



QUESTION BANK 2011

OMNIPREP QUESTION BANK 2011

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QUESTION 1

Inventor Joe is anxious to get a patent with the broadest claim coverage possible for the invention. Joe retained a registered practitioner, Jane, to obtain the advantage of legal counsel in obtaining broad protection. Jane filed a patent application for the invention. The inventor heard that, although patent prosecution is conducted in writing, it is possible to get interviews with examiners. Joe believes an interview might hasten the grant of a patent by providing the examiner a better understanding of the true novelty of the invention. Which of the following are consistent with the patent law, rules and procedures as related by the MPEP regarding usage of interviews?

- (A) Prior to the first Office action being mailed the inventor calls the examiner to whom the application is docketed to offer help in understanding the specification.
- (B) After receiving the first Office action Jane calls the examiner for an interview for the purpose of clarifying the structure and operation of the invention as claimed and disclosed, because the examiner's analysis regarding patentability in the rejection is novel and suggests that the examiner is interpreting the claimed invention in a manner very different from the inventor's intent.
- (C) Jane has Larry, a registered practitioner in the Washington D.C. area, who is more familiar with interview practice to call the examiner. Jane gives Larry a copy of the first Office action, which suggests that the primary examiner's analysis is incorrect, and offers to explain why. Jane instructs Larry that because Larry is unfamiliar with the inventor, Larry should not agree to possible ways in which the claims could be modified, or at least indicate to the examiner that Jane would have to approve of any such agreement.
- (D) Jane calls the primary examiner after receiving the final rejection, demanding that the examiner withdraw the finality of the final action. When the examiner states that the final rejection is proper, Jane demands an interview as a matter of right to explain the arguments.
- (E) (B) and (D).

(B) is the most correct answer. MPEP § 713.01, under the heading "Scheduling And Conducting An Interview," states "[a]n interview should be had only when the nature of the case is such that the interview could serve to develop and clarify specific issues and lead to a mutual understanding between the examiner and the applicant, and thereby advance the prosecution of the application."

QUESTION 2

Claim 1 of an application recites "[a]n article comprising: (a) a copper substrate; and (b) an electrically insulating layer on said substrate." The specification defines the term "copper" as being elemental copper or copper alloys. In accordance with the patent laws, rules and procedures as related in the MPEP, for purposes of searching and examining the claim, the examiner should interpret the term "copper" in the claim as reading on:

- (A) Elemental copper only, based on the plain meaning of "copper."
- (B) Copper alloys only, based on the special definition in the specification.

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- (C) Elemental copper and copper alloys, based on the special definition in the specification.
- (D) Any material that contains copper, including copper compounds.
- (E) None of the above.

Answer: (C) is the most correct answer. When the specification expressly provides a special definition for a term used in the claims, the term must be given that special meaning. See MPEP § 2111.01.

QUESTION 3

In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following does not constitute prior art upon which a primary examiner could properly rely upon in making an obviousness rejection under 35 USC 103?

- (A) A U.S. patent in the applicant's field of endeavor which was issued two years before the filing date of applicant's patent application.
- (B) A non-patent printed publication in a field unrelated to the applicant's field of endeavor but relevant to the particular problem with which the inventor-applicant was concerned, which was published the day after the filing date of applicant's application.
- (C) A printed publication published more than 1 year before the filing date of applicant's patent application, which publication comes from a field outside the applicant's field of endeavor but concerns the same problem with which the applicant-inventor was concerned.
- (D) A printed publication in the applicant's field of endeavor published 3 years before the filing date of applicant's patent application.
- (E) A U.S. patent which issued more than 1 year before the filing date of applicant's patent application, which the Office placed in a different class than the applicant's patent application, but which concerns the same problem with which the applicant-inventor was concerned, and which shows the same structure and function as in the applicant's patent application.

(B) is the most correct answer. MPEP § 2141.01. Quoting from *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593, 1597 (Fed. Cir.), cert. denied, 481 U.S. 1052 (1987), MPEP 2141.01, under the heading "Prior Art Available Under 35 U.S.C. 102 Is Available Under 35 U.S.C. 103," states "[b]efore answering Graham's 'content' inquiry, it must be known whether a patent or publication is in the prior art under 35 U.S.C. § 102.' Subject matter that is prior art under 35 U.S.C. § 102 can be used to support a rejection under section 103. *Ex parte Andresen*, 212 USPQ 100, 102 (Bd. Pat. App. & Inter. 1981) ('it appears to us that the commentator [of 35 U.S.C.A.] and the [congressional] committee viewed section 103 as including all of the various bars to a patent as set forth in section 102.')." Because the printed publication in (B) was not published until after the filing date of the patent application, it does not constitute prior art.

QUESTION 4

In a reexamination proceeding a non-final Office action dated November 8, 2001 set a shortened statutory period of 2 months to reply. The patent owner, represented by a registered practitioner, filed a response on March 7, 2002, which included an amendment of the claims. No request for an extension of time was received. As of May 8, 2002, which of the following

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actions would be in accord with the patent laws, rules and procedures as related in the MPEP?

- (A) The registered practitioner should file a request and fee for an extension of time of two months.
- (B) The registered practitioner should file a petition for revival of a terminated reexamination proceeding showing the delay was unavoidable or unintentional, and the appropriate petition fee for entry of late papers.
- (C) The primary examiner responsible for the reexamination should mail a Notice of Allowance and grant a new patent. The patent owner's failure to timely respond to the outstanding Office action does not affect the allowability of the claims in the patent.
- (D) The examiner should provide an Office action based upon the claims in existence prior to the patent owner's late amendment, and mail a Final Office action.
- (E) The registered practitioner should request an extension of time of four months, and file a Notice of Appeal.

(B) is the most correct answer. 37 CFR § 1.137; and MPEP § 2268. The patent owner will need to file a petition for entry of late papers in order to have their response entered, considered and acted upon. According to MPEP 2268, "[p]ursuant to 37 CFR 1.550(d), an ex parte reexamination proceeding is terminated if the patent owner fails to file a timely and appropriate response to any Office . . . An ex parte reexamination proceeding terminated under 37 CFR 1.550(d) can be revived if the delay in response by the patent . . . was unavoidable in accordance with 37 CFR 1.137(a), or unintentional in accordance with 37 CFR 1.137(b)."

QUESTION 5

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

Compound Y.

- (A) In the specification, Bloc explains that compound Y is an intermediate in the chemical
- (B) manufacture of synthetic Z. With respect to synthetic Z, the specification discloses its structural
- (C) formula and further states that synthetic Z is modeled on the natural form of Z to give it the same therapeutic ability to alleviate pain. The specification goes on to state that synthetic Z is also a cure for cancer. On June 2, 2001, the practitioner received an Office action from the primary examiner rejecting the claim. The claim is rejected under 35 U.S.C. 101 as being inoperative; that is, the synthetic Z does not operate to produce a cure for cancer (i.e., incredible utility). Bloc believes he is entitled to a patent to his compound Y. In accordance with the patent laws, rules and procedures as related in the MPEP, how best should the practitioner reply to the rejection of the claim?

- (A) Advise Bloc that he should give up because a cure for cancer is indeed incredible and is unproven.
- (B) File a reply arguing that a cure for cancer is not incredible and he can prove it if

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given the chance.

- (C) File a reply arguing that whether or not a cure for cancer is incredible is superfluous since Bloc has disclosed another utility – alleviating pain, which is not incredible.
- (D) File a reply arguing that the claim is directed to compound Y, not synthetic Z.
- (E) File a reply arguing that synthetic Z is modeled on the natural form of Z.

(C) is the best answer. MPEP §§ 2107.01 and 2107.02. MPEP § 2107.01, under the heading “Therapeutic or Pharmacological Utility,” cites *In re Chilowsky*, 229 F.2d 457, 461-2, 108 USPQ 321, 325 (CCPA 1956); *In re Gazave*, 379 F.2d 973, 978, 154 USPQ 92, 96 (CCPA 1967); and *Nelson v. Bowler*, 626 F.2d 853, 856, 206 USPQ 881, 883 (CCPA 1980) as taking the position that “[i]nventions asserted to have utility in the treatment of human or animal disorders are subject to the same legal requirements for utility as inventions in any other field of technology.” MPEP § 2107.02, under the heading “The Claimed Invention Is The Focus Of The Utility Requirement,” states “. . . regardless of the category of invention that is claimed (e.g., product or process), an applicant need only make one credible assertion of specific utility for the claimed invention to satisfy 35 U.S.C. 101 and 35 U.S.C. 112; additional statements of utility, even if not “credible,” do not render the claimed invention lacking in utility. See, e.g., . . . *In re Gottlieb*, 328 F.2d 1016, 1019, 140 USPQ 665, 668 (CCPA 1964) (‘Having found that the antibiotic is useful for some purpose, it becomes unnecessary to decide whether it is in fact useful for the other purposes ‘indicated’ in the specification as possibly useful.’).” The issue is whether Mr. Bloc has disclosed a specific utility for the claimed compound Y sufficient to satisfy the practical utility requirement of 35 U.S.C § 101. According to the set of facts, we know that compound Y is an intermediate in the chemical manufacture of synthetic Z. We are given two utilities for synthetic Z: 1) alleviating pain, a utility it shares with the natural form of Z; and, 2) curing cancer. The examiner focuses on the disclosure that synthetic Z is a cure for cancer. Even if one were to agree that synthetic Z’s ability to cure cancer amounts to an incredible utility, a claim to the intermediate compound Y would not run afoul of the utility requirement of 35 U.S.C. § 101 where another substantial, credible and specific utility is alternatively demonstrated. Here, the specification discloses that synthetic Z, like the natural form of Z, alleviates pain. The alleviation of pain is another substantial, credible and specific utility and serves to give compound Y an alternative utility to that of being used to make a cancer-curing substance. An applicant need not show that all disclosed utilities are credible. An applicant need only show that one of the disclosed utilities is in fact credible. *In re Gottlieb*, supra. The establishment of a credible, substantial and specific utility renders the disclosure of an additional incredible utility superfluous, and therefore ultimately irrelevant. Accordingly, Mr. Bloc’s best course of action is to make the argument that he has disclosed another substantial, credible, and specific utility, notwithstanding the disclosure of curing cancer.

QUESTION 6

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

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35USC 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.

(D) is the most correct answer. As set forth in MPEP § 2135, under the heading "General Requirements of 35 U.S.C. 102(d)," states "(C) The foreign patent or inventor's certificate must be actually granted (e.g., by sealing of the papers in Great Britain) before the U.S. filing date. It need not be published."

QUESTION 7

Smith's first invention is a new method of fabricating a semiconductor capacitor in a dynamic random access memory (DRAM) cell. Smith filed a first patent application on December 13, 2001 disclosing and claiming the first invention. Smith's later, second invention, is an improved semiconductor capacitor in a DRAM cell and a method of making it. Smith filed a second application on December 16, 2002, claiming the benefit of the filing date of the copending first application. The second application contains claims 1-20, and a specification that provides support for the claimed subject matter in compliance with 35 USC 112, first paragraph. In the second application, claims 1-10 are drawn to Smith's first invention, and claims 11-20 are drawn to Smith's second invention. The primary examiner found a non patent printed publication authored by Jones published on February 4, 2002. The article discloses the both of Smith's inventions. Which of the following courses of action by the examiner would be in accord with the patent laws, rules and procedures as related in the MPEP?

- (A) The examiner can reject claims 1-20 in the second application using the article because the publication date of the article is earlier than the filing date of the second application.
- (B) The examiner cannot reject any of the claims in the second application using the article because the second application claims the benefit of the filing date of the first application.
- (C) The examiner can reject claims 1-20 in the second application using the article because the second application is not entitled to the benefit of the filing date of the first application since the second application was filed more than one year from the filing date of the first application.
- (D) The examiner can reject claims 1-10, but cannot reject claims 11-20 in the second application because the first application did not disclose the improved capacitor set forth in claims 11-20.
- (E) The examiner cannot reject claims 1-10, but can reject claims 11-20 in the second application because the first application did not disclose an improved capacitor set forth in claims 11-20.

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The most correct answer is (E). See MPEP § 201.11, under the heading "VI. When Not Entitled To Benefit Earlier Of Filing Date, " states "[a]ny claim in a continuation-in-part application which is directed *solely* to subject matter adequately disclosed under 35 U.S.C. 112 in the parent nonprovisional application is entitled to the benefit of the filing date of the parent nonprovisional application. However, if a claim in a continuation-in-part application recites a feature which was not disclosed or adequately supported by a proper disclosure under 35 U.S.C. 112 in the parent nonprovisional application, but which was first introduced or adequately supported in the continuation-in-part application such a claim is entitled only to the filing date of the continuation-inpart application. See *In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995) and *Transco Products, Inc. v. Performance Contracting Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994)." Accordingly, claims 1-10 are entitled to the benefit of the filing date of the first application, but claims 11-20 are not entitled to the benefit of the filing date of the first application because claims 11-20 recite an improved capacitor, which was not disclosed in the first application. Claims 1-10 have an effective filing date earlier than the publication date of the article. Claims 11-20 have a filing date later than the publication date of the article. For 35 U.S.C. 102(a) to apply, the reference must have a publication date earlier in time than the effective filing date of the application. See MPEP 706.02(a), paragraph "III. 35 U.S.C. 102(a)."

