

Training Module for Chapter 21 of the MPEP

Summary

Chapter 21: Patentability

Section 2106 – Patent Subject Matter Eligibility

- An invention cannot be patented unless it falls within the categories of (1) process, (2) machine, (3) manufacture, and (4) compositions of matter.
- A recent topic of interest has been the patentability of a business model.

In 2008 the Federal Circuit Court of Appeal ruled that the “machine or transformation test” is the appropriate test for patent-eligible subject matter.

Under this test, a business model is patentable if it:

(1) is tied to a particular machine or application, *or*

(2) transforms a particular article into a different state or thing.

- So, a business model is patentable if it is either tied to a particular machine or transforms some object.

[Doug’s Comment: This may seem like a “stretch”. However, there are a number of cases where a business model has been shown to transform some object.]

Section 2107.01 – General Principles Governing Utility Rejections

- **RECALL:** An invention must be (1) novel, (2) useful, and (3) non-obvious before the USPTO will issue a patent on it.

Utility addresses the second requirement, that of usefulness.

- Rejection on the basis of utility may be made for 2 reasons:
 - (1) the applicant has failed to identify the utility of the invention and it would not be obvious to a POSITA (person of ordinary skill in the art),
 - (2) the utility lacks credibility (e.g. a method of reverting the aging process).
- NOTE: An applicant does not need to specifically set forth a utility in a specification if a POSITA would readily recognize a utility.
- NOTE: A rejection for lack of utility should also trigger a rejection for lack of enablement. That's because if an invention is useless, it would not be possible to teach someone how to use it (enablement).

Section 2111 – Claim Interpretation; Broadest Reasonable Interpretation

- During patent examination, a pending claim must be given the “broadest reasonable interpretation”.

But, courts use a different standard for issued claims. Their interpretation is that given by a POSITA.

- An applicant is free to define the terms used in his/her application even if different from the customary meaning. For example a “vacuum” means a lot of different things to different people. So, a specific definition would be appropriate in an application.
- It is improper to impose limitations on the claims based on the specifications unless these limitations are explicit.

Section 2112 – Requirements of Rejection Based on Inherency; Burden of Proof

- The *express* or *inherent* teachings of a prior art reference may be relied upon in the rejection of claims under Section 102.
- However, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.

TO ESTABLISH INHERENCY, THE MISSING MATTER ***MUST*** NECESSARILY BE PRESENT IN THE THING DESCRIBED IN THE REFERENCE.

- When relying on inherency, the examiner must provide a basis in fact or technical reasoning to support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the prior art.
- Once the examiner issues a rejection based on inherency, the burden shifts to the applicant to show a non-obvious difference.

Section 2113 – Product-by-Process Claims

- A product-by-process claim is an authorized claim type written in the form of a product – but with process limitations.
- Patentability of a product-by-process claim *is based on the product itself and does not depend on the method of production.*

Thus, if prior art supports an identical product made by a different process, the product-by-process claim is not valid unless - the applicant can teach that there is some non-obvious difference in the product supported by his claim.

Section 2121 – Prior Art; General Level of Operability Required to Make a Prima Facie Case

- DEFINITION OF “PRIOR ART”

Prior Art = Anything available to a POSITA that anticipates a claim in an application.

NOTE: Prior Art is **NOT** art in existence before an invention! For that, it would be better to use a phrase like “existing state-of-the-art before the invention” or something similar. This terminology removes any suggestion of anticipation.

- The general rule is that a prior art reference is good for all that it teaches a POSITA. Thus, a reference may be used to reject a claim if it expressly, inherently, or implicitly discloses the subject matter claimed.

HOWEVER: the *disclosure must be enabling*. That is, it must teach the invention to a POSITA. Otherwise, a POSITA would not appreciate or recognize the invention from the prior art.

- NOTE: It is not sufficient for the applicant to say that his invention is more efficient or superior to the prior art. The burden is on him to show how it is different from the prior art!

Section 2128 – “Printed Publications” as Prior Art

- Printed publications constitute prior art as of the date the publication was *publically accessible*.

THIS INCLUDES PUBLICATION ON THE INTERNET.

- Examples of printed art on previous bar exams:
 - (1) a PhD thesis shelved in library that has public access can be prior art
 - (2) an orally presented technical paper for which written copies are disseminated without restriction can be prior art.
 - (3) documents distributed only within an organization that are marked confidential can not be used as prior art *if the organization has an existing policy of confidentiality or an agreement with employees to retain confidential documents.*

- (4) a publically displayed document that a POSITA could see and is not precluded from copying is prior art.

Section 2129 – Admission as Prior Art

- **CAUTION:** A statement made by an applicant identifying something as prior art can be used against him by the examiner for anticipation and obvious rejection even if the reference might otherwise not qualify as prior art. It can also be relied upon in a court of law.
- **NOTE:** A listing of something in an Information Disclosure Statement (IDS) is not an admission of PRIOR ART. Rather it is merely an indication that the item may be MATERIAL TO PATENTABILITY. It would be dumb to identify something in the IDS a “prior art”. That determination should be left for the examiner!

Section 2133.03 – Rejections Based on “Public Use” or “On Sale”

- A person is entitled to a patent - unless the invention was patented or described in a printed publication in any country ***or in use or on sale in the U.S.*** for more than a year prior to the date of the application for a patent in the U.S.
- The public use bar is applicable if the use was:
 - (1) accessible to the public, or
 - (2) commercially exploited (excludes experimental use to perfect product)
- **NOTE:** Public use occurs if the inventor puts his invention on display even if it is hidden from direct view as part of a larger machine or article - as long as the invention is used as intended and is accessible to the public.
- The on sale bar relates to the article or object described in an application ***but not selling the rights to the application or patent***

itself.

- “On sale” includes an *offer to sell*, even if the sale is not consummated.
- NOTE: An often tested exception to the public use and on-sale bars occurs with *experimental use*. For example, these bars are not operative to perfect a product or verify its intended operation – even if incidental commercial exploitation occurs as a result of the experimental use.

Section 2137.01 – Inventorship

- It is important to recognize that inventorship relates to the *claimed subject matter*, not necessarily the matter disclosed in the application.
- The threshold question in determining inventorship is *who conceived of the invention?* (Merely reducing an invention to practice is not sufficient to be an inventor – unless there was some non-obvious improvements made in the course of reducing the invention to practice.)
- Inventors may apply for a patent jointly even though:
 - (1) they did not physically work together at the same time
 - (2) each did not make the same type or amount of contribution, or
 - (3) each did not make a contribution to the subject matter of every claim.
- What is required for individuals to be joint inventors is for some amount of collaboration.

Section 2163 – The Written Description Requirement

- RECALL: There are three separate requirements dealing with the adequacy of an applicant’s disclosure [and the test for adequacy]:
 - (1) written description [Must show that inventor was in possession of invention.]

