

REPEAT QUESTIONS

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Q) Product by Process (4.00.6a)

6. Which of the following statements is true regarding a product-by-process claim?

- (A) Product-by-process claims cannot vary in scope from each other.
- (B) Product-by-process claims may only be used in chemical cases.
- (C) **A lesser burden of proof may be required to make out a case of prima facie obviousness for product-by-process claims than is required to make out a prima facie case of obviousness when the product is claimed in the conventional fashion.**
- (D) It is proper to use product-by-process claims only when the process is patentable.
- (E) **It is proper to use product-by-process claims only when the product is incapable of description in the conventional fashion.**

6. ANSWER: (C). MPEP § 2113, page 2100-51, citing *In re Fessman*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). (A) and (E) are incorrect because “[t]he fact that it is necessary for an applicant to describe his product in product-by-process terms does not prevent him from presenting claims of varying scope.” MPEP § 2173.05(p), item (I). (D) is incorrect even if it is not necessary to describe the product in product-by-process form. (D) is incorrect because “determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process.” MPEP § 2113, [p.2100-51]. (B) is incorrect. “A claim to a device, apparatus, claim, or composition of matter may contain a reference to the process in which it is intended to be used...so long as it is clear that the claim is directed to the product and not the process.” MPEP § 2173.05(p), item (I) [p.2100-174].

Q) Mario Lepieux (4.00.10a/4.00.11a)

10. Mario Lepieux was a member of a Canadian national hockey team touring Europe. While traveling through Germany (a WTO member country) in December 1998, Mario conceived of an aerodynamic design for a hockey helmet that offered players improved protection while reducing air resistance during skating. Upon Mario's return to Canada (a NAFTA country), he enlisted his brothers Luigi and Pepe Lepieux to help him market the product under the tradename "Wing Cap." On February 1, 1999, without Mario's knowledge or permission, Luigi anonymously published a promotional article written by Mario and fully disclosing how the Wing Cap was made and used. The promotional article was published in Moose Jaw Monthly, a regional Canadian magazine that is not distributed in the United States. The Wing Cap was first reduced to practice on March 17, 1999. A United States patent application properly naming Mario as the sole inventor was filed September 17, 1999. That application has now been rejected as being anticipated by the Moose Jaw Monthly article.

10. Which of the following statements is most correct?

(A) The promotional article cannot be used as prior art because the Wing Cap had not been reduced to practice at the time the article appeared in the regional Canadian magazine. (B) The regional Canadian magazine article is not *prima facie* prior art because it was published without Mario's knowledge or permission. (C) The regional Canadian magazine article is not *prima facie* prior art because it appeared in a regional Canadian publication and does not evidence knowledge or use in the United States. (D) The promotional article in the regional Canadian magazine constituted an offer to sell that operates as an absolute bar against Mario's patent application. (E) Mario, as the inventor, can overcome the rejection by filing an affidavit under 37 C.F.R. § 1.132 establishing that he is the inventor, and the article describes his work.

11. Which of the following statements is most correct?

(A) In a priority contest against another inventor, Mario can rely on his activities in Canada in establishing a date of invention.

(B) In a priority contest against another inventor, Mario can rely on his activities in Germany in establishing a date of invention.

(C) Mario can rely on his activities in Canada in establishing a date of invention prior to publication of the regional Canadian magazine article.

(D) (A) and (C).

(E) (A), (B), and (C).

10. ANSWER: (E). MPEP § 716.10.

11. ANSWER: (E). MPEP § 715.01(c).

Q) Laurel, Abbot and Hardy (4.00.14a)

14. On August 7, 1997, practitioner Costello filed a patent application identifying Laurel, Abbot, and Hardy as inventors. Each named inventor assigned his patent rights to Burns just prior to the application being filed. Laurel and Abbot, alone, jointly invented the subject matter of independent claim 1 in the application. Hardy contributed to inventing the subject matter of claim 2. Claim 2 properly depends upon claim 1. The examiner rejected claim 1 and claim 2 under 35 U.S.C. § 102(a) as anticipated by a journal article by Allen, dated July 9, 1997. Laurel, Abbot, and Hardy are readily available to provide evidence in support of and sign an antedating affidavit under 37 C.F.R. § 1.131 showing reduction to practice of the subject matter of claims 1 and 2 prior to July 9, 1997. Which of the following may properly make an affidavit under 37 C.F.R. § 1.131 to overcome the rejection of claims 1 and 2.?

- (A) Laurel and Abbot.
- (B) Laurel, Abbot, and Hardy.
- (C) Laurel, Hardy and Burns.
- (D) Burns only.
- (E) None of the above.