QUESTION 8

In accordance with the patent laws, rules and procedures as related in the MPEP, definiteness of claim language under 35 U.S.C. 112, second paragraph must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure.
- (B) The teachings of the prior art.
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.
- (D) The claim interpretation that would be given by one possessing expert skill in the pertinent art at the time the invention was made
- (E) (A), (B) and (C).

ANSWER: (E) is the most correct answer. As set forth in MPEP § 2173.02, "[d]efiniteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made."

QUESTION 9

Inventors B and C are employed by Corporation D, which authorized registered practitioner E to prepare and file a patent application claiming subject matter invented by B and C. Inventor B signed the oath, an assignment to Corporation D, and a power of attorney authorizing practitioner E to prosecute the application. Inventor C refused to sign the oath and any assignment documents for the application. The employment contract between inventor C and Corporation D contains no language obligating C to assign any invention to Corporation D. A patent application was properly filed in the USPTO under 37 CFR 1.47 naming B and C as inventors, but without inventor C signing the oath. C has now started his own company

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competing with Corporation D producing a product with the invention in the application. Inventor B is a friend of inventor C and wants C to have continued access to the application. Which of the following statements is in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) Inventor C, who has not signed the oath or declaration, may revoke the power of attorney to practitioner E and appoint practitioner F to prosecute the application.
- (B) Inventor C cannot be excluded from access to the application because inventor B has not agreed to exclude inventor C. In order to exclude a co-inventor from access to an application, all the remaining inventors must agree to exclude that coinventor.
- (C) Inasmuch as one of the named joint inventors has not assigned his or her rights to Corporation D, the corporation is not an assignee of the entire right and interest, and therefore cannot exclude inventor C from access to the application.
- (D) An inventor who did not sign the oath or declaration filed in an application can always be excluded from access to an application.
- (E) An assignee filing an application can control access to an application and exclude inventors who have not assigned their rights and other assignees from inspecting the application.

(C) is the most correct answer. MPEP § 106 states “[t]he assignee of record of the entire interest in an application may intervene in the prosecution of the application, appointing an attorney or agent of his or her own choice. See 37 CFR § 3.71. Such intervention, however, does not exclude the applicant from access to the application to see that it is being prosecuted properly, unless the assignee makes specific request to that effect.”

QUESTION 10

In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following fees may not be reduced by 50 percent for “small entities”?

- (A) The basic filing fee for a design patent application.
- (B) The fee for a disclaimer.
- (C) The fee for a petition for an extension of time.
- (D) The fee for recording a document affecting title.
- (E) The maintenance fee due at 3 years and six months after grant.

(D) is the most correct answer. 35 U.S.C. § 41(h); MPEP §§ 302.06; 509.02. 35 U.S.C. § 41(h) specifies that the fees “charged under subsection (a) or (b) shall be reduced by 50 percent with respect to their application to any small business concern as defined under section 3 of the Small Business Act, and to any independent inventor or nonprofit organization as defined in regulations issued by the Director.” Since the fee for a document affecting title is charged pursuant to 35 U.S.C. § 41(d)(1), it is not subsection (a) or (b), and it is not entitled to a small entity discount. See also MPEP 509.02, which states, “[o]ther fees, established under section 41 (c) or (d) of Title 35, United States Code, are not reduced for small entities since such a reduction is not permitted or authorized by Public Law 97-247. Fees which are not reduced include . . . miscellaneous fees and charges, 37 CFR 1.21.” Fees for recording documents

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affecting title are set under 37 CFR § 1.21(h). See MPEP § 302.06.

QUESTION 11

The specification of a patent application contains limited disclosure of using antisense technology in regulating three particular genes in *E. coli* cells. The specification contains three examples, each applying antisense technology to regulating one of the three particular genes in *E. coli* cells. Despite the limited disclosure, the specification states that the “the practices of this invention are generally applicable with respect to any organism containing genetic material capable of being expressed such as bacteria, yeast, and other cellular organisms.” All of the original claims in the application are broadly directed to the application of antisense technology to any cell. No claim is directed to applying antisense technology to regulating any of the three particular genes in *E. coli* cells. The claims are rejected under 35 USC 112, first paragraph, for lack of enablement. In support of the rejection, a publication is cited that correctly notes antisense technology is highly unpredictable, requiring experimentation to ascertain whether the technology works in each type of cell. The publication cites the inventor’s own articles (published after the application was filed) that include examples of the inventor’s own failures to control the expressions of other genes in *E. coli* and other types of cells. In accordance with the patent laws, rules and procedures as related in the MPEP, the rejection is:

- (A) appropriate because the claims are not commensurate in scope with the breadth of enablement inasmuch as the working examples in the application are narrow compared to the wide breadth of the claims, the unpredictability of the technology, the high quantity of experimentation needed to practice the technology in cells other than *E. coli*.
- (B) appropriate because the claims are not commensurate in scope with the breadth of the enablement inasmuch no information is provided proving the technology is safe when applied to animal consumption.
- (C) inappropriate because the claims are commensurate in scope with the breadth of enablement inasmuch as the specification discloses that the “the practices of this invention are generally applicable with respect to any organism containing genetic material capable of being expressed.”
- (D) inappropriate because the claims are commensurate in scope with the breadth of enablement inasmuch as the claims are original, and therefore are self-supporting.
- (E) inappropriate because the claims are commensurate in scope with the breadth of the enablement inasmuch as the inventor is not required to theorize or explain why the failures reported in the article occurred.

(A) is the most correct answer. 35 U.S.C. § 112, first paragraph; MPEP §§ 2164.01 and 2164.06(b). MPEP § 2164.01 states “[t]he standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. In *re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term ‘undue experimentation,’ it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation.” See also the

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discussion of *Enzo Biochem, Inc. v. Calgene, Inc.*, 52 USPQ2d 1129 (Fed. Cir. 1999) in MPEP § 2164.06(b).

QUESTION 12.

Tribell files a patent application for her aroma therapy kit on November 29, 1999, which issues as a patent on August 7, 2001. She tries to market her kit but all of her prospects are concerned that her patent claims are not sufficiently broad. On September 5, 2001, Tribell asks a registered practitioner for advice on what to do to improve her ability to market her aroma therapy kit. At the consultation the practitioner learns that in the original patent application, Tribell had a number of claims which were subjected to a restriction requirement, but were nonelected and withdrawn from further consideration. The practitioner also determines that the claims in the patent obtained by Tribell were narrower than the broader invention disclosed in the specification, and the cited references may not preclude patentability of the broader invention. Which of the following is the best course of action to pursue in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) Tribell should file a reissue application under 35 USC 251 within two years of the issuance of the patent, broadening the scope of the claims of the issued patent.
- (B) Tribell should file a reissue application under 35 USC 251 any time during the period of enforceability of the patent to broaden the scope of the claims of the issued patent, and then file a divisional reissue application of the first reissue application on the nonelected claims that were subjected to a restriction requirement in the nonprovisional application which issued as a patent.
- (C) Tribell should simultaneously file two separate reissue applications under 35 USC 251, one including an amendment of broadening the claims in the original patent, and the other including the nonelected claims that were subjected to a restriction requirement in the nonprovisional application which issued as a patent.
- (D) Tribell should immediately file a divisional application under 37 CFR 1.53(b) including the nonelected claims that were subjected to a restriction requirement in the original application.
- (E) Tribell should immediately file a reissue application under 35 USC 251, including the nonelected claims that were subjected to a restriction requirement in the original application.

(A) is the most correct answer. 35 U.S.C. § 251, MPEP § 1402 (fifth paragraph). MPEP § 1402 states that one of the “most common bases for filing a reissue application [is] (A) the claims are too narrow or too broad.” The claims may be broadened in a reissue application filed by the inventor within two years from the patent issue date.

QUESTION 13

Inventor files an application containing the following original Claim 1:

1. A widget comprising element A, and element B.

In a first Office action on the merits, a primary examiner rejects claim 1 under 35 USC 103 as

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being obvious over reference X. Reference X explicitly discloses a widget having element A, but it does not disclose element B. The examiner, however, takes official notice of the fact that element B is commonly associated with element A in the art and on that basis concludes that it would have been obvious to provide element B in the reference X widget. In reply to the Office action, the registered practitioner representing the applicant makes no amendments, but instead requests reconsideration of the rejection by demanding that examiner show proof that element B is commonly associated with element A in the art. Which of the following actions, if taken by the examiner in the next Office action would be in accord with the patent laws, rules and procedures as related in the MPEP?

- I. Vacate the rejection and allow the claim.
- II. Cite a reference that teaches element B is commonly associated with element A in the art and make the rejection final.
- III. Deny entry of applicant's request for reconsideration on the ground that it is not responsive to the rejection and allow applicant time to submit a responsive amendment.

- (A) I and II only.
- (B) II only.
- (C) II and III only.
- (D) I, II, and III.
- (E) I and III only.

(A) is the most correct answer. MPEP § 2144.03 provides that when an applicant seasonably traverses an officially noticed fact, the examiner may cite a reference teaching the noticed fact and make the next action final. Here, applicant did seasonably traverse the noticed fact by demanding proof in response to the rejection. II is therefore an appropriate action by the examiner. I is also an appropriate action because the examiner should vacate a rejection based on official notice if no support for the noticed fact can be found in response to a challenge by the applicant. See *In re Ahlert*, 424 F.2d 1088, 1091 (C.C.P.A. 1970) (“[a]ssertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work” and “[a]llegations concerning specific “knowledge” of the prior art, which might be peculiar to a particular art should also be supported”).

QUESTION 14

In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following statements regarding operability or enablement of a prior art reference is the most correct?

- (A) The level of disclosure required for a reference to be enabling prior art is no less if the reference is a United States patent than if it is a foreign patent.
- (B) A reference is not presumed to be operable merely because it expressly anticipates or makes obvious all limitations of an applicant's claimed apparatus.
- (C) A non-enabling reference may not qualify as prior art for the purpose of determining anticipation or obviousness of the claimed invention.
- (D) A reference does not provide an enabling disclosure merely by showing that the public was in possession of the claimed invention before the date of the

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applicant's invention.

(E) All of the above are correct.

(A) is the most correct answer. MPEP § 2121, under the heading "What Constitutes An 'Enabling Disclosure' Does Not Depend On The Type Of Prior Art The Disclosure Is Contained In," states, in reliance upon *In re Moreton*, 288 F.2d 708, 711, 129 USPQ 227, 230 (CCPA 1961): "The level of disclosure required within a reference to make it an 'enabling disclosure' is the same no matter what type of prior art is at issue.... There is no basis in the statute (35 U.S.C. 102 or 103) for discriminating either in favor of or against prior art references on the basis of nationality."

QUESTION 15

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.

(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)."

QUESTION 16

On January 3, 2003, a registered practitioner filed a continuation application that includes a benefit claim to a prior-filed application. The practitioner simultaneously filed in the prior filed application an express abandonment in favor of a continuing application. The prior application contained five drawing figures described in the specification. However, the continuation application contains only four of the five drawing figures. The specification of the continuation application did not include a complete description of the missing drawing figure. A postcard from the USPTO, listing the contents of the continuation application, contains a note that only four drawing figures were received. The practitioner inadvertently omitted one of the drawing figures mentioned in the specification when he filed the continuation application. The missing drawing figure shows a claimed feature of the invention. On February 10, 2003, the practitioner received a Notice of Omitted Item(s) properly according a filing date of January 3, 2003 for the continuation application without the missing drawing figure and notifying the applicant that the drawing is missing. Which of the following procedures for filing the missing drawing would comply with the patent laws, rules and procedures as related in the MPEP for according the

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continuation application a January 3, 2003 filing date with the five drawing figures that were present in the application?

- (A) The practitioner files the missing drawing figure in response to the Notice of Omitted Item(s) within the time period set forth in the notice.
- (B) The practitioner files the missing drawing figure and an amendment to the specification to add a complete description of the missing drawing figure in response to the Notice of Omitted Item(s) within the time period set forth in the notice.
- (C) The practitioner files an amendment to cancel the description of the missing drawing figure from the specification of the continuation application.
- (D) If the continuation application as originally filed includes an incorporation by reference of the prior-filed application to which the benefit is claimed, the practitioner can file the missing drawing figure any time prior to the first Office action.
- (E) The practitioner files the missing drawing figure accompanied by a petition under 37 CFR 1.53(e) with the petition fee set forth in 37 CFR 1.17(h) only alleging that the drawing figure indicated as omitted was in fact deposited with the USPTO with the application papers.

