

**AFTERNOON SECTION MODEL ANSWERS  
PART I**

1. ANSWER: (B), false. Since the scope of the claim is ascertainable by one skilled in the art, the claim is definite. The disclosure of "a screw" in the drawings provides support for "a screw" in the claim. 35 U.S.C. § 112, second paragraph; MPEP 2173.05(e) and 2163.06.

2. ANSWER: (B), false. The claim limitation "at least 42 mg%" does not meet the description requirement because the phrase "at least" has no upper limit, and reads upon embodiments outside the "35mg - 80mg" range. 35 U.S.C. § 112, first paragraph; *In re Wertheim*, 541 F.2d 257, 191 USPQ 90, 97-99 (CCPA 1976); MPEP 2163.05(c).

3. ANSWER: (A), true. The scanning device without a specific angular view is what was originally disclosed and supported. 35 U.S.C. § 112, first paragraph, 35 U.S.C. § 251; *In re Peters*, 723 F.2d 891, 221 USPQ 952 (Fed. Cir. 1983); MPEP 2163.05(a).

4. ANSWER: (B), false. The stated preference may lead to confusion as to whether the narrower range defines a limitation in the claim. MPEP 2173.05(c).

5. ANSWER: (B), false. There is no requirement to disclose every species. MPEP 2164.03.

6. ANSWER: (A), true. 35 U.S.C. § 112, first paragraph. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); MPEP 2163.05(c).

7. ANSWER: (B), false. 35 U.S.C. § 112, first paragraph. MPEP 2164.05(a) states:

Publications dated after the filing date providing information publicly first disclosed after the filing date generally cannot be used to show what was known at the time of filing. *In re Gunn*, 537 F.2d 1123, 190 USPQ 402 (CCPA 1976) . . . . [A] later dated publication cannot supplement an insufficient disclosure in a prior dated application to make it enabling . . . .

8. ANSWER: (A), true. 35 U.S.C. § 112, first paragraph. MPEP 2173.05(h), states:

Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being "selected from the group consisting of A, B and C." See *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925).

*Ex parte Markush* sanctions claiming a genus expressed as a group consisting of certain specified materials . . . . It is improper to use the term "comprising" instead

of "consisting of." *Ex parte Dotter*, 12 USPQ 382 (Bd. App. 1931).

9. ANSWER: (A), true. 35 U.S.C. §§ 112, first paragraph, and 251, *In re Wilder*, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984). MPEP 2163.05 states:

The failure to meet the written description requirement of 35 U.S.C. 112, first paragraph, commonly arises when the claims are changed after filing to either broaden or narrow the breadth of the claim limitations, or to alter a numerical range limitation or to use claim terminology which is not synonymous with the terminology used in the original disclosure.

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[I]n *In re Wilder*, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984), the Federal Circuit affirmed that part of a Board of Appeals decision rejecting reissue claims for a recording apparatus which omitted a limitation that required indexing means to scan an array of light emitting diodes "in synchronism" with the scanning of the record medium by scanning means. The court held that the generic invention represented by the reissue claims (i.e., covering scanning means and indexing means not in synchronism) was not supported by the original patent's disclosure in such a way as to indicate possession, as of the original filing date, of that generic invention.

10. ANSWER: (B), false. Publications may be used to support a rejection under 35 U.S.C. § 112, first paragraph, to show a lack of enabling disclosure. *In re Wright*, 27 USPQ2d 1510 (Fed. Cir. 1993).

11. ANSWER: (B), false. The term "said lever" lacks antecedent basis according to 35 U.S.C. § 112, second paragraph, because it is indefinite whether the term refers to the aluminum lever or the plastic lever. See MPEP 2173.05(e).

12. ANSWER: (A), true. Only one example may provide enablement which is not rejectable under 35 U.S.C. § 112, first paragraph. *In re Marzocchi*, 439 F.2d 220, 169 USPQ 367 (CCPA 1971). See MPEP 2164.08.

13. ANSWER: (A), true. *Mowry v. Whitney*, 81 U.S. (14 Wall.) 620 (1871); *In re Fouche*, 439 F.2d 1237, 169 USPQ 429 (CCPA 1971). See MPEP 2164.07.