14. ANSWER: (B). MPEP 715.04. (A) is incorrect since it cannot be shown that less than all the inventors invented the subject matter of claim 2. (C) and (D) are incorrect since the assignee can make an affidavit under 37 C.F.R. § 1.131, only when it is not possible to produce the affidavit of the inventor. The facts indicate that all inventors were readily available produce the affidavit. (E) is incorrect since (B) is correct.

Q) SMITH LAMINATE (4.00.17A)

17. Smith invented a laminate. In a patent application, Smith most broadly disclosed the laminate as comprising a transparent protective layer in continuous, direct contact with a light-sensitive layer without any intermediate layer between the transparent protective layer and the light-sensitive layer. The prior art published two years before the effective filing date of Smith's application included a laminate containing a transparent protective layer and a light-sensitive layer held together by an intermediate adhesive layer. Which of the following is a proper claim that would overcome a 35 U.S.C. § 102 rejection based on the prior art?

- (A) A laminate comprising a transparent protective layer and a light-sensitive layer.
- (B) A laminate comprising a transparent protective layer and a light-sensitive layer which is in continuous and direct contact with the transparent protective layer.
- (C) A laminate comprising a transparent protective layer and a light-sensitive layer, but not including an adhesive layer.
- (D) (A) and (B).
- (E) (B) and (C).

A recent test taker noted that the question currently asked on the Prometric exam is a variant. The USPTO added a claim limitation distinction to correct the answer choice. The new question has two choices between using "Comprising" OR "Consisting of". The correct answer is the same answer from April 00 am practice exam.

ANSWER: (E) is correct because (B) and (C) are correct. (A) does not overcome the prior art because the broad "comprising" language permits the laminate to include additional layers, such as an adhesive layer. MPEP 2111.03. (B) overcomes a 35 U.S.C. § 102 rejection because the claim requires a light-sensitive layer to be in continuous and direct contact with the transparent protective layer, whereas the prior art interposes an adhesive layer between the light-sensitive layer and transparent protective layer. (C) also avoids the prior art by using a negative limitation to particularly point out and distinctly claim that Smith does not claim any laminate including an adhesive layer. MPEP 2173.05(i).

Q) Tommie and Jo (4.00.23a/4.00.24a)

Please answer questions 23 and 24 based on the following facts.

Jo invented a new and unobvious technique for inexpensively manufacturing a chemical that has been used in paper mills for years to bleach paper. Tommie developed a new and unobvious technique to clean-up toxic waste spills. Jo and Tommie collaborated to invent a method to clean-up toxic waste spills using the chemical made according to the unobvious technique invented by Jo. The inventions have been assigned to your client Dowel Chemical Company. You prepared a single patent application fully disclosing and claiming each invention. Claims 1-9 were directed to the method of manufacturing; claims 10-19 were directed to the method of cleaning up toxic waste spills; and claim 20 was directed to a method of cleaning up toxic waste spills using the chemical manufactured in accordance with claim 1. Both inventors approve the application, but Tommie is unavailable to sign an oath before an upcoming statutory bar. Accordingly, you are instructed to immediately file the application without an executed oath. On June 1, 1999, you file the application along with an information sheet to identify the application. However, you do not notice that Tommie was inadvertently left off the list of inventors on the information sheet, which listed Jo as the sole inventor. After receiving a Notice to File Missing Parts, you submit an oath executed by both Jo and Tommie. No paper was filed to change the named inventive entity. You later receive an Office action requiring restriction between Jo's invention and Tommie's invention. In reply to the restriction requirement, you elect Jo's invention, cancel claims 10-20, and immediately file a divisional application directed to the invention of claims 10-19. Claim 20 was omitted from the divisional application. The divisional application includes a specific reference to the original application and is filed with an inventor's oath executed by Tommie only. The divisional application incorporated the original application by reference.

23. Which of the following statements is correct?

- (A) Because the original application as filed only named Jo as an inventor, Tommie's divisional application is not entitled to the filing date of the original Application because there is no common inventor between the original application and the divisional application.
- (B) The incorrect inventorship listed on the information sheet of the original application was never properly corrected and, therefore, any patent issuing on that application will be invalid under 35 U.S.C. § 116 unless the inventorship is later corrected.
- (C) **After canceling claims 10-20, it is necessary to change the named inventive entity in the original application by filing a petition including a statement identifying Tommie as being deleted and acknowledging that Tommie's invention is no longer being claimed in the application and an appropriate fee.**

(D) **Written consent of the Dowel Chemical Company is required before Tommie can be deleted as an inventor in the original application.**

(E) It is necessary in the divisional application to file a petition including a statement identifying Jo as being deleted as an inventor and acknowledging that Jo's invention is not being claimed in the divisional application.

24. Which of the following statements is most correct?

(A) Since claim 20 was omitted from the divisional application as filed, it cannot be added to the divisional application by subsequent Amendment because such an Amendment would constitute new matter.