(D) is the most correct answer. MPEP § 201.06(c), under the heading "INCORPORATION BY REFERENCE", subheading "B. Application Entitled to a Filing Date," states that "[i]f the application as originally filed includes a proper incorporation by reference of the prior application(s), an omitted specification page(s) and/or drawing figure(s) identified in a "Notice of Omitted Item(s)" may be added by amendment provided the omitted item(s) contains only subject matter in common with such prior application(s). In such case applicant need **not** respond to the "Notice of Omitted Item(s)." Applicant should submit the amendment adding the omitted material prior to the first Office action to avoid delays in the prosecution of the application."

QUESTION 17

Patent application A was filed on January 12, 1995, containing claims 1-10. A primary examiner rejects the claims under 35 USC 102(b) as being anticipated by a U.S. patent issued on June 2, 1992. The rejection also relies on a technical paper published March 12, 1993 to show that a characteristic is inherent in the patent, although not expressed in its disclosure. According to the patent laws, rules and procedures as related in the MPEP, which of the following actions is most likely to overcome the rejection?

- (A) Filing a declaration and exhibits under 37 CFR 1.131 to antedate the reference U.S. patent.
- (B) Filing evidence under 37 CFR 1.132 tending to show commercial success of the invention.
- (C) Filing evidence under 37 CFR 1.132 tending to show unexpected results of the invention.
- (D) Amending the specification of application A to claim priority under 35 USC 120 by a specific reference to a prior copending application B that was filed before June 2, 1992 by the same inventor and discloses the invention claimed in at least one claim of application A in the manner provided by the first paragraph of 35 USC 112.

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(E) Submitting arguments pointing out that the rejection under 35 USC 102(b) relies on more than one reference.

(D) is most correct. MPEP § 706.02(b) (8th ed., Rev. 1) states that “[a] rejection based on 35 U.S.C. § 102(b) may be overcome by... (C) perfecting priority under... 35 U.S.C. § 120 by amending the specification of the application to contain a specific reference to a prior application...” Answer (A) is incorrect because a declaration and evidence filed under 37 CFR § 1.131 cannot antedate a reference that qualifies as prior art under 35 U.S.C. § 102(b), a statutory bar. See 37 CFR § 1.131(a); MPEP § 715, “SITUATIONS WHERE 37 CFR 1.131 AFFIDAVITS OR DECLARATIONS ARE INAPPROPRIATE.”

QUESTION 18

Application Number A was published as U.S. Patent Application Publication Number B. A member of the public reviewed the listing of the file contents of the application on the Patent Application Information Retrieval system and determined that the application was still pending, that a final Office action was mailed, and that the application file is in the Technology Center where it is being examined. The member of the public does not have a power to inspect, but would like a copy of the final Office action as well as the other papers in the patent application. In accordance with the patent laws, rules and procedures as related in the MPEP, can a copy of these papers be obtained by the member of the public, and if so, how can the copy be obtained?

- (A) No, a copy cannot be obtained because patent applications are maintained in confidence pursuant to 35 USC 122(a).
- (B) No, a copy cannot be obtained because the patent application is still pending.
- (C) Yes, a member of the public can go to the Technology Center and ask for the file for copying at a public photocopier.
- (D) Yes, the member of the public can complete a “Request for Access to an Application Under 37 CFR 1.14(e)” and, without payment of a fee, order the file from the File Information Unit. Upon the Unit’s receipt of the application, the member of the public can use a public photocopier to make a copy.
- (E) Yes, the member of the public can order a copy from the Office of Public Records, with a written request and payment of the appropriate fee.

(E) is the most correct answer. MPEP § 103, under the heading “Published U.S. Patent Applications” states that “If a patent application has been published pursuant to 35 U.S.C. 122(b), then a copy of the specification, drawings, and all papers relating to the file of that published application (whether abandoned or pending) may be provided to any person upon written request and payment of the fee.”

QUESTION 19

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

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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).

(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.

QUESTION 20

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.

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(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.

QUESTION 21

When, in accordance with the patent laws, rules and procedures as related in the MPEP, is a supplemental oath or declaration treated as an amendment under 37 CFR 1.312?

- (A) When filed in a nonprovisional application after the Notice of Allowance has been mailed.
- (B) When filed in a reissue application at any point during the prosecution.
- (C) When filed in a nonprovisional application after the payment of the Issue Fee.
- (D) When filed in a reissue application after the Notice of Allowance has been mailed.
- (E) (A) and (D).

(D) is the most correct answer. MPEP § 714.16, third paragraph, states "a supplemental reissue oath or declaration is treated as an amendment under 37 CFR 1.312 because the correction of the patent which it provides is an amendment of the patent, even though no amendment is physically entered into the specification or claim(s)."

QUESTION 22

A registered practitioner files a patent application with the following claim:

1. A plastic insert for the bottom of a shopping cart comprising circular receptacles to receive wine bottles and to maintain them in an upright and stable position even while the shopping cart is moved about a store so that they do not fall and break.

Patent A discloses a plastic insert for the bottom of a shopping cart comprising rectangular receptacles to receive cereal boxes and to maintain them in an upright and stable position even while the shopping cart is moved about a store in order to keep them organized in the cart. Patent A also discloses that the receptacles could be any circular diameter to receive complementary shaped bottles or jars such as to securely hold 2-liter soft drink bottles or mayonnaise jars. A primary examiner rejected the claim as being obvious under 35 USC 103 over Patent A reasoning that Patent A suggests to one of ordinary skill in the art an insert for a shopping cart with circular receptacles for the purpose of stably maintaining any bottle, including wine bottles, while pushing the cart about a store so that the cart remains organized. Assume the examiner has made a sufficient prima facie case of obviousness. Following receipt of the rejection, the

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practitioner filed a timely reply. The practitioner argued that Patent A does not render obvious the claimed subject matter because there is no suggestion of a plastic insert to keep a wine bottle from falling and breaking in a shopping cart. Which of the following best explains why, in accordance with the patent laws, rules and the procedures as related in the MPEP, the examiner should or should not be persuaded by the practitioner's argument?

- (A) No, because Patent A suggests circular receptacles for any complementary bottle, albeit for a different purpose.
- (B) Yes, because there is no suggestion in Patent A that the plastic insert can hold a wine bottle.
- (C) Yes, because the claim uses the insert to keep the bottles from falling and breaking while Patent A uses the insert to keep the cart organized.
- (D) Yes, because Patent A is more interested in organizing boxes than holding bottles.
- (E) Yes, because the prevention from breakage is an unexpected property of the plastic insert.

(A) is the most correct answer. MPEP § 2144, under the heading "Rationale Different From Applicant's Is Permissible." Patent A suggests an insert with receptacles that are circular and which can be shaped to complement the shape of the object to be received. The purpose for this in Patent A is to keep the cart organized, not as in the claim to prevent the object from falling and breaking. The difference in objectives does not defeat the case for obviousness because, as MPEP § 2144 states, the "reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) ...; In re Dillon, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991)" In other words, it does not matter that Patent A does not appreciate the claimed purpose of preventing breakage. It suggests an insert with receptacles to hold bottles. That is enough to render the claimed subject matter prima facie obvious. The prima facie case is not rebutted by arguing that the purpose for the claimed insert is different from that specified for the insert described in Patent A.

QUESTION 23

In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following statements regarding publications as references is incorrect?

- (A) A doctoral thesis indexed and shelved in a library can be sufficiently accessible to the public to constitute prior art as a printed publication.
- (B) Evidence showing routine business practices is never sufficient to establish the date on which a publication became accessible to the public.
- (C) A paper which is orally presented in a forum open to all interested persons can constitute a "printed publication" if written copies are disseminated without restriction.
- (D) Documents distributed only internally within an organization, which has an existing policy of confidentiality or agreement to remain confidential are not

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“printed publications” even if many copies are distributed.

- (E) A publication disseminated by mail is not available as prior art until it is received by at least one member of the public.

(B) is the most proper answer. MPEP § 2128.02, under the heading “Date of Accessibility Can Be Shown Through Evidence of Routine Business Practices,” states, in reliance upon *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir.), cert. denied, 988 U.S. 892 (1988), and *In re Hall*, 781 F.2d 897, 228 USPQ 453 (Fed. Cir. 1986), “Evidence showing routine business practices can be used to establish the date on which publication became accessible to the public. Specific evidence showing when the specific document actually became available is not always necessary.”

QUESTION 24

A registered practitioner receives an Office action for Application X, a patent application filed after November 29, 1999. The action contains a rejection of all the claims as being obvious under 35 USC 103(a) over Patent A in view of Patent B. Patent A is only available as prior art under 35 USC 102(e). Patent B is available under 35 USC 102(b). The practitioner seeks to disqualify Patent A as prior art under 35 USC 103(c). Which of the following would be sufficient evidence to disqualify Patent A as prior art in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) A declaration signed by an employee of Corporation K, who is not empowered to act on behalf of Corporation K, stating that at the time the invention claimed in Application X was made, the claimed invention and Patent A were commonly owned by Corporation K.
- (B) A declaration signed by the inventor of Patent A stating that at the time the invention claimed in Application X was made, the invention claimed in Application X and the invention claimed in Patent A were both subject to an obligation of assignment to the same person.
- (C) A statement by the inventor Jones, the sole inventor of Application X, saying that at the present time, Application X and Patent A are commonly owned.
- (D) A statement by the practitioner stating that Application X and Patent A were, at the time the invention claimed in Application X was made, commonly owned by the same person.
- (E) A statement by inventor Jones, the sole inventor of Application X, saying that at the time the invention claimed in Application X was made, Jones owned a majority interest in Patent A.

(B) or (D) is accepted as the correct answer. As to (B) and (D), see MPEP § 706.02(I)(2), under the heading “II. Evidence Required To Establish Common Ownership.” (B) is accepted because applicants, e.g., inventors, have the best knowledge of the ownership of their applications, and because their statement of such is sufficient evidence because of their paramount obligation of candor and good faith to the USPTO. (D) reproduces the example set forth under the foregoing heading.

QUESTION 25

Reexamination has been ordered following receipt of a request for reexamination of U.S. Patent X, filed by the patentee. Patent X contains independent claims 1 through 4, each directed to a hydrocyclone separator apparatus. They are the only claims that were ever presented during prosecution of the application that matured into Patent X. In the first Office action during reexamination, claims 1 through 4 are rejected as being obvious under 35 USC 103 over U.S. Patent Z. The apparatus is used for separating material, including fibers suspended in a liquid suspension, into a light fraction containing the fibers, and a heavy fraction containing rejects. Assume there are no issues under 35 USC 102, 103, or 112, and that any dependent claim is properly dependent. Recommend which of the following claims, if any, would be subject to rejection under 35 USC 305 for improperly enlarging the scope of the original claim in accordance with the patent laws, rules and procedures as related in the MPEP.

- (A) Claim 5. A hydrocyclone separator apparatus according to claim 4, wherein said blades are configured in the form of generally plane surfaces curved in one plane only.
- (B) Claim 5. A hydrocyclone separator apparatus according to claim 4, wherein the outlet duct is in the form of two frusto-conical portions joined at their narrow ends.
- (C) Claim 5. A method of separating material including fibers suspended in a liquid suspension comprising the steps of separating the material into a light fraction containing the fibers and a heavy fraction containing rejects, and converting the light fraction into a pulp and paper stock suspension.
- (D) Claim 5. A hydrocyclone separator apparatus according to claim 4, wherein the separator chamber is conical in shape having at the narrow end an outlet for the heavy fraction and at its wide end an outlet for the light fraction.
- (E) None of the above.

