EXAM NO. _____

Patent Practice and Procedure I
IPSI 2003
FINAL EXAM

INSTRUCTIONS: This is a closed-book examination. 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) Assuming cobalt-based alloy, titanium, stainless steel, and platinum all belong to an art recognized class, which of the following alternative expressions is(are) permitted under 35 U.S.C. 112, 2nd paragraph:

   I) "wherein said prosthesis is made of a material selected from the group consisting of cobalt-based alloy, titanium, stainless steel, and platinum"

   II) "wherein said prosthesis is made of cobalt-based alloy, titanium, stainless steel, and platinum"

   III) "wherein said prosthesis is made of cobalt-based alloy, titanium, stainless steel, or platinum"

   IV) "wherein said prosthesis is made of a material selected from the group consisting of cobalt-based alloy, titanium, stainless steel, platinum, or the like"

   V) "wherein said prosthesis is made of a biomaterial such as cobalt-based alloy, titanium, stainless steel, or platinum"

   a) I)

   b) I) and II)

   c) I), II) and III)

   d) I), II), III) and IV)

   e) I), II), III) and V)

2) Consider the following hypothetical: Inventor Garciaparra invents a shoe polish for shining shoes (which, for the sake of example, is novel, useful, and nonobvious). Garciaparra receives a patent having composition claims for shoe polish. The preamble of these hypothetical claims recites "a composition for polishing shoes." More than a year after Garciaparra's patent issues, Inventor Jeter discovers that the polish composition also repels water when rubbed onto shoes and inventor Wells discovers that the polish composition grows hair when rubbed on bare human skin.

   Which of the following is most likely to be true?

   a) Jeter can patent the method of using the polish composition to repel water.

   b) Wells can patent the method of using the polish composition to grow hair.

   c) Wells can patent the polish composition as "a composition for growing hair."

   d) Jeter can patent the method of using the polish composition to shine shoes.

   e) Wells can make and sell the composition for use in growing hair.

3) A product-by-process claim can be used to:

   a) Patent a composition in a "recipe" format where the composition is defined according to the starting materials used to make the composition.

   b) Patent a product that is not novel by reciting a novel and non-obvious method for making the product.

   c) Patent both the product and the process used to make the product.

   d) Invoke the interpretation under 35 U.S.C. 112, paragraph 6.

   e) b) and d)

4) Which of the following claims is most likely to invoke the interpretation under 35 U.S.C. 112, paragraph 6:

   a) "A cooking apparatus comprising: a grill means; and an element for heating said grill means, said element including a gas burner.

   b) "A means for cooking a cheeseburger."

   c) "A cheeseburger made according the steps of: heating a beef patty to cook said beef patty; and melting cheese on said beef patty."

   d) "A method of making a cheeseburger comprising the steps of: heating a beef patty to cook said beef patty; and melting cheese on said beef patty.

   e) "A method of making a cheeseburger comprising: a step for cooking a beef patty; and melting cheese on said beef patty.

5) The Jepson claim format is:

   a) Indefinite under 35 U.S.C. 112, paragraph 2.

   b) Improper under 35 U.S.C. 101.

   c) Required under 37 CFR 1.75 for improvement claims.

   d) A two-part claim format in which prior art is identified in the preamble of the claim.

   e) A claim format invented by Professor Jepson at Pierce Law.

6) Which of the following statements is true about patent examiners at the U.S. Patent and Trademark Office (PTO):

   a) All examiners at the PTO are lawyers.

   b) To promote the issuance of valid patents, the PTO encourages examiners to take as much time as needed to conduct a thorough search of the prior art.

   c) Examiners routinely grant examiner interviews to patent applicants before the first Office action on the merits.

   d) An examiner must have signatory authority to sign an Office action representing a position of the PTO.

   e) Examiners must take and pass the patent bar exam.