14. ANSWER: (B), false. A claim term which lacks antecedent basis is not necessarily indefinite. In this example, however, the use of the definite article leaves it unclear as to which element the claim is referring to, therefore, the claim is indefinite under 35 U.S.C. § 112, second paragraph; MPEP 2173.05(e).

15. ANSWER: (A), true. 35 U.S.C. §§ 112, first paragraph, and 119; *In re Gostelli*, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989); MPEP 2163.05.

## PART II

1. ANSWER: (E). 35 U.S.C. §§ 102 and 103; *Ex parte Edwards*, 231 USPQ 981 (Bd. Pat. App. & Int. 1986); and MPEP 2173.05(p). Answers (A) - (D) are wrong because they are product-by-process claims, and the novelty is only in the process.

2. ANSWER: (C). (C) is true because claim 3 does restrict or narrow the scope of Claim 1, the claim on which it depends. Claim 3 is narrower than Claim 1 since 6-7  $\mu\text{f}$  in claim 3 is narrower than 3-8  $\mu\text{f}$  in Claim 1. 37 CFR § 1.75(c). (A) is false because the disclosure of a "DC current source capable of producing a variable current of . . . 10-20 volts" supports Claim 1. (B) is false because Claim 2 does not restrict or narrow the scope of the claim on which it depends. Claim 2 is broader than claim 1, since 5-10 ohms in claim 2 is broader than 8-10 ohms in Claim 1. (D) is false because Claim 4 does not further restrict the scope of Claim 2, the claim from which Claim 4 depends. Inasmuch as Claim 2 depends from Claim 1, Claim 2 incorporates the structures of Claim 1 not otherwise specified in Claim 2, and Claim 4 incorporates the structures of Claim 2. Thus, Claim 4 recites the same 3-8  $\mu\text{f}$  capacitor, and the same 10-20 volt DC current source as in Claim 1. Thus, Claim 4 does not narrow Claim 2. (E) is incorrect because Claims 1 and 2 are anticipated by the British patent inasmuch as they read upon the single disclosed circuit. 35 U.S.C. § 102(b).

3. ANSWER: (D). Claim 11 is a multiple dependent claim which depends from preceding claims, none of which is a multiple dependent claim, and is properly worded in the alternative. 37 CFR § 1.75(c). (A) is incorrect because Claim 5, a dependent claim, depends from Claim 6, which is not a preceding claim. A proper dependent claim must "refer[] back" to a preceding claim. 37 CFR § 1.75(c). (B) is incorrect. Claim 8, a multiple dependent claim, would improperly depend from Claim 5, a multiple dependent claim. 35 U.S.C. § 1.75(c). (C) is incorrect. Claim 10, a multiple dependent claim, would depend from Claim 8, a multiple dependent claim. 35 U.S.C. § 1.75(c). (E) is incorrect because (C) is incorrect. See MPEP 608.01(n), page 600-56.

4. 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.

5. ANSWER: (C). The transitional phrase "consisting of" in Claim 1 excludes any element from the claims not specified in Claim 1. *In re Gray*, 53 F.2d 520, 11 USPQ 225 (CCPA 1931); *Ex*

*parte Davis*, 80 USPQ 448 (Bd. App. 1948) ("consisting of" defined as "closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith"). In Claim 1, "consisting of" is a transitional phrase between "clamp" and "two metal wires." Thus, "consisting of" precludes the clamp from having elements in addition to "two metal wires," e.g., it precludes "horizontally disposed ceramic arms on the end of said metal wires." The dependent claim in (C), which must further limit the claim from which it depends, cannot properly add an element which further limits the invention to having the element recited in (C). When "consisting of" appears in a clause of a claim, as opposed to immediately following the preamble, it limits only the element set forth in that clause, other elements are not excluded from the claim as a whole. *Mannesmann Demag Corp. v. Engineered Metal Products Co.*, 793 F.2d 1279, 230 USPQ 45 (Fed. Cir. 1986); MPEP 2111.03. The transitional term "comprising" immediately following the preamble is inclusive or open-ended, and does not exclude additional, unrecited elements except where "consisting of" appears in a clause after the preamble. MPEP 2111.03. Accordingly, "comprising" permits the additional ring element to be added to dependent Claim 2, or for the base to be pecan resin. (A) and (B) are proper dependent claims inasmuch as "comprises" permits the doll stand to have further elements (as in (A)), and it permits recited elements which are not defined in terms of "consisting of" (such as the base) to be further defined or limited. (D) or (E) are erroneous because (A) and (B) are proper dependent claims.