(B) **It was improper to include Tommie and Jo as joint inventors in the patent application.**

(C) The examiner may properly make a provisional obviousness-type double patenting rejection in the divisional application based on the parent application, but that rejection may be readily overcome with the filing of a terminal disclaimer.

(D) Because the inventive entity of the amended parent application is different than the inventive entity of the divisional application, the examiner may reject the claims of the divisional application under the provisions of 35 U.S.C. § 102(e).

(E) Statements (A), (B), (C) and (D) are each incorrect.

23. ANSWER: (C). **The original mistake in omitting Tommie from the list of inventors was automatically corrected by filing the oath executed by both Jo and Tommie.** 37 C.F.R. § 1.48(f)(1). Under 37 C.F.R. § 148(b), a change to the inventive entity is thereafter required upon cancellation of the non-elected claims. (B) is wrong because inventorship was automatically corrected with the filing of the corrected oath, (A) is wrong because Tommie was properly named as a co-inventor in the parent application, and 35 U.S.C. § 120 requires, *inter alia*, only one common inventor. (D) is incorrect because **an assignee's written consent is not required if an inventor is being deleted because the prosecution of the application results in the cancellation of claims so that fewer than a;; of the currently named inventors are the actual inventors of the inventions being claimed in the application.** 37 C.F.R. §148(b). (E) is incorrect because the divisional application never named Jo as an inventor so there is no need to correct the inventorship.

24. ANSWER: (E). Statement **(B) is wrong because at least claim 20 is properly viewed as a joint invention** ("JO and Tommie collaborated to invent a method to clean-up toxic waste spills using the chemical made according to the unobvious technique invented by Jo.") MPEP §§ 605.07, item (E), and 2137.01. Under 35 U.S.C. § 116, inventors may apply for a patent jointly even if they did not make the same type or amount of contribution and did not each make a contribution to the subject matter of every claim in the patent.

Q) Obviousness (4.00.32a)

32. Nonobviousness of a claimed invention may be demonstrated by:

- (A) **producing evidence that all the beneficial results are expected based on the teachings of the prior art references.**
- (B) producing evidence of the absence of a property the claimed invention would be expected to possess based on the teachings of the prior art.
- (C) **producing evidence showing that unexpected results occur over less than the entire claimed range.**
- (D) **producing evidence showing that the unexpected properties of a claimed invention have a significance less than equal to the expected properties.**
- (E) (A), (B), (C) and (D).

32. ANSWER: (B). See *Ex parte Mead Johnson & Co.*, 227 USPQ 78 (Bd. Pat. App. & Int. 1985); MPEP 716.02(a) page 700-155 (Absence of Expected Property is Evidence of Nonobviousness). (A) is incorrect. "Expected beneficial results are evidence of obviousness of the claimed invention." In *re Gershon*, 372 F.2d 535, 538, 152 USPQ 602, 604 (CCPA 1967), MPEP 716.02(c). (C) is incorrect. Unexpected results must be commensurate in scope with the claimed invention. In *re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 298, 296 (CCPA 1980); MPEP 716.02(d). (D) is incorrect. Evidence not showing that the unexpected properties of a claimed invention have a significance equal to or greater than the expected properties may be insufficient to rebut the evidence of obviousness. In *re Nolan*, 553 F.2d 1261, 1267, 193 USPQ 641, 645 (CCPA 1977); MPEP 716.02(c). (E) is incorrect because (A), (C) and (D) are incorrect.

Q) DECLASSIFIED REFERENCE (4.00.34A)

34. You have just received an Office action rejecting all of your claims in your patent application as anticipated under 35 U.S.C. § 102(a) using published declassified material as the reference. The examiner explains that the declassified material is being used as prima facie evidence of prior knowledge as of the printing date. The published declassified material contains information showing that it was printed six months before the filing date of the application, and that it was published two months after the application's filing date. You correctly note that although the printing date precedes your application filing date by six months, you note that the publication was classified as of its printing date (thus, available only for limited distribution even when the application was filed), and was not declassified until its publication date (when it became available to the general public). Each element of the claimed invention is described in the publication of the declassified material. Which of the following statements is true?

- (A) The rejection is not supported by the reference.
- (B) The publication is not available as a reference because it did not become available to the general public until after the filing date of your patent application.
- (C) **The publication is prima facie evidence of prior knowledge even though it was available only for limited distribution as of its printing date.**
- (D) The publication constitutes an absolute statutory bar.
- (E) It is not possible to use a Rule 131 affidavit or declaration to antedate the printing date of the publication.