7) To satisfy the duty to disclose information material to patentability under 37 CFR 1.56, a patent applicant is obligated to do which of the following:

   a) disclose new patents applied by the European Patent Office in a rejection of a corresponding application

   b) list all patents, publications, or other information material to patentability on a PTO form 1449, provide a copy of each patent, publication or other information, and provide a concise explanation pointing out how the claims distinguish over the prior art

   c) disclose an offer to sell an earlier version of the product that is being claimed in the patent application, where the offer to sell occurred more than 1 year prior to filing the application

   d) conduct a patent search

   e) a) and c)

8) A claim having a very narrow scope will be:
   a) Objected to by the examiner because the claim fails to adequately protect the inventor.
   b) More likely to be patentable.
   c) Rejected by the examiner under 35 U.S.C. §112, ¶4.
   d) Easier to design around.
   e) b) and d)

9) One purpose of the requirement under 35 U.S.C. §112, ¶2 is to:
   a) Ensure that the breadth of the claims is narrow.
   b) Allow the patent examiner to determine if the claimed invention is patentable.
   c) Enable one of ordinary skill in the art to make the invention.
   d) Set forth the best mode of practicing the invention.
   e) Provide a written description of the invention.

10) Which of the following claims should properly be rejected under 35 U.S.C. §112, ¶2?
   a) a claim with exemplary language
   b) a kit claim
   c) a claim that fails to recite the elements of the claim in sub-paragraphs
   d) a dependent claim that fails to add a further limitation
   e) a claim that fails to recite a feature described as critical in the specification

11) Which of the following types of claims should be rejected under 35 U.S.C. 101:
   a) a claim to new use for a known composition
   b) a product-by-process claim
   c) a claim to an algorithm per se
   d) a single means claim
   e) a claim to an improvement on a known machine

12) An application was filed December 1, 2001 and a final Office action was mailed on April 1, 2002. In response to the final Office action, an applicant files an Amendment After Final on June 30, 2002. The examiner mails an Advisory Action on September 30, 2002 refusing entry of the amendment because it requires further consideration and search. To retain the December 1, 2001 filing date and have the amendment considered, which of the following options does the applicant have:
   a) File a Continued Prosecution Application without an extension of time
   b) File a Request for Continued Examination (RCE) together with the Amendment After Final that was refused entry and a 3 month extension of time
   c) File a Notice of Appeal

d) File the amendment with a Petition for a New Examiner

e) none of the above

13) Which of the following does not count toward a patent examiner's production:

a) a first Office action on the merits

b) a final Office action

c) an allowance

d) an express abandonment of a patent application

e) an unintentional abandonment of a patent application

14) A continuation application claiming priority on an earlier application under 35 U.S.C. 120 must be filed within one year of the earlier application.

a) True

b) False

15) If a provisional application has a filing date of July 1, 2002, an application claiming priority on the provisional application can be timely filed

a) by Express Mail on July 1, 2003

b) by Express Mail on July 2, 2003 with a one month extension of time

c) by first class mail on July 1, 2003 with a Certificate of Mailing under 37 CFR 1.8

d) by facsimile on Mon. July 1, 2003 with a Certificate of Facsimile transmission under 37 CFR 1.8

e) any of the above

16) To overcome a *prima facie* case of obviousness based on a combination of references under 35 U.S.C. 103, an applicant may:

a) provide objective evidence of non-obviousness

b) establish that one of the references used in the combination is not in the same field of endeavor as the claimed invention and is not reasonably pertinent to the particular problem with which the inventor was involved

c) show that one of the references teaches away from the combination

d) all of the above

e) none of the above

17) Inventor Martinez files a patent application in the U.S. on July 21, 2001. All of the claims are anticipated by a Canadian patent to the inventor Lowe and the same inventor Martinez. The Lowe-Martinez patent has a filing date of January 22, 1999, a publication date of July 22, 2000 and an issue date of July 30, 2001. The Lowe-Martinez patent is prior art under which of the following:

a) 35 U.S.C. 102(a)

b) 35 U.S.C. 102(b)

c) 35 U.S.C. 102(e)

d) 35 U.S.C. 102(a) and (e)

e) None of the above

18) If the examiner gives a general enablement rejection under 35 U.S.C. 112, 1st paragraph, because the specification fails to enable any of the subject matter within the scope of the claims, the rejection can be overcome by

a) filing a declaration under 37 CFR 1.131.

