument. (C) is not the most correct answer. See MPEP § 2112, discussing when a reference can anticipate based on an inherent, as opposed to an expressly or implicit, disclosure. (D) is not the most correct answer. In discussing the stretchability property, the recited ability to stretch the string beyond its initial unstretched length was equally addressed.

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29. ANSWER: (A) is the most correct answer. MPEP § 2121, under the heading “What Constitutes An ‘Enabling Disclosure’ Does Not Depend On The Type Of Prior Art The Disclosure Is Contained In,” states, in reliance upon *In re Moreton*, 288 F.2d 708, 711, 129 USPQ 227, 230 (CCPA 1961): “The level of disclosure required within a reference to make it an ‘enabling disclosure’ is the same no matter what type of prior art is at issue.... There is no basis in the statute (35 U.S.C. 102 or 103) for discriminating either in favor of or against prior art references on the basis of nationality.” Answer (B) is incorrect. MPEP § 2121, under the heading “Prior Art Is Presumed To Be Operable/Enabling,” states that “[w]hen the reference relied on expressly anticipates or makes obvious all of the elements of the claimed invention, the reference is presumed to be operable.” Answer (C) is incorrect. MPEP § 2121.01, under the heading “35 U.S.C. 103 Rejections And Use Of Inoperative Prior Art,” quotes *Symbol Technologies Inc. v. Opticon Inc.*, 935 F.2d 1569, 1578, 19 USPQ2d 1241, 1247 (Fed. Cir. 1991) as stating that “a non-enabling reference may qualify as prior art for the purpose of determining obviousness under 35 U.S.C. 103.” Answer (D) is incorrect. MPEP § 2121.01 states that “[a] reference contains an ‘enabling disclosure’ if the public was in possession of the claimed invention before the date of invention.” Answer (E) is incorrect because answers (B), (C) and (D) are incorrect.

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32. ANSWER: (C) is the best answer. MPEP §§ 2107.01 and 2107.02. MPEP § 2107.01, under the heading “Therapeutic or Pharmacological Utility,” cites *In re Chilowsky*, 229 F.2d 457, 461-2, 108 USPQ 321, 325 (CCPA 1956); *In re Gazave*, 379 F.2d 973, 978, 154 USPQ

92, 96 (CCPA 1967); and *Nelson v. Bowler*, 626 F.2d 853, 856, 206 USPQ 881, 883 (CCPA 1980) as taking the position that “[i]nventions asserted to have utility in the treatment of human or animal disorders are subject to the same legal requirements for utility as inventions in any other field of technology.” MPEP § 2107.02, under the heading “The Claimed Invention Is The Focus Of The Utility Requirement,” states “...regardless of the category of invention that is claimed (e.g., product or process), an applicant need only make one credible assertion of specific utility for the claimed invention to satisfy 35 U.S.C. 101 and 35 U.S.C. 112; additional statements of utility, even if not “credible,” do not render the claimed invention lacking in utility. See, e.g.,...*In re Gottlieb*, 328 F.2d 1016, 1019, 140 USPQ 665, 668 (CCPA 1964) (‘Having found that the antibiotic is useful for some purpose, it becomes unnecessary to decide whether it is in fact useful for the other purposes ‘indicated’ in the specification as possibly useful.’).” The issue is whether Mr. Bloc has disclosed a specific utility for the claimed compound Y sufficient to satisfy the practical utility requirement of 35 U.S.C § 101. According to the set of facts, we know that compound Y is an intermediate in the chemical manufacture of synthetic Z. We are given two utilities for synthetic Z: 1) alleviating pain, a utility it shares with the natural form of Z; and, 2) curing cancer. The examiner focuses on the disclosure that synthetic Z is a cure for cancer. Even if one were to agree that synthetic Z’s ability to cure cancer amounts to an incredible utility, a claim to the intermediate compound Y would not run afoul of the utility requirement of 35 U.S.C. § 101 where another substantial, credible and specific utility is alternatively demonstrated. Here, the specification discloses that synthetic Z, like the natural form of Z, alleviates pain. The alleviation of pain is another substantial, credible and specific utility and serves to give compound Y an alternative utility to that of being used to make a cancer-curing substance. An applicant need not show that all disclosed utilities are credible. An applicant need only show that one of the disclosed utilities is in fact credible. *In re Gottlieb*, *supra*. The establishment of a credible, substantial and specific utility renders the disclosure of an additional incredible utility superfluous, and therefore ultimately irrelevant. Accordingly, Mr. Bloc’s best course of action is to make the argument that he has disclosed another substantial, credible, and specific utility, notwithstanding the disclosure of curing cancer. (A) is not the most correct answer. The advice could prevent him from getting a patent to which he may be entitled. (B) is not the most correct answer. A cure for cancer is ostensibly incredible. It is hardly a response to the examiner’s rejection to ask for the chance to prove one can cure cancer. (D) is not the most correct answer. While it is true that the utility requirement is addressed to the claimed invention, which here is compound Y not synthetic Z, it is not enough to respond by repeating what the invention is but, rather, to show that the invention has indeed a substantial, credible, and specific utility. Whatever is claimed as the invention, it must comply with the utility requirement of 35 U.S.C. § 101. Here the examiner states that the claim does not comply, as evidenced by the incredible utility of the final product. It is Mr. Bloc’s responsibility to then show that compound Y does comply with 35 U.S.C. § 101. (E) is not the most correct answer. Noting that synthetic Z is modeled on natural Z does not go far enough in establishing a substantial, credible and specific utility for compound Y. It is synthetic Z’s therapeutic ability to alleviate pain which establishes the necessary alternative utility.

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34. ANSWER: (C) is the most correct answer. See MPEP §§ 706.03(o) and 2143.03. MPEP

§ 2143.03, under the heading “Limitations Which Do Not Find Support In The Original Specification Must Be Considered,” states: “When evaluating claims for obviousness under 35 U.S.C. § 103, all the limitations of the claims must be considered and given weight, including limitations which do not find support in the specification as originally filed (*i.e.*, new matter).” In (C), the examiner considered the new matter as required. MPEP § 706.03(o) states, “In amended cases, subject matter not disclosed in the original application is sometimes added and a claim directed thereto. Such a claim is rejected on the ground that it recites elements without support in the original disclosure under 35 U.S.C. 112, first paragraph, *Waldemar Link, GmbH & Co. v. Osteonics Corp.* 32 F.3d 556, 559, 31 USPQ2d 1855, 1857 (Fed. Cir. 1994); *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).” (A) is incorrect. An amendment adding new matter is not necessarily a non-*bona fide* response as (A) implies. Moreover, abandonment is not proper after the expiration of the period for response since even if the response is considered non-responsive, applicant would be notified and given the remaining time period plus available extensions of time to reply. See MPEP § 714.03. (B) is incorrect. The mere fact that a claim recites new matter does not mean that the claim lacks utility. See MPEP § 2107.01, under the heading “Relationship Between 35 U.S.C. 112, First Paragraph, And 35 U.S.C. 101,” discussing the difference between new matter under 35 U.S.C. § 112(1) and lack of utility under 34 U.S.C. § 101. (D) is incorrect because it contradicts MPEP § 2143.03, which requires the examiner to consider new matter. (E) is incorrect inasmuch as (A), (B), and (D) are incorrect and (C) is correct.

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39. ANSWER: (E) is the most correct answer. For (A) *see*, MPEP § 2107, under the heading “Examination Guidelines For The Utility Requirement,” penultimate paragraph, which states “The applicant can do this by... providing reasoning or arguments... .” For (B), *see* MPEP § 2107, under the heading “Examination Guidelines For The Utility Requirement,” penultimate paragraph, which states “The applicant can do this by amending the claims... .” For (C) *see*, MPEP § 2107, under the heading “Examination Guidelines For The Utility Requirement,” penultimate paragraph, which states “The applicant can do this by...providing evidence in the form of a declaration under 37 C.F.R. § 1.132...rebutting the basis or logic of the *prima facie* showing.” For (D), *see*, MPEP § 2107, under the heading “Examination Guidelines For The Utility Requirement,” penultimate paragraph, which states “The applicant can do this by...providing evidence in the form of a...printed publication...rebutting the basis or logic of the *prima facie* showing.” (A), (B), (C), and (D) alone are not the most correct answer inasmuch (E), referencing all of the above, is the most correct answer.

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36. ANSWER: (D) is the most correct answer. Extending patent term is not a policy underlying any section of 35 U.S.C. § 102. Answers (A), (B), (C) and (E) do state policies underlying the public use bar. *Lough v. Brunswick Corp.*, 86 F.3d 1113, 39 USPQ2d 1100 (Fed. Cir. 1996).

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41. ANSWER: (A) is the most correct answer. In accordance with MPEP § 2172, under the heading “II. Evidence To The Contrary,” states that evidence that shows a claim does not correspond in scope with that which applicant regards as applicant’s invention may be found,

for example, in contentions or admissions contained in briefs or remarks filed by applicant. *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969). (B) is incorrect. MPEP § 2172, under the heading “II. Evidence To The Contrary,” states, “As noted in *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA 1979) agreement, or lack thereof, between the claims and the specification is properly considered only with respect to 35 U.S.C. 112, first paragraph; it is irrelevant to compliance with the second paragraph of that section.” (C) is incorrect. MPEP § 2172, under the heading “III. Shift In Claims Permitted,” indicates that the second paragraph of 35 U.S.C. § 112 does not prohibit applicants from changing what they regard as their invention during the pendency of the application. *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971) (Applicant was permitted to claim and submit comparative evidence with respect to claimed subject matter which originally was only the preferred embodiment within much broader claims (directed to a method). (D) is incorrect. MPEP § 2172, under the heading “III. Shift In Claims Permitted,” indicates that the fact that claims in a continuation application were directed to originally disclosed subject matter which applicants had not regarded as part of their invention when the parent application was filed was held not to prevent the continuation application from receiving benefits of the filing date of the parent application under 35 U.S.C. § 120. *In re Brower*, 433 F.2d 813, 167 USPQ 684 (CCPA 1970). (E) is incorrect because (B), (C), and (D) are incorrect.

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42. ANSWER: (D) is the most correct answer. See 35 U.S.C. § 102(b); MPEP § 2131. Citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), MPEP § 2131, under the heading, “To Anticipate A Claim, The Reference Must Teach Every Element Of The Claim” states, “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”. The claim is directed to a method of use that is not disclosed by the reference. Answer (A) is incorrect. 35 U.S.C. § 102(b); MPEP §§ 2112, 2112.01. The claimed composition is the same as that disclosed in the prior art, because it is made from the same starting material subjected to the same processing steps. The recitation of “the composition is effective for treating cancer,” is only a statement of the inherent properties of the composition. Where the claimed and prior art products are identical in structure or composition, or are produced by identical processes, a *prima facie* case of anticipation has been established. *In re Best*, 195 USPQ 430, 433 (CCPA 1977). The burden is shifted to applicant to show that the prior art product does not necessarily possess the characteristics of the claimed product. The reference is prior art under 35 U.S.C. § 102(b), and therefore the claim is anticipated. Answer (B) is incorrect. 35 U.S.C. § 102(b); MPEP §§ 2112, 2112.01, and 2112.02. The claimed composition is the same as that disclosed in the prior art, because it is made from the same starting material subjected to the same processing steps. The recitation of a composition “for treating cancer” reflects only a preamble statement of an intended use of the claimed composition, which does not limit the scope of the claim. Answer (C) is incorrect. See 35 U.S.C. § 102(b); MPEP §§ 2112, 2112.01. The claimed method is the same as that disclosed in the prior art, because it subjects the same starting material to the same manipulative steps. The recitation of making “a cancer-treating composition” reflects only a preamble’s statement of an intended use of the claimed composition, which does not further limit the claimed method. Answer (E) is incorrect, because (A), (B), and (C) are incorrect.

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46. ANSWER: (C) is the most correct answer. The internal report was intended to be confidential and therefore is not a “printed publication” under 35 U.S.C. § 102(b). See MPEP § 2128.01. Answer (A) is incorrect. An orally presented paper can be a “printed publication” if copies are available without restriction. The paper is a “printed publication” under 35 U.S.C. § 102(b). See MPEP § 2128.01. Answer (B) is incorrect. The thesis is a “printed publication” under 35 U.S.C. § 102(b). See MPEP § 2128.01. Answer (D) is incorrect. An electronic publication disclosed on the Internet is considered to be publicly available as of the date the item was posted. The reference is a “printed publication” under 35 U.S.C. § 102(b). See MPEP § 2128. Answer (E) is incorrect. There is no need to prove that anyone actually looked at a document. The manual is a “printed publication” under 35 U.S.C. § 102(b). See MPEP § 2128.

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49. ANSWER: (B) is the most proper answer. MPEP § 2111, under the heading “Claims Must Be Given Their Broadest Reasonable Interpretation,” states, in reference to *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969): “The court explained that ‘reading a claim in light of the specification,[’] to thereby interpret limitations explicitly recited in the claim, is a quite different thing from ‘reading limitations of the specification into a claim,’ to thereby narrow the scope of the claim by implicitly adding disclosed [sic, *disclosed*] limitations which have no express basis in the claim.” Answer (A) is incorrect because, as pointed out in MPEP § 2111.01, the court in *In re Marosi*, 710 F.2d 799, 802, 218 USPQ 289, 292 (Fed. Cir. 1983) (quoting *In re Okuzawa*, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976)), states: “It is well settled that ‘claims are not to be read in a vacuum and limitations therein are to be interpreted in light of the specification in giving them their “broadest *reasonable* interpretation.”’” Answer (C) is incorrect because MPEP § 2111.01, under the heading “Plain Meaning Refers To The Meaning Given to The Term By Those Of Ordinary Skill In The Art,” states that “[w]hen not defined by applicant in the specification, the words of a claim must be given their plain meaning.” Answer (D) is incorrect because MPEP § 2111.01 states that it is only when the specification provides a definition for terms appearing in the claims can the specification be used to interpret the claim language. Answer (E) is incorrect. See MPEP § 2111.01, under the heading “Plain Meaning Refers To The Meaning Given to The Term By Those Of Ordinary Skill In The Art,” states, in reliance upon *In re Donaldson*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994), that there is “one exception, and that is when an element is claimed using language falling under the scope of 35 U.S.C. 112, 6th paragraph (often broadly referred to as means or step plus function language). In that case, the specification must be consulted to determine the structure, material, or acts corresponding to the function recited in the claim.”

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50. ANSWER: (E) is the most correct answer. Both (A) and (C) are correct. MPEP § 2163.01, under the heading “Support For The Claimed Subject Matter In The Disclosure,” states that “[I]f the examiner concludes that the claimed subject matter is not supported [described] in an application as filed, this would result in a rejection of the claim on the ground of a lack of written description under 35 U.S.C. 112, first paragraph, or denial of the

benefit of filing date of a previously filed application.” (B) is incorrect. MPEP § 2163.01 states that unsupported claims “should not be rejected or objected to on the ground of new matter. As framed by the court in *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981), the concept of new matter is properly employed as a basis for objection to amendments to the abstract, specification or drawings attempting to add new disclosure to that originally presented.” (D) is incorrect because (B) is incorrect.

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2. ANSWER: (C) is the most correct answer. *See*, “Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1105 (Jan. 5, 2001) left column, first paragraph. “The claimed invention as a whole may not be adequately described if the claims require an essential or critical feature that is not described in the specification and is not conventional in the art or known to one of ordinary skill in the art.”

(A) is not the most correct answer. *See*, “Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1104 (Jan. 5, 2001) right column, last paragraph. Describing an actual reduction to practice of the claimed invention is a means of showing possession of the invention. (B) is not the most correct answer. *See*, “Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1104 (Jan. 5, 2001) right column, last paragraph. (D) is not the most correct answer. *See*, “Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1105 (Jan. 5, 2001), left column, second paragraph, which states, “While there is no *in haec verba* requirement, newly added claim limitations must be supported by in the specification through express, implicit, or inherent disclosure.” (E) is not the most correct answer. *See*, “Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1105 (Jan. 5, 2001), left column, second paragraph, which states, “An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of the error in the specification, but also recognize the appropriate correction.”

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7. ANSWER: (B) is best choice because it is a false statement. MPEP § 2112.01 cites *Titanium Metals Corp. v. Banner*, 778 F.2d 660, 227 USPQ 773 (Fed. Cir. 1985), as stating, “it was immaterial what properties the alloys had...because the composition is the same and thus must necessarily exhibit the properties.” (A) is not correct because it is a true statement. (C), (D) and (E) are incorrect because the stated reliance is permitted. 37 C.F.R. § 1.104(c)(3); MPEP § 706.

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13. ANSWER: (A) is the most correct answer. MPEP § 2144.03. I is incorrect because an applicant must seasonably traverse the well-known statement or the object of the well-known statement is taken to be admitted prior art. *In re Chevenard*, 60 USPQ 239 (CCPA 1943). Therefore (B) and (D) are incorrect. III is incorrect because the action can potentially be made final. Therefore (C) is incorrect. (E) is incorrect because (A) is correct.

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14. ANSWER: The most correct answer is (E). (A), (B), (C) and (D) are not in accordance with proper USPTO practice and procedure. (A) alone is not correct. MPEP § 2131.04 and see *In re Wiggins*, 179 USPQ 421, 425 (CCPA 1973). (B), (C), and (D) are not correct. MPEP § 2131.05, and see *Twin Disc, Inc. v. U. S.*, 231 USPQ 417, 424 (Cl. Ct. 1986); *In re Self*, 213 USPQ 1, 7 (CCPA 1982).

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20. ANSWER: The most correct answer is (E). MPEP § 2164.01(a).

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23. ANSWER: (C) is the most correct answer. MPEP § 2181 expressly requires that for a claim limitation to be interpreted in accordance with 35 U.S.C. § 112, paragraph 6, that limitation must (1) use the phrase “means for”, (2) the “means for” must be modified by functional language, and (3) the “means for” must not be modified by sufficient structure for achieving the specified function. In the above fact pattern, only answer choice (C) satisfies the above requirements. (A) is wrong because it does not use the phrase “means for” and recites structure for achieving the specified function (“printer”). (B) is wrong because it modifies the “means” with structure, and also fails to modify the “means” with functional language. (D) is wrong because it does not use the phrase “means for” and also recites structure modifying “mechanism.”

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27. ANSWER: The most correct answer is (B). 35 U.S.C. § 103; *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966); MPEP § 2141. Resolving any issue of indefiniteness in favor of clarity is not among the factual inquiries enunciated in *Graham*. The four factual inquiries are set forth in answers (A), (C), (D), and (E).

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32. ANSWER: (A) is the most correct answer. The patentability of a product-by-process claim is determined based on the product itself, not on the process of making it. See *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985), and MPEP § 2113. (B) and (D) are not proper choices because when evidence indicates that the applicant’s product and that of the prior art are identical or substantially identical, the burden shifts to the applicant to overcome the rejection by providing evidence that the prior art product does not necessarily or inherently possess a relied-upon characteristic of the applicant’s claimed product. See *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980); *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977), and MPEP § 2112. (C) is not the proper choice because evidence of unexpected results is not relevant to anticipation. See *In re Malagari*, 499 F.2d 1297, 1302, 182 USPQ 549, 553 (CCPA 1974), and MPEP § 711.03(c). (E) is not the proper choice because a rejection under 35 U.S.C. § 102(b) is a statutory bar to patentability, and 37 C.F.R. § 1.131(a)(2) states that § 131 cannot be used to establish prior invention when the rejection is based upon a statutory bar.

