Patent Practice and Procedure I
IPSI 2002
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) In the case *Sage Products, Inc. v. Devon Industries, Inc.*, infringement was avoided because:
   a) subject matter disclosed in the specification, but not claimed, is dedicated to the public.
   b) the patentee did not use means plus function language.
   c) the claim language was interpreted under 35 U.S.C. §112, ¶6.
   d) the patentee recited that the slot was "at the top of the container body."
   e) a) and d)

2) A claim having a very narrow scope will be:
   a) Rejected by the examiner under 35 U.S.C. §112, ¶1.
   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)

3) One purpose of the requirement under 35 U.S.C. §112, ¶2 is to:
   a) Allow competitors to determine if the claim is infringed
   b) Ensure that the claims narrowly define the invention.
   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.

For questions 4-7, a patent application includes claims 1-8 below. The drawings in the patent application are the same as in the prosthesis extractor assignment. The specification in the patent application states "All embodiments of the impact providing device have a shaft, a sliding weight and a stop at the end of the shaft. The stop is formed as one piece with the shaft to prevent the stop from detaching, which was a frequent problem with the prior art devices having a removable stop."

> 1. A system for extracting a prosthesis, comprising:
>
> a prosthesis extractor comprising a base portion and a pair of spaced jaws extending from said base portion, said pair of jaws converging from a first region to a second region for grasping a neck of the prosthesis, said base portion and said spaced jaws consisting of stainless steel; and

an impact providing device coupled to said base portion, for providing an impact force to said spaced jaws, wherein said jaws align and direct said impact force along a stem of the prosthesis.

2. In a system for extracting a prosthesis, said system comprising a shaft, a sliding weight on said shaft, and a stop at a first end of said shaft, wherein the improvement comprises:

a base portion coupled to said shaft; and

first and second jaws extending from said base portion for grasping the outer surface of the prosthesis.

3. A prosthesis extractor comprising a base portion and a pair of jaws extending from said stainless steel base portion, said pair of jaws converging from a first region to a second region for grasping a neck of the prosthesis.

4. The prosthesis extractor of claim 3 wherein said jaws are angled with respect to said base portion.

5. A system for extracting a prosthesis, comprising:

a prosthesis extractor for grasping the prosthesis; and

means for providing an impact force to said extractor such that said impact force is directed along a stem of the prosthesis.

6. The system of claim 5 wherein said prosthesis extractor includes a base portion and a pair of jaws extending from said base portion.

7. An extractor means for extracting the prosthesis by providing an impact force aligned with a stem of the prosthesis.

8. A system for extracting a prosthesis, comprising:

a prosthesis extractor for grasping the prosthesis; and

an impact providing device for providing an impact force to said prosthesis extractor such that said impact force is directed along a stem of the prosthesis.

4) Which of the following changes to the design of the system for extracting a prosthesis is most likely to design around and avoid infringement of claim 1?

a) Making the base portion and the spaced jaws out of stainless steel with a polymer coating.

b) Adding a pivot pin to pivotably couple the base portion to the impact providing device.
c) Angling the jaws with respect to the base portion.
d) Making the shaft of the impact providing device out of stainless steel.
e) Making the shaft detachable from the base portion.

5) Assume that the only known prior art is a pair of pliers and a hammer. Assume that a competitor is selling a system having a prosthesis extractor and an impact providing device. The prosthesis extractor of the competitor's system has a base portion and first and second jaws extending from the base portion. The impact providing device of the competitor's system has a shaft, a sliding weight and a removable stop at the end of the shaft. The base portion is coupled to the shaft. Which of the following claims is most likely to be found valid and literally infringed by competitor's system.
a) Claim 2.
b) Claim 5.
c) Claim 7.
d) Claim 8, assuming claim 8 does *not* invoke 35 U.S.C. 112, ¶6.
e) None of the above.