34. ANSWER: (C). As stated in MPEP § 707.05(f), “**For the purpose of anticipation predicated upon prior knowledge under 35 U.S.C. 102(a), the above noted declassified material may be taken as prima facie evidence of such prior knowledge as of its printing date even though such material was classified at that time.**” (A) is incorrect. The reference supports the rejection inasmuch as each element of the claimed invention is disclosed in the reference. (B), (D), and (E) are not the most correct. MPEP § 707.05(f).

Q) REEXAMINATION (4.00.47A)

47. Which of the following, if any, is true?

- (A) The loser in an interference in the PTO is estopped from later claiming he or she was the first to invent in a Federal District Court since the loser must win in the PTO or he/she will lose the right to contest priority.
- (B) **A person being sued for infringement may file a request for reexamination without first obtaining the permission of the Court in which the litigation is taking place.**
- (C) A practitioner may not represent spouses, family members or relatives before the PTO since such representation inherently creates a conflict of interest and a practitioner is likely to engage in favoritism over his/her other clients.
- (D) Employees of the PTO may not apply for a patent during the period of their employment and for **two years** thereafter.
- (E) None of the above.

47. ANSWER: (B). **Any person at any time may file a request for reexamination.** 35 U.S.C. § 302. As to (A) loser may appeal to District Court under 35 U.S.C. § 146. As to (C), there is no prohibition regarding spouses, family members, and other relatives. As to (D) according to 35 U.S.C. § 4, employees are prohibited during the period of their employment and **one year** thereafter. As to (E), (B) is true.

Q) FEDERAL COURT DECISIONS BINDING FOR OFFICE (4.00.19P)

19. Which of the following is true?

- (A) A final decision by a United States District Court finding a patent to be **invalid** will have no binding effect during reexamination since the PTO may still find the claims of the patent to be valid.
- (B) A final decision by a United States District Court finding a patent to be **valid** will have no binding effect during reexamination since the PTO may still find the claims of the patent to be invalid.
- (C) Once the Court of Appeals for the Federal Circuit determines that the claims of a patent are valid, the USPTO may not find such claims invalid based upon newly discovered art.
- (D) If a patentee fails to disclose prior art to the PTO during regular prosecution, the only way that a patentee can disclose later discovered prior art to the PTO after issuance is by filing a request for reexamination.
- (E) Once a patent claim is found valid during a District Court Proceeding then the patent claims are entitled to a higher standard of patentability and the presumption of validity can only be rebutted by **clear and convincing evidence in a concurrent or later reexamination proceeding.**

19. ANSWER: (B) is the most correct answer. As to (A) and (B) see MPEP 2286, page 2200- 97, stating, “[t]he issuance of a final district court decision upholding validity during a reexamination also will have no binding effect on the examination of the reexamination.” Thus, (A) is incorrect because a **final holding of invalidity is binding on the PTO**. As to (C), the PTO may discover new art and find claims unpatentable as that art would raise a substantial new question. MPEP §§ 2216 and 2286. As to (D), the patentee could file a prior art statement under 35 U.S.C. § 301, or disclose prior art in reissue application if the original patent (through error without deceptive intent) is defective or claims more or less than should be claimed. As to (E), **preponderance of evidence standard does not change in reexamination proceedings**. MPEP 2286.

Q) GRAPE SQUEEZING (4.00.21P)

21. Mr. Roberts, an American citizen touring a vineyard, saw a unique grape-squeezing machine in France. The machine was highly efficient, and produced excellent wine. The vineyard owner was not hiding the machine. It was out of public view and was the only one of its kind. The vineyard owner had built it himself several years earlier, and no drawing or technical description of the machine was ever made. The vineyard made only local sales of its wines. Using his photographic memory, Roberts went back to his hotel and made technical drawings of what he had seen. Upon his return to the United States, Roberts promptly prepared and filed a patent application directed to the machine. Which of the following statements is correct?

- (A) Roberts may not obtain a patent on the machine because it was known by others before Mr. Roberts made technical drawings of the machine.
- (B) Roberts may not obtain a patent on the machine because wine made by the machine had been sold more than a year before Roberts' application filing date.
- (C) Roberts is entitled to a patent because a goal of the patent system is public disclosure of technical advances, and the machine would not have been disclosed to the public without Roberts' efforts.
- (D) Roberts may not obtain a patent on the machine because the vineyard owner was not hiding the machine and therefore the machine was in public use more than a year before Roberts' application filing date.
- (E) Statements (A), (B), (C) and (D) are each incorrect.

21. ANSWER: (E). Roberts is not entitled to a patent because he did not himself invent the subject matter sought to be patented. 35 U.S.C. § 102(f). Therefore, statement (C) cannot be correct. Statement (A) is incorrect because, although the machine was known by others, it was not known by others in this country as required under 35 U.S.C. § 102(a). Similarly, statements (B) and (D) are incorrect because, even if there was a sale or public use more than a year before Roberts' filing date, it was not "in this country" as required by 35 U.S.C. § 102(b).