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36. ANSWER: (A) is the correct answer. The phrase “consisting of” excludes any step not

specified in the claim. MPEP § 2111.03. Thus, a claim that depends from a claim which “consists of” the recited steps cannot add a step. *Id.* Here, the dependent claim adds the step of cooling. Answer (B) is incorrect because the transitional term “comprising” is inclusive or open-ended and does not exclude additional, unrecited steps. MPEP § 2111.03. Answers (C) and (D) are incorrect because the terms “including” and “characterized by” are synonymous with the term “comprising.” MPEP § 2111.03. Answer (E) is incorrect because Answer (C) and Answer (D) are incorrect.

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43. ANSWER: The most correct answer is (A). MPEP § 2143.03 (Indefinite Limitations Must Be Considered). (B) is not correct because it is proper procedure to be followed by an examiner. MPEP § 2143.03, (Indefinite Limitations Must Be Considered), and see *Ex parte Ionescu*, 222 USPQ 537 (Bd. Pat. App. & Inter. 1984). (C) is not correct because it is proper procedure to be followed by an examiner. MPEP § 2143.03, (Indefinite Limitations Must Be Considered), and see *In re Wilson*, 165 USPQ 494 (CCPA 1970) (if no reasonably definite meaning can be ascribed to certain claim language, the claim is indefinite, not obvious). (D) is not correct because it is proper procedure to be followed by an examiner. MPEP § 2143.03, (Limitations Which Do Not Find Support In The Original Specification Must Be Considered), and see *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff’d mem.*, 738 F.2d 453 (Fed. Cir. 1984). (E) is incorrect because the examiner may properly take the actions set forth in (B), (C), and (D).

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47. ANSWER: The most correct answer is (A). MPEP § 2106.02 (Affidavit Practice (37 C.F.R. § 1.132)). Factual evidence directed to the amount of time and effort and level of knowledge required for the practice of the invention from the disclosure alone can rebut a prima facie case of nonenablement. See *Hirschfield v. Banner, Commissioner of Patents and Trademarks*, 200 USPQ 276, 281 (D.D.C. 1978). (B) is not correct. MPEP § 2106.02 (Arguments of Counsel), and see *In re Budnick*, 190 USPQ 422, 424 (CCPA 1976); *In re Schulze*, 145 USPQ 716 (CCPA 1965); and *In re Cole*, 140 USPQ 230 (CCPA 1964). (C) is not correct. MPEP § 2106.02 (Affidavit Practice (37 C.F.R. § 1.132)), and see *In re Brandstadter*, 179 USPQ 286 (CCPA 1973). (D) is not correct. MPEP § 2106.02 (Affidavit Practice (37 C.F.R. § 1.132)), and see *Hirschfield v. Banner, Commissioner of Patents and Trademarks*, 200 USPQ 276, 281 (D.D.C. 1978). (E) is not correct. MPEP § 2106.02, (Referencing Prior Art Documents), and see *In re Budnick*, 190 USPQ 422, 424 (CCPA 1976); and *In re Gunn*, 190 USPQ 402, 406 (CCPA 1976).

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3. ANSWER: (E) is the correct answer. (A) is incorrect because it is permitted experimental testing. MPEP §§ 2133.03(e)(3) and (6). (B) and (D) are each incorrect because the sales occurred outside of the United States. 35 U.S.C. § 102(b); MPEP §§ 706.02(c) and 2133.03(d). (C) is incorrect as it provides the basis for a rejection under 35 U.S.C. § 103, but not 35 U.S.C. § 102(b).

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6. ANSWER: (E) is the most correct answer. For (A) see, “Utility Examination Guidelines,”

66 F.R. 1092, 1099, left column (Jan. 5, 2001). “The applicant can do this by... providing reasoning or arguments... .” For (B), *see*, “Utility Examination Guidelines,” 66 F.R. 1092, 1099, left column (Jan. 5, 2001). “The applicant can do this by amending the claims... .” For (C) *see*, “Utility Examination Guidelines,” 66 F.R. 1092, 1099, left column (Jan. 5, 2001). “The applicant can do this by...providing evidence in the form of a declaration under 37 C.F.R. § 1.132...rebutting the basis or logic of the prima facie showing.” For (D), *see*, “Utility Examination Guidelines,” 66 F.R. 1092, 1099, left column (Jan. 5, 2001). “The applicant can do this by...providing evidence in the form of a...printed publication...rebutting the basis or logic of the prima facie showing.” (A), (B), (C), and (D) alone are not the most correct answer inasmuch (E), referencing all of the above, is the most correct answer.

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8. ANSWER: The most correct answer is (B). MPEP § 2163.01. (A) is incorrect because the claims as filed in the original application are part of the disclosure, MPEP §§ 2163.03 and 2163.06(III), and claim 2 is enabled by the original disclosure. (C) is incorrect. The original disclosure enables claim 2. (D) is incorrect because although the specification should be objected to, the original disclosure enables each of the claims. MPEP § 2163.06(I). (E) is incorrect because (B) is correct.

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9. ANSWER: (A) is true, and thus the most correct answer. As stated in MPEP § 2129, and *see In re Fout*, 675 F.2d 297, 300-01, 213 USPQ 532,535-36 (CCPA 1982). (B) is not true, and thus not correct. MPEP § 2129, and *see Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 650, 223 USPQ 1168, 1172 (Fed. Cir. 1984). (C) is not true, and thus not correct because the admitted foundational discovery is a statutory bar. See the reasons discussed for answer (B). (D) is not true, and is thus incorrect. MPEP § 2129, and *see In re Nomiya*, 184 USPQ 607, 610 (CCPA 1975) (figures in the application labeled “prior art” held to be an admission that what was pictured was prior art relative to applicant’s invention.). (E) is not true. MPEP § 2129; and *see In re Ehrreich*, 590 F.2d 902, 909 – 910, 200 USPQ 504, 510 (CCPA 1979); *Sjolund v. Musland*, 847 F.2d 1573, 1577, 6 USPQ2d 2020, 2023 (Fed. Cir. 1988); *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 315, 227 USPQ 766, 770 (Fed. Cir. 1985); and *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 650, 223 USPQ 1168, 1172 (Fed. Cir. 1984).

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15. ANSWER: (A) is accepted as the most correct answer. MPEP § 2173.05(e). Claim 2 is indefinite because it is not clear which “said pipe” the claim is referring to since claim 1 recites a copper pipe and an aluminum pipe. Accordingly, claim 2 provides the basis for a proper rejection under 35 U.S.C. § 112, second paragraph. In (B), claim 3 would be construed as definite, inasmuch as “the outer circumference” is an inherent part of the pipe and would not require antecedent recitation. Thus claim 3 does not provide a proper basis for the rejection. Therefore, (B) and (D) would be incorrect. Claim 4 is definite inasmuch as there is antecedent basis for “said plastic valve.” Therefore, (C) and (E) are incorrect.

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16. ANSWER: (C). MPEP 2163.03, item I. Original claims constitute their own description. *In re Koller*, 613 F.2d 819, 204 USPQ 702 (CCPA 1980). (A) and (B) are incorrect. As stated in MPEP 2163.03, item I, “An amendment to the specification (e.g., a change in the definition of a term used both in the specification and claim) may indirectly affect a claim even though no actual amendment is made to the claim.” There is no supporting disclosure in the original description of the invention for the holder to a clasp, crimp, or tong. (D) is incorrect. MPEP 2163.03, item IV. A broad generic disclosure is not necessarily a sufficient written description of a specific embodiment, especially where the broad generic disclosure conflicts with the remainder of the disclosure. *Fields v. Conover*, 443 F.2d 1386, 170 USPQ 276 (CCPA 1970). (E) is not correct because (C) is correct.

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19. ANSWER: The most correct answer is (A). As stated in MPEP § 2107.01 (IV). A deficiency under 35 U.S.C. § 101 also creates a deficiency under 35 U.S.C. § 112, first paragraph. See *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995); *In re Jolles*, 628 F.2d 1322, 1326 n.10, 206 USPQ 885, 889 n.11 (CCPA 1980); *In re Fouche*, 439 F.2d 1237, 1243, 169 USPQ 429, 434 (CCPA 1971) (“If such compositions are in fact useless, appellant’s specification cannot have taught how to use them.”). (B) is not correct. MPEP § 2107 (II), and see *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1571, 24 USPQ2d 1401, 1412 (Fed. Cir. 1992); and *E.I. du Pont De Nemours and Co. v. Berkley and Co.*, 620 F.2d 1247, 1260 n.17, 205 USPQ 1, 10 n.17 (8th Cir. 1980). (C), (D) and (E) are not correct. MPEP § 2107 (II), and see *E.I. du Pont De Nemours and Co. v. Berkley and Co.*, 620 F.2d 1247, 1260 n.17, 205 USPQ 1, 10 n.17 (8th Cir. 1980).

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38. ANSWER: (C) is the most correct answer. As stated in MPEP § 2172.01, “a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. § 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968).” (A) is incorrect. As stated in MPEP § 2172.01, “A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. § 112, first paragraph, as not enabling. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976); MPEP § 2164.08(c). (B) is incorrect. As stated in MPEP § 2165, “Failure to disclose the best mode need not rise to the level of active concealment or grossly inequitable conduct in order to support a rejection or invalidate a patent. Where an inventor knows of a specific material that will make possible the successful reproduction of the effects claimed by the patent, but does not disclose it, speaking instead in terms of broad categories, the best mode requirement has not been satisfied. *Union Carbide Corp. v. Borg - Warner*, 550 F.2d 555, 193 USPQ 1 (6th Cir. 1977).” (D) is incorrect. MPEP § 2165.01, part V indicates that if there is no disclosure of the best mode contemplated by the inventor at the time the application is filed, such a defect cannot be cured by submitting an amendment seeking to put into the specification something required to be there when the patent application was originally filed. *In re Hay*, 534 F.2d 917, 189 USPQ 790 (CCPA 1976). Any proposed amendment of this type should be treated as new matter. MPEP § 2165.01. (E) is incorrect. As stated in MPEP § 2165.02, “The best mode requirement is a separate and

distinct requirement from the enablement requirement of the first paragraph of 35 U.S.C. § 112. *In re Newton*, 414 F.2d 1400, 163 USPQ 34 (CCPA 1969).

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40. ANSWER: (C) is the most correct answer. See MPEP § 2128 under the subheading “Date of Availability,” of the heading “Electronic Publications As Prior Art.” (A) is wrong. See MPEP § 2129 under the heading “A Jepson Claim Results In An Implied Admission That Preamble Is Prior Art.” (B) is wrong. See MPEP § 2128.02. A journal article or other publication becomes available as prior art on date it is received by at least one member of the public. (D) is wrong. See MPEP § 2128.01 under the heading “A Thesis Placed In A University Library May Be Prior Art If Sufficiently Accessible To The Public.” (E) is wrong. See *In re Nomiya*, 184 USPQ 607, 610 (CCPA 1975); MPEP § 2129 under the heading “Admissions By Applicant Constitute Prior Art.”

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43. ANSWER: (D). “It is not necessary in order to establish a prima facie case of obviousness...that there be a suggestion or expectation from the prior art that the claimed [invention] will have the same or a similar utility as one newly discovered by the applicant.” *In re Dillon*, 919 F.2d 688, 692, 16 USPQ2d 1897, 1900 (Fed. Cir. 1990) (emphasis in original). Thus, “[i]t is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant.” MPEP § 2144 (“Rationale Different from Applicant’s is Permissible”). Here, T suggests the combination with P to achieve a different advantage or result, i.e., waterproofing, from that discovered by applicant, i.e., reducing breakage. Answers (A) - (C) are incorrect because the suggestion to combine does not need to be for the same purpose as applicant discloses in the application. *Dillon*, 919 F.2d at 692, 16 USPQ2d at 1900; MPEP § 2144 (“Rationale Different from Applicant’s is Permissible”). Answer (E) is incorrect because an applicant is under no obligation to submit evidence of non-obviousness unless the examiner meets his or her initial burden to fully establish a prima facie case of obviousness. MPEP § 2142.

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50. ANSWER: (D) is correct. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP § 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). Here, the examiner fails to show that substituting Larry’s device for another type of device in Morris would have been desirable. (A) is incorrect. The test of obviousness is not whether the features or elements of the references are physically combinable. *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981); *In re Sneed*, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983). (B) is incorrect. “The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law.” MPEP § 2144 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)). Here, the argument overlooks the fact that a suggestion to combine Larry and Morris may be reasoned from knowledge generally available to one of

ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. (C) is incorrect. “The fact that a combination would not be made by businessmen for economic reasons does not mean that a person of ordinary skill in the art would not make the combination because of some technological incompatibility.” MPEP § 2145 (citing *In re Farrenkopf*, 713 F.2d 714, 718, 219 USPQ 1, 4 (Fed. Cir. 1983)). Here, the high cost of Barry’s device does not teach away from a person of ordinary skill in the art combining it with Lance’s device.

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1. ANSWER: (C) is the most correct answer. MPEP § 2181 expressly requires that for a claim limitation to be interpreted in accordance with 35 U.S.C. § 112, paragraph 6, that limitation must (1) use the phrase “means for”, (2) the “means for” must be modified by functional language, and (3) the “means for” must not be modified by sufficient structure for achieving the specified function. In the above fact pattern, only answer choice (C) satisfies the above requirements. (A) is wrong because it does not use the phrase “means for” and recites structure for achieving the specified function (“printer”). (B) is wrong because it modifies the “means” with structure, and also fails to modify the “means” with functional language. (D) is wrong because it does not use the phrase “means for” and also recites structure modifying “mechanism.”

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4. ANSWER: (B) is the most correct answer. 35 U.S.C. § 113 reads “Drawings submitted after the filing date of the application may not be used (i) to overcome any insufficiency of the specification due to lack of an enabling disclosure.” Since choice (A) may be done, 37 C.F.R. § 1.111, it is an incorrect answer to the above question. Since choice (C) may be done, 35 U.S.C. §120, it is an incorrect answer to the above question. Since choice (D) may be done, 37 C.F.R. §1.121, it is an incorrect answer to the above question. Since choice (E) may be done, 37 C.F.R. §1.111, it also is an incorrect answer to the above question.

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9. ANSWER: (C), not being in accord with proper USPTO practice and procedure, is the most correct answer. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1107 (Jan. 5, 2001), middle column, “A general allegation of ‘unpredictability in the art’ is not a sufficient reason to support a rejection for lack of adequate written description.” (A), being in accord with proper USPTO practice and procedure, is not correct. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1107 (Jan. 5, 2001), left column, “A description as filed is presumed to be adequate... .” (B), being in accord with proper USPTO practice and procedure, is not correct. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1107 (Jan. 5, 2001), “A description as filed is presumed to be adequate, unless or until sufficient evidence⁶⁵ or reasoning to the contrary has been presented by the examiner to rebut the presumption. ...The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the⁶⁶ art would not recognize in an applicant’s disclosure a description of the invention defined by the claims. ” (footnotes not reproduced). (D), being in accord with proper USPTO practice and procedure, is not correct. As

stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1107 (Jan. 5, 2001), left column, “[W]hen filing an amendment, applicant should show support in the original disclosure for new or amended claims.”⁵⁹ Footnote 59 states, “See MPEP §§ 714.02 and 2163.06 (‘Applicant should... specifically point out the support for any amendments made to the disclosure.’).” (E), being in accord with proper USPTO practice and procedure, is not correct. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1106 (Jan. 5, 2001), right column, “[W]hen there is substantial variation within a genus, an applicant must describe a sufficient variety of species to reflect the variation within the genus.”

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11. ANSWER: (B) is the most correct answer. 35 U.S.C. § 102(e)(1) provides that a USPTO published application, based on an earlier international application, has prior art effect as of its international filing date, if the international application designated the United States, and was published in English. Because in the above fact pattern, the international application designated the United States and was published in English, the USPTO published application is entitled to its international filing date of February 27, 1997 for prior art purposes. (A) is wrong because the Japanese filing date is relevant under 35 U.S.C. § 119 only for priority, but not for prior art purposes. (C) and (E) are wrong because they recite prior art dates that are later than February 27, 1997. (D) is wrong because the amendments to § 102(e) by the American Inventors Protection Act of 1999 make the national stage entry date irrelevant for prior art purposes.

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12. ANSWER: (E) is the most correct answer. 35 U.S.C. § 102(e)(2), as amended by the American Inventors Protection Act, provides that a United States patent is prior art as of its earliest filing date in the United States. Section 102(e)(2) also specifically notes that a patent is not entitled to any international application filing date for prior art purposes. Because in the above fact pattern, no application was ever filed in the United States, the patent is not entitled to any prior art date earlier than its issue date, December 1, 2001. (A) is wrong because the Japanese filing date is relevant under 35 U.S.C. § 119 only for priority and not prior art purposes. (B) is wrong because while a USPTO published application may be entitled to its international filing date under section 102(e)(1), a United States patent is not entitled to any international filing date under section 102(e)(2). (C) is wrong because while the publication of an international application in English has its own prior art effect as a reference, it is not relevant to the prior art effect of the United States patent. (D) is wrong because national stage entry of an international application is not to be confused with a United States filing date. While the version of section 102(e) that existed prior to the American Inventors Protection Act expressly provided for prior art effect as fulfillment of certain national stage requirements, the amended section 102(e) no longer provides for that prior art effect, thus making national stage entry irrelevant for 102(e) prior art purposes.

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18. ANSWER: (C) is the most correct answer. See, “Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1105 (Jan. 5, 2001) left column, first paragraph. “The claimed invention as a whole may not be adequately described if the claims require an essential or critical feature that is not

described in the specification and is not conventional in the art or known to one of ordinary skill in the art.” (A) is not the most correct answer. *See*, “Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1104 (Jan. 5, 2001) right column, last paragraph. Describing an actual reduction to practice of the claimed invention is a means of showing possession of the invention. (B) is not the most correct answer. *See*, “Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1104 (Jan. 5, 2001) right column, last paragraph. (D) is not the most correct answer. *See*, “Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1105 (Jan. 5, 2001), left column, second paragraph, which states, “While there is no *in haec verba* requirement, newly added claim limitations must be supported by in the specification through express, implicit, or inherent disclosure.” (E) is not the most correct answer. *See*, “Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1105 (Jan. 5, 2001), left column, second paragraph, which states, “An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of the error in the specification, but also recognize the appropriate correction.”

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22. ANSWER: (A) is the correct answer. The phrase “consisting of” excludes any step not specified in the claim. MPEP §2111.03. Thus, a claim that depends from a claim which “consists of” the recited steps cannot add a step. *Id.* Here, the dependent claim adds the step of cooling. Answer (B) is incorrect because the transitional term “comprising” is inclusive or open-ended and does not exclude additional, unrecited steps. MPEP § 2111.03. Answers (C) and (D) are incorrect because the terms “including” and “characterized by” are synonymous with the term “comprising.” MPEP § 2111.03. Answer (E) is incorrect because Answer (C) and Answer (D) are incorrect.

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24. ANSWER: (B) is the correct answer. It is inappropriate and injudicious to disregard any admissible evidence in any judicial proceeding. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). The examiner has not analyzed the data in the declaration nor provided an explanation as to why the declaration did not overcome the rejection. Furthermore, the rejection has not been reviewed anew in light of the declaration. The examiner should have reweighed the entire merits of the *prima facie* case of obviousness in light of the data. *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986). Accordingly, Block should ask that the rejection be reconsidered and file a Notice of Appeal to safeguard his interest for a review of the rejection by the Board of Patent Appeals and Interferences if the rejection is not reconsidered. 37 C.F.R. § 1.116. (A) is wrong because there is no evidence that the examiner made any review of the declaration. (C) is wrong because whether or not Reference X provides an enabling disclosure for Block’s invention is immaterial to the question of obviousness. If there were to be a question of enabling disclosure for Reference X, it would be with respect to the “Q” ball relied upon by the examiner, not applicant’s “Y” ball. (D) is wrong because whether or not Reference X provides a written description for Block’s invention is immaterial to the question of obviousness raised by the examiner. (E) is wrong because the issue is one of obviousness

under 35 U.S.C. § 103, not identity under 35 U.S.C. § 102. Given that the examiner has rejected the claim under 35 U.S.C. § 103 and not under § 102, the examiner has already conceded that the “Q” and “Y” balls are not the same.