6) According to the MPEP, which of the following groups of claims should be rejected under 35 U.S.C. 112, ¶2 because a claimed element lacks antecedent basis:
a) 3, 4, 7
b) 3,7
c) 2,3,4,7
d) 2,3,4,6,7
e) 1-7

7) Which of the claims should be rejected under 35 U.S.C. 112, 1st paragraph:
a) Claim 2
b) Claim 5
c) Claim 7
d) Claims 2 and 5
e) Claims 2 and 7

8) Which of the following claims should be rejected under 35 U.S.C. §112, ¶2?
   a) a claim having a lack of cooperation between elements
   b) a product-by-process 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

9) 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 use claim
   c) a product-by-process claim
   d) a single means claim
   e) a claim to an improvement on a known machine

10) Which of the following is most likely to invoke the interpretation under 35 U.S.C. 112, ¶6:
   a) valve means for controlling the flow of steam
   b) steam flow control means comprising a valve
   c) a steam flow controlling element
   d) moving a valve for controlling the flow of steam
   e) a mechanism for controlling the flow of steam comprising a valve

11) Which of the following can be properly rejected under 35 U.S.C. ¶2:
   a) wherein said prosthesis is made from a material selected from the group consisting of cobalt-based alloy, titanium, stainless steel, and platinum.
   b) wherein said prosthesis is made from at least one of cobalt-based alloy, titanium, stainless steel, and platinum.
   c) wherein said prosthesis is made of cobalt-based alloy, titanium, stainless steel, and optionally platinum.
   d) wherein said prosthesis is made of cobalt-based alloy, titanium, stainless steel, or platinum.
   e) None of the above

12) The materials on which a process is carried out should not be accorded weight in determining the patentability of a process.
   a) True
   b) False

13) Which of the following cannot be used to limit the scope of the claims when a court construes the claims?

a) Abstract
b) Detailed Description
c) Summary of the Invention
d) Prosecution History
e) None of the above

14) A patent attorney discovers a prior art patent that is material to the patentability of an invention invented by one of the attorney's clients. Under which of the following circumstances should the attorney disclose the patent pursuant to Rule 56:

a) When filing a patent application under 35 U.S.C. 111(a)
b) When filing a patent application under 35 U.S.C. 111(b)
c) After paying the issue fee but before the issue date
d) all of the above
e) a) and b)

15) A Non-publication Request can be filed:

a) when the application is filed
b) within three months after the filing date
c) at any time if filed electronically
d) at any time before the application is sent to the Office of Publication
e) all of the above

16) An application is filed with claims 1-10 including independent claims 1 and 5. In a first Office action, claims 1-3 and 5-9 were rejected under 35 U.S.C. 102(b) over the Smith patent. The examiner indicated that claims 4 and 10 include allowable subject matter. In response to the Office action, the applicant argued that claims 1-3 were not anticipated and did not amend claims 1-3. The applicant also amended claim 5 to add an element not disclosed in the Smith patent. The applicant further added new claim 11, which was the equivalent of claim 10 rewritten in independent format. In a second Office action, the examiner rejects claims 1-3 and 5-9 under 35 U.S.C. 103 over the same Smith patent in view of the Jones patent. The Jones patent, which teaches the element added to claim 5 by amendment, was cited in the first Office action but was not applied in a rejection in the first Office action. The examiner also allowed claim 11 in the second Office action. Which of the following statements is true?

a) The examiner can only make the second Office action final with respect to the rejection of claims 5-9.

b) The examiner can make the second Office action final.
c) The examiner cannot make the second Office action final because claim 11 was allowed
d) The examiner cannot make the second Office action final because the same Smith patent was used in the rejection in the second Office action.
e) c) and d)

17) 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 1, 2002. The examiner mails an advisory action on July 4, 2002 refusing entry of the amendment because it requires further consideration and search. If applicant waits until October 4, 2002 before responding to the advisory action, which of the following options does the applicant have:
a) File a Continued Prosecution Application
b) File a Request for Continued Examination (RCE) together with the Amendment After Final that was refused entry
c) File a petition for entry of an amendment under 37 CFR 1.116
d) File a request for reconsideration under 37 CFR 1.112
e) none of the above

18) After a final rejection, applicant is entitled to an examiner interview as a matter of right.
a) True
b) False

19) Which of the following does not count toward a patent examiner's production:
a) a first Office action on the merits
b) an allowance
c) an express abandonment of a patent application
d) an unintentional abandonment of a patent application
e) an advisory action

20) An in-person interview with an examiner does not take the place of a reply under 37 CFR 1.111.
a) True
b) False

