

**Examination for Registration to Practice in Patent Cases
Before the U.S. Patent and Trademark Office
November 3, 1999**

Morning Session Answers

1. ANSWER: (E). MPEP §§ 1502.01, and 201.04(b) [p. 200-14].
2. ANSWER: (D). “It is not necessary in order to establish a prima facie case of obviousness...that there be a suggestion or expectation from the prior art that the claimed [invention] will have the same or a similar utility as one newly discovered by the applicant.” *In re Dillon*, 919 F.2d 688, 692, 16 USPQ2d 1897, 1900 (Fed. Cir. 1990) (emphasis in original). Thus, “[i]t is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant.” MPEP § 2144 (“Rationale Different from Applicant’s is Permissible”).
Here, T suggests the combination with P to achieve a different advantage or result, i.e., waterproofing, from that discovered by applicant, i.e., reducing breakage. Answers (A) - (C) are incorrect because the suggestion to combine does not need to be for the same purpose as applicant discloses in the application. *Dillon*, 919 F.2d at 692, 16 USPQ2d at 1900; MPEP § 2144 (“Rationale Different from Applicant’s is Permissible”). Answer (E) is incorrect because an applicant is under no obligation to submit evidence of non-obviousness unless the examiner meets his or her initial burden to fully establish a prima facie case of obviousness. MPEP § 2142.
3. ANSWER: (E). Both (B) and (D) cannot be incorporated into a U.S. utility application. MPEP § 608.01(p) [pp. 600-72-73].
4. ANSWER: (D) and (E). (D) is a correct statement because a claim that includes a tradename, whose definition is neither sufficiently precise nor definite, fails to comply with 35 U.S.C. § 112, paragraph 2. Claim 2 has two tradenames, “Acme SmellNice” and “A-1 Silky.” The ingredient composition of “Acme SmellNice” has “recently changed,” and the change is “unknown,” and otherwise indefinite. MPEP §§ 608.01(v), and 706.03(d); and *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). (E) is also correct to the extent (B) correctly points out that an incorrect theory of operation is incorporated into a claim, that claim is invalid under either 35 U.S.C. § 101 (utility) or 35 U.S.C. § 112 (enablement). *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 220 USPQ 592, 596 (Fed. Cir. 1983). (B) alone is not accepted as a correct answer because no fact was given preceding the answer that claim 2 sets for an incorrect theory of formation of chemical X, whereas sufficient facts were given to recognize that (D) is a correct answer. (A) is incorrect at least because prophetic examples may well provide an enabling disclosure. MPEP 608.01(p), and 2164.02. Also, an inventor need not understand how an invention works. (C) is incorrect because naturally occurring compounds may be patented particularly when a new use (industrial lubricant) is part of the claim.
5. ANSWER: (D). 37 CFR § 1.116; MPEP § 714.13, Entry Not Matter of Right [p. 700-124]. The reply in (D) is directed to a reply authorized under 37 CFR § 1.116(a). (A), (B), and (C) are directed to the merits of the application, and are not in accord with 37 CFR § 1.116(a).