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32. ANSWER: (B). Since Johnnie developed the material and James thought of the idea to use it in microwave ovens, they rightfully could be considered coinventors of the new article of manufacture. As to (A) and (C), public use began on when the experimental use ended on January 30, 2001, and occurs even when the public is unaware that they were walking on the developed material since the material was used in a public place. As to (D), even though James only took a second to think of the idea, he is entitled to receive a patent unless it was obvious to one of ordinary skill in the art. Nothing in the prior art revealed that it was obvious to use the material in microwave ovens. As to (E), the article of manufacture is not barred even though the floor material itself cannot be patented. Johnnie conducted an experimental use of the article from December 31, 2000 through January 30, 2001. Thereafter, Johnnie had one year from the end date of the experimental use to file a patent application for the article. Johnnie may file a patent application before January 30, 2002.

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1. ANSWER: (C) is the correct answer. MPEP § 2133.03(e). The issue is whether the invention was in “public use” more than one year prior to the filing of the application. The crux of the issue is whether the agreement, which is the only evidence the examiner relied upon, indicates that a “public” use has occurred. Issues arising under the public use bar of 35 U.S.C. § 102(b) are determined by considering the totality of the circumstances. In *re* Brigrance, 792 F.2d 1103, 1107, 229 USPQ 988, 991 (Fed. Cir. 1986). The circumstances are that: 1) Even if Cone received the ball, she was limited to using it for experimental, not public, uses. And, finally, 2) even though Cone can conduct experiments with the ball, control of the ball remains with Block. In view of all these facts, the totality of the circumstances leads to the conclusion that a “public use” more than one year prior to the filing of the application did not occur. In view of this response, and assuming no other evidence of a public use is available, the rejection under 35 U.S.C. § 102(b) under these grounds should be withdrawn. (A) is wrong because it is not enough that a document is dated more than one year prior to the filing date of an application for it to constitute a statutory bar under 35 U.S.C. § 102(b). The issue to be addressed by Block is whether the examiner appropriately rejected the claim over the “public use” clause of 35 U.S.C. § 102(b), not the “printed publication” clause. (B) is wrong because whether or not the agreement is a printed publication is irrelevant. The rejection is on the grounds of “public use”, not “printed publication”. (D) is wrong because the issue of whether an invention was “known or used by others in this country” is relevant to a rejection under 35 U.S.C. § 102(a), not § 102(b) which is at issue here. Furthermore, the fact that Cone also signed the agreement suggests “others” were associated with the use of the invention which would mean this response is incorrect even if the issue was the propriety of a rejection under 35 U.S.C. § 102(a). In that situation, the issue would not be whether it was used by others, since it plainly was, but rather whether the use was a “public” one. (E) is wrong because it assumes that the issue is whether the invention was “on sale”. While the rejection was under 35 U.S.C. § 102(b), the “public use” clause, not the “on sale” clause is at issue. Whether or not the ball was on sale or not is

irrelevant to overcoming the rejection.

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9. ANSWER: (D) is correct. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP § 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). Here, the examiner fails to show that substituting Larry’s device for another type of device in Morris would have been desirable. (A) is incorrect. The test of obviousness is not whether the features or elements of the references are physically combinable. *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981); *In re Sneed*, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983). (B) is incorrect. “The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law.” MPEP § 2144 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)). Here, the argument overlooks the fact that a suggestion to combine Larry and Morris may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. (C) is incorrect. “The fact that a combination would not be made by businessmen for economic reasons does not mean that a person of ordinary skill in the art would not make the combination because of some technological incompatibility.” MPEP § 2145 (citing *In re Farrenkopf*, 713 F.2d 714, 718, 219 USPQ 1, 4 (Fed. Cir. 1983)). Here, the high cost of Barry’s device does not teach away from a person of ordinary skill in the art combining it with Lance’s device.

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12. ANSWER: (C) is correct. “If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). Here, the combination would render Lance’s device unsatisfactory for its intended purpose. (A) is incorrect. “The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art.” MPEP § 2145, paragraph III (quoting *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)). Here, the argument fails to address what the combined teachings of the references would or would not have suggested to those of ordinary skill in the art. (B) is incorrect. “In order to rely on a reference as a basis for rejection of the applicant’s invention, the reference must either be in the field of the applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” MPEP § 2141.01(a) (quoting *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)). Here, Barry’s art could still be analogous if it was reasonably pertinent to the particular problem with which the applicant was concerned. (D) is incorrect. The argument addresses a rejection under 35 U.S.C. § 102, as opposed to the rejection that was made, under 35 U.S.C. § 103, which raises obviousness, not anticipation, issues. (E) is not correct because (A), (B) and (D) are

incorrect.

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44. ANSWER: (B) is the correct answer. 35 U.S.C. § 112, second paragraph, 35 U.S.C. § 101, and MPEP § 2173.05(h)(II). (A) is incorrect because the claim presented in (A) attempts to claim a process without setting forth any steps involved in the process. MPEP § 2173.05(q). (C) is incorrect because the claim presented in (C) recites “an effective amount” without stating the function that is to be achieved, and more than one effect can be implied from the specification. *In re Fredericksen* 213 F.2d 547, 102 USPQ 35 (CCPA 1954). It is unclear whether “an effective amount” in (C) is an effective amount to increase stickiness or an effective amount to increase hardness. MPEP § 2173.05(c)(III). (D) is incorrect because it is unclear whether “preferably between 15 and 20 degrees Celsius” is a limitation on the scope of the claim presented in (D). MPEP § 2173.05(c)(I). (E) is incorrect at least because the claim presented in (E) claims both a composition and a process of using it. MPEP § 2173.05(p)(II). Further, the portion of the claim in (E) drawn to a process of using the composition does not set forth any steps involved in the process. MPEP § 2173.05(q).

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1. ANSWER: The most correct answer is (B). 35 U.S.C. § 103; *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966); MPEP § 2141. Resolving any issue of indefiniteness in favor of clarity is not among the factual inquiries enunciated in *Graham*. The four factual inquiries are set forth in answers (A), (C), (D), and (E).

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6. ANSWER: The most correct answer is (A). As stated in MPEP § 2107.01 (IV). A deficiency under 35 U.S.C. § 101 also creates a deficiency under 35 U.S.C. § 112, first paragraph. See *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995); *In re Jolles*, 628 F.2d 1322, 1326 n.10, 206 USPQ 885, 889 n.11 (CCPA 1980); *In re Fouche*, 439 F.2d 1237, 1243, 169 USPQ 429, 434 (CCPA 1971) (“If such compositions are in fact useless, appellant’s specification cannot have taught how to use them.”). (B) is not correct. MPEP § 2107 (II), and see *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1571, 24 USPQ2d 1401, 1412 (Fed. Cir. 1992); and *E.I. du Pont De Nemours and Co. v. Berkley and Co.*, 620 F.2d 1247, 1260 n.17, 205 USPQ 1, 10 n.17 (8th Cir. 1980). (C), (D) and (E) are not correct. MPEP § 2107 (II), and see *E.I. du Pont De Nemours and Co. v. Berkley and Co.*, 620 F.2d 1247, 1260 n.17, 205 USPQ 1, 10 n.17 (8th Cir. 1980).

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14. ANSWER: (C), not being in accord with proper USPTO practice and procedure, is the most correct answer. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1107 (Jan. 5, 2001), middle column, “A general allegation of ‘unpredictability in the art’ is not a sufficient reason to support a rejection for lack of adequate written description”; MPEP § 2163, paragraph III. A. (pg. 2100166) (8th Ed.). (A), being in accord with proper USPTO practice and procedure, is not correct. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1107 (Jan. 5, 2001), left

column, “A description as filed is presumed to be adequate...” MPEP § 2163, paragraph III. A. (pg. 2100166) (8th Ed.). (B), being in accord with proper USPTO practice and procedure, is not correct. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1107 (Jan. 5, 2001), “A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption.⁶⁵ ...The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.”⁶⁶ (footnotes not reproduced); MPEP § 2163, paragraph III. A. (pg. 2100-166) (8th Ed.). (D), being in accord with proper USPTO practice and procedure, is not correct. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1107 (Jan. 5, 2001), left column, “[W]hen filing an amendment, applicant should show support in the original disclosure for new or amended claims.”⁶⁹ Footnote 59 states, “See MPEP §§ 714.02 and 2163.06 (‘Applicant should...specifically point out the support for any amendments made to the disclosure.’)”; MPEP § 2163, paragraph III. A. 3. (b) (pg. 2100-165) (8th Ed.). (E), being in accord with proper USPTO practice and procedure, is not correct. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1106 (Jan. 5, 2001), right column, “[W]hen there is substantial variation within a genus, an applicant must describe a sufficient variety of species to reflect the variation within the genus”; MPEP § 2163, paragraph III. A. 3. (a)(ii) (pg. 2100-164) (8th Ed.).

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18. ANSWER: The most correct answer is (B). MPEP §2106 (IV)(B)(2)(b)(ii) (Computer Related Process ...), “If the ‘acts’ of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. Thus, a claim to a process consisting solely of mathematical operations, i.e., converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a statutory process.” (A) is not correct. MPEP § 2106 (V)(B)(1), and see *In re Barker*, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), cert. denied, *Barker v. Parker*, 434 U.S. 1064 (1978) (a specification may be sufficient to enable one skilled in the art to make and use the invention, but still fail to comply with the written description requirement). See also *In re DiLeone*, 436 F.2d 1404, 1405, 168 USPQ 592, 593 (CCPA 1971). Also, the written description requirement is in the first paragraph, not the second paragraph, of 35 U.S.C. § 112. (C) is not correct. MPEP § 2106 (IV)(B)(2)(a) (Statutory Product Claims). (D) is not correct. MPEP § 2106 (IV)(B)(1)(c) (Natural Phenomena Such As Electricity or Magnetism), and see *O’Reilly v. Morse*, 56 U.S. (15 How.) at 112 -114. (E) is incorrect. MPEP § 2106 (IV)(B)(2) (Statutory Subject Matter), and see *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 206 USPQ 193, 197 (1980); and *Shell Development Co. v. Watson*, 149 F. Supp. 279, 280, 113 USPQ 265, 266 (D.D.C. 1957), *aff’d per curiam*, 252 F.2d 861, 116 USPQ 428 (D.C. Cir. 1958).

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19. ANSWER: The correct response is (E). Adams is not entitled to a patent because he did not himself invent the subject matter sought to be patented. 35 U.S.C. § 102(f). Therefore,

statement (C) cannot be correct. Statement (A) is incorrect because, although the machine was known by others, it was not known by others in this country as required under 35 U.S.C. § 102(a). It does not matter that Mexico is a NAFTA country. Similarly, statements (B) and (D) are incorrect because, even if there was a sale or public use more than a year before Adams' filing date, it was not "in this country" as required by 35 U.S.C. § 102(b). Again, it does not matter that Mexico is a NAFTA country.

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21. ANSWER: The most correct answer is (C). MPEP § 2144.04(VII), citing *In re Bergstrom*, 427 F.2d 1394, 166 USPQ 256 (CCPA 1970). (A) is not correct. MPEP § 2144.04(IV)(A), citing *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). (B) is not correct. MPEP § 2144.04(IV)(B) citing *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). (D) is not correct. MPEP § 2144.04(VI)(A), citing *In re Gazda*, 219 F.2d 449, 104 USPQ 400 (CCPA 1955). (E) is not correct. MPEP § 2144.04(II)(A), citing *In re Larson*, 340 F.2d 965, 144 USPQ 347 (CCPA 1965); *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975); and *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989).

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24. ANSWER: The most correct answer is (D). 35 U.S.C. § 116, first paragraph; MPEP § 2137.01, "Inventorship," and see *Kimberly-Clark Corp. v. Procter & Gamble Distributing*, 23 USPQ2d 1921, 1925 -26 (Fed. Cir. 1992); and *Moler v. Purdy*, 131 USPQ 276, 279 (Bd. Pat. Inter. 1960). (A) is not correct. MPEP § 2137.01 (Requirements for Joint Inventorship) and see *Kimberly-Clark Corp. v. Procter & Gamble Distributing*, 23 USPQ2d 1921, 1925 -26 (Fed. Cir. 1992); and *Moler v. Purdy*, 131 USPQ 276, 279 (Bd. Pat. Inter. 1960). (B) is not correct. 35 U.S.C. §§101, 115; MPEP § 2137.01. (C) is not correct. MPEP § 2137.01. The inventor of an element, per se, and the inventor of a combination using that element may differ. See *In re DeBaun*, 214 USPQ 933, 936 (CCPA 1982); and *In re Facius*, 161 USPQ 294, 301 (CCPA 1969). (E) is not correct. There is no provision in the Patent Statute requiring the invention to be reduced to practice in order to file a patent application claiming the invention. Further, see MPEP § 2137.01; and see *In re DeBaun*, 214 USPQ 933, 936 (CCPA 1982).

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25. ANSWER: (C). Ada may file an affidavit or declaration pursuant to 37 CFR 1.131. As to (A), *In Evans Cooling Systems, Inc. v. General Motors Corp.*, 125 F.3d 1448, 44 USPQ 2d 1037 (Fed. Cir. 1997), the Federal Circuit held that even though an invention is misappropriated by a third party, the public sale bar applies (35 U.S.C. § 102(b)). However, the sale occurs in China and not in the United States as is required by 35 U.S.C. § 102(b). As to (B), the sale in China is not a bar. 35 U.S.C. § 102(b) requires the sales to be in the United States. As to (D), reexaminations are based solely upon patents and printed publications. (E) is incorrect since disclosure of another's idea does not render a patent invalid and breach of the confidentiality agreement does not render the patent invalid.

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34. ANSWER: (D) is the correct answer. The phrase “consisting of” excludes any step not specified in the claim. MPEP §2111.03. Thus, a claim that depends from a claim which “consists of” the recited steps cannot add a step. *Id.* Here, the dependent claim adds the step of cooling. Answer (A) is incorrect because the transitional term “comprising” is inclusive or open-ended and does not exclude additional, unrecited steps. MPEP § 2111.03. Answers (B) and (C) are incorrect because the terms “including” and “characterized by” are synonymous with the term “comprising.” MPEP § 2111.03. Answer (E) is incorrect because Answer (B) and Answer (C) are incorrect.

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37. ANSWER: The most correct answer is (B). MPEP § 2163.01. (A) is incorrect because the claims as filed in the original application are part of the disclosure, MPEP §§ 2163.03 and 2163.06(III), and claim 2 is enabled by the original disclosure. (C) is incorrect. The original disclosure enables claim 2. (D) is incorrect because although the specification should be objected to, the original disclosure enables each of the claims. MPEP § 2163.06(I). (E) is incorrect because (B) is correct.

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40. ANSWER: (A) is true since only the inventor may file for a patent. 35 U.S.C. § 101. As to answers (C) and (E), since Alice is not a joint inventor and she does not have sufficient proprietary interest in the invention, she may not file a patent application on Mike’s behalf. 35 U.S.C. § 116; 37 CFR 1.47(b). As to (B), you ordinarily may not accept payment from someone other than your client. 37 CFR 10.68(a)(1). As to (D), inventorship cannot be changed when there is deceptive intent.

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43. ANSWER: (E) is the correct answer. (A) is incorrect because it is permitted experimental testing. MPEP §§ 2133.03(e)(3) and (6). (B) and (D) are each incorrect because the sales occurred outside of the United States. 35 U.S.C. § 102(b); MPEP §§ 706.02(c) and 2133.03(d). (C) is incorrect as it provides the basis for a rejection under 35 U.S.C. § 103, but not 35 U.S.C. § 102(b).

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50. ANSWER: (B) is the most correct answer. Admissions by applicant constitute prior art. 37 CFR 1.104(a)(3). As explained in *Tyler Refrigeration v. Kysor Industrial Corp.*, 777 F.2d 687, 227 USPQ 845 (Fed. Cir. 1985), the Fed. Circuit found that

the district court decided on two separate and independent grounds that the Aokage patent was such prior art. One basis was Tyler’s admission of the Aokage reference as prior art before the PTO during the prosecution of the ’922 Subera patent. The court found that, in a wrap-up amendment, the Tyler attorney admitted in his discussion as to “all the claims” of the three Subera applications, that “the most pertinent available prior art known to the Applicants and their representatives is the Aokage U.S. Patent 4,026,121 cited by the Examiner” (emphasis added). In view of this explicit admission, the district court’s decision was proper and was sufficiently based on clear and convincing evidence. The controlling case law in this court recognizes this principle. See *Aktiebolaget Karlstads Mekaniska*

Werkstad v. ITC, 705 F.2d 1565, 1574, 217 U.S.P.Q. (BNA) 865, 871 (Fed. Cir. 1983); *In re Fout*, 675 F.2d 297, 300, 213 U.S.P.Q. (BNA) 532, 536 (CCPA 1982), and *In re Nomiya*, 509 F.2d 566, 571, 184 U.S.P.Q. (BNA) 607, 612 (CCPA 1975). Thus, we must affirm the court's decision that the Aokage patent was prior art and as such binding on Tyler. (Here again, we do not pass on the other grounds on which the court concluded that the Aokage was prior art within the meaning of 35 U.S.C. § 102.)

Since (B) is true, (D) is not true. Answers (A), (C) and (D) also are not true since the Acme patent can not be sworn behind or otherwise removed as a result of the admission. (E) is not true because (A) and (D) are not true.

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1. ANSWER: (B) is the correct answer. 35 U.S.C. § 112, second paragraph and MPEP § 2173.05(c)(III). The claim presented in (B) is improper as "an effective amount" has been held to be indefinite when the claim fails to state the function that is to be achieved and more than one effect can be implied from the specification. *In re Fredericksen* 213 F.2d 547, 102 USPQ 35 (CCPA 1954). It is unclear whether "an effective amount" in (B) is an effective amount to reduce acidity or an effective amount to reduce moisture. The claims presented in (A) and (C) find support in the disclosure, which provides guidelines for determining "an effective amount" for each of the claims in (A) and (C). MPEP § 2173.05(c)(III). The claim presented in (D) is not indefinite, given that A, B, and C are known materials as set forth in the question and the composition can be determined by the claim language. (E) is incorrect because (B) is correct.

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2. ANSWER: The most correct answer is (A). MPEP § 2137.01 (The Inventor Is Not Required To Reduce The Invention To Practice) citing *In re DeBaun*, 214 USPQ 933, 936 (CCPA 1982). (B) is not correct. MPEP § 2137.01 (An Inventor Must Contribute To The Conception Of The Invention) citing, *Fiers v. Revel*, 25 USPQ2d 1601, 1604 -05 (Fed. Cir. 1993); and *In re Hardee*, 223 USPQ 1122, 1123 (Dep. Asst. Comm'r Pat. 1984). (C) is not correct. MPEP § 2137.01 (As Long As The Inventor Maintains Intellectual Domination Over Making The Invention, Ideas, Suggestions, And Materials May Be Adopted From Others) citing *Morse v. Porter*, 155 USPQ 280, 283 (Bd. Pat. Inter. 1965); and *New England Braiding Co., Inc. v. A.W. Chesterton Co.*, 23 USPQ2d 1622, 1626 (Fed. Cir. 1992). (D) and (E) are not correct. 35 U.S.C. § 116; MPEP § 2137.01 (Requirements For Joint Inventorship).