- (2) enablement [Must provide sufficient information so that a POSITA would not have to conduct undue experimentation.]
 - (3) best mode [must include among the disclosed alternatives the best mode or embodiment in the mind of the inventor.]
- An examiner can reject a claim based on an applicant's failure to comply with the written description requirement.

Section 2164 – The Enablement Requirement

- The enablement requirement refers to the requirement of USC Section 112 that the specification describes how to make and use the invention.
- An examiner may reject claims for failure to comply with the enablement requirement.
- For enablement purposes, the disclosure of an application must be sufficient to inform a POSITA how to ***both make and use*** the claimed invention without undue experimentation.
- The fact that experimentation may be complex does not necessarily make it “undue” if the art typically engages in such experimentation.

NOTE: Questions indicating that the experimentation was “complex but routine” are in essence stating the enablement requirement has been satisfied.

Section 2165 – The Best Mode Requirement

- The best mode requirement is a safeguard against the desire on the part of some applicants to obtain protection without making a full disclosure to the public, as required by statute. The requirement does not permit applicants to disclose only what they know to be their second-best embodiment, while retaining the best for themselves.
- Failure to disclose the best mode need not rise to the level of active concealment or grossly inadequate conduct in order to support a rejection or invalidate a patent. The mere fact that the applicant knew

of a best mode for practicing the invention and failed to adequately disclose it in the application is sufficient to support rejection.

Section 2171 – Two Separate Requirements for Claims under 35 USC 112, Second Paragraph

- The specification must conclude with one or more claims particularly pointing out and distinctly claiming the subject matter for which the applicant regards as his invention. This is known as the definiteness requirement.
- NOTE: An applicant may change what they regard as the invention during the pendency of the application. So, an applicant is free to shift the focus of the claims as he sees fit.
- But, claims that contain vague language, lack antecedent basis, or otherwise are not amenable to construction do not comply with the definiteness requirement.
- The test for the distinctly claiming the inventive subject matter is based on the impression of a POSITA.

Section 2181 – Identifying 35 USC 112, Sixth Paragraph Limitations.

- The sixth paragraph of Section 112 sets forth the special type of claim called a “means plus function” claim.
- A claim limitation is presumed to be a means-plus-function limitation if:
 - (1) the claim limitation uses the phrase “means for” or “step for”
 - (2) the limitation is modified by functional language (e.g. “means for measuring temperature”)
 - (3) the limitation does not contain sufficient structure, material, or acts

for achieving the specified function.

- If it is not clear whether a claim limitation falls within Section 112, sixth paragraph, a rejection may be appropriate.
- Means-plus-function limitations are construed to cover the corresponding structure described in the specification ***or any equivalent thereto***.
- NOTE: Means-plus-function limitations are special because they receive a statutory construction – unlike other limitations that are construed as a POSITA would construe them.
- Means-plus-function limitations are linked to the definiteness requirement (in the previous section). If an applicant fails to disclose sufficient structure for a means-plus-function limitation, the claim is indefinite and probably invalid.

Selected Questions and Answers for Chapter 21

Question 21-1 (Oct03am-19a)

In accordance with patent laws, rules and procedures as related in the MPEP, a rejection under 35 USC 102 can be overcome by demonstrating:

- (A) the reference is nonanalogous art.
- (B) the reference teaches away from the claimed invention.
- (C) the reference disparages the claimed invention.
- (D) (A), (B) and (C).
- (E) None of the above.

ANSWER: (E) is the most correct answer. As set forth in MPEP § 2131.05, “‘Arguments that the alleged anticipatory prior art is ‘nonanalogous art’ or ‘teaches away from the invention’ or is not recognized as solving the problem solved by the claimed invention, [are] not ‘germane’ to a rejection under section 102.’ *Twin Disc, Inc. v. United States*, 231 USPQ 417, 424 (Cl.Ct.1986) (quoting *In re Self*, 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982)). A reference is no less anticipatory if, after disclosing the invention, the reference then disparages it. The question whether a reference ‘teaches away’ from the invention is inapplicable to an anticipation analysis. *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d

1516, 1522-23 (Fed.Cir.1999).” Therefore, answers (A) through (D) are incorrect. See also MPEP § 706.02(b) as to ways to overcome a rejection under 35 U.S.C. § 102.

Question 21-2 (Oct03am-23)

Applicant files a claim which includes the following limitation: “a step for crossing the road.” The specification recites the following acts: “(1) go to the curb, (2) look both ways, (3) if the road appears safe, walk across the road, (4) step up onto the far curb, (5) continue walking.” The primary examiner properly construes the step limitation to cover the foregoing acts. A prior art reference, published two years before the application was filed, expressly describes acts (1)-(4), but not (5). This same reference also discloses the remaining limitations recited in applicant’s claim, i.e., those other than the step plus function limitation. The examiner rejects the claim under 35 USC 102(b) as being anticipated by the prior art reference. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following is the most complete reply to overcome the rejection under these circumstances?

- (A) An argument explaining that since act (5) is not disclosed in the reference, it does not anticipate the claim.
- (B) An amendment to the specification deleting act (5) – continue walking.
- (C) An argument showing that neither the equivalent of act (5) nor act (5) is disclosed in the reference, which therefore does not anticipate the claim.
- (D) An amendment to the claim by adding a negative limitation to expressly exclude act (5) from crossing the road.
- (E) (B) and (D).

ANSWER: (C) is the most correct answer. Pursuant to 35 U.S.C. § 112, paragraph 6, *In re Donaldson Co.*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1849 (Fed. Cir. 1994) (in banc), and MPEP § 2181, under the heading “Written Description Necessary To Support A Claim Limitation Which Invokes 35 U.S.C. 112, Sixth Paragraph,” “step” plus function limitations shall be construed to cover the corresponding acts disclosed in the specification and their equivalents. Accordingly, the step plus function imitation correspondingly includes acts (1)-(5) and their equivalents. Thus, in order to anticipate, a prior art reference must disclose each and every act, or its equivalent, for the step plus function. If the reference is shown to not disclose one of the acts, or its equivalents, then the reference fails to anticipate, which is the answer set forth in (C). Thus, (C) is the most complete answer. (A) is not the most complete answer because acts (1)-(4) are disclosed in the reference and the equivalent of act (5) has to be dealt with, i.e., the equivalent of continuing to walk may still be met by the reference unless the applicant shows through argument that the reference also fails to contain any equivalent for act (5). Thus, the most complete answer is (C) as compared to (A). (B) is not the most correct answer because once act (5) is removed from the specification, the prior art reference clearly anticipates

(since it otherwise expressly has acts (1)-(4) and the other claim limitations) under the above recited facts absent act (5) in the specification. See Donaldson, 16 F.3d at 1193, 29 USPQ2d at 1849; MPEP § 2181. (D) is not the most complete answer the prior art still anticipates the claim. (E) is not the most correct answer because it includes two incorrect answer choices, (B) and (D).

