Patent Practice and Procedure I
IPSI 2004
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) 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.

2) 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.

3) 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.

4) 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.

5) A claim having a very narrow scope will be:

a) Guaranteed a broader interpretation under the doctrine of equivalents

b) Objected to by the examiner because the claim fails to adequately protect the inventor.

c) Rejected by the examiner under 35 U.S.C. §112, ¶4.

d) Easier to design around.

e) b) and d)

6) One purpose of the requirement under 35 U.S.C. §112, ¶2 is to:

a) Allow the patent examiner to determine if the claimed invention is patentable.

b) Allow competitors to determine if there is infringement.

c) Enable one of ordinary skill in the art to make the invention and set forth the best mode of practicing the invention.

d) a) and b)

e) a), b) and c)

7) Which of the following claims should properly be rejected under 35 U.S.C. §112, ¶4?

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 recites both a narrow and broader range

8) Which of the following types of claims should be rejected under 35 U.S.C. 101:

I) a claim to new use for a known composition

II) a product-by-process claim

III) a claim to an algorithm per se

IV) a claim to a law of nature

V) a single means claim

VI) a claim to an improvement on a known machine

a) III) and IV)

b) II), III) and IV)

c) I), II), III), and IV)

d) II), III), IV), and V)

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

9) 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 Request for Continued Examination (RCE) together with the Amendment After Final that was refused entry and a 3 month extension of time

   b) File a Notice of Appeal

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

   d) none of the above

   e) all of the above

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

   a) a first Office action on the merits

   b) a second non-final Office action

   c) an allowance

   d) an express abandonment of a patent application

   e) an unintentional abandonment of a patent application

11) An application claiming priority on an earlier application under 35 U.S.C. 119 must be filed within one year of the earlier application.

   a) True

   b) False

12) 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 Express Mail on Mon. July 2, 2003 as long as the provisional application is co-pending

   d) a) and c)

   e) a) and b)

13) To overcome a *prima facie* case of anticipation under 35 U.S.C. 102(b) based on inherency, an applicant may:

   a) submit a Declaration under 37 CFR 1.131

   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) submit evidence of long-felt need with an Affidavit under 37 CFR 1.132

d) all of the above

e) none of the above

14) 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

15) 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) under 37 CFR 1.114 with an amendment adding the subject matter necessary to satisfy the enablement requirement.

d) filing a continuation-in-part application with the subject matter necessary to satisfy the enablement requirement

e) all of the above

16) 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 with reasonable certainty by competitors.

e) c) and d)

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

a) True

b) False

18) Which of the following can be used to overcome an anticipation rejection under 35 U.S.C. 102(e) over a U.S. patent?

a) An affidavit under 37 CFR 1.131 that establishes a date of invention prior to the filing date of the U.S. patent.

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).

19) 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 merely make explicit what is already implicitly recited in the claim

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 --

20) After electing a species In response to a species restriction requirement, the claims drawn to the non-elected species will be allowed if a generic claim is allowed.

a) True

b) False

21) A claim is necessary to obtain a filing date at the U.S. Patent and Trademark Office.

a) True

b) False

22) 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 132 Affidavit establishing unexpected results

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

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)

23) 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) If an independent claim is rejected under 35 U.S.C. 112, 2nd paragraph, a dependent claim that depends from the independent claim must also be rejected under 35 U.S.C. 112, 2nd paragraph

d) a) and b)

e) a), b) and c)

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

a) 35 U.S.C. 102

b) 35 U.S.C. 103

c) 35 U.S.C. 112

d) all of the above

e) a) and c)

25) A Non-publication Request may only be filed when the application is filed.

a) True

b) False

26) 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) a pending non-published patent application that is incorporated by reference

c) the abstract

d) a), b) and c)

e) a) and c)

27) Which of the following may not be relied on as prior art in an obviousness 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."

28) When prosecuting a patent application, which of the following is considered material to patentability pursuant to 37 CFR 1.56:

a) a prior art patent

b) a commonly-owned pending patent application with substantially similar claims

c) another examiner's rejection of substantially similar claims in a commonly-owned pending patent application

d) all of the above

e) a) and b)

29) Which of the following may be used to determine the meaning of the language used in the claims:

a) a dictionary

b) the patent specification

c) the patent prosecution history

d) a), b) and c)

e) b) and c)

30) Which of the following is <u>not</u> required by 35 U.S.C. 112:

a) one or more claims particularly pointing out and distinctly claiming what applicant regards to be the invention

b) a specification that provides an enabling disclosure

c) claims that set forth the best mode of the invention

d) a specification that contains a written description of the invention

e) if a claim is presented in dependent form, it must specify a further limitation of the subject matter claimed

31) Which of the following is required for joint inventorship under 35 U.S.C. 116:

a) inventors who physically worked together at the same time

b) inventors who made the same type or amount of contribution

c) inventors who contribute to the subject matter of every claim in the patent

d) a contribution to the actual reduction to practice of the claimed subject matter

e) a contribution to the conception of the claimed subject matter

32) Which of the following is required by a declaration from the inventors under 37 CFR 1.63:

a) a statement that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed

b) a statement that the inventors conducted a search of the prior art

c) a statement that the invention was only developed in the United States

d) notarization

e) a concise statement of the relevance of all prior art cited under 37 CFR 1.56

33) Which of the following may help to overcome an enablement rejection under 35 U.S.C. 112:

a) a Declaration under 37 CFR 1.131

b) a Declaration under 37 CFR 1.132

c) An amendment to add new subject matter under 35 U.S.C. 132

d) a) and c)

e) b) and c)

34) Which of the following is a function of the patent claim:

a) to provide public notice of the exclusive right

b) to enable one skilled in the art to make and use the invention

c) to set forth the best mode

d) to describe the utility of the invention

e) to exclude all inoperative embodiments

35) 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)

36) 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.

37) Which of the following is required by Title 37 of the Code of Federal Regulations:

a) A Summary of the Invention

b) An Abstract

c) Jepson claim format for improvement inventions

d) A description of the relevance of the prior art

e) An assignment of rights

38) According to 35 U.S.C. 133, an applicant must file a response to an Office action within 6 months to avoid abandonment of the patent application.

a) True

b) False

39) A patent issuing on an application with respect to which a restriction requirement has been made may not be used as a reference against a divisional application in a double patent rejection.

a) True

b) False

40) When filing a continuation-in-part application, a claim of priority under 35 U.S.C. 120 to a parent application requires:

a) filing the continuation-in-part application within 1 year of the parent application

b) a reference to the parent application in the oath or declaration

c) a reference to the parent application in the specification of the continuation-in-part application

d) a) and b)

e) a) and c)