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6. ANSWER: The most correct answer is (A). MPEP § 2106.02 (Affidavit Practice (37 CFR 1.132)). Factual evidence directed to the amount of time and effort and level of knowledge required for the practice of the invention from the disclosure alone can rebut a prima facie case of nonenablement. See *Hirschfield v. Banner, Commissioner of Patents and Trademarks*, 200 USPQ 276, 281 (D.D.C. 1978). (B) is not correct. MPEP § 2106.02 (Arguments of Counsel), and see *In re Budnick*, 190 USPQ 422, 424 (CCPA 1976); *In re Schulze*, 145 USPQ 716 (CCPA 1965); and *In re Cole*, 140 USPQ 230 (CCPA 1964). (C) is not correct. MPEP § 2106.02 (Affidavit Practice (37 CFR 1.132)), and see *In re Brandstadter*, 179 USPQ 286 (CCPA 1973). (D) is not correct. MPEP § 2106.02 (Affidavit Practice (37

CFR 1.132)), and see *Hirschfield v. Banner, Commissioner of Patents and Trademarks*, 200 USPQ 276, 281 (D.D.C. 1978). (E) is not correct. MPEP § 2106.02, (Referencing Prior Art Documents), and see *In re Budnick*, 190 USPQ 422, 424 (CCPA 1976); and *In re Gunn*, 190 USPQ 402, 406 (CCPA 1976).

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9. ANSWER: The most correct response is (D). Bill's thesis constitutes a printed publication as of January 29, 2001. *In re Hall*, 228 USPQ 453 (Fed. Cir. 1986). Since (B) and (C) are both correct statements, the most correct response is (D). The provisions of § 102(b) apply equally with regard to publications written in non-English languages.

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13. ANSWER: The most correct answer is (D). MPEP § 2107(I), “‘Real World Value’ Requirement.” The USPTO regards assertions falling within this category as sufficient to identify a specific utility for the invention. (A) is not correct. An invention that is not a machine, an article of manufacture, a composition, or a process cannot be patented. 35 U.S.C. § 101; MPEP § 2107; see *Diamond v. Chakrabarty*, 447 U.S. 303, 206 USPQ 193 (1980); and *Diamond v. Diehr*, 450 U.S. 175, 209 USPQ 1 (1981). (B) and (C) are incorrect. The USPTO regards assertions in choices (B) and (C) as insufficient to define a specific utility for the invention, especially if the assertion takes the form of a general statement that makes it clear that a “useful” invention may arise from what has been disclosed by the applicant. *Knapp v. Anderson*, 477 F.2d 588, 177 USPQ 688 (CCPA 1973). (E) is incorrect. 35 U.S.C. §§ 101, and 112; and see *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995).

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17. ANSWER: The most correct answer is (E). MPEP § 2164.01(a).

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19. ANSWER: (A) is true, and thus the most correct answer. As stated in MPEP § 2129, and see *In re Fout*, 675 F.2d 297, 300-01, 213 USPQ 532,535-36 (CCPA 1982). (B) is not true, and thus not correct. MPEP § 2129, and see *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 650, 223 USPQ 1168, 1172 (Fed. Cir. 1984). (C) is not true, and thus not correct because the admitted foundational discovery is a statutory bar. See the reasons discussed for answer (B). (D) is not true, and is thus incorrect. MPEP § 2129, and see *In re Nomiya*, 184 USPQ 607, 610 (CCPA 1975) (figures in the application labeled “prior art” held to be an admission that what was pictured was prior art relative to applicant's invention.). (E) is not true. MPEP § 2129; and see *In re Ehrreich*, 590 F.2d 902, 909 – 910, 200 USPQ 504, 510 (CCPA 1979); *Sjolund v. Musland*, 847 F.2d 1573, 1577, 6 USPQ2d 2020, 2023 (Fed. Cir. 1988); *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 315, 227 USPQ 766, 770 (Fed. Cir. 1985); and *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 650, 223 USPQ 1168, 1172 (Fed. Cir. 1984).

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22. ANSWER: (A) is the most correct answer. See, “Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099,

1105 (Jan. 5, 2001) left column, first paragraph. “The claimed invention as a whole may not be adequately described if the claims require an essential or critical feature that is not described in the specification and is not conventional in the art or known to one of ordinary skill in the art”; MPEP § 2163, paragraph I. A. (pg. 2100-156) (8th Ed.). (B) is not the most correct answer. See, “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1104 (Jan. 5, 2001) right column, last paragraph; MPEP § 2163, paragraph I. (pg. 2100-155) (8th Ed.). (C) is not the most correct answer. See, “Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1104 (Jan. 5, 2001) right column, last paragraph. Describing an actual reduction to practice of the claimed invention is a means of showing possession of the invention; MPEP § 2163, paragraph I. (pg. 2100-155) (8th Ed.). (D) is not the most correct answer. See, “Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1105 (Jan. 5, 2001), left column, second paragraph, which states, “While there is no in haec verba requirement, newly added claim limitations must be supported by in the specification through express, implicit, or inherent disclosure”; MPEP § 2163, paragraph I. B. (pg. 2100-157) (8th Ed.). (E) is not the most correct answer. See, “Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1105 (Jan. 5, 2001), left column, second paragraph, which states, “An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of the error in the specification, but also recognize the appropriate correction”; MPEP § 2163, paragraph I. B. (pg. 2100-157) (8th Ed.).

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28. ANSWER: The most correct answer is (B). 35 U.S.C. §102(d); MPEP §2135.01, (A Continuation - In - Part Breaks The Chain Of Priority As To Foreign As Well As U.S. Parents). If an applicant files a foreign application, later files a U.S. application claiming priority based on the foreign application, and then files a continuation -in -part (CIP) application whose claims are not entitled to the filing date of the U.S. parent, the effective filing date of the CIP application is the filing date of the CIP. The applicant cannot obtain the benefit of either the U.S. parent or foreign application filing dates. *In re van Langenhoven*, 173 USPQ 426, 429 (CCPA 1972); *Ex parte Appeal No. 242 - 47*, 196 USPQ 828 (Bd. App. 1976). (A) is incorrect. 35 U.S.C. § 102(d). (C) is not correct. 35 U.S.C. § 102(d); MPEP § 2135.01, (An Allowed Application Can Be A ‘Patent’ For Purposes Of 35 U.S.C. 102(d) As Of The Date Published For Opposition Even Though It Has Not Yet Been Granted As A Patent), citing *Ex parte Beik*, 161 USPQ 795 (Bd. App. 1968). An application must issue into a patent before it can be applied in a 35 U.S.C. 102(d) rejection. *Ex parte Fujishiro*, 199 USPQ 36 (Bd. App. 1977). (D) is not correct. 35 U.S.C. § 102(d); MPEP § 2136 (Defensive Publications Are Not Prior Art As Of Their Filing Date) citing *Ex parte Osmond*, 191 USPQ 334 (Bd. App. 1973). (E) is not correct inasmuch as (A), (C) and (D) are not correct.

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36. ANSWER: The most correct answer is (A). MPEP § 2143.03 (Indefinite Limitations Must Be Considered). (B) is not correct because it is proper procedure to be followed by an examiner. MPEP § 2143.03, (Indefinite Limitations Must Be Considered), and see *Ex parte*

Ionescu, 222 USPQ 537 (Bd. Pat. App. & Inter. 1984). (C) is not correct because it is proper procedure to be followed by an examiner. MPEP § 2143.03, (Indefinite Limitations Must Be Considered), and see *In re Wilson*, 165 USPQ 494 (CCPA 1970) (if no reasonably definite meaning can be ascribed to certain claim language, the claim is indefinite, not obvious). (D) is not correct because it is proper procedure to be followed by an examiner. MPEP § 2143.03, (Limitations Which Do Not Find Support In The Original Specification Must Be Considered), and see *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). (E) is incorrect because the examiner may properly take the actions set forth in (B), (C), and (D).

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37. ANSWER: (C) is the most correct answer. As stated in MPEP § 2172.01, “a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968).” (A) is incorrect. As stated in MPEP § 2172.01, “A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. § 112, first paragraph, as not enabling. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976)”; MPEP § 2164.08(c). (B) is incorrect. As stated in MPEP § 2165, “Failure to disclose the best mode need not rise to the level of active concealment or grossly inequitable conduct in order to support a rejection or invalidate a patent. Where an inventor knows of a specific material that will make possible the successful reproduction of the effects claimed by the patent, but does not disclose it, speaking instead in terms of broad categories, the best mode requirement has not been satisfied. *Union Carbide Corp. v. Borg - Warner*, 550 F.2d 555, 193 USPQ 1 (6th Cir. 1977).” (D) is incorrect. MPEP § 2165.01, part V indicates that if there is no disclosure of the best mode contemplated by the inventor at the time the application is filed, such a defect cannot be cured by submitting an amendment seeking to put into the specification something required to be there when the patent application was originally filed. *In re Hay*, 534 F.2d 917, 189 USPQ 790 (CCPA 1976). Any proposed amendment of this type should be treated as new matter. MPEP § 2165.01. (E) is incorrect. As stated in MPEP § 2165.02, “The best mode requirement is a separate and distinct requirement from the enablement requirement of the first paragraph of 35 U.S.C. §112. *In re Newton*, 414 F.2d 1400, 163 USPQ 34 (CCPA 1969).

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38. ANSWER: The most correct answer is (B). 35 U.S.C. § 102(b). The on sale activity by the inventors was not a statutory bar since the one year anniversary ends on Tuesday, June 26, 2001. (A) is not the correct answer. 35 U.S.C. § 102(a). The reference, published before the filing date of the client’s application, is prior art under 35 U.S.C. 102(a). The inventive entity is Able and Baker. The authorship is “by others,” Able, Baker, and McGeiver. The reference is prior art “by others.” See MPEP § 2132 (‘Others’ Means Any Combination Of Authors Or Inventors Different Than The Inventive Entity), and MPEP § 2132.01. See also *In re Katz*, 215 USPQ 14 (CCPA 1982). (C) is not correct. 35 U.S.C. § 102(b). The invention was placed in public use more than one year before the filing date of the patent application. See MPEP § 2133 (The 1 – Year Time Bar Is Measured From The U.S. Filing

Date); MPEP § 2133.03(a); and *Egbert v. Lippmann*, 104 U.S. 333, 336 (1881). (D) is not correct. Although public knowledge may not be a public use or sale bar under 35 U.S.C. 102(b), it can provide grounds for rejection under 35 U.S.C. 102(a). MPEP §§ 2132 and 2133.03(a)(C) (Use by Independent Third Parties). In this instance, the public knowledge is more than one year before the application filing date. (E) is not correct. 35 U.S.C. § 102(b). A “secret” use by another inventor of a machine to make a product is “public” if the details of the machine are ascertainable by inspection or analysis of the product that is sold or publicly displayed. *Gillman v. Stern*, 46 USPQ 430 (2d Cir. 1940); *Dunlop Holdings v. Ram Golf Corp.*, 188 USPQ 481, 483 -484 (7th Cir. 1975); *W.L. Gore & Assocs. v. Garlock, Inc.*, 220 USPQ 303, 310 (Fed. Cir. 1983).

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43. ANSWER: The most correct answer is (D). MPEP § 2131.03 (Prior Art Which Teaches A Range Within, Overlapping, Or Touching The Claimed Range Anticipates If The Prior Art Range Discloses The Claimed Range With “Sufficient Specificity”). If the prior art discloses a range that touches, overlaps or is within the claimed range, but there is no disclosure of specific examples falling within the claimed, a case by case determination must be made as to anticipation. To anticipate the claims, the claimed subject matter must be disclosed in the reference with “sufficient specificity to constitute an anticipation under the statute.” What constitutes a “sufficient specificity” is fact dependent. (A) is not correct. 35 U.S.C. § 102(b); MPEP § 2131.02 (A Species Will Anticipate A Claim To A Genus) citing *In re Slayter*, 125 USPQ 345, 347 (CCPA 1960); and *In re Gosteli*, 10 USPQ2d 1614 (Fed. Cir. 1989). (B) is not the correct answer. 35 U.S.C. § 102(b); MPEP § 2131.02 (A Reference That Clearly Names The Claimed Species Anticipates The Claim No Matter How Many Other Species Are Named) citing *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990). (C) is not the correct answer. 35 U.S.C. § 102(b); MPEP § 2131.03 (A Specific Example In The Prior Art Which Is Within A Claimed Range Anticipates The Range), and see *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985) (citing *In re Petering*, 301 F.2d 676, 682, 133 USPQ 275, 280 (CCPA 1962)).

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44. ANSWER: The most correct answer is (A). 35 U.S.C. § 102(c); MPEP § 2134, and see *Davis Harvester Co., Inc. v. Long Mfg. Co.*, 149 USPQ 420, 435 -436 (E.D. N.C. 1966). (B) is not correct. 35 U.S.C. § 102(c); MPEP § 2134, and see *Ex parte Dunne*, 20 USPQ2d 1479 (Bd. Pat. App. & Inter. 1991). (C) is not correct. 35 U.S.C. § 102(c); MPEP § 2134, and see *Moore v. U.S.*, 194 USPQ 423, 428 (Ct. Cl. 1977). (D) is not correct. 35 U.S.C. § 102(c); MPEP § 2134, and see *Petersen v. Fee Int'l, Ltd.*, 381 F. Supp. 1071, 182 USPQ 264 (W.D. Okla. 1974). (E) is not correct. 35 U.S.C. § 102(c); MPEP § 2134, and see *In re Gibbs*, 437 F.2d 486, 168 USPQ 578 (CCPA 1971).

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47. ANSWER: The most correct answer is (E). (A), (B), (C) and (D) are not in accordance with proper USPTO practice and procedure. (A) alone is not correct. MPEP § 2131.04 and see *In re Wiggins*, 179 USPQ 421, 425 (CCPA 1973). (B), (C), and (D) are not correct. MPEP § 2131.05, and see *Twin Disc, Inc. v. U. S.*, 231 USPQ 417, 424 (Cl. Ct. 1986); *In re Self*, 213 USPQ 1, 7 (CCPA 1982).

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50. ANSWER: The most correct response is (A). 35 U.S.C. § 102(g); *Mahurkar v. C.R. Bard, Inc.*, 38 USPQ2d 1288 (Fed. Cir. 1996). If statement (D) were correct, there would be no need for interference proceedings. Statement (B) is incorrect because Debbie need not establish diligence for the period from February 2000 until just before Billie's conception on May 15, 2000. Statement (C) is incorrect because, so long as there has not been an abandonment, suppression or concealment of the invention, Debbie need not show diligence between the actual reduction to practice and the patent filing. Statement (E) is inconsistent with 35 U.S.C. § 102(g).

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9. ANSWER: (C), not being in accord with proper USPTO practice and procedure, is the most correct answer. As stated in "Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, 'Written Description' Requirement," 66 F.R. 1099, 1107 (Jan. 5, 2001), middlecolumn, "A general allegation of 'unpredictability in the art' is not a sufficient reason to support a rejection for lack of adequate written description." (A), being in accord with proper USPTO practice and procedure, is not correct. As stated in "Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, 'Written Description' Requirement," 66 F.R. 1099, 1107 (Jan. 5, 2001), left column, "A description as filed is presumed to be adequate... ." (B), being in accord with proper USPTO practice and procedure, is not correct. As stated in "Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, 'Written Description' Requirement," 66 F.R. 1099, 1107 (Jan. 5, 2001), "A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption.⁶⁵ ...The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims."⁶⁶ (footnotes not reproduced). (D), being in accord with proper USPTO practice and procedure, is not correct. As stated in "Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, 'Written Description' Requirement," 66 F.R. 1099, 1107 (Jan. 5, 2001), left column, "[W]hen filing an amendment, applicant should show support in the original disclosure for new or amended claims."⁵⁹ Footnote 59 states, "See MPEP §§ 714.02 and 2163.06 ('Applicant should... specifically point out the support for any amendments made to the disclosure.')." (E), being in accord with proper USPTO practice and procedure, is not correct. As stated in "Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, 'Written Description' Requirement," 66 F.R. 1099, 1106 (Jan. 5, 2001), right column, "[W]hen there is substantial variation within a genus, an applicant must describe a sufficient variety of species to reflect the variation within the genus."

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10. ANSWER: (A) or (D) are accepted as correct answers. MPEP § 2173.05(e). Claim 2 is indefinite because it is not clear which “said pipe” the claim is referring to since claim 1 recites a copper pipe and an aluminum pipe. Accordingly, claim 2 provides the basis for a proper rejection under 35 U.S.C. § 112, second paragraph. In (B), claim 3 can be construed as definite, inasmuch as “the outer surface,” e.g., the outer circumference, is an inherent part of the pipe and would not require antecedent recitation. Therefore, (B), would be incorrect. Alternatively, claim 3 in (B) could be properly construed as not being clear as to which outer surface is being referenced, i.e., “the outer surface” defined by the outer circumference of the pipe, or the external surface defined by the inner circumference of the pipe or the end(s) of the pipe inasmuch as the pipe is not defined as being closed and both the inner circumference and end(s) are external surfaces to the material of the pipe. However, recognizing claim 3 in (B) as being indefinite, but not claim 2, is incorrect because claim 2 is necessarily indefinite. Claim 2 must be recognized as being indefinite. Accordingly, selection of (D), which recognizes both (A) and (B) as providing the basis for a proper rejection under 35 U.S.C. § 112, second paragraph is also accepted. Selection of (B) alone is not accepted as a correct answer because it does not recognize claim 2 as being indefinite. Claim 4 is definite inasmuch as there is antecedent basis for “said plastic valve.” Therefore, (E) is incorrect.

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16. ANSWER: (B) is the most correct answer. Admissions by applicant constitute prior art. 37 C.F.R. § 1.104(a)(3). As explained in *Tyler Refrigeration v. Kysor Industrial Corp.*, 777 F.2d 687, 227 USPQ 845 (Fed. Cir. 1985), the Fed. Circuit found that the district court decided on two separate and independent grounds that the Aokage patent was such prior art. One basis was Tyler’s admission of the

Aokage reference as prior art before the PTO during the prosecution of the ’922 Subera patent. The court found that, in a wrap-up amendment, the Tyler attorney admitted in his discussion as to “all the claims” of the three Subera applications, that “the most pertinent available prior art known to the Applicants and their representatives is the Aokage U.S. Patent 4,026,121 cited by the Examiner” (emphasis added). In view of this explicit admission, the district court’s decision was proper and was sufficiently based on clear and convincing evidence. The controlling case law in this court recognizes this principle. See *Aktiebolaget Karlstads Mekaniska Werkstad v. ITC*, 705 F.2d 1565, 1574, 217 U.S.P.Q. (BNA) 865, 871 (Fed. Cir. 1983); *In re Fout*, 675 F.2d 297, 300, 213 U.S.P.Q. (BNA) 532, 536 (CCPA 1982), and *In re Nomiya*, 509 F.2d 566, 571, 184 U.S.P.Q. (BNA) 607, 612 (CCPA 1975). Thus, we must affirm the court’s decision that the Aokage patent was prior art and as such binding on Tyler. (Here again, we do not pass on the other grounds on which the court concluded that the Aokage was prior art within the meaning of 35 U.S.C. § 102.)

Since (B) is true, (D) is not true. Answers (A), (C) and (D) also are not true since the Acme patent can not be sworn behind or otherwise removed as a result of the admission. (E) is not true because (A) and (D) are not true. [Note re Question 16, choice (B), line 1: Examination proctors were instructed to direct examination candidates after the word “by,” to insert the word --the--. Also in Question 16, choice (D), line 3, examination proctors were instructed to direct examination candidates after the word “by” to insert the words --the registered

practitioner--. The question has been carefully reviewed to see if there is any alternative reasonable meaning to the question if any or all of the changes were not made. No such meaning was found. The Director of Enrollment and Discipline concluded that omission of the changes should have no material affect on the question, and should not inhibit an individual's ability to correctly answer the question.

