Answers

Patent Practice and Procedure I
IPSI 2000
FINAL EXAM

INSTRUCTIONS: This is an open book examination. You may use the MPEP, your class materials, and other written materials. You have 2 hours to complete the 40 multiple choice questions. Using the SCANTRON® SCORE SHEET provided, enter your EXAM NUMBER in the appropriate location and answer each of the questions 1-40 by filling in the appropriate letter. No credit will be given for any answers given in blue books or on scratch paper.

1) Designing around valid patent claims to avoid infringement is
   a) illegal.
   b) contrary to the constitutional purpose of the patent system.
   c) consistent with the constitutional purpose of the patent system.
   d) legal but can be prevented by drafting ambiguous claims having a scope that cannot be ascertained by competitors.
   e) a) and b)

2) Obtaining a U.S. patent shields the owner of the U.S. patent from infringing other U.S. patents.
   a) True
   b) False

3) The function(s) of patent claims is(are):
   a) to define the exclusive right
   b) to put the public on notice
   c) to enable someone of ordinary skill in the art to make and use the invention.
   d) to set forth the best mode.
   e) a) and b)

4) The omnibus claim in *Ex parte Fressola* was based on the peripheral definition method of claiming where the claim clearly and precisely marked out the periphery or boundary of the area covered by the claim.
   a) True
   b) False

5) The Jepson claim format suggested in 37 CFR 1.75 may be not be desirable in the U.S. because:
   a) the transition "wherein the improvement comprises" is closed-ended.
   b) This claim format can only be used for improvement type inventions.

c) The preamble is an implied admission of prior art.
d) All of the above
e) a) and c)

6) Considering the claim - "A composition consisting of A, B, and C." - which of the following is true?
a) A prior art reference disclosing a composition having A, B, C and D would anticipate the claim.
b) A prior art reference disclosing a composition having A, B and C would anticipate the claim.
c) A prior art reference disclosing a composition having A and B would anticipate the claim.
d) All of the above
e) a) and b)

7) *In re Schreiber* involved a claim drawn to a dispensing top for passing only several kernels of popped popcorn at a time. The claim was rejected as anticipated under principles of inherency over a prior art reference disclosing a spout used to dispense oil from an oil can. The prior art reference does not disclose the use of the spout to dispense popcorn. This anticipation rejection could have been overcome by
a) Presenting sufficient evidence to prove that the dispensing top claimed by Schreiber was in fact structurally different from the spout disclosed in the prior art reference.
b) Replacing the article claims with method claims to the new use of the dispensing top to dispense kernels of popcorn.
c) Arguing that the prior art reference is non-analogous art.
d) All of the above
e) a) or b)

8) To avoid being overly broad under 35 U.S.C. 112, 1st paragraph, claims should:
   a) recite all elements of the preferred embodiment, even if the elements are not critical or essential.
   b) be commensurate in scope with the invention described and enabled by the specification.
   c) particularly point out and distinctly claim the invention.
   d) set forth the best mode of the invention.
   e) incorporate the specification and drawings by reference.

9) One practical claim drafting lesson learned from *Sage Products Inc. v. Devon Industries Inc.* is:
   a) You should use means plus function language to broadly cover any structure capable of performing a function.
   b) You can usually rely on the Doctrine of Equivalents to broaden your claims.
   c) You can usually rely on an open-ended transition word like "comprising" to cover one or more elements even if you claim "a" single element.
   d) If you disclose multiple variations of an invention, you only need to claim one variation to cover all of the variations.
   e) You should foresee potentially limiting language and negotiate broader claims that cover foreseeable alterations of an invention.

10) When preparing a patent application, the best reason to draft a number of dependent claims providing a varying scope is:
   a) More billable hours.
   b) An unlimited number of dependent claims can be filed without incurring additional fees.
   c) A restriction requirement can be avoided using dependent claims.
   d) You can increase your chance of having at least one claim that is both valid and infringed during litigation.

e) Dependent claims are broader than independent claims.