(C). 35 U.S.C. § 305; MPEP §§ 2258 and 1412.03. MPEP § 2258, under the heading "Claims In Proceeding Must Not Enlarge Scope Of The Claims Of The Patent," states "[w]here new or amended claims are presented . . . the claims of the reexamination proceeding should be examined under 35 U.S.C. 305, to determine whether they enlarge the scope of the original claims. 35 U.S.C. 305 states that 'no proposed amended or new claim enlarging the scope of the claims of the patent will be permitted in a reexamination proceeding...'." Under the further subheading "Criteria for Enlargement of the Scope of the Claims," MPEP § 2258 states "A claim presented in a reexamination proceeding 'enlarges the scope' of the claims of the patent being reexamined where the claim is broader than each and every claim of the patent. See MPEP § 1412.03 for guidance as to when the presented claim is considered to be a broadening claim as compared with the claims of the patent, i.e., what is broadening and what is not. If a claim is considered to be a broadening claim for purposes of reissue, it is likewise considered to be a broadening claim in reexamination." MPEP § 1412.03, under the heading "New Category of Invention Added In Reissue – Broadening," states "[t]he addition of process claims as a new category of invention to be claimed in the patent (i.e., where there were no method claims present in the original patent) is generally considered as being a broadening of the invention. See *Ex parte Wikdahl*, 10 USPQ2d 1546, 1549 (Bd. Pat. App. & Inter. 1989)." MPEP 2258, under the further subheading "Rejection of Claims Where There Is Enlargement," states "[a]ny claim in a reexamination proceeding which enlarges the scope of the claims of the patent should be rejected under 35 U.S.C. 305." Since no claims drawn to a method were ever presented during prosecution of Patent X (claims 1 through 4

"are the only claims that were ever presented during prosecution of the application that matured into Patent X"), the claim recited in (C) is not directed to "the invention as claimed."

QUESTION 26

With respect to the examiner's burden in making an enablement rejection under 35 USC 112, first paragraph, which of the following statements is or are in accordance with the patent laws, rules and procedures as related in the MPEP?

- (1) The examiner may properly make an enablement rejection before construing the claims.
- (2) The examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention.
- (3) The examiner need not give reasons for the uncertainty of the enablement when there is no evidence of operability beyond the disclosed embodiments.

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

(B) is the most correct, as only statement (2) is true. The examiner has the initial burden to establish a reasonable basis to question the enablement provided. MPEP § 2164.04 states "[i]n order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. In re Wright, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure)."

QUESTION 27

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."

(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.*

QUESTION 28

A registered practitioner filed a utility application on February 11, 2002. On April 4, 2002, the practitioner filed an information disclosure statement (IDS) in the application. The practitioner received a notice of allowance dated January 3, 2003 soon after it was mailed. When discussing the application with the practitioner on January 21, 2003, and before paying the issue fee, the client notices for the first time that a reference, which is one of many patents obtained by the client's competitor, was inadvertently omitted from the IDS. The client has been aware of this reference since before the application was filed. The client is anxious to have this reference appear on the face of the patent as having been considered by the USPTO. Which of the following actions, if taken by the practitioner, would not be in accord with the patent law, rules and procedures as related by the MPEP?

- (A) Before paying the issue fee, timely file an IDS citing the reference, along with the certification specified in 37 CFR 1.97(e), and any necessary fees.
- (B) Within three months of the mail date of the notice of allowance, without paying the issue fee, timely file a Request for Continued Examination (RCE) under 37 CFR 1.114, accompanied by the fee for filing an RCE, and an IDS citing the reference.
- (C) Within three months of the mail date of the notice of allowance, without paying the issue fee, timely file a continuing application under 37 CFR 1.53(b), an IDS citing the reference, and any necessary fees.
- (D) After paying the issue fee, timely file a petition to withdraw the application from issue to permit the express abandonment of the application in favor of a continuing application, a continuation application under 37 CFR 1.53(b), an IDS citing the reference, and any necessary fees.
- (E) After paying the issue fee, timely file a petition to withdraw the application from issue to permit consideration of a Request for Continued Examination (RCE) under 37 CFR 1.114, the fee for filing an RCE, and an IDS citing the reference.

(A), describing a procedure that is not in accordance with the USPTO rules and the procedures set forth in the MPEP, the most correct answer. MPEP § 609, under the heading "Minimum Requirements for an Information Disclosure Statement," under the subheading "B(3). Information Disclosure Statement Filed After B(2), but Prior to Payment of Issue Fee 37 CFR 1.97 (d)", and subheading "B(5) Statement Under 37 CFR 1.97(e)." (A) The statement specified in 37 CFR § 1.97(e) requires that the practitioner certify, after reasonable inquiry, that no item of information contained in the IDS was known to any individual designated in 37 CFR § 1.56(c) more than three months prior to the filing of the information disclosure statement. The practitioner cannot certify this because the reference was known to the client before February 11, 2002, the time of filing of the utility application, which was more than three months prior to the filing of the information disclosure statement.

QUESTION 29

A registered practitioner filed a patent application in the Office in 1999. Following examination and a final rejection, the practitioner timely filed a proper notice of appeal and a proper appeal brief in the application wherein claims 1-3 stand rejected, claims 4 and 5, which depend from claim 1, stand objected to as depending from a rejected claim but are otherwise allowable, and

claims 6-10 stand allowed. The appeal involves claims 1-3. After the brief was filed but prior to a decision by the Board of Patent Appeals and Interferences, the practitioner filed a request for continued examination (RCE) with a submission in accordance with 37 CFR 1.114 without paying the fee set forth in 37 CFR 1.17(e). In accordance with the patent laws, rules and procedures as related in the MPEP, what effect does the filing of the RCE without the fee set forth in Rule 1.17(e) have on the application under appeal?

- (A) The application is abandoned.
- (B) The application is still pending and under appeal awaiting a decision by the Board of Patent Appeals and Interferences, because the RCE was improper.
- (C) The application is still pending; the appeal is considered withdrawn and the application will be passed to issue with claims 1-3 canceled and claims 4-10 allowed.
- (D) The application is still pending; the appeal is considered withdrawn and the application will be passed to issue with claims 1-5 canceled and claims 6-10 allowed.
- (E) The appeal is withdrawn; the application is returned to the primary examiner and prosecution is reopened as to claims 1-10.

(D) is the correct answer. See MPEP §§ 706.07(h), under the heading "X. After Appeal But Before Decision By Board," and 1215.01. As explained in MPEP § 1215.01, "The filing of an RCE will be treated as a withdrawal of the appeal by the applicant, regardless of whether the RCE includes the appropriate fee or a submission." Thus, the filing of the RCE without the fee results in the withdrawal of the appeal in this application and passage of the application to issue with the allowed claims 6-10 after the cancellation of both rejected claims 1-15 and claims 4 and 5 which are allowable except for their dependency from rejected claim 1.

QUESTION 30

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.

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- (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.

(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.

QUESTION 31

Prosecution before the primary examiner results in the rejection of claim 1. Claim 2 was objected to as being allowable except for its dependency from claim 1. Independent claim 3 has been allowed. The rejection of claim 1 is properly appealed to the Board of Patent Appeals and Interferences. The Board properly affirms the rejection of claim 1. Appellant has filed no response to the decision of the Board, the appellant has taken no action, and the time for filing an appeal to the court or a civil action has expired. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following actions is the most appropriate response by the examiner?

- (A) The examiner should hold the application abandoned.
- (B) The examiner should cancel claim 1, convert dependent claim 2 into independent form by examiner's amendment, and allow the application.
- (C) The examiner should set a 1-month time limit in which appellant may rewrite the dependent claim in independent form.
- (D) The examiner should cancel claims 1 and 2 and allow the application with claim 3 only.
- (E) None of the above.

(D) is the most correct answer. 37 CFR § 1.197(c); MPEP § 1214.06. This case is specifically set forth in MPEP § 1214.06 under the heading "Claims Stand Allowed."

QUESTION 32

On May 1, 2001, a complete patent application was filed with the USPTO naming H as the sole inventor. A primary examiner rejected all the claims in the application under 35 USC 102(e) as being anticipated by a U.S. Patent granted to inventors H and S. The patent was granted on September 25, 2001 on an application filed on December 7, 2000. The claims of the patent

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application and U.S. patent define the same patentable invention as defined in 37 CFR 1.601(n). The U.S. patent and the application have common ownership. Which of the following, if properly submitted by applicant, would overcome the rejection in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) File a terminal disclaimer in accordance with 37 CFR 1.321(c).
- (B) File a declaration under 37 CFR 1.131 to establish the inventor invented the subject matter of the rejected claim prior to the effective date of the reference X.
- (C) File a declaration stating that the application and patent are currently owned by the same party, and that the inventor named in the application is the prior inventor under 35 USC 104.
- (D) (A) and (C).
- (E) All of the above.

All answers accepted

QUESTION 33

Assume that each claim 5 is in a different patent application. Recommend which, if any, of the following wording is in accord with the patent laws, rules and procedures as related in the MPEP for a multiple dependent claim.

- (A) Claim 5. A gadget according to claims 1-3, in which ...
- (B) Claim 5. A gadget as in claims 1, 2, 3, and/or 4, in which ...
- (C) Claim 5. A gadget as in claim 1 or 2, made by the process of claim 3 or 4, in which ...
- (D) Claim 5. A gadget as in either claim 6 or claim 8, in which ...
- (E) None of the above are proper multiple dependent claims.

The correct answer is (E). MPEP § 608.01(n), under the heading “B. Unacceptable Multiple Dependent Claim Wording.” Multiple dependent claims in proper form depend on preceding claims and refer to the claims from which they depend in the alternative only.

QUESTION 34

A registered practitioner filed in the USPTO a client's utility patent application on December 30, 2002. The application was filed with a request for nonpublication, certifying that the invention disclosed in the U.S. application has not and will not be the subject of an application in another country, or under a multilateral international agreement, that requires eighteen month publication. Subsequently, the client files an application in Japan on the invention and some recent improvements to the invention. The improvements are not disclosed or supported in the utility application. Japan is a country that requires eighteen month publication. Two months after filing the application in Japan, and before filing any other papers in the USPTO, the client remembers that a nonpublication request was filed and informs the practitioner about the application that was filed in Japan. Which of the following courses of action is in accordance with the patent laws, rules and procedures as related in the MPEP?

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- (A) The application is abandoned because the practitioner did not rescind the nonpublication request and provide notice of foreign filing within 45 days of having filed the application in Japan. The applicant must now file a petition and fee to revive under 37 CFR 1.137(b).
- (B) The application is abandoned because the applicant did not rescind the nonpublication request before filing the application in Japan. The applicant must now file a petition and fee to revive under 37 CFR 1.137(b).
- (C) The applicant should file an amendment to the specification of the U.S. application, adding the recent improvements to the disclosure in the specification.
- (D) The application is abandoned because the applicant did not rescind the nonpublication request by notifying the Office under 37 CFR 1.213(c) within the appropriate time. The applicant must now file a petition and fee to revive under 37 CFR 1.137(b).
- (E) The applicant could today notify the USPTO of the foreign filing. It is not necessary to file a petition and fee to revive for the application to continue to be examined in the USPTO.

(A) is the most correct answer. See 35 U.S.C. 122(b)(2)(B)(iii); 37 CFR § 1.213; MPEP § 901.03 for information on nonpublication requests. See 37 CFR § 1.137(f); MPEP § 711.03(c), under the heading "3. Abandonment for Failure to Notify the Office of a Foreign Filing After Submission of a Non-Publication Request."

QUESTION 35

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.

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."

QUESTION 36

Ben hires a registered practitioner to prosecute his patent application. The practitioner

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drafted an application having fifteen claims. Claim 1 is independent, and each of claims 2-15 are singularly dependent upon claim 1. A proper non-final Office action is mailed to the practitioner. Following consultation with Ben, the practitioner timely prepared, signed, and filed a reply to the Office action containing an amendment that does not add new matter, but does add claims 16-27. Each of claims 16-27 is directed to the same invention sought to be patented through claims 1-15. The dependency of each of claims 16-27 reads "any of claims 5-15." For purposes of fee calculation in accordance with the patent laws, rules and procedures as related in the MPEP, how many total claims are contained in the application after the amendment is entered?

- (A) One hundred thirty-six.
- (B) One hundred thirty-five.
- (C) Twenty-seven.
- (D) One hundred forty-seven.
- (E) Fifteen.

(D) is the most correct answer. 37 CFR § 1.75; MPEP § 608.01(n). As explained in MPEP § 608.01(n), under the heading "Multiple Dependent Claims," subheading "Acceptable Multiple Dependent Claim Wording" the multiple dependent claim wording of new claims 16-27 is proper. See, for example, "any one of the preceding claims," and "in any of claims 1-3 or 7-9." 37 CFR § 1.75(c) states "For fee calculation purposes under § 1.16, a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein." Therefore, claims 16-27 would each have a claim value of eleven and the total number of claims for fee calculation is one hundred forty-seven ($12 \times 11 = 132 + 15 = 147$).

QUESTION 37

In accordance with the patent laws, rules and procedures as related in the MPEP, for a nonprovisional application to receive a filing date in the USPTO under 37 CFR 1.53(b), all of the following must be filed except:

- (A) The basic filing fee required by 37 CFR 1.16(a).
- (B) A specification as prescribed by the first paragraph of 35 USC 112.
- (C) A description pursuant to 37 CFR 1.71.
- (D) At least one claim pursuant to 37 CFR 1.75.
- (E) Any drawing required by 37 CFR 1.81(a).