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19. ANSWER: (A) is the most correct answer. In *Evans Cooling Systems, Inc. v. General Motors Corp.*, 125 F.3d 1448, 44 USPQ 2d 1037 (Fed. Cir. 1997) the Federal Circuit held that even though an invention is misappropriated by a third party, the public sale bar applies (35 U.S.C. § 102(b)). Accordingly, (A) is true and (B) is not. (C) is incorrect since the people at MC were not the true inventors, and therefore, the misappropriation is within the jurisdiction of the USPTO. 35 U.S.C. § 102(f). (D) is incorrect inasmuch as (C) is incorrect. (E) is incorrect inasmuch as (A) is correct.

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20. ANSWER: (D) is the most correct answer. "It is not necessary in order to establish a prima facie case of obviousness...that there be a suggestion or expectation from the prior art that the claimed [invention] will have the same or a similar utility as one newly discovered by the applicant." In *re Dillon*, 919 F.2d 688, 692, 16 USPQ2d 1897, 1900 (Fed. Cir. 1990) (emphasis in original). Thus, "[i]t is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant." MPEP § 2144 ("Rationale Different from Applicant's is Permissible"). Here, T suggests the combination with P to achieve a different advantage or result, i.e., waterproofing, from that discovered by applicant, i.e., reducing breakage. Answers (A) -(C) are incorrect because the suggestion to combine does not need to be for the same purpose as applicant discloses in the application. *Dillon*, 919 F.2d at 692, 16 USPQ2d at 1900; MPEP § 2144 ("Rationale Different from Applicant's is Permissible"). Answer (E) is incorrect because an applicant is under no obligation to submit evidence of non-obviousness unless the examiner meets his or her initial burden to fully establish a prima facie case of obviousness. MPEP § 2142.

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29. ANSWER: (C) is the most correct answer. See MPEP § 2128 under the subheading "Date of Availability," of the heading "Electronic Publications As Prior Art." (A) is wrong. See MPEP § 2129 under the heading "A Jepson Claim Results In An Implied Admission That Preamble Is Prior Art." (B) is wrong. See MPEP § 2128.02. A journal article or other publication becomes available as prior art on date it is received by at least one member of the public. (D) is wrong. See MPEP § 2128.01 under the heading "A Thesis Placed In A University Library May Be Prior Art If Sufficiently Accessible To The Public." (E) is wrong. See *In re Nomiya*, 184 USPQ 607, 610 (CCPA 1975); MPEP § 2129 under the heading "Admissions By Applicant Constitute Prior Art."

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33. ANSWER: (C). MPEP 2163.03, item I. Original claims constitute their own description.

In re Koller, 613 F.2d 819, 204 USPQ 702 (CCPA 1980). (A) and (B) are incorrect. As stated in MPEP 2163.03, item I, “An amendment to the specification (e.g., a change in the definition of a term used both in the specification and claim) may indirectly affect a claim even though no actual amendment is made to the claim.” There is no supporting disclosure in the original description of the invention for the holder to a clasp, crimp, or tong. (D) is incorrect. MPEP 2163.03, item IV. A broad generic disclosure is not necessarily a sufficient written description of a specific embodiment, especially where the broad generic disclosure conflicts with the remainder of the disclosure. *Fields v. Conover*, 443 F.2d 1386, 170 USPQ 276 (CCPA 1970). (E) is not correct because (C) is correct.

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40. ANSWER: (A) is the most correct answer. Answer (A) is not true since Jack did not invent the knife, therefore he is not entitled to a patent. Jack derived the invention from another, and the picture of Jack with the Vietnamese knife is evidence of derivation. 35 U.S.C. § 102(f); MPEP § 2137. Answer (B) is correct in that Jack should have disclosed “all information material to patentability,” including the existence of the Vietnamese knife, during the original patent prosecution. (C) is correct in that to qualify as prior under 35 U.S.C. § 102(b), the use must be in this country. (D) is correct in that a request for reexamination must be based upon patents and printed publications. (E) is correct in that public use derived from the inventor’s own work cannot be used against the inventor under 35 U.S.C. § 102(a). MPEP § 2132.

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47. ANSWER: (E) is the most correct answer. For (A) *see*, “Utility Examination Guidelines,” 66 F.R. 1092, 1099, left column (Jan. 5, 2001). “The applicant can do this by... providing reasoning or arguments... .” For (B), *see*, “Utility Examination Guidelines,” 66 F.R. 1092, 1099, left column (Jan. 5, 2001). “The applicant can do this by amending the claims... .” For (C) *see*, “Utility Examination Guidelines,” 66 F.R. 1092, 1099, left column (Jan. 5, 2001). “The applicant can do this by...providing evidence in the form of a declaration under 37 C.F.R. § 1.132...rebutting the basis or logic of the prima facie showing.” For (D), *see*, “Utility Examination Guidelines,” 66 F.R. 1092, 1099, left column (Jan. 5, 2001). “The applicant can do this by...providing evidence in the form of a...printed publication...rebutting the basis or logic of the prima facie showing.” (A), (B), (C), and (D) alone are not the most correct answer inasmuch (E), referencing all of the above, is the most correct answer.

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49. ANSWER: (C) is the most correct answer. *See*, “Utility Examination Guidelines,” 66 F.R. 1092, 1098, left column (Jan. 5, 2001), “A claimed invention must have a specific and substantial utility. This requirement excludes ‘throw-away,’ ‘insubstantial,’ or ‘nonspecific’ utilities, such as the use of a complex invention as landfill, as a way of satisfying the utility requirement of 35 U.S.C. 101.” (A) is not the most correct answer. *See*, “Utility Examination Guidelines,” 66 F.R. 1092, 1097, middle column (Jan. 5, 2001), “An applicant need only provide one credible assertion of specific utility for each claimed invention to satisfy the utility requirement.” (B) is not the most correct answer. *See*, “Utility Examination Guidelines,” 66 F.R. 1092, 1098, middle column (Jan. 5, 2001), “Any rejection based on lack

of utility should include a detailed explanation why the claimed invention has no specific and substantial credible utility. Whenever possible, the examiner should provide documentary evidence regardless of publication date (e.g., scientific or technical journals, excerpts from treatises or books, or U.S. or foreign patents) to support a factual basis for the *prima facie* showing of no specific and substantial credible utility.” (D) is not the most correct answer. See, “Utility Examination Guidelines,” 66 F.R. 1092, 1098, left column (Jan. 5, 2001), wherein it states, “An invention has a well-established utility (1) if a person of ordinary skill in the art would immediately appreciate why the invention is useful based on the characteristics of the invention (e.g., properties or applications of a produce or process), and (2) the utility is specific, substantial, and credible.” (E) is not the most correct answer. See, “Utility Examination Guidelines,” 66 F.R. 1092, 1098 right column (Jan. 5, 2001), which states what is recited in (E).

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50. ANSWER: (D) is the most correct choice. MPEP § 2173.05(h), and *Ex Parte Cordova*, 10 USPQ2d 1949 (Bd. Pat. App. & Inter. 1989) and 35 U.S.C. § 102(b). (A) is incorrect since the article does not disclose a metallic shoelace, whereas Claim 1 requires a telecommunications device having a metallic shoelace. Since the “optional” element does not have to be disclosed in a reference for the claim to be anticipated, claims 2 and 3, which provide for inclusion of optional elements, are each anticipated by the article. Thus, (B), and (C), are incorrect. Inasmuch as (C) is correct, (E) is incorrect.

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11. ANSWER: (E) is the most correct answer. Invocation of the sixth paragraph of 35 U.S.C. § 112 does not exempt an applicant from compliance with the first and second paragraphs of 35 U.S.C. § 112. 35 U.S.C. § 112, paragraph 6; See, “Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, para. 6,” 65 F.R. 38510, 38514 (June 21, 2000), 1236 O.G. 98 (July 25, 2000) (middle column). (A), being in conformity with proper USPTO practice and procedure, is not correct. See, “Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, para. 6,” 65 F.R. 38510, 38514 (June 21, 2000), 1236 O.G. 98 (July 25, 2000) (middle column). (B), being in conformity with proper USPTO practice and procedure, is not correct. 35 U.S.C. § 112, ¶ 1; *In re Donaldson*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994); *B. Braun Medical, Inc. v. Abbott Lab.*, 124 F.3d 1419, 1425, 43 USP2d 1896, 1900 (Fed. Cir. 1997); *In re Dossel*, 115 F.3d 942, 946, 42 USPQ2d 1881, 18840185 (Fed. Cir. 1997); See, “Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, para. 6,” 65 F.R. 38510, 38514 (June 21, 2000), 1236 O.G. 98 (July 25, 2000) (middle column). (C) and (D), being in conformity with proper USPTO practice and procedure, are not correct. See, “Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, para. 6,” 65 F.R. 38510, 38514 (June 21, 2000), 1236 O.G. 98 (July 25, 2000) (right column).

[Note re Question 11, choice (D), second line: Examination proctors were instructed to direct examination candidates in choice (D), line 2, to change the word “clear” to –clearly--. The question has been carefully reviewed to see if there is any alternative reasonable meaning to the question if the change was not made. No such meaning was found. The Director of Enrollment and Discipline concluded that omission of the change should have no

material affect on the question, and should not inhibit an individual's ability to correctly answer the question.

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17. ANSWER: (C) is the most correct answer. *See*, "Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, 'Written Description' Requirement," 66 F.R. 1099, 1105 (Jan. 5, 2001) left column, first paragraph. "The claimed invention as a whole may not be adequately described if the claims require an essential or critical feature that is not described in the specification and is not conventional in the art or known to one of ordinary skill in the art." (A) is not the most correct answer. *See*, "Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, 'Written Description' Requirement," 66 F.R. 1099, 1104 (Jan. 5, 2001) right column, last paragraph. Describing an actual reduction to practice of the claimed invention is a means of showing possession of the invention. (B) is not the most correct answer. *See*, "Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, 'Written Description' Requirement," 66 F.R. 1099, 1104 (Jan. 5, 2001) right column, last paragraph. (D) is not the most correct answer. *See*, "Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, 'Written Description' Requirement," 66 F.R. 1099, 1105 (Jan. 5, 2001), left column, second paragraph, which states, "While there is no *in haec verba* requirement, newly added claim limitations must be supported by in the specification through express, implicit, or inherent disclosure." (E) is not the most correct answer. *See*, "Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, 'Written Description' Requirement," 66 F.R. 1099, 1105 (Jan. 5, 2001), left column, second paragraph, which states, "An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of the error in the specification, but also recognize the appropriate correction."

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18. ANSWER: (A) is the most correct answer. 35 U.S.C. § 102(d). The foreign application need not be published, but the patent rights granted must be enforceable. MPEP § 706.02(e). (B), (C), (D) and (E) are required by 35 U.S.C. § 102(d).

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27. ANSWER: (A) is the most correct answer. MPEP § 2133.03(e)(1) and 35 U.S.C. § 102(b). II does not create a statutory bar because it is permitted experimental testing. MPEP § 2133.03(e)(3) and 2133.03(e). Therefore (B) is incorrect. III does not create a statutory bar because the sale did not occur in the United States. MPEP § 2133.03(d). Therefore, (C) and (D) are incorrect. (E) is incorrect because (A) is correct.

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28. ANSWER: (A) is the most correct answer. 35 U.S.C. § 102(g) applies only when another inventor has not abandoned, suppressed or concealed the invention. In this case, Molly concealed the invention for 12 years. It was not until she saw the popularity of Troy's device that she filed a patent application. (A) is not true because Molly concealed the invention. (B) is not true since the invention of Molly was concealed for 12 years and effectively abandoned. (C) is not true since §102(a) applies only when the invention is publicly known by others. Since (A) is true, (E) is not.

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32. ANSWER: (B) is the most correct answer because patentability of a product claimed by a product-by-process claim is based on the product itself, and the claimed subject matter in claim 2 is not naturally occurring. MPEP § 2105. (A) is incorrect because claim 1 recites both a product and a process in the same claim and is therefore not within one of the statutory classes set forth by 35 U.S.C. 101. MPEP § 2173.05(p), subpart (II). (C) and (D) are incorrect because claim 3 is drawn to a naturally occurring composition. MPEP § 2105. (E) is incorrect because (B) is correct.

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33. ANSWER: (A) is the most correct answer. MPEP § 2144.03. I is incorrect because an applicant must seasonably traverse the well-known statement or the object of the well-known statement is taken to be admitted prior art. In re Chevenard, 60 USPQ 239 (CCPA 1943). Therefore (B) and (D) are incorrect. III is incorrect because the action can potentially be made final. Therefore (C) is incorrect. (E) is incorrect because (A) is correct.

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35. ANSWER: (B) is the correct answer. The phrase “consisting of” excludes any step not specified in the claim. MPEP § 2111.03. Thus, a claim that depends from a claim which “consists of” the recited steps cannot add a step. Id. Here, the dependent claim adds the step of cooling. Answer (A) is incorrect because the transitional term “comprising” is inclusive or open-ended and does not exclude additional, unrecited steps. MPEP § 2111.03. Answers (C) and (D) are incorrect because the terms “including” and “characterized by” are synonymous with the term “comprising.” MPEP § 2111.03. Answer (E) is incorrect because Answer (C) and Answer (D) are incorrect.

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40. ANSWER: (B) is the most correct answer. 35 U.S.C. § 102(b); MPEP § 2173.05(h). Deletion of the anticipated element from the claim leaves an invention that is no longer anticipated by the reference. (A), (D), and (E) are incorrect despite the amendments because the claim remains anticipated since the claim is still directed to the invention described in the reference wherein X is element A. For example, in (D) and (E), element A would still be a member of the group and the claim would still be anticipated by the prior art. (C) is incorrect because the argument does not change the fact that the claim remains anticipated by the same invention described in the reference wherein X is element A. (E) is incorrect because “comprising” cannot be used in a proper Markush group.

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44. ANSWER: (E) is the most correct answer. As stated in MPEP § 2172.01, “a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968).” (A) is incorrect. As stated in MPEP § 2172.01, “A claim which omits matter disclosed to be essential to the

invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. 112, first paragraph, as not enabling. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976)”; MPEP § 2164.08(c). (B) is incorrect. As stated in MPEP § 2165, “Failure to disclose the best mode need not rise to the level of active concealment or grossly inequitable conduct in order to support a rejection or invalidate a patent. Where an inventor knows of a specific material that will make possible the successful reproduction of the effects claimed by the patent, but does not disclose it, speaking instead in terms of broad categories, the best mode requirement has not been satisfied. *Union Carbide Corp. v. Borg - Warner*, 550 F.2d 555, 193 USPQ 1 (6th Cir. 1977).” (C) is incorrect. As stated in MPEP § 2165.02, “The best mode requirement is a separate and distinct requirement from the enablement requirement of the first paragraph of 35 U.S.C. 112. *In re Newton*, 414 F.2d 1400, 163 USPQ 34 (CCPA 1969). (D) is incorrect. MPEP § 2165.01, part V indicates that if there is no disclosure of the best mode contemplated by the inventor at the time the application is filed, such a defect cannot be cured by submitting an amendment seeking to put into the specification something required to be there when the patent application was originally filed. *In re Hay*, 534 F.2d 917, 189 USPQ 790 (CCPA 1976). Any proposed amendment of this type should be treated as new matter. MPEP § 2165.01.

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6. ANSWER: (A). In accordance with MPEP § 2172, part II, evidence that shows a claim does not correspond in scope with that which applicant regards as applicant’s invention may be found, for example, in contentions or admissions contained in briefs or remarks filed by applicant. *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969). (B) is incorrect. MPEP § 2172, part II, states, “As noted in *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA 1979) agreement, or lack thereof, between the claims and the specification is properly considered only with respect to 35 U.S.C. 112, first paragraph; it is irrelevant to compliance with the second paragraph of that section.” (C) is incorrect. MPEP § 2172, part III indicates that the second paragraph of 35 U.S.C. 112 does not prohibit applicants from changing what they regard as their invention during the pendency of the application. *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971) (Applicant was permitted to claim and submit comparative evidence with respect to claimed subject matter which originally was only the preferred embodiment within much broader claims (directed to a method). (D) is incorrect. MPEP § 2172, part III indicates that the fact that claims in a continuation application were directed to originally disclosed subject matter which applicants had not regarded as part of their invention when the parent application was filed was held not to prevent the continuation application from receiving benefits of the filing date of the parent application under 35 U.S.C. 120. *In re Brower*, 433 F.2d 813, 167 USPQ 684 (CCPA 1970). (E) is incorrect because (B), (C), and (D) are incorrect.

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10. ANSWER: (A) is the correct answer. MPEP § 2173.05(e). Claim 2 is indefinite because “said pipe” lacks antecedent basis. Claim 3 is definite, as “the outer surface” is an inherent part of the pipe and would not require antecedent recitation. Therefore, (B), (D), and (E) are incorrect. Claim 4 is definite as there is antecedent basis for “said plastic valve.” Therefore, (C) is incorrect.

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25. ANSWER: (B). Answer (B) is not true since Jack was not the first to invent the knife, therefore he is not entitled to a patent. Jack derived the invention from another, and the picture of Jack with the Vietnamese knife is evidence of derivation. 35 U.S.C. § 102(f) ; MPEP § 2137. Answer (A) is correct in that Jack should have disclosed “all information material to patentability,” including the existence of the Vietnamese knife, during the original patent prosecution. (C) is correct in that to qualify as prior under 35 U.S.C. § 102(b), the use must be in this country. (D) is correct in that a request for reexamination must be based upon patents and printed publications. (E) is correct in that public use derived from the inventor’s own work cannot be used against the inventor under 35 U.S.C. § 102(a). MPEP § 2132.

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27. ANSWER: (B). MPEP § 716.01(a). Affidavits or declarations containing objective evidence of criticality, unexpected results, commercial success, long-felt but unsolved needs, failure of others, skepticism of experts, is considered by an examiner. (A) is incorrect. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); MPEP § 716.01(c), subsection styled “Attorney Arguments Cannot Take The Place of Evidence”; 2145, part I. Arguments of counsel cannot take the place of factually supported objective evidence. (C) is incorrect. MPEP § 2145. The burden shifts to the applicant to come forward with arguments and/or evidence to rebut the prima facie case. *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). (D) is incorrect. *In re Soni*, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995); MPEP § 2144.05, subsections II and III. (E) is incorrect. *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979) (finding that mere recognition of latent properties in the prior art does not render **the a** known invention unobvious); MPEP § 2145, subsection II.

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31. ANSWER: (D). See MPEP § 2128 under the subheading “Date of Availability,” of the heading “Electronic Publications As Prior Art.” (A) is wrong. See MPEP § 2129 under the heading “A Jepson Claim Results In An Implied Admission That Preamble Is Prior Art.” (B) is wrong. See MPEP § 2128.02. A journal article or other publication becomes available as prior art on date it is received by at least one member of the public. (C) is wrong. See MPEP § 2128.01 under the heading “A Thesis Placed In A University Library May Be Prior Art If Sufficiently Accessible To The Public.” (E) is wrong. See *In re Nomiya*, 184 USPQ 607, 610 (CCPA 1975); 35 U.S.C. § 102(d); MPEP § 2129 under the heading “Admissions By Applicant Constitute Prior Art.”

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32. ANSWER: (D). “It is not necessary in order to establish a prima facie case of obviousness...that there be a suggestion or expectation from the prior art that the claimed [invention] will have the same or a similar utility as one newly discovered by the applicant.” *In re Dillon*, 919 F.2d 688, 692, 16 USPQ2d 1897, 1900 (Fed. Cir. 1990) (emphasis in original). Thus, “[i]t is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant.” MPEP § 2144 (“Rationale Different from Applicant’s is Permissible”). Here, T suggests the combination with P to achieve a different advantage or result, i.e., waterproofing, from that discovered by applicant, i.e., reducing breakage. Answers (A) -(C) are incorrect because the suggestion to combine does not need to

be for the same purpose as applicant discloses in the application. Dillon, 919 F.2d at 692, 16 USPQ2d at 1900; MPEP § 2144 (“Rationale Different from Applicant’s is Permissible”). Answer (E) is incorrect because an applicant is under no obligation to submit evidence of non-obviousness unless the examiner meets his or her initial burden to fully establish a prima facie case of obviousness. MPEP § 2142.