Q) CLAIMS STAND OR FALL TOGETHER (4.00.28P)

28. Which of the following is true?

- (A) On appeal of a rejection of ten claims to the Board of Patent Appeals and Interferences, each appealed claim stands or falls separately as a result of **appellant pointing out differences in what the claims cover.**
- (B) The 2-month period for filing a petition mentioned in 37 CFR 1.181(f) is extendable under 37 CFR 1.136(a).
- (C) An examiner may enter a new ground of rejection in the examiner's answer to an applicant's appeal brief.
- (D) After filing a notice of appeal, an applicant is estopped from further prosecuting the same claims in a continuation application.
- (E) **When desiring to claim foreign priority, the oath or declaration in a reissue application must claim foreign priority even though the priority claim was made in the original patent.**

28. ANSWER: (E). See MPEP 1414 Content of Reissue Oath/Declaration and 37 CFR 1.175(a) which states that reissue oaths/declarations must meet the requirements of 37 CFR 1.63, including 1.63(c) relating to a claim for foreign priority. As to (A), 37 CFR 1.192(c)(7) requires appellant to state that the claims do not stand or fall together. Appellant must present appropriate argument under 37 CFR 1.192(c)(8) why each claim is separately patentable. **Merely pointing out differences in what the claims cover is not argument why the claims are separately patentable.** MPEP 1206, pages 1200-8 and 9. As to (B), see MPEP 1002 and the sentence bridging pages 1000-2 and 1000-3. As to (C), 37 CFR 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. As to (D), continuation may be filed during pendency of parent.

Q) 102(F) (4.00.44P)

44. Which of the following statements best correctly describes current PTO practice and procedure?

(A) **Where a patent discloses subject matter being claimed in an application undergoing examination, if the patent's designation of inventorship differs from that of the application, then the patent's designation of inventorship does not raise a presumption of inventorship regarding the subject matter disclosed but not claimed in the patent so as to justify a rejection under 35 U.S.C. § 102(f).**

(B) The fact that a claim recites various components, all of which can be argumentatively assumed to be old, provides a proper basis for a rejection under 35 U.S.C. § 102(f).

(C) A person can be an inventor without having contributed to the conception of the invention.

(D) In arriving at conception, an inventor may not consider and adopt ideas and materials derived from other sources such as an employee or hired consultant.

(E) It is essential for the inventor to be personally involved in reducing the invention to actual practice.

44. ANSWER: (A) is the most correct answer. See MPEP § 2137, p.2100-89. (B) is incorrect. The mere fact that the claim recites components, all of which can be argumentatively assumed to be old, does not provide a basis for rejection under 35 U.S.C. § 102(f). *Ex parte Billottet*, 192 USPQ 413, 415 (Bd. App. 1976); MPEP § 2137. (C) is incorrect. One must contribute to the conception to be an inventor. *In re Hardee*, 223 USPQ 1122, 1123 (Comm'r Pat. 1984). Unless a person contributes to the conception of the invention, the person cannot be an inventor. *Fiers v. Revel*, 984 F.2d 1164, 1168, 25 USPQ2d 1601, 1604-05 (Fed. Cir. 1993); MPEP § 2137.01 (section styled "An Inventor Must Contribute To The Conception of the Invention"). (D) is incorrect. An inventor may consider and adopt suggestions from many sources. *Morse v. Porter*, 155 USPQ 280, 283 (Bd. Pat. Inter. 1965); *New England Braiding Co. v. A.W. Cheterton Co.*, 970 F.2d 878, 883, 23 USPQ2d 1622, 1626 (Fed. Cir. 1992); MPEP § 2137.01 (section styled "As Long As The Inventor Maintains Intellectual Domination Over Making The Invention, Ideas, Suggestions, And Materials May Be Adopted From Others"). (E) is incorrect. *In re DeBaun*, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982) ("there is no requirement that the inventor be the one to reduce the invention to practice so long as the reduction to practice was done on his behalf"); MPEP § 2137.01 (section styled "The Inventor Is Not Required To Reduce The Invention To Practice").

Q) ABC and XYZ Corps. – Appeal (10.00.2a)

2. On December 31, 1998, Sam Practitioner files a notice of appeal in a patent application assigned to ABC Corp. after the examiner has rejected all of the claims on prior art. Within two months he sends in his appeal brief and three months after the examiner's answer is filed the case is sent to the Board of Patent Appeals and Interferences (Board). Subsequently, while reading the Official Gazette Sam notices that a patent **issued to XYZ Corp. on October 26, 1999**, contains claims which read on an unclaimed embodiment in the ABC application, which is an invention that is not within the scope of the invention claimed in the ABC application. The ABC application was filed one month after the issuance of the XYZ patent. Upon learning of the XYZ patent, ABC Corp. wants to provoke an interference by adding additional claims to its application relating to the previously unclaimed embodiment. It is October 18, 2000 and Sam comes to you for advice. Which of the following is the best and correct course of action?

