EXAM # _____

Midterm Exam
United States Patent Law
Pierce Law Fall 2006

Instructions:

- This exam is closed book. You should have no materials with you.
- The exam is multiple choice. Please read each question and select the **best** answer from the options provided. Mark your answer on the scan-tron sheet.
- Sections of the statue that may be helpful are reproduced below. You do not need *to read them, they are just here for your reference.*

Section 101. Inventions patentable

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Section 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or

(f) he did not himself invent the subject matter sought to be patented, or

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and

reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Section 103. Conditions for patentability; non-obvious subject matter

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not he negatived by the manner in which the invention was made.

(b)(1) Notwithstanding subsection (a), and upon timely election by the applicant for *patent to proceed under this subsection, a biotechnological process using or resulting in a* composition of matter that is novel under section 102 and nonobvious under subsection (a) of this section shall be considered nonobvious if -

(A) claims to the process and the composition of matter are contained in either the same application for patent or in separate applications having the same effective filing date; and

(B) the composition of matter, and the proeess at the time it was invented, were owned by the same person or subject to an obligation of assignment to the same person.

(2) A patent issued on a process under paragraph (1) -

(A) shall also contain the claims to the composition of matter used in or made by that process, or

(B) shall, if such composition of matter is claimed in another patent, be set to expire on the same date as such other patent, notwithstanding section 154.

(3) For purposes of paragraph (1), the term "biotechnological process" means -

(A) a process of genetically altering or otherwise inducing a single- or multi-celled organism to -

(i) express an exogenous nucleotide sequence,

(ii) inhibit, eliminate, augment, or alter expression of an endogenous nucleotide sequence, or

(iii) express a specific physiological characteristic not naturally associated with said organism;

(B) cell fusion procedures yielding a cell line that expresses a specific protein, such as a monoclonal antibody; and

(C) a method of using a product produced by a process defined by subparagraph (A) or (B), or a combination of subparagraphs (A) and (B).

(c)(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preelude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

(2) For purposes of this subsection, subjeet matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if--

(A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;

(B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(3) For purposes of paragraph (2), the term 'joint research agreement' means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

Section 112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Exam starts here:

1. Which of the following can be patented:
   a) Algorithms
   b) Natural laws
   c) Phenomena of nature
   d) Business methods

2. The "critical date" is:
   a) the date of a reference

b) the date one year before the filing date of the application
c) the date of you must file internationally by
d) the date you can show diligence from

3. If a patentee has a claim to a range of temperatures for a chemical reaction and prior art overlaps slightly with this range, the claim is likely:
a) obvious
b) non-obvious
c) novel
d) anticipated

4. Most often, the easiest way to attack a prima facie case of obviousness is:
a) to argue objective indicia of non-obviousness
b) to argue that the art is non-analogous
c) to attack the motivation to combine
d) to appeal

5. A secret sale more than a year before the filing of an application invalidates the resulting patent:
a) True
b) False
c) Only if it relates to a business method
d) Impossible to tell

6. In the language US constitution, patents are intended to promote:
a) Indnstry
b) Science
c) Writing
d) Arts

7. To be invalidating to the resulting patent, a public sale more than a year before filing the application must:
a) disclose the invention
b) embody the invention
c) be made by the applicant
d) be made by a third party

8. The inventor's testimony regarding her date of invention:
a) must be in writing
b) is treated with skepticism
c) cannot be corroborated
d) is automatically corroborated

9. Which section of the patent law is intended to answer the fundamental question of what level of contribution to the art deserves at patent?
a) 101

b) 102
c) 103
d) 112

10. Section 102(b)
a) attempts to correct problems with the first to file system
b) can be sworn behind
c) is not applicable under 103
d) insures that the public gets a fair deal from the applicant

11. Which of the following is not one of factual inquiries used in forming a prima facie case of obviousness?
a) Differences between prior art and claims
b) Seope and content of the prior art
c) Objective indicia of non-obviousness
d) Level of ordinary skill in the art

12. To be useful for showing non-obviousness, objective indicia of non-obviousness must:
a) be corroborated
b) have a nexus to the claimed invention
c) show commercial success
d) be submitted in affidavit form

13. What treaty is the original basis for many countries allowing a patent to be filed within 12 months of a first filing in another country and as if it was filed on the original priority date?
a) TRIPS
b) PCT
c) Oslo Accord
d) Paris Convention

14. Which of the following is improper:
a) Testimony regarding events occurring shortly after the time of invention to show obviousness
b) Testimony regarding events occurring shortly after the time of invention to show non-obviousness
e) Testimony regarding events occurring shortly after the time of filing to show non-enablement
d) Swearing behind a 102(e) reference

15. In assessing the obviousness of a chemical, you should focus on:
a) structural obviousness
b) its formula
c) the compound and it's properties
d) whether a use is known for the chemical

16. You can swear behind a 103 reference:
    a) Never
    b) Always
    c) Sometimes
    d) By showing the invention was commonly owned

17. Section 101 prevents an applicant from obtaining a patent on something:
    a) totally incapable of achieving a useful result
    b) misleading to the public
    c) immoral
    d) without industrial applicability

18. If you are assessing whether art is analogous to your application and you determine it is from the same field of endeavor:
    a) It is analogous
    b) It is non-analogous
    c) You must determine whether the reference is still reasonably pertinent to the problem
    d) You must determine whether the applied reference can be reasonably described as arising from the same industry

19. To properly enable a patent you may:
    a) Only succeed if you provide all the details of manufacture
    b) Provide an embodiment you have never built or tested
    c) For a complex technology, just provide a general overview of the parameters and options for others to consider
    d) Only provide an operable embodiment you have built and tested

20. Which section of the patent law ensures that the public gets a fair deal from the inventor in return for the patent?
    a) 101
    b) 102
    c) 103
    d) 112

21. A patentee is entitled to:
    a) always claim the broadest genus that encompasses his invention and not any prior art
    b) only claim no broader than his subjective best mode for making the invention
    c) always claim the broadest reasonable scope given the art applied by the examiner
    d) only claim no broader than that which he has taught one of skill in the art to make without undue experimentation

22. Having a trade secret protects its owner from:

a) others reverse engineering the secret
b) others independently developing the secret
c) misappropriation by others of the secret
d) patenting by others of the secret

23. Can drawings provide sufficient written description?
a) No, not if there is nothing more
b) Yes, in at least some cases
c) Only if there is at least a little descriptive text
d) Yes, as long as the drawings are part of an issued design patent

24. To satisfy the written description requirement for a newly added claim, the specification of a patent does not need to:
a) Allow persons of ordinary skill in the art to recognize that the inventor invented what is claimed
b) Reasonably convey to the artisan that the inventor had possession of the later claimed subject matter
c) Particularly point out and describe the inventive features
d) none of the above

25. Who worked on the 1952 patent act and was also a long-serving and respected judge in patent matters?
a) Justice Story
b) Judge Rader
c) Judge Rich
d) Judge Learned Hand

26. What legal doctrine is designed solely to restrain inventors from applying from a patent and keeping the preferred embodiments to themselves?
a) Written description in the priority context
b) Written description in the non-priority context
c) Enablement
d) None of the above

27. Which of the following is a question of law:
a) Motivation to combine
b) Analogous art
c) Inventorship
d) Written description

28. Patent eligibility is about:
a) whether the invention is useful
b) whether the invention is novel, non-obvious and enabled
c) whether the invention is worth of the embarrassment of a monopoly
d) whether the subject matter is appropriate for a patent

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