(A) is the most correct answer. 35 U.S.C. § 111; 37 CFR § 1.53; MPEP § 601.01. As provided in MPEP § 601.01(a), the filing fee for an application filed under 37 CFR 1.53(b) can be submitted after the filing date.

QUESTION 38

A U.S. patent was granted on May 8, 2001. The sole independent claim in the patent is directed to a combination of elements ABCD. A registered practitioner filed a reissue application on April 11, 2003 to narrow sole independent claim. In the reissue application, the independent claim is amended to a combination to elements ABCDE. The reissue application is accompanied by a

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transmittal letter stating that the application was filed to narrow a claim, that all inventors could not be located to sign the reissue oath or declaration at that time, and that a declaration would be submitted in due course. No other amendments to the claims were filed on April 11, 2003. On May 8, 2003, a declaration signed by all inventors is filed declaring that they had claimed less than they had a right to claim, and that the error arose without deceptive intent. The inventors also filed on May 8, 2003 a preliminary amendment deleting element A from the sole independent claim leaving elements BCDE. The amendment and declaration are filed using the provisions of 37 CFR 1.10. The practitioner included an authorization to charge the practitioner's deposit account for any necessary fees. Which of the following actions by the primary the examiner in the first Office action is in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) Reject all the claims based upon a broadening reissue outside the two year statutory period authorized by 35 USC 251 since applicant did not file a broadened reissue claim at the time of filing.
- (B) Reject all the claims based upon a broadening reissue outside the two year statutory period authorized by 35 USC 251 since applicant did not file a claim to a broadened reissue claim within the two year period set by 35 USC 251.
- (C) Reject all the claims based upon a broadening reissue outside the two year statutory period authorized by 35 USC 251 since applicant's indication in the transmittal letter indicated that the filing of the reissue application was a narrowing reissue and that the broadening amendment was not permissible even if filed within the two-years from the grant of the original patent.
- (D) Determine that the application is a proper broadening reissue and perform an examination and issue an Office action in due course.
- (E) Determine that the application is a proper broadening reissue and reject the claims under the recapture doctrine since the claims are broader than the issued claims.

(D) is the most correct answer. MPEP §§ 1403 and 1412.03, under the heading "When A Broadened Claim Can Be Presented." A broadening reissue claim must be filed within the two years from the grant of the original patent. (D) is the most correct and the examiner should examine the case as any other application and address appropriate issues concerning reissue examination. See *Switzer v. Sockman*, 333 F.2d 935, 142 USPQ 226 (CCPA 1964) (a similar rule in interferences). Since applicant filed the amendment by Express Mail, the amendment is treated as being filed with the USPTO on the date of deposit with the US Postal Service.

QUESTION 39

A registered practitioner files an international application submission that includes a description, claims and drawings in the United States Receiving Office (RO/US) on Wednesday, January 8, 2003. The submission did not include the required request, international and search fees, or the designation of a PCT contracting State. The RO/US mails an "Invitation to Correct the Purported International Application," dated January 10, 2003, to the practitioner indicating that the designation of at least one Contracting State, as required by PCT Article 11(1)(iii)(b), was not included. A one-month period for response is set in the Invitation. On Monday, February 10, 2003, the practitioner submits by facsimile a designation sheet of the Request Form designating every available Contracting State, and authorization to charge all required fees. In accordance

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with the patent laws, rules and procedures as related in the MPEP, will the application be accorded an international filing date?

- (A) Yes. The application will be accorded a filing date of January 8, 2003.
- (B) Yes. The application will be accorded an international filing date of February 10, 2003
- (C) No. The application will not be accorded an international filing date because the failure to designate at least one contracting State cannot be cured by a facsimile transmission.
- (D) No. The application was given a one-month period for response. The practitioner would have had to have filed the response on Friday, February 7, 2003 in order to have been timely.
- (E) None of the above.

(C) is the correct answer. 37 CFR §§ 1.6(d)(3) and 1.8(a)(2)(i)(d); MPEP § 502 (reproducing Rule 1.6(d)(3)); MPEP § 512 (reproducing Rule 1.8(a)(2)(i)(d)); and MPEP §1817.01. As stated in MPEP § 1817.01, "[a]ll designations must be made in the international application on filing; none may be added later." The application will not be accorded an international filing date since the practitioner has tried to cure the failure to designate at least one contracting State by filing a paper using facsimile which is not permitted according to 37 CFR §§ 1.6(d)(3) and 1.8(a)(2)(i)(d).

QUESTION 40

Inventor Tip, a scientist in a pencil research laboratory, theorized that, based on the abrasive properties of moon dust, a highly efficient erasure can be made by adding a trace amount of moon dust to a normal pencil erasure formulation. Point, in the Sales department, determined that this would be perfect for a high end product. A U.S. patent application has been filed claiming a pencil erasure formulation with a trace amount of moon dust. An example of how to make the formulation with specified percentages of moon dust is presented therein. Thereafter, Tip learns about the duty to disclose information and he recalls signing a declaration under 37 CFR 1.63 stating that he had reviewed and understood the contents of the specification including the claims. Tip becomes concerned that the use of moon dust was only a theory and that to obtain patent would mislead the public to conclude that moon dust was actually used and found to be effective. The application has been allowed, but the issue fee has not yet been paid. Which of the following is most in accord with patent laws, rules and procedures as related in the MPEP?

- (A) Point is under a duty to disclose material information to the USPTO.
- (B) Tip is under a duty to disclose his concern regarding the moon rock information to the USPTO.
- (C) Both Point and Tip are under a duty to disclose material information to the UPSTO.
- (D) There is no duty to disclose information regarding how the moon rock formulation was developed to the USPTO.
- (E) Inasmuch as the application is allowed, an appropriate Request for Continued Prosecution pursuant to 37 CFR 1.114 needs to be filed accompanied by a information disclosure regarding the possibility of rejections under 35 USC 101, and 112, first paragraph.

(D) is the most correct answer. 37 CFR § 1.56; MPEP § 2001.05. 37 CFR

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§ 1.56(a) sets forth a duty to disclose information that is material to patentability. MPEP § 2001.05 states that “information is not material unless it comes within the definition of 37 CFR 1.56(b)(1) or (b)(2). If information is not material, there is no duty to disclose the information to the Office.” The information that moon dust was never actually used is not material as defined under 37 CFR § 1.56(b)(1) or (2) which state that information is material if “(b)(1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or (2) It refutes, or is inconsistent with, a position the applicant takes in: (i) Opposing an argument of unpatentability relied on by the Office or, (ii) Asserting an argument of patentability.” That the use of the moon dust as part of an erasure formulation was only theorized and not actually used is acceptable as is an example for making it. MPEP § 608.01(p), II, under the heading “Simulated or Predicted Test Results Or Prophetic Examples,” states that “[s]imulated or predicted test results and prophetic examples (paper examples) are permitted in patent applications. ... Paper examples describe the manner and process of making an embodiment of the invention which has not actually been conducted.” Care, however, must be taken not to state that an experiment was actually run or conducted when it was not and that “[n]o results should be presented as actual results unless they have actually been achieved.” MPEP § 2004, item 8.

QUESTION 41

The claimed invention in a patent application is directed to an explosive composition “comprising 60-90% solid ammonium nitrate, and 10-40% water-in-oil in which sufficient aeration is entrapped to enhance sensitivity to a substantial degree.” The application discloses that the explosive requires both fuel (the ammonium nitrate), and oxygen to “sensitize the composition.” A prior art reference, published more than two years before the effective filing date of the application, discloses explosive compositions containing water-in-oil emulsions having identical ingredients to those claimed, in ranges overlapping with the claimed composition. The only element of the claim not recited in the reference is “sufficient aeration entrapped to enhance sensitivity to a substantial degree.” The reference does not recognize that sufficient aeration sensitizes the fuel to a substantial degree. In addition to the prior art reference, a printed publication contains test data demonstrating that “sufficient aeration” is necessarily an inherent element in the prior art blasting composition under the circumstances. In accordance with the patent laws, rules and the procedures as related in the MPEP, the prior art reference:

- (A) anticipates the claim because it discloses every limitation of the claim either explicitly or inherently.
- (B) does not anticipate the claim because the prior art reference does not recognize an inherent property.
- (C) does not anticipate the claim because the prior art reference does not recognize an inherent function of oxygen.
- (D) (D) does not anticipate the claim because the prior art reference does not recognize an inherent ingredient, oxygen.
- (E) (B), (C) and (D).

(A) is the best answer. 35 U.S.C. § 102; MPEP § 2131.01, under the heading “Extra Reference or Evidence Can Be Used To Show an Inherent Characteristic of the

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Thing Taught by the Primary Reference," states "that as long as there is evidence of record establishing inherency, failure of those skilled in the art to contemporaneously recognize an inherent property, function or ingredient of a prior art reference does not preclude a finding of anticipation. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1349, 51 USPQ2d 1943, 1948 (Fed. Cir. 1999) (Two prior art references disclosed blasting compositions containing water-in-oil emulsions with identical ingredients to those claimed, in overlapping ranges with the claimed composition. The only element of the claims arguably not present in the prior art compositions was "sufficient aeration . . . entrapped to enhance sensitivity to a substantial degree." The Federal Circuit found that the emulsions described in both references would inevitably and inherently have "sufficient aeration" to sensitize the compound in the claimed ranges based on the evidence of record (including test data and expert testimony).

QUESTION 42

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?

- I. The inventor and his attorney must drop all other work and concentrate on the particular invention involved.
- II. The entire period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses.
- III. Work relied upon to show reasonable diligence must be directly related to the reduction to practice.

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

(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.'

QUESTION 43

In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following can a third party submit in a pending published application within two months from the publication date where the submission identifies the application to which it is directed by application number and includes the appropriate fee?

- (A) A list referencing a videotape and copy of the tape showing that the process claimed in the application was in use more than one year before the filing date of the application.
- (B) A U.S. patent issued more than one year before the filing date of the application and a written explanation of the patent made by the third party on the patent.
- (C) A publication with a publication date more than one year before the filing date of the application and including underlining made by the third party on the publication.
- (D) A protest raising fraud and inequitable conduct issues.
- (E) A list of the sole Japanese language publication submitted for consideration, including the publication date of the publication, a copy of the Japanese language publication and a written English language translation of the pertinent parts of the publication.

(E) is the most correct answer. 37 CFR § 1.99; MPEP § 610. Rule 1.99 provides that a third party may submit in a published application a foreign-language publication and an English language translation of pertinent portions of the publication. The submission must “identify the application to which it is directed by application number,” . . . “include the fee set forth in § 1.17(p);” include “a list of the patents or publications submitted for consideration by the Office, including the date of publication of each patent or publication;” . . . a “copy of each listed patent or publication in written form or at least the pertinent portions;” and an “English language translation of all the necessary and pertinent parts of any non-English language patent or publication in written form relied upon.”

QUESTION 44

A U.S. patent was granted on May 8, 2001 to five inventors. The five inventors assigned their entire patent rights to Q Company. Q Company needs to file a reissue application to broaden the claims of the patent. The registered practitioner preparing the application has been unable to locate any of the five inventors to sign the reissue oath or declaration. Today is May 8, 2003. Which of the following should the practitioner do to enable the applicant to broaden the patent claims in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) Wait to file the reissue application until the first day the signatures of all five inventors can be obtained. At that time, pay the filing fee and file a petition seeking May 8, 2003 as the filing date. File with the petition a showing of the unavailability of all inventors until the filing of the application.
- (B) Wait to file the reissue application until the signatures of at least three inventors can be obtained. At that time, file a petition seeking May 7, 2003 as the filing date accompanied by a showing of the unavailability of all inventors on May 8th. Payment of the filing fees may be postponed until receipt of a decision on the petition.

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- (C) File the reissue application on May 8, 2003, presenting only the claims in the patent, and include a listing of inventors, but not pay the filing fee at the time of filing.
- (D) Wait to file the reissue application until the signature of one of the inventors has been obtained since at least one inventor is needed to show a lack of deceptive intent on the part of the applicants.
- (E) File the complete reissue application complying with 37 CFR 1.173(a) and 1.53(b) with an unexecuted reissue declaration listing the names of all the inventors with at least one broadening claim on May 8, 2003.

(E) is the most correct answer. 35 U.S.C. § 251; 37 CFR § 1.53(f); MPEP § 1403. Filing a broadened reissue application with at least one broadening claim prior to the expiration of the two-year time period set in the statute satisfies the diligence provisions of 35 U.S.C. § 251. The executed reissue oath/declaration and the filing fee may be filed at a later time. According to MPEP § 1403, a reissue application can be granted a filing date without an oath or declaration, or without the filing fee being present. See 37 CFR § 1.53(f). The reissue applicant will be given a period of time to provide the missing parts and to pay the surcharge under 37 CFR § 1.16(e). See MPEP § 1410.01.