Question 21-3 (Oct03am-24a)

A registered practitioner filed an application for an applicant claiming a “a means for pulling the door open.” The specification describes a handle and a knob as being used together as a corresponding structure for pulling the door open. A prior art patent discloses a door opened by pulling on an attached bar. The primary examiner issued an Office action rejecting the claim under 35 USC 102 as being anticipated. In the action, the examiner properly identified the corresponding structure described in applicant’s specification as the means for pulling the door open, and properly explained why the prior art attached bar is the equivalent of the structure described in applicant’s specification. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following is the most correct reply to overcome the rejection under these circumstances?

- (A) An amendment to the claim changing the pulling means to expressly include an attached bar.
- (B) Only argue that the claimed pulling means is not found in the prior art relied-upon reference and therefore the claim is patentable.
- (C) An amendment to the specification that adds an attached bar to correspond to the prior art.
- (D) An amendment to the claim substituting for the term “means for pulling the door open” the structure of a handle and a knob.
- (E) An amendment to the specification that excludes an attached bar as a pulling means.

ANSWER: (D) is the most correct answer. MPEP § 2181 under the heading “Procedures For Determining Whether The Written Description Adequately Describes The Corresponding Structure, Material, Or Acts Necessary To Support A Claim Limitation Which Invokes 35 U.S.C. 112, Sixth Paragraph.” 35 U.S.C. 112, sixth paragraph states that a claim limitation expressed in means plus function language “shall be construed to cover the corresponding structure, materials, or acts described in the specification and ‘equivalents thereof.’” See also *B. Braun Medical, Inc. v. Abbott Lab.*, 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1899 (Fed. Cir. 1997).” The examiner has made a prima facie case of equivalent in the Office action to support the rejection based on 35 U.S.C. § 102. By amending the claim to no longer include the means limitation in question, the claim becomes narrower inasmuch as it no longer includes equivalents under 35 U.S.C. § 112, paragraph 6 for examination purposes. Thus, (D) overcomes the

lack of novelty rejection under these circumstances. (A) is not the most correct answer because such an amended claim would continue to lack novelty, since both it and the prior art would have the attached bar expressly. Furthermore, such an amendment would introduce new matter lacking support in the application as originally filed. 35 U.S.C. § 112, first paragraph. (B) is not the most correct answer because the “not found in the prior art” argument does not rebut the prima facie case of equivalents raised by the examiner. (C) is not the most correct answer because it does not address the rejection. (E) is not the most correct answer because the amendment would raise a new matter issue.

Question 21-4 (Oct03am-33a)

Which of the following phrases taken from an independent claim has an antecedent basis problem according to the patent laws, rules and the procedures as related in the MPEP?

- (A) “the center of the circle having ...,” where the claim does not previously recite that the circle has a “center.”
- (B) “the major diameter of the ellipse being ...,” where the claim does not previously recite that the ellipse has a “major diameter.”
- (C) “the outer surface of the sphere being ...,” where the claim does not previously recite that the sphere has an “outer surface.”
- (D) “the lever of the machine being located ...,” where the claim does not previously recite a “lever.”
- (E) “the area of the rectangle being ...,” where the claim does not previously define an “area.”

ANSWER: (D) is correct. "Inherent components of elements recited have antecedent basis in the recitation of the components themselves." MPEP § 2173.05(e). The MPEP provides an analogous example: "the limitation 'the outer surface of said sphere' would not require an antecedent recitation that the sphere have an outer surface." *Id.* (A), (B), (C), and (E) are all examples of things which inherently have the claimed characteristic and do not have an antecedent basis problem; that is, all circles have a center, all ellipses have a major diameter, all spheres have an outer surface, and all rectangles have an area, and these characteristics need not be provided with express antecedent basis. The ellipse example is from *Bose Corp. v. JBL Inc.*, 61 USPQ2d 1216, 1219 (Fed. Cir. 2001) ("There can be no dispute that mathematically an inherent characteristic of an ellipse is a major diameter."). The lever recited in (D) is not an inherent component of a machine and therefore requires express antecedent basis.

Question 21-5 (Oct03am-37a)

Applicant filed an application containing a claim directed to a polishing wheel coated

with diamond grit particles. The application discloses, but does not claim, a diamond grit particle size of 5-7 microns. The examiner rejected the claim under 35 USC 102(b) as being anticipated by a U.S. patent which disclosed as its invention a polishing wheel in accordance with the claim of the application but coated with glass grit particles instead of diamond grit particles. The applied patent, which issued more than 1 year prior to the effective filing date of the application, also disclosed that diamond grit particles were known for coating on polishing wheels but were inferior to glass grit particles because they were more expensive and did not adhere as well to the polishing wheel. The applied patent disclosed a grit particle size of 50-100 microns. Which of the following timely taken courses of action would comply with the patent laws, rules and procedures as related in the MPEP for overcoming the rejection?

- (A) Argue that the patent teaches away from the use of a diamond grit particle coating on a polishing wheel and thus does not teach the claimed invention.
- (B) File a declaration under 37 CFR 1.132 showing unexpected results using diamond grit rather than glass grit.
- (C) Antedate the applied patent by filing a declaration under 37 CFR 1.131 showing that applicant invented the claimed subject matter prior to the effective date of the applied patent.
- (D) Argue the applied patent is nonanalogous art.
- (E) Amend the claim by adding a limitation that the diamond grit particle size is 5-7 microns, and arguing that the claimed invention differs from applied patent by limited the diamond grit particle size to 5-7 microns.

ANSWER: (E) is the correct answer. 35 U.S.C. § 102(b); 37 CFR § 1.111(b); MPEP §§ 706.02(b), 2131 and 2131.03. As stated in MPEP 2131, under the heading “To Anticipate A Claim, The Reference Must Teach Every Element Of The Claim,” “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 California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). MPEP 2131.03, under the heading, “Prior Art Which Teaches A Range Within, Overlapping, Or Touching The Claimed Range Anticipates If The Prior Art Range Discloses The Claimed Range With ‘Sufficient Specificity.’” states “When the prior art discloses a range which touches, overlaps or is within the claimed range, but no specific examples falling within the claimed range are disclosed, a case by case determination must be made as to anticipation. In order to anticipate the claims, the claimed subject matter must be disclosed in the reference with ‘sufficient specificity to constitute an anticipation under the statute.’” A claim containing a limitation that the grit particle size is 5-7 microns would not be anticipated by the applied reference, because the applied reference discloses a different grit particle size well outside that range. (A) is incorrect. MPEP § 2123(8th Ed.). Patents are relevant as prior art for all they contain and are not limited to their preferred embodiments. *See In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) and *Merck & Co. v. Biocraft Laboratories*, 874 F.2d