6. 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.

7. ANSWER: (D). Only the amendment in (D) causes the claim to be drawn to a multi-layer material for a diver's wet suit which is both disclosed in the specification, and not anticipated by the publication. 35 U.S.C. §§ 102 and 112, first paragraph. (A) is incorrect because Claim 1 requires the first inner layer to be only one of several materials in a Markush group, i.e., "a member selected from the group," as opposed to being a combination of cotton, silk, wool, and synthetic fabric interwoven together. Claim 1 in (A) is anticipated because it reads on the publication. (B) and (C) are incorrect because changing the introductory clause to the Markush group did not cause the composition of the first layer to change from being one of several materials to being a combination of cotton, silk, wool, and synthetic fabric interwoven together. The objection still obtains in (A), (B), and (C) because the claim does not conform to the invention disclosed in the specification. 37 CFR § 1.75(d)(1). (E) is incorrect because (B), and (C) are incorrect.

8. ANSWER: (A). Claim 1 in (A) is broadened by the deletion of "bayonet" as a modifier of "socket." Claims cannot be broadened at any time in a reexamination proceeding. 35 U.S.C. § 305; 37 CFR § 1.552(b), or in a reissue application filed more than two years from the grant of the original patent. 35 U.S.C. § 251. Accordingly, answer (A) is the only proper selection.

9. ANSWER : (B). 37 CFR § 1.75(b) and (c); MPEP 608.01(n). (B) further limits Claim 2. (A) is incorrect because Claim 4 conflicts with Claim 3. (C) is not correct because it is a multiple dependent claim dependent on a multiple dependent claim. (D) is an improper multiple dependent claim. (E) is not correct because the structural relation of a stool having a spring and rubber tip are not supported by the disclosure.

10. ANSWER: (E). It is in accord with client's wishes by introducing claims to the stool with the foot rests, and amends the specification to achieve correspondence between the newly introduced claims and the specification. 35 U.S.C. §§ 112, first paragraph, 113, and 132; *In re Heinle*, 145 USPQ 131, 136 (CCPA 1965); 37 CFR § 1.118; MPEP 2163.06. (A) is wrong because it is inaccurate to identify the foot rests as new matter, and it is unnecessary to subject the client to the additional filing expense. (B) alone is insufficient because it is not in accord with client's wishes to introduce claims to the stool having foot rests, i.e., it does not present claims to stools having foot rests. (C) alone is insufficient because it fails to achieve correspondence between the newly presented claims and the specification, i.e., it does not amend the description in the specification to correspond to the claims. (D) is wrong because it suffers the same drawbacks as described with respect to choice (A).

11. 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 door frame 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 door frame. 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.

12. ANSWER: (C). Though the reissue application is filed more than two years after the original patent was granted, the application narrows, as opposed to enlarges the scope of Claim 1. Also, the amended claim does not read upon the British patent disclosure. 35 U.S.C. §§ 102(b), and 251. (A) and (B) are not correct because the amended claims are anticipated by the British patent. 35 U.S.C. § 102. (D) is not correct. The claim is unpatentable because the amendment changing 8-10 mg. sugar to 8-15 mg. sugar enlarges the scope of the claim in the reissue application, and the reissue application is filed more than two years after the original patent was granted, and no reissue patent shall be granted enlarging the scope of the claims of the original patent applied for more than two years from the grant of the original patent. 35 U.S.C. § 251. (E) is not correct because (A), (B), and (D) are incorrect.