QUESTION 45

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).

(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."

QUESTION 46

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:

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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.

(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 Y. 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

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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.

QUESTION 47

Applicant filed an international patent application under the Patent Cooperation Treaty (PCT) designating the United States. A copy of the international application has not been submitted to the USPTO by the International Bureau. The deadline for entering the national stage under 35 USC 371(c) was August 15, 2002. Applicant submitted all of the national stage items required by 35 USC 371(c) by facsimile transmission on August 15, 2002. The facsimile transmission was successfully received by the USPTO on August 15, 2002. The submission included an authorization to charge any required fees to the valid deposit account of the registered practitioner representing applicant. The account contained sufficient funds. Assuming that applicant has made no other national stage submissions under 35 USC 371(c), which of the following statements is most correctly describes why the national stage submission in accordance with the patent laws, rules and the procedures as related in the MPEP is proper or improper?

- (A) The national stage submission was proper because facsimile transmission is a valid method of correspondence in the USPTO.
- (B) The national stage submission was proper because a copy of an originally executed oath or declaration is acceptable, but the original oath or declaration should be retained as evidence of authenticity.
- (C) The national stage submission was improper because a copy of the international application and the basic national fee necessary to enter the national stage as required by 35 USC 371(c) may not be submitted by facsimile transmission.
- (D) The national stage submission was improper because the USPTO does not accept fee payments via facsimile transmission.
- (E) The national stage submission was improper because facsimile transmission may never be used for PCT applications.

(C) is the most correct answer. 37 §§ CFR 1.6(d)(3); 1.8(a)(2)(i)(F); 1.495(b); MPEP § 1893.01(a)(1), 2nd paragraph. The filing of the copy of the international application and the basic national fee in order to avoid abandonment under 37 CFR § 1.495(b), as appropriate, may not be transmitted by facsimile. See 37 CFR § 1.6(d)(3) and 37 CFR § 1.8(a)(2)(i)(F).

QUESTION 48

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

- I. 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.
- II. In a 35 USC 103 obviousness analysis, an inventor's assertion the he has discovered the source or cause of an identified problem should never be considered.

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III. 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

(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).

QUESTION 49

A patent application was filed on November 1, 2000 for the invention of J.J. Smithy. The application has no priority or benefit claims to any other application. Claims in the application are separately rejected under 35 USC 102 as being anticipated by each of the following references. Which reference can be properly applied under 35 U.S.C. 102(e) in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) A WIPO publication of an international application under PCT Article 21(2), which has an international filing date of October 3, 2000, was published in English and designated the United States.
- (B) A U.S. patent by J.J. Smithy that has a filing date of September 5, 2000.
- (C) A U.S. application publication under 35 U.S.C. 122(b) by inventor Jones that was filed on August 8, 2000.
- (D) A journal article by Marks published on October 11, 2000.
- (E) All of the above.

The correct answer is answer (C). 35 U.S.C. § 102(e); MPEP § 706.02(f). The application publication is a proper reference under 35 U.S.C. 102(e) because it was filed by another prior to the filing date of the invention. See MPEP § 706.02(f) et seq.

QUESTION 50

A registered practitioner filed a design patent application on December 30, 2003. The application was filed with an inventor-executed declaration naming Jon Jones as the sole inventor, who has not assigned the invention and is not under an obligation to assign his invention. The filing receipt was recently received, indicating that the application will be published on Thursday, July 1, 2004. In reviewing the filing receipt the practitioner realizes that the typed name of the inventor contained a typographical error (an "h" was missing) and that the correct spelling was John Jones. Which of the following would be the course of action at the least expense to correct the error in accordance with the patent laws, rules and procedures as related in the MPEP?

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- (A) The practitioner should file a request under 37 CFR 1.48 to correct the inventorship of the application with a new declaration under 37 CFR 1.63 signed by John Jones (with the correct spelling of this name), a statement by Mr. Jones as to how the error occurred and that the error was without deceptive intention, and the processing fee set forth in 37 CFR 1.17(q).
- (B) The practitioner should file a petition under 37 CFR 1.182 and the petition fee set forth in 37 CFR 1.17(h), requesting correction of the spelling of the inventor's name.
- (C) The practitioner should file a request for a corrected filing receipt and a separate letter to the Office explaining that the declaration contains a typographical error, that the correct spelling of the inventor's name is John Jones, and requesting correction of the Office records.
- (D) The practitioner should expressly abandon the application, and file a continuation with a new declaration with the correct spelling.
- (E) The practitioner should call the examiner and tell the examiner that the inventor's name is wrong, and ask for the examiner to change the name on the declaration.

(C) is the most correct answer. See MPEP § 605.04(b), which states "Except for correction of a typographical or transliteration error in the spelling of an inventor's name, a request to have the name changed to the signed version or any other corrections in the name of the inventor(s) will not be entertained...When a typographical or transliteration error in the spelling of an inventor's name is discovered during pendency of an application, a petition is not required, nor is a new oath or declaration under 37 CFR 1.63 needed. The U.S.[PTO] should simply be notified of the error and reference to the notification paper will be made on the previously filed oath or declaration by the Office."

QUESTION 50

The claims in an application are rejected under 35 USC 103 as obvious over prior art reference A in view of prior art reference B. All of the following statements are in accord with the patent laws, rules and procedures as related in the MPEP except:

- (A) Where the combination of prior art references provides motivation to make the claimed invention to achieve the same advantage or result discovered by the applicant, the references do not have to expressly suggest the combination of references.
- (B) The rationale to modify or combine the prior art references may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law.
- (C) In considering the disclosure of the prior art references, it is proper to take into account the specific teachings of the references, as well as the inferences that one skilled in the art could reasonably draw from the specific teachings.
- (D) An examiner may take official notice of facts outside the record that are capable of instant and unquestionable demonstration as being "well known" prior art or common knowledge in the art.
- (E) To rely on equivalence as a rationale supporting an obviousness rejection under

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35 USC 103 an examiner may base the rejection on the mere fact that the components at issue are functional or mechanical equivalents.

(E) is the most correct answer. MPEP § 2144.06, under the heading “Substituting Equivalents Known For The Same Purpose,” states “[i]n 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).”

QUESTION 52

Recommend which of the following rejections under 35 USC 102 in a reexamination proceeding is in accordance with the patent laws, rules and procedures as related in the MPEP.

- (A) A rejection under 35 USC 102(a) based on an affidavit that the invention was known or used by others before the invention thereof by the applicant for patent.
- (B) A rejection under 35 USC 102(b) based on an affidavit that the invention was in the public use in this country more than one year prior to the date of the application for a patent in the United States.
- (C) A rejection under 35 USC 102(e) that the invention was described in a patent by another filed in the United States before the invention thereof by the patent applicant.
- (D) A rejection under 35 USC 102(f) based on an affidavit that the applicant did not himself invent the subject matter sought to be patented.
- (E) A rejection under 35 USC 102(b) that the invention was on sale in this country, more than one year prior to the date of the application for patent in the United States.

(C) is the most correct answer. 35 U.S.C. § 302; 37 CFR § 1.552; and MPEP § 2258. MPEP § 2258, under the heading “Prior Patents Or Printed Publications,” states “[r]ejections on prior art in reexamination proceedings may only be made on the basis of prior patents or printed publications. Prior art rejections may be based upon the following portions of 35 U.S.C. 102: . . . (e).”

QUESTION 53

Which of the following would comply with the patent laws, rules and procedures as related in the MPEP and would be a fully responsive reply to a non final Office action on the merits rejecting all the claims in the application as being unpatentable under 35 USC 102 and/or 103 over prior art references?

- (A) A timely filed and properly signed written reply which does not include an amendment to the claims, but includes a request for the examiner's rejections to be reconsidered supported by arguments replying to every ground of rejection and distinctly and specifically points out the supposed errors in every rejection. and pointing out the specific distinctions believed to render the claims patentable over any applied references.
- (B) A timely filed and properly signed written reply which includes an amendment canceling all

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the claims in the application and adding new claims, and a request for the examiner's rejections to be reconsidered in view of the newly presented claims.

- (C) A timely filed and properly signed written reply which does not include an amendment to the claims, but does generally allege that the claims define a patentable invention.
- (D) A timely filed and properly signed written request for continued examination (RCE).
- (E) All of the above.

(A) is the most correct answer. 37 CFR § 1.111; MPEP § 714.02. Section 1.111 states in pertinent part: "(a)(1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, ... must reply and request reconsideration or further examination, with or without amendment. ... (b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.... The applicant's or patent owner's reply must appear throughout to be a *bona fide* attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section." MPEP § 714.02 states "In all cases where reply to a requirement is indicated as necessary to further consideration of the claims ... a complete reply must either comply with the formal requirements or specifically traverse each one not complied with."

QUESTION 54

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

- (A) Where an inventor's residence is stated correctly in the 37 CFR 1.76 application data sheet and incorrectly in the inventor's 37 CFR 1.63 oath or declaration, the discrepancy must be corrected by filing a supplemental 37 CFR 1.67 oath or declaration giving the correct residence.
- (B) Where two inventors file separate 37 CFR 1.63 oaths or declarations which do not identify both inventors, the USPTO will presume they are joint inventors and will not require new oaths or declarations.
- (C) A dependent claim which merely repeats a limitation that appears in the claim on which it depends is properly rejected under the fourth paragraph of 35 USC 112.
- (D) In a statement under 37 CFR 1.97(e)(1) specifying that "each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the statement," the three-month period begins on the date the communication was first received by either a foreign associate or a U.S. registered practitioner.
- (E) None of statements (A) to (D) is correct.

(E) is the correct answer.

QUESTION 55

A patent application is filed having one claim (claim 1). The most relevant prior art uncovered by the primary examiner, after searching the claimed subject matter, is a published abstract summarizing the disclosure of a foreign patent document. The abstract is in English, the foreign document is in German. Both the published abstract and the foreign document are prior art under 35 USC 102(b). The published abstract provides an adequate basis for concluding that claim 1 is prima facie obvious under 35 USC 103. Which of the following actions is in accord with the patent laws, rules and procedures as related in the MPEP?

- (A) Reject claim 1 under 35 USC 103, based on the abstract, because it is a publication in its own right and provides sufficient basis for a prima facie case of obviousness.
- (B) Reject claim 1 under 35 USC 103, based on the abstract, because disclosures that are not in English cannot form the basis of a prior art rejection.
- (C) Reject claim 1 under 35 USC 103, based on the German-language patent document, as evidenced by the abstract.
- (D) Do not reject claim 1 based on the abstract; instead, obtain a translation of the German-language document and determine whether its full disclosure supports a rejection under 35 USC 102(b) or 103.
- (E) Do not reject the claims based on the abstract because an abstract can never provide sufficient disclosure to be enabling.

(A) or (D) is accepted as correct. As to (A), MPEP § 706.02, under the heading “Reliance Upon Abstracts And Foreign Language Documents In Support Of A Rejection,” states “[i]n limited circumstances, it may be appropriate for the examiner to make a rejection in a non-final Office action based in whole or in part on the abstract only without relying on the full text document.” In the facts, the “published abstract provides an adequate basis for concluding that claim 1 is prima facie obvious under 35 USC 103.” As to (D) MPEP § 706.02, under the heading “Reliance Upon Abstracts And Foreign Language Documents In Support Of A Rejection,” states “[c]itation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art. See *Ex parte Jones*, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Int. 2001) (unpublished).”

QUESTION 56

Applicant filed a provisional patent application in the USPTO under 35 USC 111(b) on Tuesday, November 30, 1999. On Tuesday, November 28, 2000, applicant filed a nonprovisional application in the USPTO under 35 USC 111(a) that properly claimed priority under 35 USC 119(e) to the filing date of the provisional application. On Wednesday, November 29, 2000, applicant filed an international application for patent in the USPTO under the Patent Cooperation Treaty that designated the United States and properly claimed priority to both the provisional and the nonprovisional applications. On Friday, July 28, 2001, applicant filed a national stage application in the USPTO under 35 USC 371, providing all of the requirements under 35 USC 371 and properly claiming benefit to the filing date of the

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provisional application under 35 USC 119(e) and the nonprovisional application under 35 USC 120. The national stage application was published on Tuesday, January 30, 2002 and issued as a patent on Tuesday, February 4, 2003. Assuming no patent term extension or adjustment, the patent term ends on the date that is 20 years from which of the following dates in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) Tuesday, November 30, 1999
- (B) Tuesday, November 28, 2000
- (C) Wednesday, November 29, 2000
- (D) Friday, July 28, 2001
- (E) Tuesday, February 4, 2003

The filing date of the nonprovisional application, (B), is the correct answer. See MPEP § 201.04(b), which states “[t]he [Uruguay Agreement Round Act] provides a mechanism to enable domestic applicants to quickly and inexpensively file provisional applications. Under the provisions of 35 U.S.C. § 119(e) applicants are entitled to claim the benefit of priority in a given application in the United States. The domestic priority period will not count in the measurement of the 20-year patent term. See 35 U.S.C. 154(a)(3). Thus, domestic applicants are placed on the same footing with foreign applicants with respect to the patent term.” A provisional application is filed under 35 U.S.C. § 119(e) and according to 35 U.S.C. § 154(a)(3), such a filing date is not taken into account in determining patent term. Therefore, (A) is incorrect. The fact pattern states that benefit was properly claimed in the international application to both the provisional application and the national application and that the national stage application filed under 35 U.S.C. § 371 claimed benefit to the filing date of the nonprovisional application under 35 U.S.C. § 120. According to 35 U.S.C. § 154(a)(2), where an application contains a reference to an earlier filed application or applications under 35 U.S.C. § 120, 121, or 365(c), the patent term ends 20 years from the date on which the earliest such application was filed; in this fact pattern that date would be (B), the filing date of the nonprovisional application.