804, 10 USPQ2d 1843 (Fed. Cir. 1989), *cert. denied*, 493 U.S. 975 (1989). (B) is incorrect. See MPEP § 2131.04. Evidence of secondary considerations such as unexpected results is irrelevant to 35 U.S.C. § 102 rejections and thus cannot overcome a rejection so based. See *In re Wiggins*, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973). (C) is incorrect. See MPEP § 715, under the heading “Situations Where 37 CFR 1.131 Affidavits or Declarations Are Inappropriate.” An affidavit or declaration under 37 CFR § 1.131 is inappropriate where the reference publication date is more than 1 year prior to applicant’s effective filing date. Such a reference is a “statutory bar” under 35 U.S.C. § 102(b) as referenced in 37 CFR § 1.131(a)(2). (D) is also incorrect. See MPEP § 2131.05. Arguments that the alleged anticipatory prior art is “nonanalogous art” are not “germane” to a rejection under 35 U.S.C. § 102. *Twin Disc, Inc. v. United States*, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting *In re Self*, 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982)).

Question 21-6 (Oct03am-46a)

In accordance with the patent law, rules and procedures as related by the MPEP, which of the following is not a “printed publication” under 35 USC 102(b), with respect to a patent application filed June 1, 2002?

- (A) A paper that was orally presented at a meeting held May 1, 2001, where the meeting was open to all interested persons and the paper was distributed in written form to six people without restriction.
- (B) A doctoral thesis that was indexed, cataloged, and shelved May 1, 2001, in a single, university library.
- (C) A research report distributed May 1, 2001, in numerous copies but only internally within an organization to persons who understood the organization’s unwritten policy of confidentiality regarding such reports.
- (D) A reference available only in electronic form on the Internet, which states that it was publicly posted May 1, 2001.
- (E) A technical manual that was shelved and cataloged in a public library as of May 1, 2001, where there is no evidence that anyone ever actually looked at the manual.

ANSWER: The correct answer is (C). The internal report was intended to be confidential and therefore is not a “printed publication” under 35 U.S.C. § 102(b). See MPEP § 2128.01, under the heading “Internal Documents Intended To Be Confidential Are Not ‘Printed Publications,’” citing *In re George*, , 2 USPQ2d 1880 (Bd. Pat. App. & Int. 1987) states “Research reports disseminated in-house to only those persons who understood the policy of confidentiality regarding such reports are not printed publications even though the policy was not specifically stated in writing.” Answer (A) is incorrect. An orally presented paper can be a “printed publication” if copies are available without restriction. The paper is a “printed publication” under 35 U.S.C. § 102(b). See MPEP § 2128.01. Answer (B) is incorrect. The thesis is a “printed

publication” under 35 U.S.C. § 102(b). See MPEP § 2128.01. Answer (D) is incorrect. An electronic publication disclosed on the Internet is considered to be publicly available as of the date the item was posted. The reference is a “printed publication” under 35 U.S.C. § 102(b). See MPEP § 2128. Answer (E) is incorrect. There is no need to prove that anyone actually looked at a document. The manual is a “printed publication” under 35 U.S.C. § 102(b). See MPEP § 2128.

Question 21-7 (Oct03pm-8a)

With respect to establishing “reasonable diligence” for under 35 USC 102(g), which of the following statements is or are in accordance with the patent laws, rules and procedures as related in the MPEP?

- (1) The inventor and his attorney must drop all other work and concentrate on the particular invention involved.
 - (2) The entire period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses.
 - (3) Work relied upon to show reasonable diligence must be directly related to the reduction to practice.
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- (A) Statement (1) only
 - (B) Statement (2) only
 - (C) Statement (3) only
 - (D) Statements (1) and (3)
 - (E) Statements (2) and (3)

ANSWER: (E) is the most correct, because statements (2) and (3) are true. The entire period for which diligence is required must be accounted for. MPEP § 2138.06, under the heading “The Entire Period During Which Diligence Is Required Must Be Accounted For By Either Affirmative Acts Or Acceptable Excuses,” states “[a]n applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.)” MPEP § 2138.06, under the heading “Work Relied Upon To Show Reasonable Diligence Must Be Directly Related To The Reduction To Practice,” states “[t]he work relied upon to show reasonable diligence must be directly related to the reduction to practice of the invention in issue. *Naber v. Cricchi*, 567 F.2d 382, 384, 196 USPQ 294, 296 (CCPA 1977), cert. denied, 439 U.S. 826 (1978). ‘U]nder some circumstances an inventor should also be able to rely on work on closely related inventions as support for diligence toward the reduction to practice on an invention in issue.’” (A) is incorrect because statement (1) is not true – an inventor or his attorney need not drop all other work to establish reasonable

diligence. *Emery v. Ronden*, 188 USPQ 264, 268 (Bd. Pat. Inter. 1974); MPEP § 2138.06. (B) is incorrect because it does not include true statement (3). (C) is incorrect because it does not include true statement (2). (D) is incorrect because it includes false statement.

Question 21-8 (Oct03pm-12a)

Which of the following is patentable subject matter under 35 USC 101 in accordance with the patent laws, rules, and procedures as set forth in the MPEP?

- (A) A claim to a new mineral discovered in the earth or a new plant found in the wild.
- (B) A claim to a method of using a computer to select a set of arbitrary measurement point values. (The selected values are not to be transformed outside of the computer into computer data).
- (C) A claim to a method of controlling a mechanical robot which relies upon storing data in a computer that represents various types of mechanical movements of the robot.
- (D) A claim to a method of updating alarm limits by changing the number value of a variable to represent the result of the calculation.
- (E) A claim to a data structure *per se*. (The claim does not specify any location where the data structure is stored).

ANSWER: (C) is the most correct answer. MPEP § 2106(IV)(B)(2)(b)(i), under the heading “Safe Harbors,” subheading “Independent Physical Acts (Post-Computer Process Activity),” states that “[e]xamples of this type of statutory process include ...[a] method of controlling a mechanical robot which relies upon storing data in a computer that represents various types of mechanical movements of the robot, using a computer processor to calculate positioning of the robot in relation to given tasks to be performed by the robot, and controlling the robot’s movement and position based on the calculated position.” (A) is a true statement, and is therefore an incorrect answer. As set forth in MPEP § 2105 a “new mineral discovered in the earth or a new plant found in the wild is not patentable subject matter.” (B) is an incorrect answer. As set forth in MPEP § 2106(IV)(B)(2)(b)(i), under the heading “Safe Harbors,” subheading “Manipulation of Data Representing Physical Objects or Activities (Pre-Computer Process Activity),” states that “[e]xamples of claimed processes that do not limit the claimed invention to pre-computing safe harbor include: . . . - selecting a set of arbitrary measurement point values ([*In re*] *Sarkar*, 588 F.2d [1330] at 1331, 200 USPQ [132] at 135).” (D) is an incorrect answer. MPEP § 2106(IV)(B)(2)(b)(i) under the heading “Safe Harbors,” subheading “Independent Physical Acts (Post-Computer Process Activity),” states that “[e]xamples of claimed process that do not achieve a practical application include:-step of ‘updating alarm limits’ found to constitute changing the number value of a variable to represent the result of the calculation (*Parker v. Flook*, 437 U.S.584, 585, 198 USPQ 193, 195 (1978).” (E) is a true statement, and therefore is an incorrect answer. MPEP §

2106(IV)(B)(1), under the heading “Nonstatutory Subject Matter” states “[*In re*] *Warmerdam*, 33 F.3d [1354,] at 1361, 31 USPQ2d [1754,] at 1760 (claim to a data structure per se held nonstatutory).”