6. ANSWER: All answers are accepted.
7. ANSWER: (C) is the most correct answer. 37 CFR § 1.116; MPEP § 714.13.
8. ANSWER (C). MPEP § 2163.03, item I. Original claims constitute their own description *In re Koller*, 613 F.2d 819, 204 USPQ 702 (CCPA 1980). (A) and (B) are incorrect. As stated in MPEP § 2163.03, item I, “An amendment to the specification (e.g., a change in the definition of a term used both in the specification and claim) may indirectly affect a claim even though no actual amendment is made to the claim.” There is no supporting disclosure in the original description of the invention for the holder to a clasp, crimp, or tong. (D) is incorrect. MPEP § 2163.03, item IV. A broad generic disclosure is not necessarily a sufficient written description of a specific embodiment, especially where the broad generic disclosure conflicts with the remainder of the disclosure. *Fields v. Conover*, 443 F.2d 1386, 170 USPQ 276 (CCPA 1970). (E) is not correct because (C) is correct.
9. ANSWER: (C). Dependent Claim 4 must further limit Claim 1 from which it depends. 35 U.S.C. § 112, paragraph 4; 37 CFR § 1.75(c). The dependent claim 4 in (C) improperly seeks to broaden Claim 1 by omitting an element set forth in the parent claim.
10. ANSWER: (C). “A claim may be written in dependent or multiple dependent form.” 35 U.S.C. § 112, paragraph 3. When written in dependent form, the claim “shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed.” 35 U.S.C. § 112, paragraph 4. When written in multiple dependent form, the claim “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.” 35 U.S.C. § 112, paragraph 5. See also 37 CFR § 1.75(c); MPEP § 608.01(n). Here, the claim is in proper multiple dependent form, referring back in the alternative to claims previously set forth, *i.e.*, claims 1, 2 or 3. Answers (A) and (B) are incorrect because each claim does not refer back to a preceding claim. In Answer (A), claim 4 refers to claim 5. In Answer (B), claim 2 refers to claim 5. 35 U.S.C. § 112, paragraph 4; 37 CFR § 1.75(c); MPEP § 608.01(n) (“2. Claim Does Not Refer to a Preceding Claim”). Answers (D) and (E) are incorrect because each claim does not refer back in the alternative. In Answer (D), claim 3 refers to all the preceding claims, *i.e.*, claims 1, 2 and 3. In Answer (E), claim 5 refers to claims 1 and 2, or claim 3. 35 U.S.C. § 112, paragraph 5; 37 CFR § 1.75(c); MPEP § 608.01(n) (“1. Claim Does Not Refer Back in the Alternative Only”).
11. ANSWER: (B). The question is directed to the proper conduct by patent attorneys and agents. Practitioners, including registered patent agents, (37 CFR § 10.1(r)), may advertise on television and radio. 37 CFR § 10.32(a). Additionally, a registered patent agent may accept cases on a contingent fee basis. 37 CFR § 10.36(b)(8) (permits contingent and fixed fees that are not clearly excessive or illegal). (A) and (C) are incorrect. The patent agent is not authorized to practice in trademark cases. 37 CFR § 10.14(b). (D) is incorrect. Practitioners are proscribed

from entering into partnership agreements restricting their right to practice before the PTO. 37 CFR § 10.38(a). The agreement in choice (D) provides “that after termination of the partnership, the agent and the attorney will not practice in each other’s neighborhoods or accept each other’s established clients,” which is contrary to §10.38(a). (E) is incorrect. A patent agent is proscribed from misrepresenting himself or herself as being a registered patent attorney. 37 CFR §§ 10.23(b)(4) and 10.34(b).

12. ANSWER: (C). 35 U.S.C. § 102(b) and (e); 37 CFR § 1.131(a). A reference under 35 U.S.C. § 102(b) cannot be antedated. Therefore, (A), (B) and (E) are incorrect. (D) is incorrect because it is non-responsive, and it does not matter when the Spot patent issued.

13 ANSWER: (A). 35 U.S.C. §§ 102, and 103. Anticipation requires that each and every limitation in the claim be shown in a single reference, either expressly or impliedly. MPEP §§ 706.02, and 2131. Here, Claim 1 has been amended to require that the seat portion be formed of plastic (see fifth and sixth lines following the claim). Baker does not disclose or imply a plastic seat. However, Baker does disclose the recited “supporting means” because under 35 U.S.C. § 112, paragraph 6, that claim language covers under its literal scope the disclosed structure (four legs) and equivalent structures (three legs), and Able’s argument is therefore unconvincing. MPEP § 2181. An obviousness rejection over Baker/Charlie is appropriate because Charlie suggests replacing wooden seats with plastic seats. MPEP §§ 706.02, and 2143. (B) is not the most correct answer because the rationale that “Baker does not disclose a four legged supporting means” does not distinguish Baker from the claimed subject matter. Under 35 U.S.C. § 112, paragraph 6, the “means for supporting” in Claim 1 is equivalent to the supporting means disclosed in Baker inasmuch as the claimed means is not limited to four legs. The “three legged” supporting means in Baker is within the literal scope of the claim, and anticipation is not avoided on that basis. (C) is not the most correct answer because the issue of whether one of ordinary skill in the art would recognize that plastic could be substituted for wood goes to obviousness, not anticipation. Maintaining the anticipation rejection is improper because the claim has been amended to require that the seat portion be formed of plastic (see fifth and sixth lines following the claim), a limitation not disclosed by Baker. (D) is incorrect because there is an adequate written description of the plastic seat in the application, and applicants commonly (and properly) limit claims to a preferred embodiment during prosecution. MPEP § 2172 (III. SHIFT IN CLAIMS PERMITTED). (E) is incorrect because (B) and (D) are both incorrect.