- (A) Since the ABC application is at the Board of Patent Appeals and Interferences already, Sam need only request that the case be transferred to the Interference part of the Board where an interference can be declared between the ABC application and the XYZ patent.
- (B) Sam should file an amendment adding the claims copied from the XYZ patent and the Board is required to enter the amendment.
- (C) Sam should promptly file an amendment containing the claims copied from the XYZ patent and request entry. If the Board declines to enter the amendment, Sam should file a separate, continuation application **no later than October 26, 2000**, containing the claims copied from the XYZ patent as well as claims previously appealed, and then, to avoid the rendering of a decision of the Board, he should promptly inform the clerk of the Board in writing that they have decided to refile and abandon the application containing an appeal waiting a decision.
- (D) Sam should file an amendment containing the claims copied from the XYZ patent and ask that the interference between the ABC application and the XYZ patent be considered while the case is at the Board.
- (E) Sam should wait until the appeal is decided before filing an amendment to incorporate claims copied from the XYZ patent and to provoke an interference. There is no benefit to filing new claims since only allowable claims will be considered during an interference.

2. ANSWER: (C). 35 U.S.C. § 135(b) requires that the claim be made in the ABC patent within one year of the issuance of the XYZ patent. MPEP § 1211.01 states that there is no obligation resting on the Board to consider new or amended claims submitted while the case is on appeal. MPEP § 1210 states that when an application is refiled, the Board should be promptly notified. Failure to notify the Board may result in the Board's refusing an otherwise proper request to vacate its decision. See also MPEP § 2307.03. (E) is incorrect as 35 U.S.C. § 135(b) requires the claim to be made within one year. (D) is incorrect because the Board may refuse the amendment and because the claims have not yet been determined to be allowable. Note that the XYZ patent was filed before the ABC application and is therefore prior art under 35 U.S.C. § 102(e). See MPEP § 2306 and 2307.02.

Q) Prior Art (10.00.16a)

16. Which of the following statements regarding a proper prior art reference is true?

- (A) Canceled matter in the application file of a U.S. patent is a prior art reference as of the filing date under 35 U.S.C. 102(e).
- (B) **Where a patent refers to and relies on the disclosure of a copending subsequently abandoned application, such disclosure is not available as a reference.**
- (C) Where the reference patent claims the benefit of an earlier filed, copending but subsequently abandoned application which discloses subject matter in common with the patent, and the abandoned application has an enabling disclosure for the common subject matter and the claimed matter in the reference patent, the effective date of the reference patent as to the common subject matter is the filing date of the reference patent.
- (D) **Matter canceled from the application file wrapper of a U.S. patent may be used as prior art as of the patent date.**
- (E) All foreign patents are available as prior art as of the date they are translated into English.

16. ANSWER: (D). 35 U.S.C. § 102(a). As explained in MPEP § 901.01, the “matter canceled from the application file wrapper of a U.S. patent may be used as prior art as of the patent date in that it then constitutes prior public knowledge under 35 U.S.C. 102(a), *In re Lund*, 376 F.2d 982, 153 USPQ 625 (CCPA 1967). See also MPEP § § 2127 and § 2136.02.” (A) is incorrect. 35 U.S.C. § 102(e). As stated in MPEP § 901.01, “Canceled matter in the application file of a U.S. patent is not a proper reference as of the filing date under 35 U.S.C. 102(e), see *Ex parte Stalego*, 154 USPQ 52, 53 (Bd. App. 1966).” (B) is incorrect. As stated in MPEP § 901.02, “*In re Heritage*, 182 F.2d 639, 86 USPQ 160 (CCPA 1950), holds that where a patent refers to and relies on the disclosure of a copending abandoned application, such disclosure is available as a reference. See also *In re Lund*, 376 F.2d 982, 153 USPQ 625 (CCPA 1967).” (C) is incorrect. As MPEP § 901.02 indicates, where the reference patent claims the benefit of a copending but abandoned application which discloses subject matter in common with the patent, and the abandoned application has an enabling disclosure of the common subject matter and claimed matter in the reference patent, the effective date of the reference as to the common subject matter is the filing date of the abandoned application. *In re Switzer*, 77 USPQ 1, 612 O.G. 11 (CCPA 1948); *Ex parte Peterson*, 63 USPQ 99 (Bd. App. 1944); and *Ex parte Clifford*, 49 USPQ 152 (Bd. App. 1940).” (E) is incorrect. As stated in MPEP § 901.05, “In general, a foreign patent, the contents of its application, or segments of its content should not be cited as a reference until its date of patenting or publication can be confirmed by an examiner’s review of a copy of the document.”