Question 21-9 (Oct03pm-13a)

On January 2, 2001, a registered practitioner filed a patent application with the USPTO for inventor Beck. The application includes a specification and a single claim to the invention which reads as follows:

1. Mixture Y made by the process Q1.

In the specification, Mr. Beck discloses that mixture Y has a melting point of 150° F. On June 2, 2001, the practitioner received an Office action from the primary examiner rejecting the claim. The claim is rejected under 35 USC 102/103 as being clearly anticipated by or obvious over Patent A. The examiner states “Patent A teaches mixture Y but made by a different process Q2.” Beck believes he is entitled to a patent to mixture Y. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following would be the best reply to the rejection of his claim?

- (A) An argument that the claimed product has an unexpectedly low melting point of 150° F, supported by an affidavit showing that the mixture Y made by process Q2 exhibits a melting point of 300° F.
- (B) An argument that the processes used by applicant and patent A are different, supported by a third-party declaration stating only that the processes are different.
- (C) An argument that the claimed product has an unexpectedly low melting point of 150° F, supported by a third-party declaration stating only that the products are different.
- (D) An argument that the processes used by applicant and patent A are different, supported by an affidavit showing that the mixture Y made by process Q2 exhibits a melting point of 300° F.
- (E) An argument that the claimed product has an unexpectedly low melting point of 150° F because the claimed mixture Y has a melting point of 150° F and the mixture Y of patent A has a melting point of 300° F.

ANSWER: (A) is the most correct answer. MPEP § 2113, under the heading “Product-By-Process Claims Are Not Limited To The Manipulations Of The Recited Steps, Only The Structure Implied By The Steps,” states “even though product-by-process claims are limited by and defined by the process, 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 product was

made by a different process.’ *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).” The issue is whether the claimed mixture Y is the same as or obvious over the patented mixture X. MPEP § 2113, under the heading “Once A Product Appearing To Be Substantially Identical Is Found And A 35 U.S.C. 102/103 Rejection Made, The Burden Shifts To The Applicant To Show An Unobvious Difference,” states “[o]nce the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983).” Evidence that the two processes produce different properties is germane to the issue of patentability of the product-by-process claim. Accordingly, a comparison of the results obtained by conducting the process recited in the claim versus the process used by patent A and which shows that the claimed product exhibits an unexpectedly lower melting point would be a persuasive demonstration that, although the products would appear to be substantially identical, in fact, they are patentably different. *Ex parte Gray*, 10 USPQ2d 1922 (Bd. Pat. App. & Inter. 1989). Therefore, the best reply to the outstanding rejection would be to argue that the claimed product has an unexpectedly lower melting point and to support that argument with evidence showing that the result of the patent A process is a mixture with higher melting point as compared to the claimed product. (B) is incorrect. The patentability of a product-by-process claim is determined on the basis of product characteristics, not process steps. (C) is incorrect. The declaration is conclusory, as opposed to being factual. Thus, the argument is not supported by facts. As stated in MPEP § 716.02(c), under the heading “Opinion Evidence,” “Although an affidavit or declaration which states only conclusions may have some probative value, such an affidavit or declaration may have little weight when considered in light of all the evidence of record in the application. *In re Brandstadter*, 484 F.2d 1395, 179 USPQ 286 (CCPA 1973).” Thus, the reply in (A) is the most correct answer vis-à-vis (C). (D) like (B), is incorrect for the same reason discussed for (B). (E) is incorrect. Like (C), this reply rightly focuses on product properties. But without the comparative factual evidence to support it, this reply is weaker than one described in (A).

Question 21-10 (Oct03pm-16a)

Which of the following statements is or are in accord with the patent laws, rules and procedures as related in the MPEP?

- (1) In a 35 USC 103 obviousness analysis, the proper question is whether the differences between the prior art and the claims would have been obvious to one of ordinary skill in the art.
- (2) In a 35 USC 103 obviousness analysis, an inventor’s assertion that he has discovered the source or cause of an identified problem should never be considered.

- (3) A 35 USC 103 obviousness analysis requires consideration not just of what is literally recited in the claims, but also of any properties inherent in the claimed subject matter that are disclosed in the specification.

- (A) Statement 1
- (B) Statement 2
- (C) Statement 3
- (D) Statements 1 & 2
- (E) Statements 1 & 3

ANSWER: (C) is the most correct answer. The principle in Statement 3, that consideration of inherent properties is part of proper consideration of the invention as a whole, is recited in MPEP § 2141.02, under the heading “Disclosed Inherent Properties Are Part Of ‘As A Whole’ Inquiry,” and in *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977). (A) is incorrect, because the proper question is whether the invention as a whole, not just the differences, would have been obvious. *See* MPEP § 2141.02, under the heading “The Claimed Invention As A Whole Must Be Considered,” (citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983)). (B) is incorrect because an examiner should consider such assertions by an inventor as part of the “subject matter as a whole.” *See* MPEP § 2141.02 (citing *In re Sponnoble*, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969)). (D) and (E) are incorrect because they include incorrect Statements 1 and/or 2.

Question 21-11 (Oct03pm-37a)

The specification of an application does not disclose the utility of the claimed composition. In fact, the claimed invention is useful for shrinking a specific class of tumors. In a first Office action, the primary examiner has properly determined that the claims lack utility, and has rejected all of the composition claims under the first paragraph of 35 USC 112 as lacking utility. Which of the following responses is in accord with the USPTO rules and the procedures of the MPEP for persuading the examiner that the rejection is improper?

- (A) Explain that the rejection is statutorily improper because the first paragraph of section 112 is concerned with enablement and written description issues and therefore does not support a rejection for lack of utility.
- (B) Point out that the rejection is based on an erroneous finding by the examiner because the specification, in fact, clearly discloses that the composition in question possesses “useful biological” properties.
- (C) Show that the rejection is improper by filing probative evidence that the claimed composition has unambiguously proven to be useful for shrinking a specific class of tumors.