13. ANSWER: (C). 37 CFR § 1.75(c). Claim 4 further limits the scope of Claim 1 inasmuch as both claims are directed to a bird call, and Claim 4 limits "said reed assemblies" of Claim 1. Claim 2 in (A) is not a proper dependent claim because Claim 2 does not further limit Claim 1. Claim 2 is directed to reed assemblies, whereas Claim 1 is directed to a bird call. Claim 3 in (B) is not a proper dependent claim because it does not limit the scope of Claim 2. Claim 3 is drawn to a bird call whereas Claim 2 is drawn to reed assemblies. Also, there is no antecedent basis in Claims 1 or 2 for "said tongue" to which reference is made in Claim 3. Claim 5 in (D) is not a proper dependent claim because it does not further limit the invention of Claim 4. Claim 5 is directed to an air channel, whereas Claim 4 is directed to a bird call. (E) is incorrect inasmuch as (A), (B), and (D) are incorrect.

14. ANSWER: (E). 35 U.S.C. § 112, second paragraph; MPEP 2173.05(r); *Ex parte Fressola*, 27 USPQ2d 1608 (Bd.Pat.App.&Inter. 1993). (A) through (D) are omnibus claims, seeking patent protection for an invention as shown and described, or substantially as shown and described, as disclosed, etc., and each should be rejected under 35 U.S.C. § 112, second paragraph.

15. ANSWER: (B). 35 U.S.C. §§ 101, and 112, second paragraph; MPEP 2173.05(q). The claim in (B) recites two positive steps of using paint. The first step is by applying it to a surface. The second step is removing the excess. (A), (C), and (D) are not proper process claims because they do not recite a positive step specifying how a use is accomplished. For example, (A) does not set forth the step(s) by which the antibodies isolate interferon.

16 ANSWER: (C). 35 U.S.C. § 102(b); MPEP 715.03, 2111.03, and 2173.05(h). Deletion of the anticipated element from the claim leaves an invention which is no longer anticipated by the reference. (A), (D), and (E) are incorrect because despite the amendments, the claims remain anticipated since the claims are still directed to the invention described in the reference wherein X is element A. For example, in (D) and (E), element A would still be a member of the group and the claim would still be anticipated by the prior art. (B) is incorrect because the argument does not change the fact that the claim remains directed to the same invention described in the reference wherein X is element A. (E) is also incorrect because "comprising" cannot be used in a proper Markush group.

17. ANSWER: (A). 37 CFR § 1.121. (A) is correct because Claim 2 is rewritten in accordance with 37 CFR § 1.121(b), i.e., brackets are employed around all deleted words, and only around deleted words; underlining is employed below all added words, and only under added words; and the original claim number is retained followed by the parenthetical designation "amended once." MPEP 714.22 makes clear that the term "brackets" in 37 CFR § 1.121(b) means angular brackets, thus: [ ]. "Brackets" in 37 CFR § 1.121(b) does not encompass and is to be distinguished from parentheses, thus: ( ). (B) is incorrect because the claim uses parentheses to identify what is being deleted, and all matter added to the claim is not underlined. Thus, the parentheses at the beginning and end of the phrase "apparatus as set forth above" does not show whether the phrase is to be deleted. All the words from "for producing" to "of said tube," are added to the claim, and must be underlined inasmuch as the dependent Claim 2 is being rewritten in independent form.

(C) is incorrect because words have been deleted without identifying them by putting brackets around them. (D) is incorrect because the word "a" is deleted without indicating the same, and "said" has been added without being underlined. (E) is incorrect because (D) is incorrect.

18. ANSWER: (E). 35 U.S.C. §§ 102 and 112, second paragraph. (E) is correct because it recites a combination of ingredients which is not disclosed in the publication. The composition is novel. (E) satisfies all the requirements of patentability in 35 U.S.C. §§ 101, 102, and 103. (A) and (C) are improper process claims because no steps are recited. As is pointed out in MPEP 2173.05(q), an attempt to claim a process without setting forth any steps involved in the process generally raises an issue of indefiniteness under 35 U.S.C. § 112, second paragraph. *Ex parte Erlich*, 3 USPQ2d 1011 (Bd. Pat. App. & Int. 1986). (B) is incorrect because it claims a compound which is anticipated by the prior art publication. 35 U.S.C. § 102(a). (D) is incorrect because it recites an omnibus claim. MPEP 2173.05(r) indicates that an omnibus claim should be rejected under 35 U.S.C. § 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language wrong.