11) When a patent claim drafter acts as his/her own lexicographer, which of the following is true?

a) The claim drafter cannot give a new meaning to a term that is repugnant to its accepted meaning.
b) The claim drafter must have a basis for claim terminology in the description.
c) The claim language must particularly point out and distinctly claim what applicant regards to be the invention.
d) All of the above.
e) a) and b)

12) A claim satisfies 35 U.S.C. 112, 2nd paragraph, if one of ordinary skill in the art is able to ascertain the scope of the claim with reasonable certainty when read in light of the specification.

a) True
b) False

13) Which of the following is a proper Markush group:

a) "aniline or its homologues or halogen substitutes"
b) "material selected from the group comprising aniline, homologues of aniline and halogen substitutes"
c) "material selected from the group consisting of aniline, homologues of aniline and halogen substitutes"
d) "mono-amine, such as aniline, homologues of aniline, and halogen substitutes"
e) "one of aniline, homologues of aniline, and halogen substitutes"

14) In *In re Marosi*, the court found that:

a) "essentially free of alkali metal" was acceptable under 35 U.S.C. 112, 2nd paragraph, because the specification provided general guidelines and examples sufficient for one of ordinary skill in the art to determine when an amount is "essentially free of alkali metal"

b) "essentially free of alkali metal" was not acceptable under 35 U.S.C. 112, 2nd paragraph, because applicant was required to narrowly define a numerical limit in order to particularly point out and distinctly claim the invention

c) "essentially free of alkali metal" was not acceptable under 35 U.S.C. 112, 2nd paragraph, because broadening modifiers are per se indefinite when used at the point of novelty

d) None of the above.

e) b) and c)

15) To be responsive (pursuant to 37 CFR 1.111) to the Office action in the Bulk Material Dispensing System assignment, the applicant must:

a) respond to rejections under 35 U.S.C. 102 and 103.

b) respond to a rejection under 35 U.S.C. 112, 1st paragraph.

c) respond to a rejection under 35 U.S.C. 112, 2nd paragraph.

d) All of the above.

e) a) and c)

16) Which of the following is(are) required for the patent examiner to establish *prima facie* obviousness?

a) An absence of any evidence of unexpected results derived from the claimed invention.

b) A suggestion or motivation to modify or combine the prior art references.

c) An absence of any evidence of commercial success derived from the claimed invention.

d) All of the claim limitations identically disclosed in a single prior art reference.
e) a) and b)

17) Which of the following is NOT a valid argument in response to a rejection under 35 U.S.C. 103 in which multiple prior art references are combined?
a) The prior art references are non-analogous.
b) One of the prior art references "teaches away" from the combination.
c) Too many references are being combined.
d) All of the claim limitations are not taught or suggested by the references, even when combined.
e) Applicant discovered the source of a problem that others have not been able to solve.

18) When the specification and claims are both amended to include new matter that is not supported by the original disclosure, the examiner should:
a) reject the claims and specification under 35 U.S.C. 132.
b) object to the amendment under 35 U.S.C. 132 and reject the claims under 35 U.S.C. 112, 1st paragraph.
c) reject the specification under 35 U.S.C. 112, 1st paragraph, and object to the claims under 35 U.S.C. 132.
d) allow the amendment to be entered if the new matter is the best mode.
e) allow the amendment to be entered if the new matter is necessary to satisfy the enablement requirement under 35 U.S.C. 112, 1st paragraph.

19) Which of the following can be used to overcome an anticipation rejection under 35 U.S.C. 102(b) over a prior art patent?
a) An affidavit under 37 CFR 1.131 that establishes a date of invention prior to the effective date of the prior art reference.
b) An affidavit under 37 CFR 1.132 that presents evidence of commercial success.

c) An amendment to the rejected claim adding an element that is not disclosed, expressly or inherently, in the prior art patent.
d) An argument that the prior art patent has expired.
e) Either a) or c).

20) During patent examination, the patent examiner should give each claim the broadest possible interpretation without referring to the specification.
a) True
b) False

21) If a patent application is filed under 37 CFR 1.53(c) with a specification as prescribed by 35 U.S.C. 112, 1st paragraph, all drawings required by 37 CFR 1.81(a), and a cover sheet identifying the application as a provisional application, which of the following is true?
a) A Notice of Incomplete Application will be sent by the Patent Office because the application does not include at least one claim.
b) A Notice of Omitted Items will be sent by the Patent Office because a Declaration signed by all of the inventors has not been filed.
c) A filing date will be granted only if the inventors are identified in the cover sheet.
d) A filing date will be granted, but a Notice to File Missing Parts will be sent by the Patent Office if the filing fee was not submitted with the application.
e) An Information Disclosure Statement must be filed identifying any prior art known to be material to patentability.