- (D) File declarations by persons with ordinary skill in the art stating that they would immediately appreciate that the claimed composition is useful for shrinking a specific class of tumors due to the fact that similar compositions having the same characteristics as applicant's claimed composition were known to be effective for this purpose.
- (E) Argue that the rejection is improper because the examiner has failed to present evidence in support of his position that the claimed composition has no utility.

ANSWER: (D) is most correct answer. As explained at MPEP § 2107.02, II, B, under the heading “No Statement of Utility for the Claimed Invention in the Specification Does Not Per Se Negate Utility,” the fact that a specification does not contain a statement of utility for the claimed invention does not *per se* negate utility. This is because a claimed invention may have a well-established utility, and an invention has a well-established utility if (i) a person of ordinary skill in the art would immediately appreciate why the invention is useful based on the characteristics of the invention and (ii) the utility is specific, substantial, and credible. In this case, the declarations specify a specific substantial and credible utility and explain why the declarants (*i.e.*, persons of ordinary skill in the art) would immediately appreciate that the applicant's claimed composition would possess this utility. (A) is incorrect. A lack of utility deficiency under 35 U.S.C. § 101 also creates a lack of utility deficiency under the first paragraph of 35 U.S.C. § 112 as fully explained at MPEP § 2107.01, under the heading “IV. Relationship Between 35 U.S.C. 112, First Paragraph, And 35 U.S.C. 101.” (B) is not the most correct answer. 35 U.S.C. § 101 (and the first paragraph of 35 U.S.C. § 112) requires that the utility be specific. Therefore, the disclosure of a general utility such as “useful biological” properties does not satisfy this requirement as fully explained at MPEP § 2107.01, under the heading “I. Specific And Substantial Requirements.” Response (C) also would not be persuasive since the rejection is based on the fact that the applicant's specification fails to identify any specific and substantial utility for the claimed composition or fails to disclose enough information about the invention to make its usefulness immediately apparent to those familiar with the technological field of the invention. This is explained at MPEP § 2107.01. The fact that the claimed composition has unambiguously proven to be useful for curing a form of cancer previously thought to be incurable does not negate these specification deficiencies. That is, notwithstanding this unambiguous proof, the fact remains that the applicant's specification fails to identify any specific and substantial utility for the composition. Moreover, it is clear that the specification would not make this specific usefulness immediately apparent to those familiar with the technological field of the composition since the cancer was previously thought to be incurable. Finally, response (E) also would not be persuasive. Under current USPTO policy and procedure, the examiner is not required to present evidence in support of a rejection based on lack of utility where, as here, the specification does not identify a specific, substantial and credible utility and does not appear to provide sufficient information such that a well-established utility would be apparent to a person with ordinary skill in the art. See MPEP § 2107, under the heading “II. Examination Guidelines For The Utility Requirement.”

Question 21-12 (Oct03pm-46a)

A primary examiner is examining a patent application. The application includes a specification and a single claim to the invention that reads as follows:

1. A building material to be used as an alternative to brick in the construction of a house, said building material comprising compressed refuse, the majority of which is wood.

In the specification, the inventor explains that the wood to be used in the inventive building material should be balsa wood. According to the specification, balsa-containing building material has the advantage of being lighter than brick. In a first Office action mailed to the registered practitioner representing the inventor the single claim was rejected as anticipated under 35 U.S.C. § 102 over Patent A. Patent A issued more than one year before the effective filing date of the application, and teaches a building material to be used as an alternative to brick in the construction of a house comprising compressed refuse, the majority of which is pine. The practitioner replies to the first Office action by arguing that the invention is different from that of Patent A. According to the practitioner, the inventor uses balsa wood, not pine. The claim has not been amended. Which of the following describes how the examiner should proceed in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) The examiner should allow the claim.
- (B) The examiner should allow the claim only after including a Reasons for Allowance pointing out that the inventor argues that her invention is directed to using balsa wood, not pine.
- (C) The examiner should issue a Final Rejection again rejecting the claim as anticipated under 35 USC102 over Patent A.
- (D) The examiner should reopen prosecution and begin anew, this time searching for a reference that shows a building material containing balsa wood.
- (E) The examiner should withdraw the rejection but issue a new Office action this time rejecting the claim under 35 USC 112, second paragraph, because the claim is broad enough to encompass using pine.

ANSWER: (C) is the best answer. 35 U.S.C. § 102; MPEP §§ 2111 and 2131. MPEP § 2131, under the heading, "To Anticipate A Claim, The Reference Must Teach Every Element Of The Claim." "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." See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Here, every element of the claim is found in Patent A. See MPEP 2111, under the heading "Claims Must Be Given Their Broadest Reasonable Interpretation," where it explained that "[d]uring patent examination, the

pending claims must be 'given the broadest reasonable interpretation consistent with the specification,' and cites *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) to explain that "reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim." (A) and (B) are incorrect. MPEP § 2111. The claim, as written, is not allowable over Patent A since Patent A disclosed every element recited in the claim. (D) is incorrect. There is no need to search again for a building material, this time looking for balsa wood. The claim has not been amended to be directed to balsa wood. Since it still broadly recites "wood," Patent A that discloses pine remains germane and anticipates the claim. (E) is incorrect for one or more reasons. It is incorrect because it wrongly agrees with the practitioner's argument that Patent A is poor reference. It also is incorrect because it seeks to reject the claim over 35 U.S.C. § 112, second paragraph, for indefiniteness. The claim is clear on its face and there is nothing indefinite about what the claim says. This answer makes the mistake of confusing breadth with indefiniteness. The claim is broad but it is definite.

Question 21-13 (Oct03pm-47a)

To rely in a rejection under 35 USC 102(a) on an invention that is known or publicly used in accordance with patent laws, rules and procedures as related in the MPEP, the invention:

- (A) must be known or used in NAFTA or WTO member countries.
- (B) must be known or used in a NAFTA member country, but only if the filing date of the application is after the effective date of the North American Free Trade Agreement Implementation Act.
- (C) must be known or used in this country.
- (D) can be known or used in any country.
- (E) must be known or used in a WTO member country, but only if the filing date of the application is after the effective date of the implementation of the Uruguay Round (WTO) Agreements Act.

ANSWER: (C) is the most correct answer. 35 U.S.C. § 102(a); MPEP § 2132. As set forth in MPEP § 2132, under the heading "II. 'In This Country,'" subheading "Only Knowledge or Use In The U.S. Can Be Used in a 35 U.S.C. 102(a) Rejection," states "[t]he knowledge or use relied on in a 35 U.S.C. 102(a) rejection must be knowledge or use 'in this country.' Prior knowledge or use which is not present in the United States, even if widespread in a foreign country, cannot be the basis of a rejection under 35 U.S.C. 102(a). *In re Ekenstam*, 256 F.2d 321, 118 USPQ 349 (CCPA 1958). Note that the changes made to 35 U.S.C.104 by NAFTA (Public Law 103-182) and Uruguay Round Agreements Act (Public Law 103-465) do not modify the meaning of 'in this country' as used in 35 U.S.C. 102(a) and thus 'in this country' still means in the United States for purposes of 35 U.S.C. 102(a) rejections." See also MPEP § 706.02(c), "[t]he language 'in

this country' means in the United States only and does not include other WTO or NAFTA member countries." Since "in this country" means in the United States for purposes of 35 U.S.C. § 102(a) rejections, (A), (B), (D) and (E) are incorrect.