14. ANSWER: (E). A claim may be amended by specifying the exact matter to be deleted or added, and the precise point where the deletion or addition is to be made. 37 CFR § 1.121(a)(2)(i). The amendments are limited to additions of no more than 5 words per claim or deletions. 37 CFR §§ 1.121(a)(2)(i)(A) and 1.121(a)(2)(i)(B). Here, Answer (A) is improper because the amendment does not specify the precise point where the addition is to be made. Answer (B) is improper because the amendment adds more than 5 words to the claim. Answer (C) is improper because line 3 contains the word “layer” twice and the amendment does not specify whether the word “thin” is added before the first occurrence, second occurrence, or

all occurrences of the word “layer.” Answer (D) is improper because the amendment gives no direction for who to correctly spell “talbecloth.”

15. ANSWER: (C). 37 CFR § 1.75(c). A dependent claim must further limit the claim from which it depends. The claim in (C) is an improper dependent claim because it includes resistance outside the scope of Claim 1. In the claim in (C), the term “about” allows for a range slightly above 90 ohms or below 10 ohms, which is “outside” the scope of Claim 1. See MPEP § 2144.05. (A), (B), and (D) are proper dependent claims because they further limit Claim 1 by limiting the resistance to amounts within the scope of Claim 1. (E) is incorrect because (D) is a proper dependent claim.

16. ANSWER: (D). MPEP § 1210.

17. ANSWER: (C). 35 U.S.C. § 305 recites, *inter alia*, “No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter.” MPEP §§ 2254, and 2258, item III. Since no claims drawn to a method were ever presented during prosecution of the ‘XXX patent, (claims 1-4 “are the only claims that were presented during prosecution of the application that matured into ‘XXX patent”), the claim recited in (C) is not directed to “the invention as claimed.” Moreover, such claim is regarded as enlarging the scope of the claims in the ‘XXX patent. *Ex parte Wikdahl*, 10 USPQ2d 1546, 1549 (Bd. Pat. App. & Int. 1989). (A), (B), and (C) are all incorrect because each of their claims are directed to a hydrocyclone separator apparatus, i.e., “the invention as claimed,” and they do not enlarge the scope of the claims in the ‘XXX patent. (E) is an incorrect answer because (C) is the correct answer.

18. ANSWER: (A). The phrase “consisting of” excludes any step not specified in the claim. MPEP § 2111.03. Thus, a claim that depends from a claim which “consists of” the recited steps cannot add a step. *Id.* Here, the dependent claim adds the step of cooling. Answer (B) is incorrect because the transitional term “comprising” is inclusive or open-ended and does not exclude additional, unrecited steps. MPEP § 2111.03. Answers (C) and (D) are incorrect because the terms “including” and “characterized by” are synonymous with the term “comprising.” MPEP § 2111.03. Answer (E) is incorrect because Answer (C) and Answer (D) are incorrect.

19. ANSWER: (A). MPEP § 2144. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991). (B) is incorrect. MPEP § 2144. The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). (C) is incorrect. MPEP § 2144.01. *In re Preda*,

401 F.2d 825, 159 USPQ 342, 344 (CCPA 1968) (“[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.”). (D) is incorrect. *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970) (Board properly took judicial notice that “it is common practice to postheat a weld after the welding operation is completed” and that “it is old to adjust the intensity of a flame in accordance with the heat requirement”); and MPEP § 2144.03. (E) is incorrect. MPEP § 2144.06 (Substituting Equivalents Known For The Same Purpose). To rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure. *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958).

20. ANSWER: (A). (A) provides proper antecedent basis for “said mid-point” in part (iv) of Claim 1 and in Claim 2, and “said connector” in Claim 3. (B) is incorrect at least because it includes the unnecessary limitation that the cutting members are formed of metal and because it does not provide antecedent basis for “said connector” in Claim 3. (C) is incorrect because it includes the unnecessary limitation of a reservoir, and it does not provide antecedent basis for “said connector” in Claim 3. (D) is incorrect because it does not provide antecedent basis for “said mid-point” in part (iv) of Claim 1 and Claim 2, and for “said connector” in Claim 3. (E) is incorrect because it does not provide proper antecedent basis for “said mid-point” in part (iv) of Claim 1 and in Claim 2.