21) In the case *Gentry Gallery, Inc. v. Berkline*, a patent was invalidated. During the prosecution of that patent, the original claims were amended to remove the limitation of the recliner controls being located on the console. After this amendment was filed, the examiner should have:
   a) rejected the amended claims under 35 U.S.C. 132
   b) rejected the amended claims under 35 U.S.C. 112, 1st paragraph
   c) rejected the amended claims under 35 U.S.C. 112, 2nd paragraph
   d) required an amendment to the specification to provide support for the amended under 35 U.S.C. 112, 1st paragraph
   e) b) or d)

22) The '111 patent application was filed August 4, 2001 by the inventors Franklin and Pierce. The application claimed priority under 35 U.S.C. 120 based on a parent application filed on August 1, 2000 by the same inventor Franklin and inventor Jones. The inventors of the '111 application assigned the application to the XYZ company, but the parent application was not assigned by the inventors. In a first Office action on the merits given in the '111 patent application, the examiner rejects claims 1-10 under 35 U.S.C. 103 as being unpatentable over the '999 patent in view of an article to Smith et al. The '999 patent was filed July 22, 2000, issued October 12, 2001 and is commonly owned with the '111 patent application. The rejection can be overcome by
   a) arguing that the '999 patent is not prior art under 35 U.S.C. 102
   b) showing that the '999 patent is disqualified as prior art under 35 U.S.C. 103(c)
   c) arguing that the article to Smith et al. is not analogous prior art because it is not a patent
   d) submitting a Terminal Disclaimer
   e) none of the above

23) An application claiming priority under 35 U.S.C. 119(a) must contain, in the specification, a reference to the prior-filed application.
   a) True
   b) False

24) If an Office action has a mailing date of January 12, 2002 and a 3 month shortened statutory period of response, a response to that Office action can be timely filed
   a) by Express Mail on Mon. July 15, 2002 with a request for a 3 month extension of time

b) by first class mail on Mon. July 15, 2002 with a request for a 3 month extension of time and a Certificate of Mailing under 37 CFR 1.8
c) by facsimile on Mon. July 15, 2002 with a request for a 3 month extension of time and a Certificate of Facsimile transmission under 37 CFR 1.8
d) any of the above
e) none of the above

25) To support a *prima facie* case of obviousness when combining references under 35 U.S.C. 103, an examiner must:
a) consider objective evidence of non-obviousness that is disclosed in the specification
b) establish that the prior patents are in the same field of endeavor as the claimed invention and are reasonably pertinent to the particular problem with which the inventor was involved
c) show that one of the references includes an express suggestion of the desirability of combining the prior art references
d) all of the above
e) none of the above

26) Which of the following is a requirement pursuant to Title 37 of the Code of Federal Regulations?
a) The Summary section of an application must include objects of the invention.
b) Improvement claims must be in a two part or Jepson format.
c) The terms and phrases used in claims must find antecedent basis in the description.
d) The Background section of an application must describe prior art that is known to be material to patentability.
e) The broadest claim in an application must be first.

27) In an Office action, the examiner rejects claims 1-10 under 35 U.S.C. 102(e) as being anticipated by the Smith patent and in the alternative, under 35 U.S.C. 103 as being obvious over the Smith patent. This rejection is:
a) Improper because the same claims are rejected over the same prior art reference under two different statutory grounds.
b) Improper because the obviousness rejection must be based on a combination of references.
c) Improper because prior art under 35 U.S.C. 102(e) cannot be used in a rejection under 35 U.S.C. 103
d) All of the above
e) None of the above

28) Which of the following individuals do *not* have a duty to disclose information material to patentability?

a) a named inventor in the application
b) a registered patent attorney who prepares and files the application
c) a registered patent agent who responds to an office action in the application
d) a registered patent attorney who reviews a patent application but does not prepare or file the application
e) a president of the assignee of the application, who is not a named inventor and has not reviewed the application

29) A patent application was filed in the United States on July 21, 1999 without an Information Disclosure Statement. A counterpart European patent application was also filed on July 21, 1999. A European Search Report received on January 21, 2000 revealed the Smith patent, which was deemed to be material to patentability. On July 21, 2000, a first non-final Office action was received in the U.S. application, but the Smith patent was not cited in that Office action. Which of the following statements is true?

a) To have the Smith patent considered, the applicant can file a Request for Continued Examination with an Information Disclosure Statement citing the Smith patent.
b) To have the Smith patent considered, the applicant can file an Information Disclosure Statement with a response to the Office action without having to pay a fee under 37 CFR 1.17(i).
c) Applicant does not have a duty to disclose the Smith patent because it was discovered after the U.S. application was filed.
d) To have the Smith patent considered, the applicant can file an Information Disclosure Statement with a response to the Office action but must pay a fee under 37 CFR 1.17(i).
e) To have the Smith patent considered, the applicant must file a continuation.