Q) MEGACORP (10.01.5A)

5. You have agreed to represent an independent inventor in connection with a patent application that was filed in the USPTO by the inventor on a pro se basis. As filed, the application included a detailed written description that, when viewed together with four accompanying color photographs, enabled one of ordinary skill in the pertinent art to make and use the invention. The application was filed with an inventor's declaration in compliance with 37 CFR 1.63, a small entity statement (independent inventor) under 37 CFR 1.27, and all necessary small entity filing fees. MEGACORP, a very large multi-national corporation, licensed rights in the invention after the application was filed.

You have been asked to suggest steps to remove any formal objections that can be expected from the patent examiner, without incurring unnecessary government fees. You determine that the first color photograph is the only practical medium by which to disclose certain aspects of the claimed invention, but that the substance of the remaining photographs could readily be illustrated through ordinary ink drawings. You correctly recall that the Office announced in the Official Gazette in May 2001 (1246 OG 106) that it is sua sponte waiving 37 CFR 1.84(a)(2)(iii), and is no longer requiring a black and white photocopy of any color drawing or color photograph. Which of the following represents the most reasonable advice to the independent inventor?

(A) Submit a request for approval of drawing changes wherein the first photograph is labeled "Figure 1" and the remaining photographs are cancelled in favor of corresponding ink drawings labeled Figures 2 through 4; and immediately withdraw the claim for small entity status because of the license to MEGACORP.

(B) Submit a **request for approval** of drawing changes wherein the first photograph is labeled "Figure 1" and the remaining photographs are cancelled in favor of corresponding ink drawings labeled Figures 2 through 4; and submit a **petition for acceptance of Figure 1 in the form of a color photograph along with three sets** of the color photograph, a proposed amendment to insert language concerning the color photograph as the first paragraph of the specification and the required petition **fee. The photographs must be sufficient quality that all details in the photographs are reproducible in a printed patent.**

(C) Submit a request for approval of drawing changes wherein the first photograph is labeled "Figure 1" and the remaining photographs are cancelled in favor of corresponding ink drawings labeled Figures 2 through 4.

(D) Immediately withdraw the claim for small entity status because of the license to MEGACORP and submit to the USPTO the difference between the small entity filing fee and the large entity filing fee.

(E) File a rewritten application as a continuation application including a color photograph as Figure 1, ink drawings as Figures 2-4, a new inventor's declaration and a small entity filing fee.

5. ANSWER: The most correct answer is (B). 37 CFR 1.84(a)(2), MPEP § 608.02; Notice (Interim Waiver of Parts of 37 CFR 1.84 and 1.165, and Delay in the Enforcement of the Change in 37 CFR 1.84(e) to No Longer Permit Mounting of Photographs) in Official Gazette May 22, 2001, 1246 OG 106 ("In summary, the USPTO has sua sponte waived 37 CFR 1.84(a)(2)(iii) and 1.165(b) and is no longer requiring a black and white photocopy of any color drawing or photograph")

Q) Able and Baker (10.01.24a)

24. Able and Baker conceived an improved gas grille for cookouts. Using elements A, B, C, D, E and F found in their backyards, as well as elements G, H, I, J, K, L, M and N purchased at a local hardware store, they successfully constructed and used a gas grille conforming to their concept. The grille includes subcombination of elements K, L and M conceived by Able, and subcombination C, D, F, G and M conceived by Baker. Able and Baker conceived their respective subcombinations separately and at different times. Able and Baker retain you to prepare and file a patent application for them. You are considering whether and what can be claimed in one patent application. Which of the following is true?

- (A) For Able and Baker to properly execute an oath or declaration under 37 CFR 1.63 in a patent application claiming not only the grille, but also the two subcombinations, Able and Baker must be joint inventors of the grille, and each of the two subcombinations.
- (B) A characteristic of U.S. patent law that is generally shared by other countries is that the applicant for a patent must be the inventor.
- (C) If Able and Baker execute an oath or declaration under 37 CFR 1.63 as joint inventors and file an application claiming the grille (a combination of elements A, B, C, D, E, F, G, H, I, J, K, L, M and N), the existence of the claim to the grille is evidence of their joint inventorship of the individual elements.
- (D) **Able and Baker may properly execute an oath or declaration under 37 CFR 1.63 as joint inventors and file an application containing claims to the grille (a combination of elements A, B, C, D, E, F, G, H, I, J, K, L, M and N), claims to the subcombination conceived by Able, and claims to the subcombination conceived by Baker.**
- (E) Able and Baker could not properly claim the combination unless they successfully and personally reduced the grille to practice.

