

Homework Assignments regarding 35 USC 102/103 Questions

Please select the best answer for each of the following questions:

1. 35 USC §102(d) establishes four conditions which, if all are present, establish a bar against the granting of a patent in this country. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following is not one of the four conditions established by 35 USC §102(d)?

- (A) The foreign application must be filed more than 12 months before the effective U.S. filing date.
- (B) The foreign application must have been filed by the same applicant as in the United States or by his or her legal representatives or assigns.
- (C) The foreign patent or inventor's certificate must be actually granted before the U.S. filing date.
- (D) The foreign patent or inventor's certificate must be actually granted and published before the U. S. filing date.
- (E) The same invention must be involved.

2. Roberto files a U.S. patent application fourteen months after he perfects an invention in Europe. Which of the following would establish a statutory bar against the granting of a U.S. patent to Roberto?

- (A) A foreign patent issued to Roberto 11 months prior to the filing date of Roberto's U.S. patent application. The foreign patent was granted on an application that was filed 23 months prior to the effective filing date of Roberto's U.S. patent application. The foreign patent application and the U.S. patent application claim the same invention.
- (B) The invention was described in a printed publication in the United States, 11 months prior to the filing date of the U.S. patent application.
- (C) The invention was in public use in the United States, less than one year prior to the filing date of the U.S. patent application.
- (D) The invention was on sale in a foreign (NAFTA member) country, more than one year prior to the filing date of the U.S. patent application.
- (E) None of the above.

3. In 1996, Sydney, while vacationing at the North Pole, invents a new method of ice fishing using a solar powered fishhook with a transmission device for indicating the presence of a fish. For 5 years, Sydney practiced his invention exclusively at the North Pole, outside of the United States, its possessions, or its territories or any WTO or NAFTA country. He showed his invention to only one person, his friend Charlie, while Charlie was visiting him at the North Pole in June 2001. Charlie spoke to no one in the United States about the idea and crafted a near duplicate and began to publicly use it upon his return to Wisconsin in September 2001. On October 18, 2001, Sydney telephoned you and complained to you that Charlie, the only person who has ever seen Sydney's device, has begun using his device. In the October 18, 2001 phone conversation, Sydney asked you for advice as to the filing of a patent application. Which of the following is the best advice for Sydney?

(A) The witnessing of the fishhook by Charlie in June 2001 constitutes knowledge of the invention, and claims directed to Sydney's invention could be properly rejected under 35 USC §102(a).

(B) Use of the device in Wisconsin constitutes public use and since Sydney cannot establish prior invention through activities at the North Pole, he is precluded from antedating the date of the first public use in the United States.

(C) Since Sydney invented the fishing device in 1996, he is the prior inventor and can overcome the first date of public use by Charlie by filing a 37 CFR §1.131 affidavit or declaration.

(D) Since Charlie first used the fishing device in the United States, Charlie may file a patent application.

(E) Since Charlie's public use in Wisconsin was not authorized, Sydney may still file a patent application on the fishing device.

4. Bill was working toward a Ph.D. in physics from a university in Japan. As part of his doctoral program, Bill prepared (in Japanese) a thesis directed to his work in the semiconductor field. Following approval of the thesis by his faculty advisory on December 21, 2000, the sole copy of Bill's thesis was placed on the shelves of the university library on January 29, 2001, where it was accessible to the faculty and students of the university as well as to the general public. At that time, the thesis was indexed in a general user's catalog maintained locally at the university library by author, title and subject. On March 4, 2001, the general user's catalog was made freely available on an Internet web page maintained by the university. Which of the following statements is most correct?

(A) Bill's thesis may be used under 35 USC §102(b) as a prior art printed publication against a United States application for patent filed January 4, 2002.

(B) Bill's thesis may be used under 35 USC §102(b) as a prior art printed publication against a United States application for patent filed February 19, 2002.

(C) Bill's thesis may be used under 35 USC §102(b) as a prior art printed publication against a United States application for patent filed March 6, 2002.

(D) Each of statements (B) and (C) is correct.

(E) Because the thesis was written in Japanese, it cannot be a prior art printed publication against a United States application for patent.

5. Applicant files a patent application in Japan on February 28, 1996. Applicant files a PCT international application designating the United States on February 27, 1997, based on the Japanese application. The international application enters the national stage in the United States on August 28, 1998. The USPTO publishes the application on June 7, 2001 at the request of the applicant. The application issues as a United States patent on December 4, 2001. When examining an application filed on or after November 29, 2000 or any application that has been voluntarily published, what is its earliest possible prior art date, for the June 7th U.S. published application in view of 35 USC §102(e)?

(A) February 28, 1996

(B) February 27, 1997

(C) August 28, 1997

(D) August 28, 1998

(E) June 7, 2001

6. Which of the following establishes a statutory bar under 35 USC §102 to patentability of Applicant's claimed invention?

(A) To further develop the invention, Applicant's invention was tested and experimented with in the United States more than one year prior to applicant's effective U.S. filing date, but the invention at the time was not fit for its intended purpose and important modifications concerning the claimed features resulted from the experimentation. The first actual reduction to practice occurred after the effective U.S. filing date.

(B) Applicant's invention was sold in a WTO member country outside the United States more than one year prior to applicant's effective U.S. filing date, and the sale was merely market testing of the invention to determine product acceptance.

(C) Applicant's invention is rendered obvious by the combination of two U.S. patents, both of which were patented more than one year prior to applicant's effective filing date.

(D) Applicant's invention was sold outside the United States in a non-WTO member country, more than one year prior to applicant's effective U.S. filing date, but the sale was merely an attempt at market penetration.

(E) None of the above.