19. ANSWER: (B). MPEP 716.09. (B) is correct because the scope of enablement set forth in the specification is identical to that set forth in the recited claim. As indicated in MPEP 2164.08, the only relevant concern between the breadth of a claim and enablement should be whether the scope of enablement provided to one skilled in the art by the disclosure is commensurate with the scope of protection sought by the claim. *In re Moore*, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971). (A) is wrong because bivalent metallic chloride is not disclosed as being the catalyst, and the test results are directed only to trivalent metallic chloride. (C) is wrong because the specification discloses a temperature range and the claim language states alternative temperatures which are more narrow than the range of temperatures set forth in the specification. (D) is wrong because it omits the requirement for heating in an inert atmosphere, which feature is taught as critical by the use of the verbal auxiliary "must" in the specification. As indicated by MPEP 2164.08(c), a claim should be rejected under the enablement provision of 35 U.S.C. § 112 if a feature is taught as critical in a specification, and is not recited in the claim. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). (E) is wrong because the claim recites alternative temperatures, which are more narrow in scope than the range of temperatures set forth in the specification, and it recites a catalyst "selected from the group consisting of AlCl<sub>3</sub> and ScCl<sub>3</sub>," which is more narrow in scope than the generic expression "a trivalent metallic chloride catalyst" set forth in the specification.

20. ANSWER: (A). The transitional phrase "consisting of" immediately following the preamble excludes any other element not specified in the claim. *In re Gray*, 53 F.2d 520, 11 USPQ 225 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448 (Bd. App. 1948) ("consisting of" defined as "closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith"); MPEP 2111.03. Thus, a claim which depends from a claim which "consists of" recited elements cannot add an element. The claim in (A) is improperly dependent on Claim 1 because the cavity and spring is not recited in Claim 1, and Claim 2 adds the "interior cavity (30)" and "retracting, metallic spring" elements to the suspended doll of Claim 1. MPEP 2111.03. The claims in (B), (C), (D), and (E) are proper dependent claims inasmuch as they

define elements existing in Claim 1, as opposed to adding new elements to the existing elements.

21. ANSWER: (E). (E) is correct because (A), (B), (C), and (D) are wrong. (A), (B), (C), and (D) are wrong because the combination of the web-manifolding machine and the typewriting machine lacks novelty. None of these answers claim the extra length carbon paper. Note that the question states "In the printing field industry, it is normal . . . ." MPEP 2115, citing *In re Young*, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 136 USPQ 458, 459 (CCPA 1963)), indicating that the recitation in the claims of the material or article worked upon by the apparatus lends no patentability to the apparatus.

22. ANSWER: (A). MPEP 2144.06 states that "In order 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 or the mere fact that the components at issue are functional or mechanical equivalents. *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958). ('The mere fact that components are claimed as members of a Markush group cannot be relied upon to establish equivalency of these components . . .')." In the present case, the rejection is based upon a reference which discloses the amino radical but does not show equivalency between the amino radical and the mercapto radical. The examiner cannot rely on the equivalency shown by the Markush grouping in John Doe's application. (B), (C), (D), and (E) are wrong because none of the actions overcomes the rejection, i.e., the claims continue to be anticipated by the reference because they read on an amino radical.

23. ANSWER: (B). The recited expression relates to a Markush group employing the term "comprising." MPEP 2111.03 recites, "The transitional term 'comprising' . . . does not exclude additional, unrecited elements . . ." *Ex parte Dotter*, 12 USPQ 382 (Bd. App. 1931), cited in MPEP 2173.05(h), holds that it is improper to employ the term "comprising" instead of "consisting of" with respect to a Markush group. The use of "comprising" to introduce the Markush group is open ended and indefinite. Hence, the expression does not particularly point out and distinctly claim the subject matter which the applicant regards as his invention as is required by 35 U.S.C. § 112, second paragraph. MPEP 2173.05(h) points out that Markush groups, which commonly recite members as being "selected from the group consisting of A, B and C," are an acceptable form of alternative expression which presents no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. (A) is wrong because the expression is not vague and indefinite. MPEP 2173.05(b). (C), (D), and (E) are wrong because they are in accord with MPEP 2173.05(h).