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6. ANSWER: (C). 35 U.S.C. § 102(b); MPEP § 2173.05(h). Deletion of the anticipated element from the claim leaves an invention that is no longer anticipated by the reference. (A), (D), and (E) are incorrect despite the amendments because the claim remains anticipated since the claim is still directed to the invention described in the reference wherein X is element A. For example, in (D) and (E), element A would still be a member of the group and the claim would still be anticipated by the prior art. (B) is incorrect because the argument does not change the fact that the claim remains anticipated by the same invention described in the reference wherein X is element A. (E) is incorrect because “comprising” cannot be used in a proper Markush group.

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19. ANSWER: (C) is the correct answer because patentability of a product claimed by a product-by-process claim is based on the product itself, and the claimed subject matter in claim 3 is not naturally occurring. MPEP § 2105. (A) is incorrect because claim 1 recites both a product and a process in the same claim and is therefore not within one of the statutory classes set forth by 35 U.S.C. 101. MPEP § 2173.05(p), subpart (II). (B) and (D) are incorrect because claim 2 is drawn to a naturally occurring composition. MPEP § 2105. (E) is incorrect because (C) is correct.

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20. ANSWER: (D) is the correct answer. Claims 1 and 2 are drawn to a naturally occurring composition but do not provide the basis for a rejection under 35 U.S.C. § 112, second paragraph, even though they do provide the basis for a rejection under 35 U.S.C. § 101. MPEP § 2105. Therefore (A) and (B) are incorrect. Claim 3 is indefinite because it recites an “effective amount” without stating the function to be achieved. MPEP § 2173.05(c). Therefore (C) is incorrect. (E) is incorrect because (D) is correct.

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25. ANSWER: (B) is the correct answer. MPEP § 2144.03. I is incorrect because an applicant must seasonably traverse the well-known statement or the object of the well-known statement is taken to be admitted prior art. *In re Chevenard*, 60 USPQ 239 (CCPA 1943). Therefore (A) and (D) are incorrect. III is incorrect because the action can potentially be made final. Therefore (C) is incorrect. (E) is incorrect because (B) is correct.

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26. ANSWER: (B). *In re Gosteli*, 10 USPQ2d 1614 (Fed. Cir. 1989); MPEP § 2136.05. (A) is incorrect. A prior abandoned application that was not copending with the application in issue cannot be used to antedate a reference. *In re Costello*, 219 USPQ 389 (Fed. Cir. 1983); MPEP § 2136.05. (C) is incorrect. 35 U.S.C. § 102(b). The one year time bar precludes

antedating the publication. *In re DeBaun*, 214 USPQ 933 (CCPA 1982) (citing *In re Katz*, 215 USPQ 14 (CCPA 1982)); MPEP § 2136.05. (D) is incorrect. The applicant must produce evidence showing who invented the subject matter. *In re Whittle*, 172 USPQ 535, 537 (CCPA 1972); MPEP § 2136.05. (E) is incorrect inasmuch as (A), (C) and (D) are incorrect.

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27. ANSWER: (A) is the correct answer. MPEP § 2133.03(e)(1) and 35 U.S.C. § 102(b). II does not create a statutory bar because it is permitted experimental testing. MPEP § 2133.03(e)(3) and (6). Therefore (B) is incorrect. III does not create a statutory bar because the sale did not occur in the United States. MPEP § 2133.03(d). Therefore, (C) and (D) are incorrect. (E) is incorrect because (A) is correct.

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35. ANSWER: (A) is the correct answer. The phrase “consisting of” excludes any step not specified in the claim. MPEP § 2111.03. Thus, a claim that depends from a claim which “consists of” the recited steps cannot add a step. *Id.* Here, the dependent claim adds the step of cooling. Answer (B) is incorrect because the transitional term “comprising” is inclusive or open-ended and does not exclude additional, unrecited steps. MPEP § 2111.03. Answers (C) and (D) are incorrect because the terms “including” and “characterized by” are synonymous with the term “comprising.” MPEP § 2111.03. Answer (E) is incorrect because Answer (C) and Answer (D) are incorrect.

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40. ANSWER: (C). Admissions by applicant constitute prior art. As explained in *Tyler Refrigeration v. Kysor Industrial Corp.*, 777 F.2d 687, 227 USPQ 845 (Fed. Cir. 1985), the Fed. Circuit found that the district court decided on two separate and independent grounds that the Aokage patent was such prior art. One basis was Tyler’s admission of the Aokage reference as prior art before the PTO during the prosecution of the ’922 Subera patent. The court found that, in a wrap-up amendment, the Tyler attorney admitted in his discussion as to “all the claims” of the three Subera applications, that “the most pertinent available prior art known to the Applicants and their representatives is the Aokage U.S. Patent 4,026,121 cited by the Examiner” (emphasis added). In view of this explicit admission, the district court’s decision was proper and was sufficiently based on clear and convincing evidence. The controlling case law in this court recognizes this principle. See *Aktiebolaget Karlstads Mekaniska Werkstad v. ITC*, 705 F.2d 1565, 1574, 217 U.S.P.Q. (BNA) 865, 871 (Fed. Cir. 1983); *In re Fout*, 675 F.2d 297, 300, 213 U.S.P.Q. (BNA) 532, 536 (CCPA 1982), and *In re Nomiyu*, 509 F.2d 566, 571, 184 U.S.P.Q. (BNA) 607, 612 (CCPA 1975). Thus, we must affirm the court’s decision that the Aokage patent was prior art and as such binding on Tyler. (Here again, we do not pass on the other grounds on which the court concluded that the Aokage was prior art within the meaning of 35 U.S.C. § 102.) Since (C) is true, (D) is not true. Answers (A), (B) and (D) also are not true since the Acme patent can not be sworn behind or otherwise removed as a result of the admission. (E) is not true because (A) and (D) are not true.

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43. ANSWER: (D) is the correct choice. MPEP § 2173.05(h). *Ex Parte Cordova*, 10 USPQ2d 1949 (Bd. Pat. App. & Inter. 1989) and 35 U.S.C. § 102(b). (B) is incorrect since the article does not disclose a metallic shoelace. Since the “optional” element does not have to be disclosed in a reference for the claim to be anticipated, claims 1 and 3 are each anticipated by the article. Thus, (A), (C), and (E) are incorrect.

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44. ANSWER: (B). As stated in MPEP § 2172.01, “a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968).” (A) is incorrect. As stated in MPEP § 2172.01, “A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. 112, first paragraph, as not enabling. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976); MPEP § 2164.08(c). (C) is incorrect. As stated in MPEP § 2165.02, “The best mode requirement is a separate and distinct requirement from the enablement requirement of the first paragraph of 35 U.S.C. 112. *In re Newton*, 414 F.2d 1400, 163 USPQ 34 (CCPA 1969). (D) is incorrect. MPEP § 2165.01, part V indicates that if there is no disclosure of the best mode contemplated by the inventor at the time the application is filed, such a defect cannot be cured by submitting an amendment seeking to put into the specification something required to be there when the patent application was originally filed. *In re Hay*, 534 F.2d 917, 189 USPQ 790 (CCPA 1976). Any proposed amendment of this type should be treated as new matter. MPEP § 2165.01. (E) is incorrect. As stated in MPEP § 2165, “Failure to disclose the best mode need not rise to the level of active concealment or grossly inequitable conduct in order to support a rejection or invalidate a patent. Where an inventor knows of a specific material that will make possible the successful reproduction of the effects claimed by the patent, but does not disclose it, speaking instead in terms of broad categories, the best mode requirement has not been satisfied. *Union Carbide Corp. v. Borg - Warner*, 550 F.2d 555, 193 USPQ 1 (6th Cir. 1977).”

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4. ANSWER: (C). *Moleculon Research Corp. v. CBS, Inc.*, 229 USPQ 805, 809 (Fed. Cir. 1986); MPEP § 2133.03(b). Although reexaminations are limited to prior art patents and printed publications, that limitation is not present in original prosecution. Thus (A) is incorrect. (B) and (D) are wrong because there is no requirement that on-sale activity be public. MPEP § 2133.03(b). (E) is wrong at least because an on-sale bar does not require an actual sale. A bar can also be based on an offer to sell.

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5. ANSWER: (B). Answers (A) and (E) are incorrect because they improperly seek to broaden the parent claim. 37 C.F.R. 1.75(c). Answer (A) broadens the range by going below the stated limit. Answer (E) broadens by trying to remove a member of the Markush group, and covering subject matter that is not covered by the parent claim. Answer (C) is incorrect because claim 1 uses the close ended claim term “consists” in connection with the second gas, which precludes the addition of further components to the second gas in claim 4. Answer

(D) is incorrect because the use of the exemplary language “such as” is improper is improper under 35 U.S.C. § 112, second paragraph, and because it is inconsistent with claim 1. See MPEP § 2173.05(d).

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6. ANSWER: (C). MPEP § 2113, page 2100-51, citing *In re Fessman*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). (A) and (E) are incorrect because “[t]he fact that it is necessary for an applicant to describe his product in product-by-process terms does not prevent him from presenting claims of varying scope.” MPEP § 2173.05(p), item (I). (D) is incorrect even if it is not necessary to describe the product in product-by-process form. (D) is incorrect because “determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process.” MPEP § 2113, [p.2100-51]. (B) is incorrect. “A claim to a device, apparatus, claim, or composition of matter may contain a reference to the process in which it is intended to be used...so long as it is clear that the claim is directed to the product and not the process.” MPEP § 2173.05(p), item (I) [p.2100-174].

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7. ANSWER: (B). Answer (B) provides proper antecedent basis for “said mid-point” in part (iv) of Claim 1 and in Claim 2, and “said connector” in Claim 3. Answer (A) is incorrect at least because it does not provide antecedent basis for “said connector” in Claim 3. Answer (C) is narrower than Answer (B) because it includes the additional limitation of a reservoir and therefore does not “most broadly” complete claim 1. Answer (D) is incorrect because it does not provide proper antecedent basis for “said mid-point” in part (iv) of Claim 1 and in Claim 2. Answer (E) is incorrect because it does not provide antecedent basis for “said connector” in Claim 3.

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13. ANSWER: (A). 35 U.S.C. § 112, first paragraph. *Enzo Biochem, Inc. v. Calgene, Inc.*, 52 USPQ2d 1129 (Fed. Cir. 1999). As stated in MPEP § 2164.01, “The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term ‘undue experimentation,’ it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation.” (B) is incorrect. As stated in MPEP 2107, part c. The requirement of 35 U.S.C. 101, for a “practical” utility or otherwise, is not a requirement that an applicant demonstrate that a utility is a safe or fully effective for human or animal consumption. *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995). (C) is incorrect. The disclosure is inconsistent with published information. 35 U.S.C. § 112, first paragraph. (D) is incorrect. Enablement for the claims in a utility application is found in the specification preceding the claims, as opposed to being in the claims. The claims do not provide their own enablement. 35 U.S.C. § 112, first paragraph. (E) is incorrect. The lack of necessity to theorize or explain

the failures does not alleviate the inventor from complying with 35 U.S.C. § 112, first paragraph by providing an enabling disclosure that is commensurate in scope with the claims.
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16. ANSWER: (E) is the most correct answer. Claim 9, though broad, is supported by the specification. The minimum memory recited in the claim as original disclosure, is self-supporting. 35 U.S.C. § 112, first paragraph. Claim 10 is a proper dependent claim because it depends from and further restricts the scope of a preceding claim. 37 C.F.R. § 1.75(c). Claim 11 is an improper dependent claim because it expands upon, as opposed to further restricts, the scope of claim 10. Claim 10, depending on Claim 9, has a 1 gigabyte memory minimum, whereas Claim 11 expands upon the minimum memory by setting a lower minimum of ½ gigabyte.

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17. ANSWER: (E) is correct because (B) and (C) are correct. (A) does not overcome the prior art because the broad “comprising” language permits the laminate to include additional layers, such as an adhesive layer. MPEP 2111.03. (B) overcomes a 35 U.S.C. § 102 rejection because the claim requires a light-sensitive layer to be in continuous and direct contact with the transparent protective layer, whereas the prior art interposes an adhesive layer between the light-sensitive layer and transparent protective layer. (C) also avoids the prior art by using a negative limitation to particularly point out and distinctly claim that Smith does not claim any laminate including an adhesive layer. MPEP 2173.05(i).

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18. ANSWER: (D). Extending patent term is not a policy underlying any section of 35 U.S.C. § 102. Answers (A), (B), (C) and (E) do state policies underlying the public use bar. *Lough v. Brunswick Corp.*, 86 F.3d 1113, 39 USPQ2d 1100 (Fed. Cir. 1996).

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26. ANSWER: (C) is the most correct. *Corona v. Dovan* 273 U.S. 692, 1928 CD 252 (1928); MPEP 2138.05 (section styled “Requirements To Establish Actual Reduction To Practice”). (A) is incorrect. MPEP 2138.05, (section styled “Requirements To Establish Actual Reduction To Practice”). The same evidence sufficient to establish a constructive reduction to practice is not necessarily sufficient to establish actual reduction to practice, which requires a showing of the invention in a physical or tangible form containing every element of the count. *Wetmore v. Quick*, 536 F.2d 937, 942 190 USPQ 223 227 (CCPA 1976). (B) is incorrect. MPEP 2138.05 (section styled “Constructive Reduction To Practice Requires Compliance With 35 U.S.C. 112, First Paragraph”). *Kawai v. Metlesics*, 489 F.2d 880, 886, 178 USPQ 158, 163 (CCPA 1973). (D) is incorrect. *Keizer v. Bradley*, 270 F.2d 396, 397, 123 USPQ 215, 216 (CCPA 1959) (the diligence of 35 U.S.C. § 102(g) does not require “an inventor or his attorney to drop all other work and concentrate on the particular invention involved”); MPEP 2138.06. (E) is incorrect. The diligence of a practitioner in preparing and filing an application inures to the benefit of the inventor. See MPEP 2138.06 (section styled “Diligence Required In Preparing And Filing Patent Application). *Haskell v. Coleburne*, 671 F.2d 1362, 213 USPQ 192,195 (CCPA 1982) (six days to execute and file application was acceptable).

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27. ANSWER: (C). MPEP § 2111.02. (A), (B), and (D) are incorrect since the “use” recited in the preamble in Claim 1 does not result in a structural difference between the claimed invention and the disclosure in the Gold patent. *In re Casey*, 370 F.2d 576 (CCPA 1967). (A) is further incorrect since the reply would not be filed within the statutory period. (D) is further incorrect since the rejection is not under 35 U.S.C. § 103, and any “teaching away” in the Gold patent is not applicable to the rejection under 35 U.S.C. § 102(a). (E) is incorrect since evidence of commercial success, relevant to secondary considerations concerning rejections under 35 U.S.C. § 103, is not relevant to overcoming rejections under 35 U.S.C. § 102(a). (C) is correct since the amendment is timely filed, supported by the disclosure, and renders the rejection under 35

U.S.C. § 102(a) inapplicable.

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28. ANSWER: (B) is the most correct answer. MPEP 2164.05(a). Statement (i) is true because a later dated publication cannot be used to enable an earlier dated application. Statement (ii) is true since an examiner can look to later dated art if the art discloses the state of the art at the time of the invention. Statement (iii) is false since enablement is judged at the date of filing and later dated references cannot be used to establish enablement.

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30. ANSWER: (C). MPEP § 2173.05(c), section III. (I) and (II) are incorrect since the phrase “an effective amount of voltage” has two different functions, i.e., to “protect windshield glass from cracking” and “for defrosting windshields.” A claim has been held to be indefinite when the claim, as in this case, fails to state which of two disclosed functions is to be achieved. Thus, choices (A), (B), and (D) are incorrect. (C) is correct, since the amended claim would state the function that is to be achieved. (E) is incorrect since (C) is correct.

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31. ANSWER: (D) is the most correct answer. See MPEP 2143.01, section styled, “The Prior Art Must Suggest The Desirability Of The Claimed Invention”), which states, “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).” (A) is incorrect because the location of the suggestion, teaching, or motivation to modify or combine the teachings is not limited to being found only in the references themselves. MPEP2143.01. (B) is incorrect. See MPEP 2143.01, section styled “Fact That The Claimed Invention Is Within The Capabilities Of One Of Ordinary Skill In The Art Is Not Sufficient By Itself To Establish *Prima Facie* Obviousness.” (C) is incorrect. See MPEP 2143.01, section styled “Fact That References Can Be Combined Or Modified Is Not Sufficient To Establish *Prima Facie* Obviousness.” (E) is incorrect inasmuch as (A), (B) and (C) are incorrect.

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42. ANSWER: (E) is the correct answer. (A) is incorrect since admissions, including figures labeled “prior art” may be used. MPEP 2129. (B) is incorrect since canceled matter in the application file of a U.S. patent becomes available as prior art as of the date the application issues into a patent. See MPEP 2127, and *Ex parte Stalego*, 154 USPQ 52, 53 (Bd. App. 1966) cited therein. (C) is incorrect since an abandoned patent application may become evidence of prior art when it has been appropriately disclosed, as, for example, when it is referenced in a publication. See 37 C.F.R. § 1.14(a)(3)(iv); MPEP 2127; and *Lee Pharmaceutical v. Kreps*, 577 F.2d 610, 613, 198 USPQ 601, 605 (9th Cir. 1978) cited in MPEP 2127. (D) is incorrect because multiple reference rejections under 35 U.S.C. § 102 may be used where one reference is used to merely explain a term used in the primary reference. See MPEP 2131.01 and *In re Baxter Travenol Labs.*, 952 F.2d 388, 21 USPQ2d 1281 (Fed. Cir. 1991) cited therein. (E) is correct since the reference is not by “another.”

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45. ANSWER: (B) is correct. MPEP § 2173.05(h). A Markush group is an acceptable form of alternative expression provided the introductory phrase “consisting of,” and the conjunctive “and” are used. (A) and (D) are incorrect because the conjunctive “or” is used. (C) and (D) are incorrect because the introductory phrase “comprising” is used. (E) is incorrect because R must simultaneously be A, B, C, and D, as opposed to being a single member of the group, i.e., no language provides for the selection of one of the members of the group of A, B, C, and D. MPEP § 2173.05(h).

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50. ANSWER: (E). MPEP 2133.03(e)(6) sets forth that while technological, developmental testing is permitted and is not a bar under 35 U.S.C. § 102(b), market testing is not permitted. Choice (A) is incorrect. Since Smith’s activities, as set forth by the facts given in the question, included market testing, choices (B) and (C) are incorrect. (C) is further incorrect since an affidavit under 37 C.F.R. § 1.131 is not applicable to rejections under 35 U.S.C. § 102(b). (D) is incorrect since secondary considerations, such as commercial success, are not applicable rejections under 35 U.S.C. § 102(b).

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4. ANSWER: (D). Answer (A) does not provide proper antecedent basis for “said first end” in part (ii) of the claim and “said second end” in part (iv) of the claim. Answer (B) fails to provide proper antecedent basis for “said dispensing chamber” in part (iii) of the claim, and “said second end” in part (iv) of the claim. Answer (C) fails to provide proper antecedent basis for “said second end” in part (iv) of the claim and “said longitudinal sides of said channel” in part (v) of the claim. Answer (E) fails to provide proper antecedent basis for “said dispensing chamber” in part (iii) and subsequent parts of the claim.