21. ANSWER: (C). 35 U.S.C. § 301; 37 CFR § 1.552; and MPEP § 2258. (A), (B), (D) and (E) are incorrect because reexamination is limited to substantially new questions of patentability based on patents and publications.

22. ANSWER: (B). The scope of Claim 1 is enlarged, or broadened by the deletion of “flanged” as a modifier of “seal.” Inasmuch as the reissue application is filed less than two years after the original patent was granted, and the application seeks to enlarge the scope of Claim 1, a reissue patent may be properly granted containing the claim. 35 U.S.C. § 251. (A) is incorrect. Inasmuch as the scope of Claim 1 is enlarged by the amendment and the reissue application was filed more than two years from the grant of the original patent, no reissue patent shall be granted. 35 U.S.C. § 251. (C) and (D) are incorrect inasmuch as the scope of Claim 1 is enlarged, or broadened as discussed above, and claims cannot be enlarged or broadened in a reexamination application regardless of when the application is filed. 35 U.S.C. § 305; 37 CFR § 1.552(b). (E) is incorrect since (D) is incorrect.

23. ANSWER: (C). Under the stated facts, Homer’s commercial use is a bar under 35 U.S.C. § 102(b) because it was not experimental, so (C) would be unreasonable advice. MPEP § 2133.03. For the same reason, and because the modified system is new and unobvious, (B) would be reasonable advice. (A) would be reasonable advice because whether the claim is limited to ultrasonic signals is a question of breadth, not definiteness. MPEP § 2173.04. (D) is reasonable advice because there is no antecedent basis for “the decoder portion of said tunneling device

sensor”. (E) is reasonable advice because an argument could be made that the claim, as originally drafted, could not be infringed until the target is actually placed in the ground. Thus, a sale of the system, with the target in a box, technically might not be a literal infringement of that claim.

24. ANSWER: (A). 35 U.S.C. § 102(b). The claimed invention is unpatentable inasmuch as the invention was in public use and on sale more than one before Homer files a patent application. (B) - (D) are incorrect because the given facts do not meet the conditions negating patentability set forth in 35 U.S.C. § 102(c), (d), or (e). (E) is incorrect because (A) is correct.

25. ANSWER: (C). The PTO does not require or recommend a minimum or maximum number of dependent claims. 37 CFR § 1.75(c). (A) is a PTO recommendation. See MPEP § 608.01(m) (“Claims should preferably be arranged in order of scope so that the first claim presented is the least restrictive.”). (B) is a PTO recommendation. See MPEP § 608.01(m) (“Similarly, product and process claims should be separately grouped.”). (D) is a PTO requirement. See MPEP § 608.01(n), at 600-63 (Claim Form and Arrangement). (E) is a PTO requirement. See MPEP § 608.01(m) (“Each claim begins with a capital letter and ends with a period.”).

26. ANSWER: (C). The combination of references presents a substantial new question of patentability. MPEP § 2244. *In re Hiniker Co.*, 150 F.3d 1362, 47 USPQ2d 1523 (Fed Cir. 1998) (where the prior art references are applied in combination, and one reference served as a rejection in the prosecution of the original patent while the other reference “was never before the examiner during the original prosecution and is thus new art[, and t]here is no indication that the [new art] was not material to the question of obviousness vel non or that it was cumulative with any old art” the decisions rejecting the claims “were based on a substantial new question of patentability.” Answers (A) and (D) are incorrect because a “prior art reference that served as a rejection in the prosecution of the original patent could not support a substantial new question of patentability that would permit the institution of a reexamination proceeding.” *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ 1776 (Fed. Cir. 1996). Answer (B) is incorrect because “prior art that was before the original examiner could not support a reexamination proceeding despite the fact that it was not the basis of a rejection in the original prosecution; as long as the art was before the original examiner, it would be considered ‘old art’.” *In re Portola Packaging, Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997). Answer (E) is incorrect because answers (A), (B) and (D) are incorrect.