QUESTION 57

A registered practitioner files a nonprovisional utility application in 2000. In 2002, the practitioner files a continuation-in-part application and claims benefit of the filing date of the 2000 application for the 2002 application. Thereafter, the practitioner amends the 2002 application to include claims that were not present in either the originally filed 2000 application or the originally filed 2002 application. The primary examiner properly concludes that the added claims are not supported by the original disclosure in either application. Which of the following is in accord with the patent laws, rules and procedures as related in the MPEP?

- (A) The added claims are rejected for lack of written description under 35 USC 112, first paragraph.
- (B) The added claims are rejected as new matter under 35 USC 132.
- (C) The added claims are denied benefit of the filing date of the 2000 application.
- (D) (A) and (B).
- (E) (A) and (C).

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(E) is the most correct answer. Both (A) and (C) are correct. MPEP § 2163.01, under the heading “Support For The Claimed Subject Matter In The Disclosure,” states that “[I]f the examiner concludes that the claimed subject matter is not supported [described] in an application as filed, this would result in a rejection of the claim on the ground of a lack of written description under 35 U.S.C. 112, first paragraph, or denial of the benefit of filing date of a previously filed application.”

QUESTION 58

In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following is not within the scope of the term “on sale” as it is used in 35 USC 102(b)?

- (A) A sale conditioned on buyer satisfaction.
- (B) A sale that did not result in a profit.
- (C) A single sale of the claimed subject matter.
- (D) A commercial offer to sale the claimed subject matter.
- (E) An offer to sale the patent rights in the claimed subject matter.

(E) is the most correct answer. As set forth in MPEP § 2133.03(b), under the heading “I The Meaning Of ‘Sale’,” subheading “A Sale of Rights Is Not a Sale of the Invention and Will Not in Itself Bar a Patent,” “[a]n assignment or sale of the rights, such as patent rights, in the invention is not a sale of ‘the invention’ within the meaning of section 102(b). The sale must involve the delivery of the physical invention itself. *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1265, 229 USPQ 805, 809 (Fed. Cir. 1986).”

QUESTION 59

A patent application is filed disclosing and claiming a system for detecting expired parking meters. The specification fully supports the original, sole claim. The application discloses that the “electronics control unit” contains a comparator and an alarm. The application includes several drawings. One of the drawings shows a block diagram of the system, illustrating the electronics control unit as a box, labeled “electronics control unit.” The sole claim of the application is as follows:

The claim. A system for detecting expired parking meters, comprising: a timer mechanism; an infrared sensor for detecting the presence of a parked vehicle; and an electronics control unit, including a comparator and an alarm, coupled to the infrared sensor and the timer mechanism.

A final Office action, dated February 3, 2004, indicates that the sole claim contains allowable subject matter, but includes an objection to the specification, on the grounds that the subject matter of the electronics control unit, though described in a sufficiently specific and detailed manner in the original specification, was required to be shown in the drawings under 37 CFR 1.83. The Office action did not set a period for reply. Determine which of the following actions, if any, comports with the patent laws, rules and procedures as related in the MPEP for overcoming the objection.

- (A) On April 1, 2004, a Notice of Appeal is filed together with appropriate fees, and a brief pointing out that a patent should issue since the subject matter of the

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- electronics control unit was adequately described in the original specification.
- (B) On April 1, 2004, a drawing is filed in the USPTO illustrating only the comparator and alarm of the electronics control unit that was described in the original specification.
- (C) On April 1, 2004, a Notice of Appeal of appeal is filed together with appropriate fees, and a brief pointing out that the addition of a drawing showing the electronics control unit would not constitute addition of new matter since the electronics control unit was adequately described in the original specification.
- (D) On September 1, 2004, a petition is filed urging that no further drawing should be required because the subject matter of the electronics control unit, for purposes of the application, was adequately disclosed in the block diagram drawing.
- (E) None of the above.

(B). 37 CFR § 1.83(a); MPEP §§ 608.01(I) and 706.03(o). MPEP § 608.01(I) states “[w]here subject matter not shown in a drawing...is claimed in the specification as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits, and requirement made to amend the drawing and description to show this subject matter...It is the drawing...that [is] defective, not the claim. It is, of course, to be understood that this disclosure in the claim must be sufficiently specific and detailed to support the necessary amendment of the drawing...” MPEP § 608.02(d) and 706.03(o). MPEP § 706.03(o), state “[i]f subject matter capable of illustration is originally claimed and it is not shown in the drawing, the claim is not rejected but applicant is required to add it to the drawing. See MPEP § 608.01(I).”

QUESTION 60

On Thursday, February 6, 2003, applicant files an application for a design patent in Country X, which issues the patent on the filing date. In accordance with the patent laws, rules and the procedures as related in the MPEP, what is the last date applicant can file a U.S. design application to avoid any loss of patent rights?

- (A) Friday, February 6, 2004 (assume not a Federal holiday).
- (B) Thursday, February 5, 2004 (assume not a Federal holiday).
- (C) Wednesday, August 6, 2003.
- (D) Wednesday, May 6, 2003.
- (E) None of the above are correct.

The correct answer is (C). See 35 U.S.C. § 172; MPEP § 1504.02. 35 U.S.C. § 172 provides that the time specified in 35 U.S.C. 102(d) shall be six months in the case of designs. Thus, to avoid a statutory bar under 35 U.S.C. § 102(d), the U.S. design patent application must be made within six months of the foreign filing, i.e., by August 6, 2003. MPEP § 1504.02 states “[r]egistration of a design abroad is considered to be equivalent to patenting under 35 U.S.C. 119(a)-(d) and 35 U.S.C. 102(d), whether or not the foreign grant is published. (See *Ex parte Lancaster*, 151 USPQ 713 (Bd. App. 1965); *Ex parte Marinissen*, 155 USPQ 528 (Bd. App. 1966); Appeal No. 239-48, Decided April 30, 1965, 151 USPQ 711, (Bd. App. 1965); *Ex parte Appeal* decided September 3, 1968, 866 O.G. 16 (Bd. App. 1966). The basis of this practice is that if the foreign applicant has received the protection offered in the foreign country,

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no matter what the protection is called ('patent,' 'Design Registration,' etc.), if the United States application is timely filed, a claim for priority will vest. If, on the other hand, the U.S. application is not timely filed, a statutory bar arises under 35 U.S.C. 102(d) as modified by 35 U.S.C. 172. In order for the filing to be timely for priority purposes and to avoid possible statutory bars, the U.S. design patent application must be made within 6 months of the foreign filing."

QUESTION 61

In accordance with the patent laws, rules and procedures as related in the MPEP, for a nonprovisional application to receive a filing date in the USPTO under 37 CFR 1.53(b), all of the following must be filed except:

- (A) An oath or declaration executed by applicant pursuant to 37 CFR 1.63.
- (B) A specification as prescribed by the first paragraph of 35 USC 112.
- (C) A description pursuant to 37 CFR 1.71.
- (D) At least one claim pursuant to 37 CFR 1.75.
- (E) A drawing when required by 37 CFR 1.81(a).

(A) is the most correct answer. 35 U.S.C. § 111; 37 CFR § 1.53; MPEP § 601.01 As provided in 37 CFR § 1.53(f) and MPEP § 601.01(a), the oath or declaration for an application filed under 37 CFR 1.53(b) can be submitted after the filing date.

QUESTION 62

Determine which of the following documents, if any, must also contain a separate verification statement in accordance with the patent laws, rules and procedures as related in the MPEP.

- (A) A request to correct inventorship in a pending application.
- (B) A petition to make an application special.
- (C) A claim for foreign priority.
- (D) A substitute specification.
- (E) None of the above.

(E) is the most correct answer. MPEP § 410 states that the certification requirement set forth in 37 CFR § 10.18(b) "has permitted the USPTO to eliminate the separate verification requirement previously contained in 37 CFR ...1.48 [correction of inventorship in a patent application], ...1.55 [claim for foreign priority], ...1.102 [petition to make an application special], [and] ... 1.125 [substitute specification]."

QUESTION 63

In accordance with the patent laws, rules and procedures as related in the MPEP , which of the following papers is precluded from receiving the benefit of a certificate of mailing or transmission under 37 CFR 1.8?

- (A) An amendment, replying to an Office action setting a period for reply, transmitted by mail with a certificate of mailing to the USPTO from a foreign country.

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- (B) An amendment, replying to an Office action setting a period for reply, transmitted by facsimile with a certificate of transmission to the USPTO from a foreign country.
- (C) An information disclosure statement (IDS) under 37 CFR 1.97 and 1.98 transmitted after the first Office action.
- (D) A request for continued examination (RCE) under 37 CFR 1.114.
- (E) An appeal brief.

(A) is the most correct answer. See MPEP § 512, which states "The Certificate of Mailing procedure does not apply to papers mailed in a foreign country."

QUESTION 64

An application naming X and Y as joint inventors, filed on April 3, 2002, has a single pending claim, and does not claim the benefit of any earlier application. Which, if any, of the following items of prior art that have been relied on in various rejections of the claim may be overcome by a suitable affidavit under 37 CFR 1.131 in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) A U.S. patent to G that issued on March 27, 2001, has an effective U.S. filing date of January 4, 2000, and does not claim the "same patentable invention" (as defined in 37 CFR 1.601(n)) as the rejected claim.
- (B) A U.S. patent to P that issued on June 5, 2001, has an effective U.S. filing date of February 1, 2000, and includes a claim that is identical to the rejected claim.
- (C) February 1, 2000, and includes a claim that is identical to the rejected claim.
- (D) A journal article to H published on December 10, 2001, and characterized in the application as "describ[ing] the prior art."
- (E) A foreign patent issued to X and Y on November 7, 2001, which claims the same subject matter as the rejected claim and is based on an application filed on January 3, 2001.
- (F) None of the above.

The correct answer is (E), "None of the above."

QUESTION 65

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

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- 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.

(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.

QUESTION 66

A registered practitioner properly recorded an assignment document for application A identifying XYZ Company as the assignee. The document assigns to XYZ Company the "subject matter claimed in Application A." A proper restriction requirement was made by a primary examiner in application A between two distinct inventions, and the practitioner elected to prosecute one of the inventions. Application A was prosecuted, and later became abandoned. Before the abandonment date of application A, the practitioner filed a complete application B as a proper divisional application of application A. Application B claimed the nonelected invention of Application A, and was published as a U.S. application publication. XYZ Company remains the assignee of application A. What must the practitioner do in accordance with the patent laws, rules and procedures as related in the MPEP to ensure that XYZ Company is listed as the assignee on the face of any patent issuing from application B?

- (A) File a proper assignment document in application B identifying XYZ Company as the assignee.
- (B) File a proper assignment document in application B identifying XYZ Company as the assignee, and confirm that USPTO's bibliographic data for application B identifies XYZ Company as the assignee by checking the filing receipt for application B, the U.S. application publication of application B, or the USPTO's Patent Application Information Retrieval (PAIR) system data for application B, depending on when the practitioner filed the assignment document in application B.
- (C) Confirm that XYZ Company is identified as the assignee on the U.S. application publication of application B.
- (D) File a proper assignment document in application B identifying XYZ Company as the assignee, and confirm that XYZ Company is identified as the assignee on the U.S. application publication of application B.
- (E) Upon allowance of application B, the practitioner must identify XYZ Company as the

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assignee in the appropriate space on the Issue Fee Transmittal form for specifying the assignee for application B.