22) A restriction requirement based on claims drawn to patentably distinct species will be withdrawn if a claim generic to each of the species is allowed.
a) True
b) False

23) The duty to disclose information material to patentability set forth in 37 CFR 1.56 requires

a) a patent search conducted by applicant to find all information material to patentability.

b) all disclosures to be made by applicant at the time the patent application is filed, otherwise a filing date will not be granted.

c) an investigation by the patent examiner to determine whether the inventor may have concealed information.

d) an explanation of every patent submitted by the applicant to the U.S. Patent and Trademark Office.

(e) None of the above.

24) For purposes of determining compliance with the written description requirement of 35 U.S.C. 112, 1st paragraph, the original disclosure includes

a) only the specification.

b) only the specification and drawings.

(c) the specification, drawings and claims.

d) the specification, drawings, claims, and any printed publication incorporated by reference.

e) the specification, drawings, claims, and any amendment submitted prior to the first office action.

25) A patent application is filed by a sole inventor Garciaparra on May 22, 1999. The examiner rejects all of the claims as being obvious over a U.S. Patent issued to Martinez on July 21, 1999. The U.S. Patent issued to Martinez was based on an application filed in the U.S. on August 4, 1998. Applicant can overcome this rejection by

a) arguing that the Martinez patent is not prior art because it did not issue prior to the filing date of the application.

(b) submitting a Declaration under 37 CFR 1.131 to swear behind the Martinez patent.

c) claiming priority on the Martinez patent under 35 U.S.C. 120 since the Martinez patent was still pending when the application was filed.
d) Any of the above
e) b) and c)

26) A patent application is prepared based on the Tissue Preservation System Disclosure without adding any new subject matter. One of the claims to the system for preserving living tissue recites "means for maintaining a temperature favorable to survival of living tissue." This "means" clause is most likely to be construed

a) to cover an insulated box containing ice and equivalent structures that perform the function of maintaining a temperature favorable to survival of living tissue.
b) to cover any and all structures capable of maintaining a temperature favorable to survival of living tissue.
c) to cover only an insulated box containing ice.
d) as not having any patentable weight since it merely recites an intended use.
e) by the patent examiner during prosecution to cover any and all structures capable of maintaining a temperature favorable to survival of living tissue, and by the judge during infringement to cover an insulated box containing ice and equivalent structures that perform the function of maintaining a temperature favorable to survival of living tissue.

27) Which of the following limitations is <u>least</u> likely to invoke the interpretation prescribed by 35 U.S.C. 112, 6th paragraph?

a) "lever moving element for moving"
b) "detent mechanism"
c) "means connected to the saw for supporting the surface of the concrete"
d) "step for adhering"
e) "lever moving means for moving"

28) In *Gentry Gallery, Inc. v. Berkline Corporation*, the claims, as originally filed, included the limitation of the recliner controls being on the console between the recliners. During prosecution, the original claims were amended to remove this limitation. Because the issued claims did not include this limitation, the claims were invalidated under 35 U.S.C. Section 112, 1st paragraph, as not being supported by the written description. This problem with the written description could have been avoided if

a) the application was originally filed with claims not limited to the recliner controls being on the console between the recliners.

b) a statement was made in the original application that the recliner controls could be in other locations.

c) the drawings filed with the original application showed the recliner controls in other locations.

d) All of the above

e) b) and c)

29) One difference between the Request for Continued Examination (RCE) and the Continued Prosecution Application (CPA) is:

a) The CPA can be used to add new subject matter.

b) The RCE is entitled to the benefit of a Certificate of Mailing under 37 CFR 1.8.

c) The RCE fee is less than the basic filing fee.

d) The CPA requires a new oath/declaration.

e) The RCE can be used to file a divisional application.