27. ANSWER: (B). “Whoever invents or discovers any new and useful...manufacture, or composition of matter...may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. However, “laws of nature, physical phenomena, and abstract ideas” are not subject matter eligible for protection under the patent statute. Diamond v. Chakrabarty, 447 U.S. 303, 309, 206 USPQ 193, 198 (1980). But, a “nonnaturally occurring manufacture or composition of matter—a product of human ingenuity—having a distinctive name, character, [and] use” is subject matter eligible for protection under the patent statute. Id.

See also MPEP § 2105. Thus, Answer (B) is correct because the top soil is a product of M's ingenuity. Answer (A) is incorrect because the top soil is a physical phenomenon, *i.e.*, naturally occurring manufacture or composition of matter, M was merely the first to locate. Chakrabarty, 447 U.S. at 309, 206 USPQ at 198; MPEP § 2105. Answer (C) is incorrect because only non-naturally occurring inanimate objects, *i.e.*, products of human ingenuity, are subject matter eligible for protection under the patent statute. Chakrabarty, 447 U.S. at 309, 206 USPQ at 198; MPEP § 2105.

28. ANSWER: (E). The cancellation of Claim 3 overcomes the examiners objection. The addition of Claim 4 and 5 provide the client with patent protection in product by process format for the cable by both methods of manufacture. Thus, if Claim 4 is invalid, Claim 5 may remain valid. Answer (A) is incorrect because it is an improper multiple dependent claim. 35 U.S.C. § 112, paragraph 5; 37 CFR § 1.75(c); MPEP § 608.01(n) (“1. Claim Does Not Refer Back in the Alternative Only”). Answer (B) alone is incorrect because, even though canceling the claim will overcome the rejection, it will also leave the application without a claim to the Ethernet cable made using the processes set forth in either claim 1 or claim 2.

29. ANSWER: (A). MPEP § 2133.03(b), item III (A). “Public” as used in 35 U.S.C. 102(b) modifies “use” only. “Public” does not modify “sale.” *Hobbs v. United States*, 451 F.2d 849, 171 USPQ 713, 720 (5th Cir. 1971). (B) is incorrect. MPEP § 2133.03(b), item IV (A). Sale or offer for sale of the invention by an independent third party more than 1 year before the filing date of applicant's patent will bar applicant from obtaining a patent. Although “an exception to this rule exists where a patented method is kept secret and remains secret after a sale of the unpatented product of the method. Such a sale prior to the critical date is a bar if engaged in by the patentee or patent applicant, but not if engaged in by another.” *In re Caveney*, 761 F.2d 671, 675-76, 226 USPQ 1, 3-4 (Fed. Cir. 1985). (C) is incorrect. MPEP § 2133.03(d). An offer for sale, made or originating in this country, may be sufficient prefatory activity to bring the offer within the terms of the statute, even though sale and delivery take place in a foreign country. The same rationale applies to an offer by a foreign manufacturer, which is communicated to a prospective purchaser in the United States prior to the critical date. *C.T.S. Corp. v. Piher Int'l Corp.*, 593 F.2d 777201 USPQ 649 (7th Cir. 1979). (D) is incorrect. MPEP § 2134. Delay alone is not sufficient to infer the requisite intent to abandon. *Moore v. U.S.*, 194 USPQ 423, 428 (Ct. Cl. 1977) (The drafting and retention in his own files of two patent applications by inventor indicates an intent to retain his invention; delay in filing the applications was not sufficient to establish abandonment). (E) is incorrect. MPEP § 2135.01, item III (B). *Ex parte Links*, 184 USPQ 429 (Bd. App. 1974) (German applications, which have not yet been published for opposition, are published in the form of printed documents called Offenlegungsschriften 18 months after filing. These applications are unexamined or in the process of being examined at the time of publication. The Board held that an Offenlegungsschriften is not a patent under 35 U.S.C. § 102(d) even though some provisional rights are granted. The court explained that the provisional rights are minimal and do not come into force if the application is withdrawn or refused.).

30. ANSWER: (D). 37 CFR § 1.16(a) and (e); and MPEP § 509.01, which states, “For applications filed after February 27, 1983, if there is an authorization to charge the filing fee to a deposit account which is overdrawn or has insufficient funds, a surcharge (37 CFR § 1.16(e)) is required in addition to payment of the filing fee. Failure to timely pay the filing fee and surcharge will result in abandonment of the application.”