Question 21-14 (Ap03am-30a)

A patent application includes the following Claim 1:

Claim 1. A method of making an electrical device comprising the steps of:

- (i) heating a base made of carbon to a first temperature in the range of 1875°C to 1925°C;
- (ii) passing a first gas over said heated base, said first gas comprising a mixture of hydrogen, SiCl₄, phosphorus, and methane, whereby said first gas decomposes over said heated base and thereby forms a first deposited layer of silicon, phosphorus and carbon on said heated base;
- (iii) heating said base having said deposited layer to a second temperature of approximately 1620°C; and
- (iv) passing a second gas over said base heated to said second temperature, said second gas consisting of a mixture of hydrogen, SiCl₄, AlCl₃, and methane, whereby said second gas decomposes over said heated base to form a second deposit layer adjacent said first layer, said second layer comprising silicon, aluminum and carbon.

Assuming proper support in the specification, which of the following claims, if presented in the same application, is a proper claim in accordance with the USPTO rules and the procedures set forth in the MPEP?

- (A) Claim 2. The method of claim 1, wherein said first temperature is in the range of 1800°C to 2000°C.
- (B) Claim 3. The method of claim 1, wherein said first gas further comprises an inert gas.
- (C) Claim 4. The method of claim 1, wherein said second gas further comprises Argon.
- (D) Claim 5. The method of claim 1, wherein said first gas is an inert gas such as Argon.
- (E) Claim 6. The method of claim 1, wherein said second gas consists of a mixture of hydrogen, SiCl₄ and AlCl₃ only.

ANSWER: (B) is the most correct answer. 37 CFR § 1.75(c). Answers (A) and (E) are incorrect because they improperly seek to broaden the parent claim. 37 CFR § 1.75(c). Answer (A) broadens the range by going below the stated limit. Answer (E) broadens by trying to remove a recited component of the second gas, and covering subject matter that is not covered by the parent claim. Answer (C) is incorrect because claim 1 uses the close ended claim term “consists” in connection with the second gas, which precludes the addition of further components to the second gas in claim 4. Answer (D) is incorrect because the use of the exemplary language “such as” is improper under 35 U.S.C. § 112, second paragraph, and because it is inconsistent with claim 1. See MPEP § 2173.05(d).

Question 21-15 (Ap03am-44a)

A claim in an application recites “[a] composition containing: (a) 35-55% polypropylene; and (b) 45-65% polyethylene.” The sole prior art reference describes, as the only relevant disclosure, a composition containing 34.9% polypropylene and 65.1% polyethylene. In accordance with USPTO rules and procedures set forth in the MPEP, the primary examiner should properly:

- (A) Indicate the claim allowable over the prior art because there is no teaching, motivation or suggestion to increase the amount of polypropylene from 34.9% to 35% and decrease the amount of polyethylene from 65.1% to 65%.
- (B) Reject the claim under 35 USC 102 as anticipated by the prior art reference.
- (C) Reject the claim under 35 USC 103 as obvious over the prior art reference.
- (D) Reject the claim alternatively under 35 USC 102 as anticipated by or under 35 USC 103 as obvious over the prior art reference.
- (E) None of the above.

ANSWER: (C) is the most correct answer. A *prima facie* case of obviousness exists where the claimed ranges and the prior art are close enough that one of ordinary skill in the art would have expected them to have the same properties. See MPEP § 2144.05. In Titanium Metals Corp. v. Banner, 778 F.2d 775, 783, 227 USPQ 773, 779 (Fed. Cir. 1985), a claim recited a titanium base alloy consisting essentially of 0.8% nickel, 0.3% molybdenum, up to 0.1% maximum iron, and the balance titanium. A prior art reference described two similar alloys: (i) one with 0.25% molybdenum, 0.75% nickel, and balance titanium; and (ii) another with 0.31% molybdenum, 0.94% nickel, and balance titanium. The court held:

As admitted by appellee's affidavit evidence from James A. Hall, the Russian article discloses two alloys having compositions very close to that of claim 3, which is 0.3% Mo and 0.8% Ni, balance titanium. The two alloys in the prior art have 0.25% Mo-0.75% Ni and 0.31% Mo-0.94% Ni, respectively. The proportions are so close that prima facie one skilled in the art would have expected them to have the same properties. Appellee produced no evidence to rebut that prima facie case. The specific alloy of claim 3 must therefore be considered to have been obvious from known alloys.

Id. Thus, (A) is incorrect. (B) and (D) are incorrect because a claim is anticipated by a prior art reference only when the prior art discloses, either expressly or inherently, every limitation of the claimed invention. (E) is incorrect because (C) is correct.

Question 21-16 (Ap03pm-42a)

Paprika is a known product. A patent application discloses a composition which is made by subjecting paprika to processing steps X, Y and Z. The composition is disclosed to be useful in treating cancer. The application was filed June 1, 2002. A reference published May 1, 2001 discloses a food product made by subjecting paprika to processing steps X, Y and Z. The reference does not disclose that the resulting composition has any properties that would make it useful for treating cancer. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following claims is not anticipated by the reference?

- (A) A composition made by the process of subjecting paprika to processing steps X, Y and Z, wherein the composition is effective for treating cancer.
- (B) A composition for treating cancer, made by the process of subjecting paprika to processing steps X, Y and Z.
- (C) A method of making a cancer-treating composition, comprising subjecting paprika to processing steps X, Y and Z.
- (D) A method of treating cancer, comprising administering an effective amount of a composition made by subjecting paprika to processing steps X, Y and Z.
- (E) All of the above.