b) amending the specification to incorporate a U.S. patent by reference.

c) filing a Request for Continued Examination (RCE) with an amendment adding the subject matter necessary to satisfy the enablement requirement.

d) amending the specification to include the subject matter necessary to satisfy the enablement requirement.

e) none of the above

19) Designing around valid patent claims to avoid infringement is

a) contributory infringement

b) contrary to the constitutional purpose of the patent system.

c) consistent with the constitutional purpose of the patent system.

d) preventable by drafting ambiguous claims having a scope that cannot be ascertained by competitors.

e) c) and d)

20) Obtaining a U.S. patent shields the owner of the U.S. patent from infringing other U.S. patents.

a) True

b) False

21) In *CCS Fitness v. Brunswick*, the claim language "reciprocating member" provided a broad scope of protection and was difficult to design around because:

a) the claim language did not invoke 35 U.S.C. 112, paragraph 6

b) the specification did not assign a unique definition to "reciprocating member"

c) the applicant did not distinguish the claim language "reciprocating member" from the prior art

d) the specification did not describe the embodiment shown in the drawings as essential

e) all of the above

22) Which of the following can be used to overcome an anticipation rejection under 35 U.S.C. 102(b) over a prior art publication?

a) An affidavit under 37 CFR 1.131 that establishes a date of invention prior to the date of publication.

b) An affidavit under 37 CFR 1.132 that presents evidence that the publication is not enabling.

c) An amendment to the rejected claim adding an element that is not disclosed, expressly or inherently, in the prior art publication.

d) Either b) or c)

e) Either a), b) or c).

23) Which of the following amendments is least likely to create prosecution history estoppel under *Festo Corp. v. Shoketsu Kinsoku Kogyo Kabushiki Co.*:

a) An amendment inadvertently made by applicant, which adds an element from an allowable dependent claim to an independent claim

b) An amendment to correct antecedent basis in response to a rejection under 35 U.S.C. 112, 2nd paragraph

c) A preliminary amendment, which adds the subject matter from a dependent claim to an independent claim, without any explanation for the amendment

d) An amendment in response to a rejection under 35 U.S.C. 102, which cancels an independent claim and replaces the claim with a new independent claim that distinguishes over the prior art

e) An amendment in response to a rejection under 35 U.S.C. 112, paragraph 2, which changes "for a period of time sufficient to form bonds between said particles" to –for a period of time of about 60 minutes --

24) In response to a species restriction requirement, applicant must elect a species and cancel the claims drawn to the non-elected species.

a) True

b) False

25) A statutory "same type" double patenting rejection can be overcome by:

a) Amending the claims.

b) Filing a terminal disclaimer.

c) Filing a Declaration under 37 CFR 1.131.

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

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

26) A claim is not necessary to obtain a filing date at the U.S. Patent and Trademark Office.

a) True

b) False

27) If a claim in a patent application recites "A composition consisting essentially of A, B and C." and a prior art reference discloses a composition made of A, B, C and D, the claim is

a) not anticipated by the prior art because the claim is closed to element D

b) anticipated by the prior art regardless of regardless of whether D materially affects the basic and novel characteristics of the composition

c) anticipated by the prior art if D does not materially affect the basic and novel characteristics of the composition

d) indefinite because of the term "essentially"

e) anticipated by the prior art unless the prior art includes a claim reciting phrase "A composition consisting essentially of A, B, C and D"

28) Functional language used to define structure in an apparatus claim is

a) per se indefinite under 35 U.S.C. 112, 2nd paragraph

b) to be ignored and not given any weight in determining patentability

c) given patentable weight if used in a means plus function limitation

d) only given patentable weight if used in the preamble

e) only given patentable weight if used in a "whereby" clause

29) A patent application is filed on August 11, 1998. The examiner rejects all of the claims under 35 U.S.C. 102(b) as being anticipated by a published European Patent Application having a publication date of September 1, 1997. The rejection can be overcome by

a) submitting a Rule 131 Affidavit establishing an actual reduction of practice prior to September 1, 1997.

b) arguing that the claims are patentably distinguishable from the invention disclosed in the European Patent Application.