31. ANSWER: (D). 37 CFR § 1.75(c); MPEP § 608.01(n).

32. ANSWER: (B). When an amendment accompanies a non-provisional patent application filed without a signed declaration, the amendment is considered part of the original disclosure, provided that the subsequently filed declaration refers to both the patent application and the amendment. MPEP §§ 608.04(b), and 714.09. Here, the application was filed with an unexecuted declaration, *i.e.*, an unsigned declaration. Thus, the best way to overcome the rejection is to file an executed declaration that refers to both the application and amendment.

Answer (A) is incorrect because the declaration must refer to both the application and amendment. MPEP §§ 608.04(b), and 714.09. Answer (C) is incorrect because, even if the original declaration had been signed, the original disclosure of an application cannot be altered by filing a supplemental declaration that refers to paper different from those referred to in the original declaration. 37 CFR § 1.67(b) (no new matter may be introduced into a non-provisional patent application after its filing date even if a supplemental declaration is filed). See also MPEP § 608.04(b). Answer (D) is incorrect because an examiner’s objection to an amendment as adding new matter to the specification is a matter petitionable to the Commissioner, pursuant to 37 CFR § 1.181(a)(1). See also MPEP § 608.04(c). Answer (E) is incorrect because, while canceling the new matter will overcome the examiner’s objection, it is not the best way to overcome the rejection because, after cancellation, the application will fail to set forth the best mode contemplated by the inventor of carrying the claimed invention. 35 U.S.C. § 112.

33. ANSWER: (D). MPEP § 2258, item III. (A) is incorrect because it is nonsensical and the form of the amendment is proper. MPEP § 2250. (B) is incorrect because the amendment broadens the scope of the claim of the patent, which is never allowed in a reexamination proceeding. MPEP § 2258, item III. (C) is incorrect because a claim is broader than another claim if it is broader in any respect, even though it may be narrower in other respects. MPEP § 2258, item III. (E) is incorrect because (D) is correct.

34. ANSWER: (A). MPEP § 2144.05, item III states, “Applicant can rebut a *prima facie* case of obviousness based on overlapping ranges by showing the criticality of the claimed range,” citing *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). (B) is incorrect. MPEP § 2145, item II. Mere recognition of latent properties contained in the prior art does not render nonobvious an otherwise known invention. The court, in *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979), points out that granting a patent on the discovery of latent or unknown, but inherent property would remove from the public that which is in the public domain

by virtue of the property's inclusion in, or obviousness from, the prior art. (C) is incorrect. MPEP § 2145, item VII. The fact that a combination would not be made by a businessman for economic reasons does not mean that a person of ordinary skill in the art would not make the combination because of some technological incompatibility. *In re Farrenkopf*, 713 F.2d 714, 219 USPQ 1 (Fed. Cir. 1983). (D) is incorrect. MPEP § 2145, item IV. Nonobviousness cannot be shown by attacking references individually where the rejection is based on a combination of references. *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). (E) is incorrect (B) and (C) are incorrect.

35. ANSWER: (C). 35 U.S.C. § 41(b); 37 CFR § 1.20(e). There is no maintenance fee for a plant patent. Thus, all of the other answers, which assume that a maintenance fee is owed, are wrong.

36. ANSWER: (C). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See also MPEP § 2131. Further, the use of the phrase “up to” includes zero as a limit, and the use of the phrase “a water content of not more than” includes no water, i.e., dry, as a limit. MPEP § 2173.05(c) (“II. Open-Ended Numerical Ranges”). Here, Answer (C) shows 76% cellulose, 16% nylon, 0% fiber, 8% cotton (“balance cotton”) and no water content. Thus, the reference sets forth all the claim limitations. Answer (A) is incorrect because the phrase “consisting of” excludes the inclusion of silk in the claimed sponge. See MPEP § 2111.03. Answer (B) is incorrect because “balance cotton” equals 4.8% cotton, a limit outside the range of “at least 6% cotton” recited in the claim. Answer (D) is incorrect because “0.6% fiber” is outside the limit outside the range of “up to 0.5% fiber” recited in the claim. Answer (E) is incorrect because Answer (B) and Answer (D) are incorrect.