30) Which of the following is <u>not</u> required to obtain the benefit of an earlier filing date in the United States under 35 U.S.C. 120?

a) A cross-reference to the earlier application

b) At least one common inventor

c) The invention was disclosed in the earlier application in the manner provided by 35 U.S.C. 112

d) Co-pendency with the earlier application

e) Filing within 12 months of the earlier application

31) If an Office Action has a mailing date of December 11, 1999 and a shortened statutory period of 3 months, a response to that Office Action can be filed

a) today with a Petition for an Extension of Time of 4 mos. and a Certificate of Mailing under 37 CFR 1.8.

b) today with a Petition for an Extension of Time of 4 mos. and a Certificate of Express Mail under 37 CFR 1.10.

c) today with a Petition for an Extension of Time of 4 mos. and a Certificate of Facsimile transmission under 37 CFR 1.8.

d) any of the above

e) none of the above

32) A patent application is filed without disclosing the best mode of practicing the invention contemplated by the inventor at the time the application was filed. To correct this problem the applicant can:

a) File a continuation-in-part application

b) File a preliminary amendment adding a description of the best mode before receiving the first office action on the merits.

c) File a Declaration under 37 CFR 1.132 showing that the best mode is within the level of ordinary skill in the art.

d) Wait until the examiner rejects the claims for lack of best mode and then file an amendment to overcome the rejection.

e) Any of the above.

33) A statutory double patenting rejection can be overcome by:

a) Filing a terminal disclaimer.

b) Filing a Declaration under 37 CFR 1.131.

c) Claiming priority under 35 U.S.C. 120.

d) Claiming priority under 35 U.S.C. 119(e).

e) None of the above.

34) Patent examination is an *Ex Parte* proceeding and the patent examiner is in a quasi-judicial position.

a) True

b) False

For questions 35-39 consider the following claims 1 and 2 based upon the prosthesis extractor assignment:

1. A system for extracting a prosthesis having a stem, a neck, and a head, said system comprising:
a base portion;
a pair of spaced jaws extending from said base portion, said pair of spaced jaws converging from a first region to a second region, said first region being adapted to receive the head of the prosthesis and said second region being adapted to grasp the neck of the prosthesis, wherein said base portion and said spaced jaws are made of a sterilizable material such as stainless steel; and
an impact providing device pivotably coupled to said base portion for directing an impact force to said prosthesis and substantially aligned with the stem of the prosthesis.

2. The system of claim 1 wherein said spaced jaws form an angle with respect to said base portion.

35) Claim 1 is likely to be rejected under 35 U.S.C. 102 as anticipated by the prior art discussed in the prosthesis extractor disclosure.

a) True
b) False

36) Claim 2 is likely to be rejected under 35 U.S.C. 112, 2nd paragraph, as indefinite because an angle in the range of 30° to 60° is essential to obtain the necessary alignment and must be recited in claim 2.

a) True
b) False

37) Which of the following is proper grounds to reject claim 1 under 35 U.S.C. 112, 2nd paragraph?

a) The term "pivotably" cannot be found in any dictionary and the applicant is not entitled to create new terminology
b) "substantially aligned" is vague and is per se indefinite
c) "a prosthesis having a stem, a neck, and a head" is inferentially claimed in the preamble
d) "adapted to" is futuristic and conditional language
e) none of the above

38) Which of the following amendment should be made to claim 1 to avoid a rejection under 35 U.S.C. 112, 2nd paragraph, while still providing the broadest possible scope of protection?

a) In claim 1, line 7, delete "a sterilizable material such as"

b) In claim 1, lines 7-8, delete "such as stainless steel"

c) In claim 1, line 7, replace "such as" with --selected from the group consisting of--

d) In claim 1, line 8, after "steel" insert --or the like--

e) In claim 1, line 8, change "stainless steel" to --metal--

39) Which of the following is a proper dependent claim?

a) 3. The system of claim 1 wherein the system does not include the impact providing device.

b) 3. The system of claim 1 and 2 wherein the spaced jaws converge at an angle in the range of about 10° to 30°.

c) 3. The system of claim 1 further including the steps of aligning said impact providing device with said stem and providing said impact force.

d) 3. The system of claim 1 wherein said spaced jaws form an angle with respect to said base portion in the range of about 30° to 60°.

e) 3. The angle of claim 2 having a range of about 30° to 60°.

40) The name of the game is

a) the Doctrine of Equivalents.

b) Contributory Infringement.

c) the claim.

d) the Detailed Description of the Invention.

e) the invention.