24. ANSWER: (E). The claim recited in (E) is directed to an apparatus comprising two basic elements, i.e., a drip pan and a grill, and the two elements are cooperatively interrelated, i.e., "said grill being removably positioned in . . . the drip pan." Since there is cooperation between the elements, the claim is not subject to a rejection on the ground of aggregation. MPEP 2173.05(k). Thus, the claim particularly points out and distinctly claims the subject matter which the applicant regards as his invention, and is compliance with 35 U.S.C. § 112, second paragraph. (A), (B), (C), and (D) are incorrect because the parts of the apparatus are not interrelated, i.e., the claims list components of the apparatus but fail to interrelate or interconnect the components. *Accord*,



*In re Hobson*, 68 USPQ 202 (CCPA 1946) (which is not listed in the MPEP).

25. ANSWER: (A). MPEP 2173.05(u) states, "If a trademark . . . is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. §112, second paragraph. *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982)." Choices (B) through (E) properly identify the particular material or product as "an elastomeric chlorosulphonated polythene," and choices (B) and (C) properly identify HYPALON as a trademark. Therefore, (B) through (E) comply with 35 U.S.C. § 112, second paragraph, regarding the reference to the trademark. The mere presence of the word "the" to introduce the "prefabricated panel" in (D) does not render an otherwise definite claim indefinite under § 112, second paragraph. MPEP 2173.05(e).

26. ANSWER: (E). In composition claims, if the composition is physically the same as that disclosed in the reference, the composition must have the same properties. *In re Spade*, 15 USPQ2d 1655 (Fed. Cir. 1990); MPEP 2112.01.

27. ANSWER: (E). In (E), the claims set forth in (B) and (D) do not violate 35 U.S.C. § 112, first and second paragraphs. Although (B) contains functional statement, i.e., "the composition being capable of being applied to a substrate submerged in water," there is no violation of 35 U.S.C. § 112, second paragraph, because it "set[s] out and circumscribes a particular area with a reasonable degree of precision and particularity . . ." *Ex parte Leonard and Brandes*, 187 USPQ 122, (Bd. App., 1974). Compare the functional statement "incapable of forming a dye with said oxidized developing agent" determined by the court in *In re Barr et al.*, 170 USPQ 330 (CCPA 1971) to be definite. Choice (D) omits any functional statement, and thus, avoids the functional issue. Both choices (B) and (D) avoid the rejection on undue breadth because they narrow the "liquid monomer" to a class known as alpha-cyanoacrylic acid esters, which the specification regards as an essential ingredient. MPEP 2174 states, "If the specification discloses that a particular feature or element is critical or essential to the practice of the invention, failure to recite or include that particular feature or element in the claims may provide a basis for a rejection based on the ground that those claims are not supported by an enabling disclosure." (A) is wrong because it recites "liquid monomer" without limiting the monomer to the essential "class known as alpha-cyanoacrylic acid esters." Since this monomer is "essential" according to the specification, any claim that does not include it would not be enabled. (A) and (C) do not overcome the rejection under 35 U.S.C. § 112, first paragraph, because the claims do not require the composition to include the filler, an ingredient disclosed as being "essential." Thus, (A) and (C) cover material that is clearly not enabled, and accordingly, they do not overcome a rejection under 35 U.S.C. § 112, first paragraph.

28. ANSWER: (B). (B) is in accordance with 37 CFR § 1.121(e), and MPEP 1453 under the heading "ORIGINAL CLAIM FURTHER AMENDED." (A) and (D) are incorrect because the second amendment does not reflect changes from the patented claim, but reflect changes from the first amendment which is not necessary. (C) and (E) are incorrect because Claim 1 is directed to be canceled, and the new claim should have a claim number which is a sequential number after Claim 1. (C) is also incorrect because by underlining the entire new claim, the amendment does

not reflect the changes made by the amendment.

29. ANSWER: (B). The claim language "means responsive to pressure increases caused by the pulse jet cleaning means for moving particulate matter in a downward direction towards the bottom of the hopper" does not read on the prior art teaching of a "rigid wall structure leading to the bottom of the hopper." *In re Donaldson Co. Inc.*, 29 USPQ2d 1845 (Fed. Cir. 1994); MPEP 2114. (A) is wrong because the wall still reads on the prior art. Both (C) and (D) are wrong because to employ pulses or means to dislodge the material also reads on the prior art.