37. ANSWER: (B). (A) fails to provide proper antecedent basis for “said first end” in part (ii) of the claim. (C) and (D) fail to provide proper antecedent basis for “said longitudinal sides of said channel” in part (iv) of the claim. (E) fails to provide proper antecedent basis for “said chamber” in part (i) and subsequent parts of the claim.

38. ANSWER: (E). 35 U.S.C. § 184; 37 CFR § 5.25(a); MPEP § 140.

39. ANSWER: (E). 35 U.S.C. §§ 102 and 103; *Ex parte Edwards*, 231 USPQ 981 (Bd. Pat. App. & Int. 1986); *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985), and MPEP §§ 2113 and 2173.05(p). (A) - (D) are wrong because they are product-by-process claims, and the novelty is only in the process.

40. ANSWER: (E). “None of the above” is correct because (A), (B), (C), and (D) are wrong. (A) is wrong because Claim 1 is directed to a ship propeller, whereas (A) recites a claim which purports to be dependent upon Claim 1 but involves a *non sequitur*, i.e., it is directed to a copper

base alloy rather than a ship propeller. Therefore, the dependent claim is indefinite and violates 35 U.S.C. § 112, paragraph 2. (B) is wrong because Claim 1 is directed to a product, i.e., a ship propeller, whereas (B) recites a claim that purports to be dependent upon Claim 1, but involves a process step. Therefore, the claim is directed to more than one statutory class of invention and violates 35 U.S.C. § 112, paragraph 2. While a claim to a product may be permissible when defining the claimed product in terms of the process by which it is made or in terms of the process by which it is intended to be used (MPEP § 2173.05(p)), the situation presented here is different and not permissible. In this regard, the term “consisting of” in Claim 1 excludes any element, step, or ingredient not specified in the claim. Thus, as stated in MPEP § 2111.03, “A claim which depends from a claim which ‘consists of’ the recited elements or steps cannot add an element or step.” (B) recites a claim that also violates this caveat. (C) is wrong because it recites a dependent claim that attempts to add “2 to 10 percent aluminum” to the propeller of Claim 1. Since the specification teaches the addition of aluminum to the copper base alloy and not the propeller of Claim 1, the dependent claim introduces new matter. Thus, the claim may be subject to a rejection under the first paragraph of 35 U.S.C. § 112. MPEP § 608.04. It is not clear from the language of the claim that the addition of aluminum is to the alloy. (E) is wrong because it recites a dependent claim which is directed to a ship propeller according to Claim 1 including 2 to 10 percent of aluminum, which has been excluded by the term “consisting of” in Claim 1. Thus, as stated in MPEP § 2111.03, “A claim which depends from a claim which ‘consists of’ the recited elements or steps cannot add an element or step.” (D) recites a claim that violates this caveat.

41. ANSWER: (C). MPEP § 2173.05(c), part (a) indicates that a preferred narrower range set forth within a broader range is an indefinite claim limitation. (A), (B), and (D) are not correct because MPEP § 2173.05(c), part (a) indicates that a preferred narrower range set forth within a broader range may render the claim indefinite. (E) is wrong because the doctrine of equivalents operates to expand claim coverage beyond the literal scope of the claim language.

42. ANSWER: (B) is the most correct answer. MPEP § 601.01(f). “It has been PTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. § 113 (first sentence).” As such, the application will be processed for examination. (A) is not the minimum that must be submitted to obtain a filing date given that the filing fee and oath may be submitted after the specification and drawing are submitted. 35 U.S.C. § 111(a)(3). (C) is not the correct answer because the filing of a petition may be deferred until the examiner requires acceptable formal drawings. MPEP § 608.02 [p. 600-86]. Also, the filing fee may be filed after the specification is submitted. 35 U.S.C. § 111(a)(3). (D) is not correct because it does not represent the minimum, which must be submitted to obtain a filing date before the statutory bar. (E) is not correct because (B) is correct.