The above answer is D.

§ 2137.01, “Inventorship,” and see *Kimberly-Clark Corp. v. Procter & Gamble Distributing*, 23 USPQ2d 1921, 1925 – 26 (Fed. Cir. 1992); and *Moler v. Purdy*, 131 USPQ 276, 279 (Bd. Pat. Inter. 1960). (A) is not correct. MPEP § 2137.01 (Requirements for Joint Inventorship) and see *Kimberly-Clark Corp. v. Procter & Gamble Distributing*, 23 USPQ2d 1921, 1925 – 26 (Fed. Cir. 1992); and *Moler v. Purdy*, 131 USPQ 276, 279 (Bd. Pat. Inter. 1960). (B) is not correct. 35 U.S.C. §§ 101, 115; MPEP § 2137.01. (C) is not correct. MPEP § 2137.01. The inventor of an element, per se, and the inventor of a combination using that element may differ. See *In re DeBaun*, 214 USPQ 933, 936 (CCPA 1982); and *In re Facius*, 161 USPQ 294, 301 (CCPA 1969). (E) is not correct. There is no provision in the Patent Statute requiring the invention to be reduced to practice in order to file a patent application claiming the invention. Further, see MPEP § 2137.01; and see *In re DeBaun*, 214 USPQ 933, 936 (CCPA 1982).

Q) Smith's Drawings (10.01.3p)

3. Practitioner Smith filed a utility patent application on January 5, 2001, with informal drawings. Upon review of the drawings, the USPTO concluded that the drawings were not in compliance with the 37 CFR 1.84(a)(1) and (k), and were not suitable for reproduction. In an Office communication, Smith was notified of the objection and given two months to correct the drawings so that the application can be forwarded to a Technology Center for examination. Which of the following complies with USPTO practices and procedures for a complete bona fide attempt to advance the application to final action?

- (A) Smith timely files a response requesting that the objections to the drawings be held in abeyance until allowable subject matter is indicated.
- (B) Smith timely files a response requesting that the objections to the drawings be held in abeyance since the requirement increases up-front costs for the patent applicant, and the costs can be avoided if patentable subject matter is not found.
- (C) Smith timely files a response requesting that the objections to the drawings be held in abeyance until fourteen months from the earliest claimed priority date.
- (D) Smith timely files a response correcting the drawings to comply with 37 CFR 1.84(a)(1) and (k), and making them suitable for reproduction.
- (E) All of the above.

3. ANSWER: (D). Under 37 CFR 1.85(a), correcting the drawings to comply with 37 CFR 1.84(a)(1) and (k), and making them suitable for reproduction is a bona fide response. (A), (B), and (C) are not the most correct answer. In each, Smith seeks to hold the requirement in abeyance. As stated in 37 CFR 1.85(a) (effective November 29, 2000), "Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a bona fide attempt to advance the application to final action." See also, "Changes to Implement Eighteen-Month Publication of Patent Applications; Final Rule," 65 F.R. 57024, 57032, "Section 1.85." (E) is not the most correct answer inasmuch as (A), (B), and (C) are not the most correct answers.

Q) 35 USC 102(e) (4.02.11a)

Applicant files a patent application in Japan on February 28, 1996. Applicant files a CT international application designating the United States on February 27, 1997, based on the Japanese application. The international application is published in English on August 28, 1997. The international application enters the national stage in the United States on August 28, 1998. The USPTO publishes the application on June 7, 2001 at the request of the applicant. The application issues as a United States patent on December 4, 2001.

11. When examining an application filed on or after November 29, 2000 or any application that has been voluntarily published, what is its earliest possible prior art date, for the June 7th U.S. published application in view of 35 U.S.C. § 102(e) as amended by the American Inventors Protection Act of 1999?

- (A) February 28, 1996.
- (B) **February 27, 1997.**
- (C) August 28, 1997.
- (D) August 28, 1998.
- (E) June 7, 2001.

11. ANSWER: (B) is the most correct answer. 35 U.S.C. § 102(e)(1) provides that a USPTO published application, based on an earlier international application, has prior art effect as of its international filing date, if the international application designated the United States, and was published in English. Because in the above fact pattern, the international application designated the United States and was published in English, the USPTO published application is entitled to its international filing date of February 27, 1997 for prior art purposes. (A) is wrong because the Japanese filing date is relevant under 35 U.S.C. § 119 only for priority, but not for prior art purposes. (C) and (E) are wrong because they recite prior art dates that are later than February 27, 1997. (D) is wrong because the amendments to § 102(e) by the American Inventors Protection Act of 1999 make the national stage entry date irrelevant for prior art purposes.

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