ANSWER: (D) is the most correct answer. See 35 U.S.C. § 102(b); MPEP § 2131. Citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), MPEP § 2131, under the heading, "To Anticipate A Claim, The Reference Must Teach Every Element Of The Claim" states, "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." The claim is directed to a method of use that is not disclosed by the reference. Answer (A) is incorrect. 35 U.S.C. § 102(b); MPEP §§ 2112, 2112.01. The claimed composition is the same as that disclosed in the

prior art, because it is made from the same starting material subjected to the same processing steps. The recitation of “the composition is effective for treating cancer,” is only a statement of the inherent properties of the composition. Where the claimed and prior art products are identical in structure or composition, or are produced by identical processes, a *prima facie* case of anticipation has been established. *In re Best*, 195 USPQ 430, 433 (CCPA 1977). The burden is shifted to applicant to show that the prior art product does not necessarily possess the characteristics of the claimed product. The reference is prior art under 35 U.S.C. § 102(b), and therefore the claim is anticipated. Answer (B) is incorrect. 35 U.S.C. § 102(b); MPEP §§ 2112, 2112.01, and 2112.02. The claimed composition is the same as that disclosed in the prior art, because it is made from the same starting material subjected to the same processing steps. The recitation of a composition “for treating cancer” reflects only a preamble statement of an intended use of the claimed composition, which does not limit the scope of the claim. Answer (C) is incorrect. See 35 U.S.C. § 102(b); MPEP §§ 2112, 2112.01. The claimed method is the same as that disclosed in the prior art, because it subjects the same starting material to the same manipulative steps. The recitation of making “a cancer-treating composition” reflects only a preamble’s statement of an intended use of the claimed composition, which does not further limit the claimed method. Answer (E) is incorrect, because (A), (B), and (C) are incorrect.

Question 21-17 (Ap00am-27a)

On February 8, 1999, you filed a patent application that you prepared for Mr. Bond. The application contains only one claim. The application disclosed a composition having 20%A, 20%B, and either 60%C or 60%D. Claim 1 is as follows:

Claim 1. A composition useful for bonding semiconductor materials to metals, comprising 20%A, 20%B, and 60%C.”

The examiner found a patent to Gold, dated March 8, 1998, which only disclosed and claimed a composition, having 20%A, 20%B, and 60%C, and also taught that the composition would only be useful for insulating metals from corrosion. The examiner rejected Claim 1 under 35 U.S.C. § 102(a) as anticipated by Gold, in an Office action dated August 9, 1999. Which of the following is most likely to overcome the rejection, and comports with proper PTO rules and procedure?

- (A) Filing a reply, on March 9, 2000, with a petition for a three-month extension and the fee for a three-month extension, traversing the rejection on the ground that Gold does not disclose using the composition for bonding semiconductor materials to metals, and therefore does not disclose all the elements of Claim 1.
- (B) Filing a reply, on September 9, 1999, traversing the rejection on the ground that Gold does not disclose using the composition for bonding semi-conductor materials to metals, and therefore does not disclose all the elements of Claim 1.

- (C) Filing a reply on October 9, 1999, amending Claim 1 to state as follows: “Claim 1. A composition comprising: 20%A, 20%B, and 60%D.” In the reply, pointing out why the amendment gives the claim patentable novelty.
- (D) Filing a reply on October 9, 1999, traversing the rejection on the grounds that the patent to Gold teaches away from using the invention in the manner taught in Bond’s application.
- (E) Filing (i) a 37 C.F.R. § 1.132 affidavit objectively demonstrating the commercial success of the invention as claimed, and (ii) a reply containing an argument why the claimed invention is patentable, but no amendment to Claim 1.

ANSWER: (C). MPEP § 2111.02. (A), (B), and (D) are incorrect since the “use” recited in the preamble in Claim 1 does not result in a structural difference between the claimed invention and the disclosure in the Gold patent. *In re Casey*, 370 F.2d 576 (CCPA 1967). (A) is further incorrect since the reply would not be filed within the statutory period. (D) is further incorrect since the rejection is not under 35 U.S.C. § 103, and any “teaching away” in the Gold patent is not applicable to the rejection under 35 U.S.C. § 102(a). (E) is incorrect since evidence of commercial success, relevant to secondary considerations concerning rejections under 35 U.S.C. § 103, is not relevant to overcoming rejections under 35 U.S.C. § 102(a). (C) is correct since the amendment is timely filed, supported by the disclosure, and renders the rejection under 35 U.S.C. § 102(a) inapplicable.

Question 21-18 (Ap00am-42a)

Which of the following can never properly be available as prior art for purposes of a rejection under 35 U.S.C. § 102(a)?

- (A) A drawing, labeled “Prior Art,” submitted by the applicant.
- (B) Canceled matter in an application that matured into a U.S. patent where the matter is not published in the patent.
- (C) An abandoned patent application referenced in a publication available to the public.
- (D) The combination of two references, where one of the references is used merely to explain the meaning of a term used in the primary reference.
- (E) A reference authored only by applicant, and published less than one year prior to the effective filing date of applicant’s patent application.

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ANSWER: (E) is the correct answer. (A) is incorrect since admissions, including figures labeled “prior art” may be used. MPEP 2129. (B) is incorrect since canceled matter in the application file of a U.S. patent becomes available as prior art as of the date the

application issues into a patent. See MPEP 2127, and *Ex parte Stalego*, 154 USPQ 52, 53 (Bd. App. 1966) cited therein. (C) is incorrect since an abandoned patent application may become evidence of prior art when it has been appropriately disclosed, as, for example, when it is referenced in a publication. See 37 C.F.R. § 1.14(a)(3)(iv); MPEP 2127; and *Lee Pharmaceutical v. Kreps*, 577 F.2d 610, 613, 198 USPQ 601, 605 (9th Cir. 1978) cited in MPEP 2127. (D) is incorrect because multiple reference rejections under 35 U.S.C. § 102 may be used where one reference is used to merely explain a term used in the primary reference. See MPEP 2131.01 and *In re Baxter Travenol Labs.*, 952 F.2d 388, 21 USPQ2d 1281 (Fed. Cir. 1991) cited therein. (E) is correct since the reference is not by “another.”

Question 21-19 (Ap00am-44a)

Which of the following is not prohibited conduct for a practitioner under the PTO Code of Professional Responsibility?

- (A) Entering into an agreement with your client to limit the amount of any damages which your client may collect for any mistakes you make during prosecution of your client’s patent application in exchange for prosecuting the application at a reduced fee.
- (B) Encouraging your client to meet with an opposing party for settlement discussions.
- (C) Failing to disclose controlling legal authority which is adverse to the client’s interest when arguing the patentability of claims in a patent application.
- (D) In reply to an Office action, stating honestly and truthfully in the remarks accompanying an amendment that you have personally used the device and found it to be very efficient and better than the prior art.
- (E) Investing the funds your client advanced for your legal fees (not costs and expenses) in long term United States Treasury Bills in order to obtain guaranteed protection of the principal.

ANSWER: (B). See 37 C.F.R. § 10.87. As to (A), practitioner may not limit damages under 37 C.F.R. § 10.78. As to (C), see 37 C.F.R. § 10.89(b)(1). As to (D), see 37 C.F.R. § 10.89(c)(4). As to (E), see 37 C.F.R. § 10.112(a) where client funds advanced for legal services are required to be deposited in a bank account.

Question 21-20 (Ap00pm-44a)

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.

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").

In-Depth Review of Chapter 21

Please click on the link, below, to bring up a special version of Chapter 21 in the MPEP that has been prepared exclusively by

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