c) amending the claims to patentably distinguish over the invention disclosed in the European Patent Application.

d) b) and c)

e) a), b), and c)

30) Which of the following statements about dependent claims is(are) true?

a) Dependent claims are important to patent protection because a dependent claim might be found valid and infringed even if an independent claim is invalidated.

b) Dependent claims must add a further limitation.

c) Multiple dependent claims can be used without incurring any additional fees.

d) a) and b)

e) a), b) and c)

31) To apply for a patent as joint inventors, each of the inventors must

a) contribute to each claim in the patent application

b) physically work together on the invention at the same time

c) contribute to the conception of a feature recited in at least one claim of the invention

d) a) and b)

e) b) and c)

32) The requirements for the specification are set forth in which of the following sections of the patent statute:

a) 35 U.S.C. 101

b) 35 U.S.C. 102

c) 35 U.S.C. 103

d) 35 U.S.C. 112

e) all of the above

33) 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 Request for Continued Examination

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) None of the above.

34) A Non-publication Request can be filed:

a) only when the application is filed

b) only if the application is *not* going to be filed in a country that requires 18 month publication

c) at any time before the application is sent to the Office of Publication

d) a) and b)

e) b) and c)

For questions 35-37 consider the following claims to an edible food product:

The invention claimed is:

1. An edible food product characterized by:

first and second slices of bread such as a sesame seed bun;

a meat product inserted between said first and second slices of bread, wherein said meat product is made of ground beef; and

a slice of cheese melted between said mead product and said slice of bread.

2. The edible food product of claim 1 wherein said bread is wheat bread.

3. The edible food product of claim 1 wherein said meat product is made of ground turkey and not ground beef.

4. The edible food product of any one of claims 1-3 wherein said cheese is american, cheddar, swiss or the like.

5. A method of making an edible food product, said method comprising:

forming a beef patty;

heating said beef patty over an open flame until said beef patty is cooked substantially to a center of said beef patty;

melting a piece of cheese on said beef patty;

spreading a sauce on at least one of first and second pieces of bread; and

placing said beef patty with said cheese between said first and second pieces of bread.

6. The method of claim 5 further including the step of heating said bread.

35) Claim 3 is:

a) not in proper dependent claim format because it does not refer to the previous claim 2.

b) an improper dependent claim because it does not specify a further limitation of the subject matter claimed pursuant to 35 U.S.C. §112, ¶4.

c) is per se indefinite because it includes a negative limitation.

d) a) and b)

e) b) and c)

36) Which claim is least likely to be rejected under 35 U.S.C. 112, 2nd paragraph:

a) claim 1

b) claim 2

c) claim 3

d) claim 4

e) claim 5

37) Which of the following is a proper multiple dependent claim based upon claims 1-6 above:

a) 7. The method of claims 5 and 6 further comprising lettuce.

b) 7. The method of claims 1 or 5 further comprising lettuce.

c) 7. The method of claims 5 or 6 further comprising lettuce.

d) 7. The edible food product of claims 1 or 4 further comprising lettuce.

e) b) and c)

38) When an amendment to the specification adds new subject matter not supported by the original written description of a patent application,

a) the specification should be rejected under 35 U.S.C. 132

b) the specification should be objected to under 35 U.S.C. 132

c) the specification should be rejected under 35 U.S.C. 112, 1st paragraph

d) the claims should be rejected under 35 U.S.C. 112, 1st paragraph

e) the amendment should be entered without any objections or rejections

39) When a limitation is added to the claims by amendment, which of the following can be relied on for support to satisfy the written description requirement under 35 U.S.C. 112, 1st paragraph:

a) the drawings

b) the specification

c) the abstract

d) a), b) and c)

e) b) and c)

40) Which of the following cannot be relied on as prior art in an anticipation rejection of claims in a patent application:

a) A statement made in the Background section of the patent application that "The prior art widget includes… "

b) The preamble in a Jepson claim.

c) A published provisional patent application.

d) A statement made in the Detailed Description section of the patent application that "The prior art widget includes…"

e) A drawing in the patent application labeled as "Prior Art."