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16. ANSWER: (B). *In re Merck & Co.*, 231 USPQ 375 (Fed. Cir. 1986); *Newell Cos. v. Kenney Mfg.*, 9 USPQ2d 1417 (Fed. Cir. 1988). Statement (A) is not correct because, although nearly simultaneous invention may be a factor in making an obviousness

determination, it does not in itself preclude patentability. *Environmental Designs, Ltd. v. Union Oil Co.*, 218 USPQ 865 (Fed. Cir. 1983). Statements (C) and (D) are incorrect because nearly simultaneous invention bears on neither long-felt need nor commercial success. Statement (E) is incorrect because statement (B) is correct.

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17. ANSWER: (B). 35 U.S.C. § 102(g); MPEP § 2138.01; *Mahurkar v. C.R. Bard, Inc.*, 38 USPQ2d 1288 (Fed. Cir. 1996). If statement (A) was correct, there would be no need for interference proceedings. Statement (C) is incorrect because Debbie need not establish diligence for the period from February 1999 until just before Billie's conception on May 15, 1999. Statement (D) is incorrect. Debbie needs to show diligence only from May 14th to her actual reduction to practice in June. Debbie is not required to show diligence between actual reduction to practice and her subsequent constructive reduction to practice in December 1999, so long as she has not abandoned, suppressed or concealed the invention. 35 U.S.C. § 102(g). Statement (E) is inconsistent with 35 U.S.C. § 102(g).

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18. ANSWER: (E) is the most correct answer because each statement, (A), (B), (C) and (D) is correct. (A) is correct. See MPEP 2141.02 (subsection styled, "Applicants Alleging Discovery Of A Source Of A Problem Must Provide Substantiating Evidence"); *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979). (B) and (C) are correct. See MPEP 716.01(c); *In re Knowlton*, 500 F.2d 566, 572, 183 USPQ 33, 37 (CCPA 1974) (where the record consisted substantially of arguments and opinions of applicant's attorney, the court indicated that factual affidavits could have provided important evidence on the issue of enablement). Arguments of counsel alone cannot take the place of evidence in the record once an examiner has advanced a reasonable basis for questioning the disclosure. See *In re Budnick*, 537 F.2d at 538, 190 USPQ at 424; *In re Schulze*, 346 F.2d 600, 145 USPQ 716 (CCPA 1965); and *In re Cole*, 326 F.2d 769, 140 USPQ 230 (CCPA 1964). (D) is correct. MPEP 716.01(c) and 2145.

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23. ANSWER: (C). As to answer (A), the publication in Popular Scientist was not enabling. Unless it is a statutory bar, a rejection based on a publication may be overcome by a showing that it was published either by applicant himself/herself on his/her behalf. MPEP § 715.01(c). The level of disclosure required within a reference to make it an "enabling disclosure" is the same no matter what type of prior art is at issue. It does not matter whether the prior art reference is a U.S. patent, foreign patent, a printed publication or other. Cf. MPEP § 2121. "In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure'..." *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). MPEP § 2121.01. As to answer (B), 35 U.S.C. 132 states that "[n]o amendment shall introduce new matter into the disclosure of the invention." As to (C), statutory bars of 35 USC 102(b) are applicable even though public use is by a third party. MPEP § 2133.03(e)(7). The statutory bar would apply to the modification by Ajax to use the windshield wiper device on trucks. As to (E), it is not necessary that the applicant be aware of the public use by the third party Ajax. As to (D), Chris would be barred by the public use

of the truck embodiment by Ajax on September 1, 1998 as the C-I-P would not receive the benefit of the earlier filing date with respect to the truck embodiment since the original disclosure did not include the truck embodiment.

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29. ANSWER: (A) is the most correct answer. 35 U.S.C. § 102(d), and MPEP § 2135 expressly list (B), (C), (D) and (E) as the four conditions which, if all are present, establish a bar against the granting of a patent in this country. The foreign patent or inventor's certificate described in (A) need not be published to establish a 35 U.S.C. § 102(d) bar. MPEP § 2135.01(III)(E).

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31. ANSWER: (E). 35 U.S.C. §§ 112, fourth paragraph, and 251. The claim is not a proper dependent claim because it is broader than the claim from which it depends. The expression "up to 300 amps" would include 0 to 300 amps, which is outside the 100-300 amp range disclosed in the specification, and recited in Claim 1. (A) is a proper dependent claim because the wattage is within the range limitation set out in Claim 1. (B) is a proper dependent claim because the wattage and voltage are within the range limitations set out in Claim 1. (C) and (D) are proper dependent claims because the wattage and voltage are within the range limitations set out in Claim 1.

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33. ANSWER: (A) is correct. MPEP § 2173.05, part (c) indicates that a preferred narrower range set forth within a broader range may render the claim indefinite if the boundaries of the claim are not discernable. (B), (C) and (D) are incorrect. MPEP § 2173.05(c), part (I) indicates that reciting in a single claim both a broad range and a preferred narrower range within the broad range may render the claim indefinite. (E) is incorrect. The doctrine of equivalents operates to expand claim coverage beyond the literal scope of the claim language.

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38. ANSWER: (B) is the most correct answer. *Ex parte Utschig*, 156 USPQ 156, 157 (Bd. App. 1966); MPEP § 2137.01 (section styled "Inventorship Is Generally 'To Another' Where There Are Different Inventive Entities With At Least One Inventor In Common"). (A) is incorrect. The same inventive entity obtains, regardless of the order in which the inventors are listed, inasmuch as the same inventors are recited. (C) is incorrect. The presence of a common inventor in a reference patent and application does not preclude determination that the inventive entity in the reference is to another within the meaning of 35 U.S.C. § 102(e). *Ex parte DesOrmeaus*, 25 USPQ2d 2040 (Bd. Pat. App. & Inter. 1992). (D) is incorrect. Merely the fact that the inventive entities differ does not cause the patent to necessarily be prior art. *Applied Materials Inc. v. Gemini Research Corp.*, 835 F.2d 279, 281, 15 USPQ2d 1816, 1818 (Fed. Cir. 1988); MPEP § 2137.01. (E) is incorrect because (A) and (C) are incorrect.

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42. ANSWER: (E). The claim in (A) recites sufficient acts performed on subject matter, e.g., passing the signals through the filter. See MPEP 2173.05(q), and *Ex parte Porter*, 25 USPQ2d 1144 (Bd. Pat. App. & Int. 1992) cited therein. Thus, (A) is a proper process claim. The claim in (B) recites the act of polymerizing an organic compound by sufficient acts. Therefore, (B) appropriately claims a process. The claim in (C) is not a proper process claim because it does not recite an act specifying how a use or process is accomplished. Therefore, the claim is indefinite, 35 U.S.C. § 112, and/or an improper definition of a process under 35 U.S.C. § 101. See MPEP 2173.05(q); *Ex parte Erlich*, 3 USPQ2d 1011 (Bd. Pat. App. & Int. 1986) (a claim to “A process for using monoclonal antibodies of claim 4 to isolate and purify human fibroblast interferon” was held to be indefinite because it merely recites a use without any active, positive steps delimiting how this use is actually practiced); *Clinical Products Ltd., v. Brenner*, 255 F.Supp. 131, 149 USPQ 475 (D.D.C. 1996) (claim to “The use of a sustained release therapeutic agent in the body of ephedrine absorbed upon polystyrene sulfonic acid” is not a proper process claim under 35 U.S.C. § 101). (D) is incorrect because (C) is incorrect.

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44. ANSWER: (A) is the most correct answer. See MPEP § 2137, p.2100-89. (B) is incorrect. The mere fact that the claim recites components, all of which can be argumentatively assumed to be old, does not provide a basis for rejection under 35 U.S.C. § 102(f). *Ex parte Billottet*, 192 USPQ 413, 415 (Bd. App. 1976); MPEP § 2137. (C) is incorrect. One must contribute to the conception to be an inventor. *In re Hardee*, 223 USPQ 1122, 1123 (Comm’r Pat. 1984). Unless a person contributes to the conception of the invention, the person cannot be an inventor. *Fiers v. Revel*, 984 F.2d 1164, 1168, 25 USPQ2d 1601, 1604-05 (Fed. Cir. 1993); MPEP § 2137.01 (section styled “An Inventor Must Contribute To The Conception of the Invention”). (D) is incorrect. An inventor may consider and adopt suggestions from many sources. *Morse v. Porter*, 155 USPQ 280, 283 (Bd. Pat. Inter. 1965); *New England Braiding Co. v. A.W. Cheterton Co.*, 970 F.2d 878, 883, 23 USPQ2d 1622, 1626 (Fed. Cir. 1992); MPEP § 2137.01 (section styled “As Long As The Inventor Maintains Intellectual Domination Over Making The Invention, Ideas, Suggestions, And Materials May Be Adopted From Others”). (E) is incorrect. *In re DeBaun*, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982) (“there is no requirement that the inventor be the one to reduce the invention to practice so long as the reduction to practice was done on his behalf”); MPEP § 2137.01 (section styled “The Inventor Is Not Required To Reduce The Invention To Practice”).

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48. ANSWER: (D) is the most correct answer. 35 U.S.C. § 103(a); *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977) (“In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question...but also to those properties of the subject matter which are inherent in the subject matter *and* are disclosed in the specification...”); MPEP 2141.02 (section styled, “Disclosed Inherent Properties Art Part of ‘As A Whole’ Inquiry”). (A) is incorrect. MPEP 2141.01(a). PTO classification is some evidence of analogy/non-analogy, but structure and function carry more weight. *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973). (B) is

incorrect. MPEP 2141.02. The question under 35 U.S.C. § 103 is whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). (C) is incorrect. MPEP 2141.02 (section styled, “Distilling The Invention Down To a ‘Gist’ or ‘Thrust’ Of An Invention Disregards ‘As A Whole’ Requirement”). *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987), *cert. denied*, 481 U.S. 1052 (1987) (district court improperly distilled claims down to a one word solution to a problem). (E) is incorrect. As stated in MPEP 2141.02 (section styled, “Disclosed Inherent Properties Are Part Of ‘As A Whole’ Inquiry), “Obviousness cannot be predicated on what is not known at the time an invention is made, even if the inherency of a certain feature is later established. *In re Rijckaert*, 9 F.2d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993).”

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2. ANSWER: (D). “It is not necessary in order to establish a prima facie case of obviousness...that there be a suggestion or expectation from the prior art that the claimed [invention] will have the same or a similar utility as one newly discovered by the applicant.” *In re Dillon*, 919 F.2d 688, 692, 16 USPQ2d 1897, 1900 (Fed. Cir. 1990) (emphasis in original). Thus, “[i]t is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant.” MPEP § 2144 (“Rationale Different from Applicant’s is Permissible”). Here, T suggests the combination with P to achieve a different advantage or result, i.e., waterproofing, from that discovered by applicant, i.e., reducing breakage. Answers (A) -(C) are incorrect because the suggestion to combine does not need to be for the same purpose as applicant discloses in the application. *Dillon*, 919 F.2d at 692, 16 USPQ2d at 1900; MPEP § 2144 (“Rationale Different from Applicant’s is Permissible”). Answer (E) is incorrect because an applicant is under no obligation to submit evidence of non-obviousness unless the examiner meets his or her initial burden to fully establish a prima facie case of obviousness. MPEP § 2142.

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8. ANSWER (C). MPEP § 2163.03, item I. Original claims constitute their own description. *In re Koller*, 613 F.2d 819, 204 USPQ 702 (CCPA 1980). (A) and (B) are incorrect. As stated in MPEP § 2163.03, item I, “An amendment to the specification (e.g., a change in the definition of a term used both in the specification and claim) may indirectly affect a claim even though no actual amendment is made to the claim.” There is no supporting disclosure in the original description of the invention for the holder to a clasp, crimp, or tong. (D) is incorrect. MPEP § 2163.03, item IV. A broad generic disclosure is not necessarily a sufficient written description of a specific embodiment, especially where the broad generic disclosure conflicts with the remainder of the disclosure. *Fields v. Conover*, 443 F.2d 1386, 170 USPQ 276 (CCPA 1970). (E) is not correct because (C) is correct.

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9. ANSWER: (C). Dependent Claim 4 must further limit Claim 1 from which it depends. 35 U.S.C. § 112, paragraph 4; 37 CFR § 1.75(c). The dependent claim 4 in (C) improperly seeks to broaden Claim 1 by omitting an element set forth in the parent claim.

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15. ANSWER: (C). 37 CFR § 1.75(c). A dependent claim must further limit the claim from which it depends. The claim in (C) is an improper dependent claim because it includes resistance outside the scope of Claim 1. In the claim in (C), the term “about” allows for a range slightly above 90 ohms or below 10 ohms, which is “outside” the scope of Claim 1. See MPEP § 2144.05. (A), (B), and (D) are proper dependent claims because they further limit Claim 1 by limiting the resistance to amounts within the scope of Claim 1. (E) is incorrect because (D) is a proper dependent claim.

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18. ANSWER: (A). The phrase “consisting of” excludes any step not specified in the claim. MPEP § 2111.03. Thus, a claim that depends from a claim which “consists of” the recited steps cannot add a step. *Id.* Here, the dependent claim adds the step of cooling. Answer (B) is incorrect because the transitional term “comprising” is inclusive or open-ended and does not exclude additional, unrecited steps. MPEP § 2111.03. Answers (C) and (D) are incorrect because the terms “including” and “characterized by” are synonymous with the term “comprising.” MPEP § 2111.03. Answer (E) is incorrect because Answer (C) and Answer (D) are incorrect.

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19. ANSWER: (A). MPEP § 2144. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991). (B) is incorrect. MPEP § 2144. The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). (C) is incorrect. MPEP § 2144.01. *In re Preda*, 401 F.2d 825, 159 USPQ 342, 344 (CCPA 1968) (“[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.”). (D) is incorrect. *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970) (Board properly took judicial notice that “it is common practice to postheat a weld after the welding operation is completed” and that “it is old to adjust the intensity of a flame in accordance with the heat requirement”); and MPEP § 2144.03. (E) is incorrect. MPEP § 2144.06 (Substituting Equivalents Known For The Same Purpose). To rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure. *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958).

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20. ANSWER: (A). (A) provides proper antecedent basis for “said mid-point” in part (iv) of Claim 1 and in Claim 2, and “said connector” in Claim 3. (B) is incorrect at least because it includes the unnecessary limitation that the cutting members are formed of metal and because it does not provide antecedent basis for “said connector” in Claim 3. (C) is incorrect because it includes the unnecessary limitation of a reservoir, and it does not provide

antecedent basis for “said connector” in Claim 3. (D) is incorrect because it does not provide antecedent basis for “said mid-point” in part (iv) of Claim 1 and Claim 2, and for “said connector” in Claim 3. (E) is incorrect because it does not provide proper antecedent basis for “said mid-point” in part (iv) of Claim 1 and in Claim 2.

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23. ANSWER: (C). Under the stated facts, Homer’s commercial use is a bar under 35 U.S.C. § 102(b) because it was not experimental, so (C) would be unreasonable advice. MPEP § 2133.03. For the same reason, and because the modified system is new and unobvious, (B) would be reasonable advice. (A) would be reasonable advice because whether the claim is limited to ultrasonic signals is a question of breadth, not definiteness. MPEP § 2173.04. (D) is reasonable advice because there is no antecedent basis for “the decoder portion of said tunneling device sensor”. (E) is reasonable advice because an argument could be made that the claim, as originally drafted, could not be infringed until the target is actually placed in the ground. Thus, a sale of the system, with the target in a box, technically might not be a literal infringement of that claim.

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24. ANSWER: (A). 35 U.S.C. § 102(b). The claimed invention is unpatentable inasmuch as the invention was in public use and on sale more than one before Homer files a patent application. (B) - (D) are incorrect because the given facts do not meet the conditions negating patentability set forth in 35 U.S.C. § 102(c), (d), or (e). (E) is incorrect because (A) is correct.

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27. ANSWER: (B). “Whoever invents or discovers any new and useful...manufacture, or composition of matter...may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. However, “laws of nature, physical phenomena, and abstract ideas” are not subject matter eligible for protection under the patent statute. Diamond v. Chakrabarty, 447 U.S. 303, 309, 206 USPQ 193, 198 (1980). But, a “nonnaturally occurring manufacture or composition of matter—a product of human ingenuity—having a distinctive name, character, [and] use” is subject matter eligible for protection under the patent statute. Id. See also MPEP § 2105. Thus, Answer (B) is correct because the top soil is a product of M’s ingenuity. Answer (A) is incorrect because the top soil is a physical phenomenon, i.e., naturally occurring manufacture or composition of matter, M was merely the first to locate. Chakrabarty, 447 U.S. at 309, 206 USPQ at 198; MPEP § 2105. Answer (C) is incorrect because only non-naturally occurring inanimate objects, i.e., products of human ingenuity, are subject matter eligible for protection under the patent statute. Chakrabarty, 447 U.S. at 309, 206 USPQ at 198; MPEP § 2105.

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29. ANSWER: (A). MPEP § 2133.03(b), item III (A). “Public” as used in 35 U.S.C. 102(b) modifies “use” only. “Public” does not modify “sale.” *Hobbs v. United States*, 451 F.2d 849, 171 USPQ 713, 720 (5th Cir. 1971). (B) is incorrect. MPEP § 2133.03(b), item IV (A). Sale or offer for sale of the invention by an independent third party more than 1 year before the

filing date of applicant's patent will bar applicant from obtaining a patent. Although "an exception to this rule exists where a patented method is kept secret and remains secret after a sale of the unpatented product of the method. Such a sale prior to the critical date is a bar if engaged in by the patentee or patent applicant, but not if engaged in by another." *In re Caveney*, 761 F.2d 671, 675-76, 226 USPQ 1, 3-4 (Fed. Cir. 1985). (C) is incorrect. MPEP § 2133.03(d). An offer for sale, made or originating in this country, may be sufficient prefatory activity to bring the offer within the terms of the statute, even though sale and delivery take place in a foreign country. The same rationale applies to an offer by a foreign manufacturer, which is communicated to a prospective purchaser in the United States prior to the critical date. *C.T.S. Corp. v. Piher Int'l Corp.*, 593 F.2d 777201 USPQ 649 (7th Cir. 1979). (D) is incorrect. MPEP § 2134. Delay alone is not sufficient to infer the requisite intent to abandon. *Moore v. U.S.*, 194 USPQ 423, 428 (Ct. Cl. 1977) (The drafting and retention in his own files of two patent applications by inventor indicates an intent to retain his invention; delay in filing the applications was not sufficient to establish abandonment). (E) is incorrect. MPEP § 2135.01, item III (B). *Ex parte Links*, 184 USPQ 429 (Bd. App. 1974) (German applications, which have not yet been published for opposition, are published in the form of printed documents called Offenlegungsschriften 18 months after filing. These applications are unexamined or in the process of being examined at the time of publication. The Board held that an Offenlegungsschriften is not a patent under 35 U.S.C. § 102(d) even though some provisional rights are granted. The court explained that the provisional rights are minimal and do not come into force if the application is withdrawn or refused.).

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34. ANSWER: (A). MPEP § 2144.05, item III states, "Applicant can rebut a *prima facie* case of obviousness based on overlapping ranges by showing the criticality of the claimed range," citing *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). (B) is incorrect. MPEP § 2145, item II. Mere recognition of latent properties contained in the prior art does not render nonobvious an otherwise known invention. The court, in *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979), points out that granting a patent on the discovery of latent or unknown, but inherent property would remove from the public that which is in the public domain by virtue of the property's inclusion in, or obviousness from, the prior art. (C) is incorrect. MPEP § 2145, item VII. The fact that a combination would not be made by a businessman for economic reasons does not mean that a person of ordinary skill in the art would not make the combination because of some technological incompatibility. *In re Farrenkopf*, 713 F.2d 714, 219 USPQ 1 (Fed. Cir. 1983). (D) is incorrect. MPEP § 2145, item IV. Nonobviousness cannot be shown by attacking references individually where the rejection is based on a combination of references. *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). (E) is incorrect (B) and (C) are incorrect.