### PART III

#### OPTION 3: BOTTLE STOPPER

3-1. Deleted.

3-2. ANSWER: (E). The tubular body having a spiral thread on the outside surface of the body is the distinguishing feature which permits the flow of gas from the bottle when the stopper is partially rotated. The limitations appearing in answers (A) through (D) are all disclosed in the prior art and would not distinguish the claimed invention.

3-3. ANSWER: (B). The claim in (B) complies with the provisions of 38 CFR § 1.153(a), and MPEP 1503.03 for the content and format for a claim for a design invention. (A), and (C) through (E) are not in the correct format for a design claim because the claim must identify the article specified in the Title of the Invention and refer to the article "as shown."

#### OPTION 4: MULTILAYERED DROPCLOTH

4-1. ANSWER: (A). The claimed thickness range of the center layer is not explicitly or impliedly taught by the prior art. As is made clear in MPEP 706.02, under the heading "DISTINCTION BETWEEN 35 U.S.C. 102 AND 103," "for anticipation under 35 U.S.C. [§] 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly." In (B), the "fabric" is taught by the prior art "dropcloth." The "center core positioned between first and second outer layers" of (B) is taught by the prior art "center layer 1" which is shown in Fig. 1 between "outer layers 1 and 5." The statement in (B) that "said outer layers made of spun bonded polypropylene film" is taught in the prior art, which states "outer layers 1 and 5 [are] made of spun bonded polypropylene film." Thus, (B) is anticipated by the prior art. In (C), the "multilayered dropcloth" is taught in line 2 of the prior art. The "first outer plastic layer and a second outer plastic layer" are taught by the prior art disclosure of "outer layers 1 and 5." The requirement in (C) for each outer plastic layer consisting of a plastic film that retains water" is taught by the prior art disclosure of the outer layers 1 and 5 being "made of spun bonded polypropylene film which is characterized by its ability to absorb and hold organic and inorganic liquids." Lastly, the requirement in (C) for "a center layer comprising plastic film" is taught by the prior art disclosure of "[a] center layer 3 . . . made of a plastic material." The plastic material is implicitly disclosed to be a film given the disclosure of the thickness of the entire dropcloth, and

the disclosure of the center layer in Fig. 1. Thus, (C) is anticipated by the prior art. Answer (D) refers, in part, to (C), which is anticipated by the prior art. Answer (E), refers to answers (B) and (C), which are anticipated by the prior art. Thus, Answers (B), (C), (D), and (E) are incorrect because each of them relates to claims every aspect of which is explicitly or impliedly taught by the prior art. Hence, no question of obviousness is present, and the claims lack novelty under 35 U.S.C. §102.

4-2. ANSWER: (C). Inasmuch as the disclosure points out that flexibility is an objective of the invention and that dropcloths of greater thickness than 0.0015 to 0.005 mils do not meet this objective, the recitation of "said dropcloth having a thickness within the range of 0.0025 to 0.005 mils" clearly satisfies the requirement of 35 U.S.C. § 112, second paragraph, and that the claim particularly point out and distinctly claim the invention. There is no supporting disclosure for the provision in (A) for the outer layers being "adhesively bonded" to the center layer, the provision in (B) for outer plastic layer having surface depressions on the inner surface, or the provision in (D) for the first and second plastic layers being bonded by heat on an adhesive layer. Inasmuch as (E) refers to (A) and (B), which lack supporting disclosure, (E) is also relies on answers which lack supporting disclosure. Thus, (A), (B), (D), and (E) are wrong because none of their passages recite features which particularly point out and distinctly claim the invention. (C) particularly points out and distinctly claims a feature of the invention related to the objective of flexibility.