43. ANSWER: (C). 37 CFR § 1.137(b).

44. ANSWER (C). Applicant's own disclosure in the specification and claims may not be used against the applicant. The content of the applicant's specification may not be used as evidence that the scope of the claims is inconsistent with the subject matter that applicant regards as his invention. Claiming that which applicant regards as his invention is a matter of compliance with 35 U.S.C. § 112, second paragraph. As noted in *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA 1979), the lack of agreement between the claims and specification is properly considered only with respect to 35 U.S.C. § 112, first paragraph; MPEP § 2172, item II. (A), (B) and (D) are incorrect. Evidence demonstrating that a claim does not correspond in scope with that which an applicant regards as his invention can be found in the admissions in arguments or briefs, *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969), or in affidavits filed under 37 CFR § 1.132. *In re Cormany*, 476 F.2d 998, 177 USPQ 450 (CCPA 1973); MPEP § 2172, item II. (E) is incorrect because (C) is correct.

45. ANSWER: (C). 35 U.S.C. § 251; and MPEP §§ 1411, 1411.02, and 1412.02. (D) is not a correct answer. MPEP § 1417. (A) is incorrect. 35 U.S.C. § 251, paragraph 2. (B) is incorrect. 35 U.S.C. § 251, paragraph 1.

46. ANSWER: (E). (A) is incorrect because a preamble is generally not accorded patentable weight where it merely recites the intended use of a structure. MPEP § 2111.02. (B) is incorrect because the facts set forth that the McGoo invention is described as limited to the elements recited in (B). MPEP § 2111.03. (C) is incorrect because the structure corresponding to means for marking baseballs and equivalents thereof, includes an invisible ink stamper. (D) is incorrect since (B) and (C) are both incorrect.

47. ANSWER: All answers are accepted.

48. ANSWER: (D). MPEP § 2173.05(e) indicates that as long as a claim phrase has a reasonable degree of clarity, such as reciting something well known in the mechanical arts, e.g., "a clip," the claim phrase is definite despite the lack of antecedent basis in the written description. (A) is not correct because MPEP § 2163.06, paragraph (c) demonstrates that an original written description may be amended to include originally claimed subject matter. (B) is not correct because MPEP § 2173.05(e) shows that a claim phrase, which has no antecedent basis in the written description, is not necessarily indefinite because it may have a reasonable degree of clarity to those skilled in the art. (C) is not correct because MPEP § 2164.05(b) demonstrates that ordinary skill in the mechanical arts is presumed when considering the question of enablement. (E) is not correct because MPEP § 2165.03 indicates that absent evidence to the contrary, it is assumed that the best mode is present. In the present case, "a clip" is disclosed in the drawing in the original application. The fact that the screw is not recited in the original description does not detract from the disclosure of the best mode.

49. ANSWERS: (A) and (B). (A) is correct. MPEP § 2165.01, item III. There is no requirement in the statute for applicants to point out which of the disclosed embodiments they

consider to be the best mode. *Ernsthausen v. Nakayam*, 1 USPQ 2d 1539 (Bd. Pat. App. & Inter. 1985). (B) is correct. MPEP §2165.01, item II. The presence of only one specific example in the application is not evidence that the best mode has been disclosed. (C) is incorrect. *Transco Products, Inc. v. Performance Contracting Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994); MPEP § 2165.01, item IV. (D) is incorrect. New matter cannot cure the defect. 35 U.S.C. § 132; *In re Hay*, 534 F.2d 917, 189 USPQ 790 (CCPA 1976), MPEP § 2165.01, item V. (E) is incorrect. The statement is a correct statement of the law. 35 U.S.C. § 112, first paragraph; *In re Gay*, 309 F.2d 768, 135 USPQ 311 (CCPA 1962); MPEP § 2165.01, item II.

50. ANSWER: (D). 35 U.S.C. § 112, first paragraph; *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976); MPEP §§ 2164.08(c), and 2173.05(l). (D) describes the combination. (A) through (C), and (E) do not describe the combination of the door secured to the doorframe by two hinges. (A) through (C), and (E) do not describe the necessary structural relationship because they describe a door and door frame which are not yet secured together. In (A), “capable of being hingedly connected” describes an intended use, as opposed to a currently existing structural connection. In (B), “having...means for securing the door” describes the existence of a means for securing a door, but not a door currently secured to a frame. In (C), “hinges for securing the door” describes the existence of the hinges for securing a door, but does not require a door be secured by hinges to a frame. In (E), a “door adapted to be secured to a door frame” describes an intended use, but does not describe a door currently secured to a doorframe. Moreover, the enablement disclosure does not describe a door assembly having a door frame without a door secured to it by a pair of hinges which is capable of keeping out the elements and provides privacy.