30) Inventor Franklin files a patent application on August 11, 2001 with claims to a gadget. The examiner finds a published U.S. patent application to inventor Pierce and the same inventor Franklin, which was filed on August 10, 2000 and published on September 1, 2001. The published application discloses, but does not claim, the same gadget claimed in the Franklin application. Which of the following is true?

a) The examiner can reject the claims in the Franklin application over the claims in the published application on the grounds of Statutory Double Patenting.

b) The examiner can reject the claims in the Franklin application under 102(e) as being anticipated by the published patent application.
c) The examiner can reject the claims under 102(b) as being anticipated by the published patent application.
d) The examiner can reject the claims under 102(a) as being anticipated by the published patent application.
e) None of the above.

31) Inventor Brady files a patent application on July 21, 2001. The examiner rejects all of the claims under 35 U.S.C. 102(b) as being anticipated by another patent to the inventor Bledsoe and the same inventor Brady. The Bledsoe-Brady patent has a filing date of January 1, 1999 and an issue date of July 22, 2000. Which of the following will *not* overcome the rejection:
a) Filing a declaration under 37 CFR 1.131 establishing an earlier date of invention
b) Arguing that the claims are patentably distinguishable from the Bledsoe-Brady patent.
c) Amending the claims to be patentably distinguishable from the Bledsoe-Brady patent.
d) Arguing that the Bledsoe-Brady patent and the Brady application are non-analogous.
e) Perfecting a priority claim under 35 U.S.C. 120 based on the Bledsoe-Brady patent.

32) 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 1.132.
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.
d) amending the specification to include the subject matter necessary to satisfy the enablement requirement.
e) any of the above

33) Which of the following might result in a narrow construction of the claims?
a) Distinguishing the claims from the prior art
b) Defining the claim terms narrowly in the specification
c) Failing to disclose alternative embodiments of the invention
d) Stating that an element is essential to the invention
e) all of the above

34) In the case *In re Gordon*, the court found that the claimed invention was not obvious because:
   a) the claim recited the intended use with blood whereas the prior art device was used with gasoline.
   b) the claimed blood filter assembly was commercially successful.
   c) the inventor of the claimed blood filter assembly discovered the source of the problem.
   d) the proposed modification rendered the prior art device inoperable for its intended purpose.
   e) the claimed invention has a gas vent for venting gas whereas the prior art device has a pet-cock for removing dirt and water.

35) Which of the following cases does *not* refer to the notice function of patent claims?
   a) *Pioneer Magnetics, Inc. v. Micro Linear Corporation*
   b) *Sage Products Inc. v. Devon Industries Inc.*
   c) *Ex parte Fressola*
   d) *In re Hammack*
   e) *In re Dembiczak*

36) Which of the following starts the 20 year patent term?
   a) a priority date under 35 U.S.C. 120
   b) a priority date under 35 U.S.C. 119(e)
   c) a priority date under 35 U.S.C. 119(a)
   d) a) and b)
   e) a) and c)

37) An examiner can properly reject claims as "clearly anticipated" based on an inherent disclosure in a prior art reference.
   a) True
   b) False

38) When the U.S. Patent and Trademark Office construes patent claims during prosecution, the Abstract can be used to limit the scope of the claims.
   a) True
   b) False

39) 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) An issued patent on which the patent application claims priority under 35 U.S.C. 120.
   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."

40) In a patent application claiming a chemical composition, a working example is required to satisfy which of the following the requirements
   a) 35 U.S.C. 112, 1st paragraph
   b) 35 U.S.C. 101
   c) 37 CFR 1.71
   d) all of the above
   e) none of the above