4-3. ANSWER: (D). In (D), the claimed feature is supported by the disclosure and not taught by the prior art, i.e., first and second outer layers made of spun bonded polypropylene film containing segments of spun bonded polybutylene. Hence, the claim recited in answer (D) is not anticipated by the prior art. MPEP 706.02(a) recites, under the heading "DISTINCTION BETWEEN 35 U.S.C. 102 AND 103," that "for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or implicitly." (A) is incorrect because it claims a feature taught by the prior art, although supported by the written description, i.e., a center plastic layer selected from the group consisting of low density polyethylene, linear low density polyethylene, and polypropylene. The claims in (B) and (C) address features taught by the prior art. In (B), the claimed feature taught by the prior art, although supported by the written description, is a center layer plastic film containing an inorganic white pigment. In (C), the claimed feature taught by the prior art is that the surface depressions on the outer surface are "uniformly distributed" about the outer surfaces of the first and second outer layers, and FIG. 1 of the prior art depicts "uniformly distributed" embossed depressions 6 about the outer surfaces of outer layers 1 and 5. Therefore, although the claim in (C) is supported by the written description, it is also anticipated by the prior art. In (E), a claimed limitation which is not supported by the disclosure is that the dropcloth have a thickness of "0.0005 mils."

#### OPTION 5: OFFICE CHAIR

5-1. ANSWER: (D). In (D), the recited limitation is disclosed as achieving the object of the invention, i.e., overcoming prior art disadvantage of exerting undesirable upward pressure on user's thighs when user attempts to place feet on floor. This satisfies the written description requirement of 35 U.S.C. § 112, first paragraph. The prior art teaching is inapposite to the

recited limitation since the user is only able to tilt the seat rearwardly while maintaining his or her thighs in a substantially fixed position. It is the substantially fixed position of the front portion of the prior art seat which gives rise to the disadvantage which the recited limitation is able to overcome. (A), (C), and (E) are wrong because the recited limitations, "casters attached to the lower most end of said column," "adjustment means comprising an adjustable screw contained inside said interconnecting means for locking said means in place," and "a backrest connected to said support column" are not supported by the written description. (B) is wrong because the recited limitation of an assembly comprising "a spring, bolt, nut and washer combination" reads on the prior art.

5-2. ANSWER: (C). In (C), the claim particularly points out the embodiment of the invention depicted in FIG. 3. (A) is wrong because "said backrest" lacks an antecedent basis and does not distinguish between the two embodiments of the invention. (B) is wrong because "said first bracket," and "said second bracket" have no antecedent basis in claim 1. (D) is incorrect because there is no antecedent basis for "said externally threaded screws" have no antecedent basis in claim 1. (E) is incorrect because the written description requirement of 35 U.S.C. § 112, first paragraph, is not satisfied because a first flange, a second flange, a bolt, and spring captured on the bolt do not claim the disclosed invention. Thus, in (E) the recited limitation does not distinguish between the two embodiments of the invention.

5-3. ANSWER: (A). The recited limitation recited in (A), i.e., "the rear portion of the seat is fixedly secured to a backrest," is particularly directed to one of the two embodiments relating to the manner in which the backrest may be attached to the chair. The disclosure recites "A conventional backrest 50 is provided and the backrest may be attached to either a rear portion of a seat 52 (not illustrated in Fig. 3) or to the mounting bracket 46." Choices (B), (C), (D), and (E) recite limitations which are not described in the disclosure. The claimed limitation in (B) of the "rear portion of the seat is fixedly connected to a frame, said frame being fixed to a backrest" reads on the prior art. The claimed limitations in (C), "a backrest is fixed to the upper end of said support column," in (D), "a backrest is fixed to said base," and in (E), "the front portion of the seat is connected to the rear seat portion solely through a bracket beneath the seat" are not described in the in disclosure of the invention.

## OPTION 6: OPTICAL RECORDING MEDIA

6-1. Deleted.

6-2. ANSWER: (C). (C) is supported by disclosure and overcomes prior art. (A) has no antecedent basis for "said quencher." MPEP 2173.05(e). Regarding (B), critical features must be claimed. For (B), the amount of the quencher is critical, but not set forth. MPEP 2164.08(c). Moreover, (B) appears to read on the prior art. (D) has narrower and broader ranges for the quencher, and such ranges are not permitted in the same claim. MPEP 2173.05(c). (E) is wrong because (B) is wrong.

6-3. Deleted.