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36. ANSWER: (C). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See also MPEP § 2131. Further, the use of the phrase "up to" includes zero as a limit, and the use of the phrase "a water content of not more than" includes no water, i.e., dry, as a limit. MPEP § 2173.05(c) ("II. Open-Ended Numerical Ranges"). Here, Answer

(C) shows 76% cellulose, 16% nylon, 0% fiber, 8% cotton (“balance cotton”) and no water content. Thus, the reference sets forth all the claim limitations. Answer (A) is incorrect because the phrase “consisting of” excludes the inclusion of silk in the claimed sponge. See MPEP § 2111.03. Answer (B) is incorrect because “balance cotton” equals 4.8% cotton, a limit outside the range of “at least 6% cotton” recited in the claim. Answer (D) is incorrect because “0.6% fiber” is outside the limit outside the range of “up to 0.5% fiber” recited in the claim. Answer (E) is incorrect because Answer (B) and Answer (D) are incorrect.

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37. ANSWER: (B). (A) fails to provide proper antecedent basis for “said first end” in part (ii) of the claim. (C) and (D) fail to provide proper antecedent basis for “said longitudinal sides of said channel” in part (iv) of the claim. (E) fails to provide proper antecedent basis for “said chamber” in part (i) and subsequent parts of the claim.

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39. ANSWER: (E). 35 U.S.C. §§ 102 and 103; *Ex parte Edwards*, 231 USPQ 981 (Bd. Pat. App. & Int. 1986); *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985), and MPEP §§ 2113 and 2173.05(p). (A) - (D) are wrong because they are product-by-process claims, and the novelty is only in the process.

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40. ANSWER: (E). “None of the above” is correct because (A), (B), (C), and (D) are wrong. (A) is wrong because Claim 1 is directed to a ship propeller, whereas (A) recites a claim which purports to be dependent upon Claim 1 but involves a *non sequitur*, i.e., it is directed to a copper base alloy rather than a ship propeller. Therefore, the dependent claim is indefinite and violates 35 U.S.C. § 112, paragraph 2. (B) is wrong because Claim 1 is directed to a product, i.e., a ship propeller, whereas (B) recites a claim that purports to be dependent upon Claim 1, but involves a process step. Therefore, the claim is directed to more than one statutory class of invention and violates 35 U.S.C. § 112, paragraph 2. While a claim to a product may be permissible when defining the claimed product in terms of the process by which it is made or in terms of the process by which it is intended to be used (MPEP § 2173.05(p)), the situation presented here is different and not permissible. In this regard, the term “consisting of” in Claim 1 excludes any element, step, or ingredient not specified in the claim. Thus, as stated in MPEP § 2111.03, “A claim which depends from a claim which ‘consists of’ the recited elements or steps cannot add an element or step.” (B) recites a claim that also violates this caveat. (C) is wrong because it recites a dependent claim that attempts to add “2 to 10 percent aluminum” to the propeller of Claim 1. Since the specification teaches the addition of aluminum to the copper base alloy and not the propeller of Claim 1, the dependent claim introduces new matter. Thus, the claim may be subject to a rejection under the first paragraph of 35 U.S.C. § 112. MPEP § 608.04. It is not clear from the language of the claim that the addition of aluminum is to the alloy. (E) is wrong because it recites a dependent claim which is directed to a ship propeller according to Claim 1 including 2 to 10 percent of aluminum, which has been excluded by the term “consisting of” in Claim 1. Thus, as stated in MPEP § 2111.03, “A claim which depends from a claim which ‘consists of’ the recited elements or steps cannot add an element or step.” (D) recites a claim that violates this caveat.

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41. ANSWER: (C). MPEP § 2173.05(c), part (a) indicates that a preferred narrower range set forth within a broader range is an indefinite claim limitation. (A), (B), and (D) are not correct because MPEP § 2173.05(c), part (a) indicates that a preferred narrower range set forth within a broader range may render the claim indefinite. (E) is wrong because the doctrine of equivalents operates to expand claim coverage beyond the literal scope of the claim language.

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44. ANSWER (C). Applicant's own disclosure in the specification and claims may not be used against the applicant. The content of the applicant's specification may not be used as evidence that the scope of the claims is inconsistent with the subject matter that applicant regards as his invention. Claiming that which applicant regards as his invention is a matter of compliance with 35 U.S.C. § 112, second paragraph. As noted in *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA 1979), the lack of agreement between the claims and specification is properly considered only with respect to 35 U.S.C. § 112, first paragraph; MPEP § 2172, item II. (A), (B) and (D) are incorrect. Evidence demonstrating that a claim does not correspond in scope with that which an applicant regards as his invention can be found in the admissions in arguments or briefs, *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969), or in affidavits filed under 37 CFR § 1.132. *In re Cormany*, 476 F.2d 998, 177 USPQ 450 (CCPA 1973); MPEP § 2172, item II. (E) is incorrect because (C) is correct.

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46. ANSWER: (E). (A) is incorrect because a preamble is generally not accorded patentable weight where it merely recites the intended use of a structure. MPEP § 2111.02. (B) is incorrect because the facts set forth that the McGoo invention is described as limited to the elements recited in (B). MPEP § 2111.03. (C) is incorrect because the structure corresponding to means for marking baseballs and equivalents thereof, includes an invisible ink stamper. (D) is incorrect since (B) and (C) are both incorrect.

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48. ANSWER: (D). MPEP § 2173.05(e) indicates that as long as a claim phrase has a reasonable degree of clarity, such as reciting something well known in the mechanical arts, e.g., "a clip," the claim phrase is definite despite the lack of antecedent basis in the written description. (A) is not correct because MPEP § 2163.06, paragraph (c) demonstrates that an original written description may be amended to include originally claimed subject matter. (B) is not correct because MPEP § 2173.05(e) shows that a claim phrase, which has no antecedent basis in the written description, is not necessarily indefinite because it may have a reasonable degree of clarity to those skilled in the art. (C) is not correct because MPEP § 2164.05(b) demonstrates that ordinary skill in the mechanical arts is presumed when considering the question of enablement. (E) is not correct because MPEP § 2165.03 indicates that absent evidence to the contrary, it is assumed that the best mode is present. In the present case, "a clip" is disclosed in the drawing in the original application. The fact that the screw is not recited in the original description does not detract from the disclosure of the best mode.

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49. ANSWERS: (A) and (B). (A) is correct. MPEP § 2165.01, item III. There is no requirement in the statute for applicants to point out which of the disclosed embodiments they consider to be the best mode. *Ernsthausen v. Nakayam*, 1 USPQ 2d 1539 (Bd. Pat. App. & Inter. 1985). (B) is correct. MPEP § 2165.01, item II. The presence of only one specific example in the application is not evidence that the best mode has been disclosed. (C) is incorrect. *Transco Products, Inc. v. Performance Contracting Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994); MPEP § 2165.01, item IV. (D) is incorrect. New matter cannot cure the defect. 35 U.S.C. § 132; *In re Hay*, 534 F.2d 917, 189 USPQ 790 (CCPA 1976), MPEP § 2165.01, item V. (E) is incorrect. The statement is a correct statement of the law. 35 U.S.C. § 112, first paragraph; *In re Gay*, 309 F.2d 768, 135 USPQ 311 (CCPA 1962); MPEP § 2165.01, item II.

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50. ANSWER: (D). 35 U.S.C. § 112, first paragraph; *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976); MPEP §§ 2164.08(c), and 2173.05(l). (D) describes the combination. (A) through (C), and (E) do not describe the combination of the door secured to the doorframe by two hinges. (A) through (C), and (E) do not describe the necessary structural relationship because they describe a door and door frame which are not yet secured together. In (A), “capable of being hingedly connected” describes an intended use, as opposed to a currently existing structural connection. In (B), “having...means for securing the door” describes the existence of a means for securing a door, but not a door currently secured to a frame. In (C), “hinges for securing the door” describes the existence of the hinges for securing a door, but does not require a door be secured by hinges to a frame. In (E), a “door adapted to be secured to a door frame” describes an intended use, but does not describe a door currently secured to a doorframe. Moreover, the enablement disclosure does not describe a door assembly having a door frame without a door secured to it by a pair of hinges which is capable of keeping out the elements and provides privacy.

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1. ANSWER: (A). MPEP § 2173.05(b). The term “substantially” has been held as definite, given sufficient guidelines contained in the specification. *In re Mattison*, 509 F.2d 563, 184 USPQ 484 (CCPA 1975). (B) is incorrect because the narrow range within the broad range using the term “preferably” will likely render the claim indefinite. MPEP § 2173.05(c). (C) - (E) are incorrect because each is narrower in scope than (A).

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6. ANSWER: (D). The claim (A) recites sufficient acts performed on subject matter, e.g. passing the signal through the filter. See MPEP § 2173.05(q) and *Ex parte Porter*, 25 USPQ2d 1144 (Bd. Pat. App. & Int. 1992) cited therein. Therefore, (A) appropriately claims a process. (B) recites the act of polymerizing an organic compound. Therefore, (B) appropriately claims a process. The claim in (C) is not a proper process claim because it does not recite an act specifying how a use or process is accomplished. Therefore, this claim would be rejected as indefinite under 35 U.S.C. § 112 or as an improper definition of a process under 35 U.S.C. § 101. See MPEP § 2173.05(q); *Ex parte Erlich*, 3 USPQ2d 1011 (Bd. Pat. App. & Int. 1986) (claim to “A process for using monoclonal antibodies of claim 4

to isolate and purify human fibroblast interferon” was held indefinite because it merely recited a use without any active, positive steps delimiting how this use is actually practiced); *Clinical Products Ltd. v. Brenner*, 255 F.Supp. 131, 149 USPQ475 (D.D.C. 1966) (claim to “The use of a sustained release therapeutic agent in the body of ephedrine absorbed upon polystyrene sulfonic acid” is not a proper process claim under 35 U.S.C. § 101). (E) is incorrect because (C) is incorrect.

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10. ANSWER: (B). *Ex parte Markush*, 1925 CD 126 (Comm’r Pat. 1925) sanctions claiming a genus as a group “consisting of” elements connected by “and.” MPEP § 2173.05(h), item I., Markush Groups. (A) is not the most correct answer inasmuch as the elements are improperly connected by “or.” (C) and (D) are not the most correct answers. It is improper to use the word “comprising” instead of “consisting of.” *Ex parte Dotter*, 12 USPQ 283 (Bd. App. 1931); MPEP § 2173.05(h).

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12. ANSWER: (B). MPEP § 2173.05(b). (A) is incorrect because the claim interpretation of one possessing ordinary skill level is relevant. MPEP § 2173.02. (C) is incorrect because the guidelines in the specification may be sufficient. MPEP § 2173.05(b). (D) is incorrect since it relies on the improper addition of new matter. (E) is incorrect since (B) is correct.

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14. ANSWER: (D). Claim 1 provides antecedent basis for Claim 2 of answer (D). 35 U.S.C. § 112, second paragraph. (A) is incorrect. Claim 1, which is drawn to a “modular telephone plug crimping tool,” provides no antecedent basis for “[t]he modular telephone” required by Claim 2. MPEP § 2173.05(e). (B) is incorrect because it fails to incorporate all the limitations of the claim to which it refers. Claim 1, requiring the secondary body part have a fixed length, provides not antecedent basis for the limitation of claim 2, that the second part have an adjustable length. 35 U.S.C. § 112, fourth paragraph. (C) is incorrect because it improperly recites a process without setting forth any steps in the process. MPEP § 2173.05(q). (E) is incorrect because (D) is correct.

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19. ANSWER: (B). In *Racing Strollers Inc. v. TRI Industries Inc.*, 11 USPQ2d 1300 (Fed. Cir. 1989) the in banc Federal Circuit stated that for design patents “the ‘best mode’ requirement of the first paragraph of §112 is not applicable, as a design has only one ‘mode’ and it can be described only by illustrations showing what it looks like (though some added description in words may be useful to explain the illustrations).” 35 U.S.C. § 171 indicates that the provisions of the Patent Act relating to utility inventions apply to designs “except as otherwise provided.” MPEP § 1504.04. The Patent Act, the Rules of Practice in Patent Cases, and the pertinent case law do not exempt designs from the written description, definiteness and independent claim requirements of 35 U.S.C. § 112. Accordingly, inasmuch as (B) is correct, (E) is incorrect. (A), (C), and (D) are incorrect because the written description, definiteness and independent claim requirements of 35 U.S.C. § 112 apply to design applications.

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22. ANSWER: (E). The transitional phrase “consisting of” in Claim 1, excludes any element not specified in the claims. MPEP § 2111.03. When the phrase “consisting of” appears in a clause of the body of a claim, rather than immediately following the preamble, it limits the elements set forth only in that clause, but other elements are not excluded from other clauses in the claim as a whole. *Id.* Here, the phrase “consisting of” in the base claim limits the output device to a video monitor. Thus, in Claim 4 the recitation of “a printer” as an output device is improper. Moreover, the recitation of the same limitation found in Claim 1, i.e., “a video monitor,” does not further limit the base claim. 35 U.S.C. § 112, paragraph 5, 37 CFR § 1.75(c). Claim 5, depends on improper Claim 4, and they are improper. A claim, which depends from an improper base claim, is itself improper. MPEP § 608.01(n). Answer (A) is incorrect because Claim 2 properly refers to a prior claim, Claim 1, it includes all the limitations of Claim 1, and it further limits claim 1. 35 U.S.C. § 112, paragraph 4, 37 CFR § 1.75(c). Answer (B) is incorrect because Claim 3 properly refers to, in the alternative, prior claims (claim 1 or claim 2), it includes all the limitations of Claim 1 or Claim 2, and it further limits Claim 1 or Claim 2. 35 U.S.C. § 112, paragraph 5, 37 CFR § 1.75(c). As discussed above, Claim 2 is a proper dependent claim. Answer (C) is incorrect because, as discussed above, Claim 3 is a proper dependent claim. Answer (D) is incorrect because, as discussed above, Claim 4 is also an improper dependent claim. Thus, the most correct answer is Answer (E).

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23. ANSWER: (E) is the most correct answer. MPEP § 2173.05(b), “Reference To An Object That Is Variable May Render A Claim Indefinite,” items B, C, and F. Each expression has been found to require support in the specification disclosing a standard for ascertaining what the inventor meant.

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24. ANSWER: (A). 37 CFR § 1.75, and MPEP § 2173.05(b). The limitation, “the outer surface of said case” does not lack antecedent basis since it is an inherent part of the case. (B) is incorrect because claim 1 recites two different memory chips and the recitation of “said memory chip” therefore renders the claim indefinite. MPEP § 2173.05(e). (C) is incorrect because claim 5 does not further limit claim 1. (D) and (E) are incorrect because (A) is correct.

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26. ANSWER: (E) is correct because (B) and (C) are correct. (A) does not overcome the prior art because the broad “comprising” language permits the laminate to have additional layers, such as an intermediate adhesive layer. MPEP § 2111.03. (B) overcomes a § 102 rejection on the basis of the prior art by reciting that the transparent protective layer and the light-sensitive layer are in actual contact therewith, eliminating the possibility of an intermediate adhesive layer. (C) also avoids the prior art by using a negative limitation to particularly point out and distinctly claim that X does not claim any laminate including an adhesive layer. MPEP § 2173.05(i).

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40. ANSWER: (C). 35 U.S.C. § 102; and MPEP §§ 2133.03(e)(4), and 2133.03(e)(6).

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41. ANSWER: (C). (C) is correct because it fails to comply with 37 CFR § 1.75(c), which states: “One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application.” In the present case, Claim 2 refers back to Claim 1, but fails to properly limit the capacitance recited in Claim 1 because it recites the term “about” immediately before the capacitance range. The term “about” allows for a range slightly above 0.011 μf or below 0.003 μf . A range below 0.003 is outside the scope of Claim 1. See MPEP 2144.05. Therefore, the claim in (C) does not properly limit Claim 1. (A), (B), and (D) are wrong because they are proper dependent claims. They further limit Claim 1 by limiting the capacitance to values within the scope of Claim 1, and therefore, comply with 37 CFR § 1.75(c). In (D), the applicant may rely upon the original claim for the description of the range of capacitance. MPEP § 608.01(I). (E) is wrong because (D) is a proper dependent claim.

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43. ANSWER: (C). 35 U.S.C. § 102(b); and MPEP § 2133.03(b), item D, states “An assignment or sale of the rights, such as patent rights, in the invention is not a sale of ‘the invention’ within the meaning of section 102(b). The sale must involve the delivery of the physical invention itself. *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1265, 229 USPQ 805, 809 (Fed. Cir. 1986).” (A) is incorrect. MPEP § 2133.03(b), item I (A), states, “An invention may be deemed to be ‘on sale’ even though the sale was conditional. The fact that the sale is conditioned on buyer satisfaction does not, without more, prove that the sale was for an experimental purpose. *Strong v. General Elec. Co.*, 434 F.2d 1042, 1046, 168 USPQ 8, 12 (5th Cir. 1970).” (B) is incorrect. MPEP § 2133.03(b), item I (B), states, “A ‘sale’ need not be for profit to bar a patent. If the sale was for the commercial exploitation of the invention, it is ‘on sale’ within the meaning of 35 U.S.C. 102(b). *In re Dybel*, 187 USPQ 593, 599 (CCPA 1975) (‘Although selling the devices for a profit would have demonstrated the purpose of commercial exploitation, the fact that appellant realized no profit from the sales does not demonstrate the contrary.’).” (D) is incorrect. MPEP § 2133.03, item IIB, states, “It is not necessary that a sale be consummated for the bar to operate. *Buildex v. Kason Indus.*, 849 F.2d 1461, 1463-64, 7 USPQ2d 1325, 1327-28 (Fed. Cir. 1988) (citations omitted).” (E) is incorrect. MPEP § 2133.03, item II (A), states, “Since the statute creates a bar when an invention is placed ‘on sale,’ a mere offer to sell is sufficient commercial activity to bar a patent. *In re Theis*, 610 F.2d 786, 791, 204 USPQ 188, 192 (CCPA 1979)... In fact, the offer need not even be actually received by a prospective purchaser. *Wende v. Horine*, 225 F. 501 (7th Cir. 1915).”

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48. ANSWER: (D). MPEP § 2136.05. (A) is incorrect. MPEP § 2137. “The mere fact that a claim recites the use of various components, each of which can be argumentatively assumed to be old, does not provide a proper basis for a rejection under 35 U.S.C. 102(f).” *Ex parte Billottet*, 192 USPQ 413, 415 (Bd. App. 1976). Derivation requires complete conception and communication by another to the applicant. *Kilbey v. Thiele*, 199 USPQ 290, 294 (Bd. Pat. Inter. 1978). (B) is incorrect. MPEP § 2137, third paragraph. The designation of inventorship in a patent does not raise a presumption of inventorship with respect to subject matter disclosed, but unclaimed in the patent. (C) is incorrect. MPEP § 2136.05. A terminal

disclaimer does not overcome a 35 U.S.C. § 102(e) rejection. *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991). (E) is incorrect because (A), (B) and (C) are incorrect.

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50. ANSWER: (C) is the most correct answer. 35 U.S.C. § 103; *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995); *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983); and MPEP § 2112. (A) and (B) are incorrect because a suggestion to modify the art to render obvious the claimed invention need not be expressly stated in one or all of the references. *In re Napier, supra*. (D) is incorrect. The burden is on the examiner to show that the prior art suggests modifying the art to render obvious the claimed invention. If the examiner sustains his burden of proof only then does the burden shift to the applicant to present rebuttal evidence. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 229 USPQ 182 (Fed. Cir. 1986), and MPEP §§ 2141, and 2143.01. (E) is incorrect because only analogous art can be used in a 35 U.S.C. § 103 rejection.