(E) is the most correct answer. MPEP §§ 306 and 307. MPEP § 306 states, "In the case of a division or continuation application, a prior assignment recorded against the original application is applied to the division or continuation application because the assignment recorded against the original application gives the assignee rights to the subject matter common to both applications." MPEP § 307 states, "Irrespective of whether the assignee participates in the prosecution of the application, the patent issues to the assignee if so indicated on the Issue Fee Transmittal form PTOL-85B. Unless an assignee's name and address are identified in item 3 of the Issue Fee Transmittal form PTOL-85B, the patent will issue to the applicant. Assignment data printed on the patent will be based solely on the information so supplied." A new assignment document need not be recorded for a divisional or continuation application where the assignment recorded in the parent application remains the same.

QUESTION 67

An international application is filed in the United States Receiving Office on September 18, 2002. In accordance with the PCT and USPTO rules and the procedures set forth in the MPEP, which of the following will result in the application not being accorded an international filing date of September 18, 2002?

- (A) The description and claims are in German.
- (B) The Request is signed by a registered attorney rather than the applicant.
- (C) The sole applicant is a Canadian resident and national.
- (D) The application does not contain a claim.
- (E) The application is not accompanied by any fees.

The correct answer is (D). PCT Article 11(1)(iii)(e); 35 U.S.C. § 363; 37 CFR § 1.431(a); MPEP § 1810. Under PCT Article 11(1)(iii)(e) to be accorded an international filing date an application must have "a part which on the face of it appears to be a claim or claims."

QUESTION 68

Applicant files a patent application in Japan on January 5, 2000. Applicant files a PCT international application designating the United States on January 5, 2001, based on the Japanese application. The international application is published in English on July 5, 2001. The international application enters the national stage in the United States on September 5, 2001. The USPTO publishes the application on June 6, 2002. The application issues as a United States patent on December 3, 2002. What is its earliest possible 35 USC 102(e) prior art date for the application published by the United States, in view of the amendment to Title 35 by the American Inventors Protection Act of 1999 and the Intellectual Property and High Technology Technical Amendments Act of 2002?

- (A) January 5, 2000.
- (B) January 5, 2001.
- (C) July 5, 2001.
- (D) June 6, 2002.

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(E) December 3, 2002.

Answer (B) is the most correct answer. 35 U.S.C. § 102(e)(1) provides that a US published application of a national stage of an international application filed on or after November 29, 2000 has a prior art effect as of its international filing date, if the international application designated the United States, and was published in English. Because in the above fact pattern, the international application designated the United States and was published in English, and was filed on or after November 29, 2000, the USPTO published application is entitled to its international filing date of January 5, 2001 for prior art purposes under 35 U.S.C. § 102(e)(1). See Example 4 of MPEP § 706.02(f)(1).

QUESTION 69

A non final Office action contains, among other things, a restriction requirement between two groups of claims (Group 1 and Group 2). Determine which of the following, if included in a timely reply under 37 CFR 1.111, preserves applicant's right to petition the Commissioner to review the restriction requirement in accordance with the patent laws, rules and procedures as related in the MPEP.

- (A) Applicant's entire reply to the restriction requirement is: "The examiner erred in distinguishing between Group 1 and Group 2, and therefore the restriction requirement is respectfully traversed and no election is being made, in order that applicant's right to petition the Commissioner to review the restriction requirement is preserved."
- (B) Applicant's entire reply to the restriction requirement is: "Applicant elects Group 1 and respectfully traverses the restriction requirement, because the examiner erred in requiring a restriction between Group 1 and Group 2."
- (C) Applicant's reply distinctly points out detailed reasons why applicant believes the examiner erred in requiring a restriction between Group 1 and Group 2, and additionally sets forth, "Applicant therefore respectfully traverses the restriction requirement and no election is being made, in order that applicant's right to petition the Commissioner to review the restriction requirement is preserved."
- (D) Applicant's reply distinctly points out detailed reasons why applicant believes the examiner erred in requiring a restriction between Group 1 and Group 2, and additionally sets forth, "Applicant therefore respectfully traverses the restriction requirement and elects Group 2."
- (E) None of the above.

(D) is the most correct answer. 37 CFR § 1.111(b); MPEP §§ 818.03(a)-(c). MPEP § 818.03(a) states "[a]s shown by the first sentence of 37 CFR 1.143, the traverse to a requirement must be complete as required by 37 CFR 1.111(b) . . . Under this rule, the applicant is required to specifically point out the reasons on which he or she bases his or her conclusions that a requirement to restrict is in error." An election must be made even if the requirement is traversed. MPEP § 818.03(b).

QUESTION 70

The primary examiner has rejected claims 1-10 under 35 USC 103(a) as being unpatentable over the Smith patent in view of the Jones reference. Appellant properly argues

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that there is no motivation to combine the teachings of Smith and Jones. The examiner repeats the rejection of claims 1-10 as being “unpatentable over Smith in view of Jones.” The examiner additionally cites a patent to Brown that was necessary to provide motivation for combining the teachings of Smith and Jones. The examiner does not list Brown in the statement of the rejection. Appellant timely appeals to the Board of Patent Appeals and Interferences, and files a proper appeal brief. The examiner files an examiner’s answer addressing the rejection of claims 1-10 under 35 USC 103(a) as being unpatentable over Smith in view of Jones, and cites Brown in the argument as providing motivation to combine Smith and Jones. In accordance with the patent laws, rules and procedures as related in the MPEP, what will be the most proper decision of the Board?

- (A) The Board will affirm the rejection based on Smith and Jones only.
- (B) The Board will affirm the rejection based on Smith, Jones and Brown.
- (C) The Board will reverse the rejection based on Smith and Jones only.
- (D) The Board will reverse the rejection based on Smith, Jones and Brown.
- (E) None of the above.

(C) is the most correct answer. 37 CFR § 1.193(a)(2); MPEP § 1208.01. If the claimed invention is rendered obvious by Smith in view of Jones and Brown, the statement of rejection must include all three references. Reliance on Brown to support the rejection is a different rejection from a rejection relying only on Smith in view of Jones. In accordance with MPEP § 1208.01, the Board will not consider the teachings of Brown because Brown was used to support the rejection, but was not listed in the statement of the rejection. As stated in MPEP § 1208.01, “Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the statement of rejection.”

QUESTION 71

In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following statements regarding claim interpretation is the most correct?

- (A) A claim having the transition term “comprising” is limited to only the limitations, elements or steps recited in the claim, and is not inclusive or open-ended of other unrecited elements or steps.
- (B) The transition term “consisting essentially of” limits the claim to the limitations recited in the claim and additional elements or steps which do not materially affect the basic and novel characteristics of the claimed invention.
- (C) A claim having the transition term “consisting of” is not limited to the elements or steps recited in the claim, but can include elements or steps other than those recited in addition to any impurities ordinarily associated therewith.
- (D) A claim which depends from a claim which claims an invention “consisting of” the recited elements or steps can add an element or step to further limit the claimed invention.
- (E) All of the above.

(B) is the most correct answer. MPEP § 2111.03 (fourth paragraph) states, in reliance upon *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976), that “[t]he

transitional phrase 'consisting essentially of' limits the scope of a claim to the specified materials or steps 'and those that do not materially affect the basic and novel characteristic(s)' of the claimed invention."

QUESTION 72

A patent application has claims 1-10 pending. Claims 1 and 7 are independent claims. Claims 2-6 depend directly from claim 1 while claims 8-10 depend directly from claim 7. Claims 1-10 have been twice rejected by the primary examiner under 35 USC 103(a) as being unpatentable over Smith patent in view of Jones patent. The applicant has appealed the rejection to the Board of Patent Appeals and Interferences. In the brief under the "grouping of claims" section, appellant states that each of the claims is separately patentable. In the arguments section of the brief, appellant separately argues only claims 1, 4 and 6. In the examiner's answer, the examiner disagrees with appellant's claim grouping because all the claims present a similar issue of patentability. The examiner states that the claims all stand or fall together as a single group. In accordance with the patent laws, rules and procedures as related in the MPEP, which claim(s) must the Board consider separately on the merits?

- (A) The Board must consider each of claims 1-10 separately on the merits.
- (B) The Board must only consider claims 1, 4 and 6 separately on the merits.
- (C) The Board must only consider claim 1 separately on the merits.
- (D) The Board must consider claim 1 and claim 7 separately on the merits as representative of all the claims on appeal.
- (E) The Board must determine which claim is representative of all the claims on appeal and consider only that claim separately on the merits.

(B) is the most correct answer. 37 CFR § 1.192(c)(7); MPEP § 1206, under the heading "Appeal Brief Content," subheading "(7) Grouping of Claims." 37 CFR § 1.192(c)(7) requires that an appellant perform two affirmative acts in the brief to receive separate consideration of the patentability of a plurality of claims that are subject to the same rejection. The appellant must (1) state that the claims do not stand or fall together and (2) present arguments why the claims subject to the same rejection are separately patentable. Since the appellant here has only performed the two affirmative acts with respect to claims 1, 4 and 6, these are the claims that the Board must consider separately for patentability. The examiner has no input on the grouping of claims.

QUESTION 73

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

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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.

(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."

QUESTION 74

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)

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Agreements Act.

(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.'

QUESTION 75

In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following facts are required for 35 USC 102(g) to form the basis for an ex parte rejection:

- (1) The subject matter at issue has been actually reduced to practice by another before the applicant's invention.
- (2) There has been no abandonment, suppression or concealment.
- (3) A U.S. patent application for the subject matter at issue has been filed by another prior to the filing of the applicant's application.
- (4) A U.S. patent has been granted for the subject matter at issue prior to the filing of the applicant's application.

- (A) Fact (1) only
(B) Fact (2) only
(C) Facts (1) and (2)
(D) Facts (1), (2) and (3)
(E) Facts (1), (2), (3) and (4)

(C) is the most correct, as a 35 U.S.C. § 102(g) rejection requires actual reduction to practice by another, and lack of abandonment, suppression, or concealment. MPEP § 2138 states "35 U.S.C. 102(g) may form the basis for an ex parte rejection if: (1) the subject matter at issue has been actually reduced to practice by another before the applicant's invention; and (2) there has been no abandonment, suppression or concealment. See, e.g., Amgen, Inc. v. Chugai Pharmaceutical Co., 927 F.2d 1200, 1205, 18 USPQ2d 1016, 1020 (Fed. Cir. 1991); New Idea Farm Equipment Corp. v. Sperry Corp., 916 F.2d 1561, 1566, 16 USPQ2d 1424, 1428 (Fed. Cir. 1990); E.I. DuPont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1434, 7 USPQ2d 1129, 1132 (Fed. Cir. 1988); Kimberly-Clark v. Johnson & Johnson, 745 F.2d 1437, 1444-46, 223 USPQ 603, 606-08 (Fed. Cir. 1984)."

QUESTION 76

In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following statements is most correct?

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- (A) The same evidence sufficient to establish a constructive reduction to practice is necessarily also sufficient to establish actual reduction to practice.
- (B) Proof of constructive reduction to practice does not require sufficient disclosure to satisfy the “how to use” and “how to make” requirements of 35 USC 112, first paragraph.
- (C) A process is reduced to actual practice when it is successfully performed.
- (D) The diligence of 35 USC 102(g) requires an inventor to drop all other work and concentrate on the particular invention.
- (E) The diligence of 35 USC 102(g) does not impose on a registered practitioner any need for diligence in preparing and filing a patent application inasmuch as such the practitioner’s acts do not inure to the benefit of the inventor.

(C) is the most correct. *Corona v. Dovan* 273 U.S. 692, 1928 CD 252 (1928); MPEP § 2138.05 under the heading “Requirements To Establish Actual Reduction To Practice.”

QUESTION 77

A registered practitioner filed in the USPTO a client’s utility patent application on December 30, 2002. The application was filed with a request for nonpublication, certifying that the invention disclosed in the U.S. application has not and will not be the subject of an application in another country, or under a multilateral international agreement, that requires eighteen month publication. Subsequently, the client files an application in Japan on the invention and some recent improvements to the invention. The improvements are not disclosed or supported in the utility application. Japan is a country that requires eighteen month publication. Two months after filing the application in Japan, and before filing any other papers in the USPTO, the client remembers that a nonpublication request was filed and informs the practitioner about the application that was filed in Japan. Which of the following courses of action is in accordance with the USPTO rules and the procedures set forth in the MPEP?

- (A) The application is abandoned because the practitioner did not rescind the nonpublication request and provide notice of foreign filing within 45 days of having filed the application in Japan. The applicant must now file a petition and fee to revive under 37 CFR 1.137(b).
- (B) The application is abandoned because the applicant did not rescind the nonpublication request before filing the application in Japan. The applicant must now file a petition and fee to revive under 37 CFR 1.137(b).
- (C) The applicant should file an amendment to the specification of the U.S. application, adding the recent improvements to the disclosure in the specification.
- (D) The application is abandoned because the applicant did not rescind the nonpublication request by notifying the Office under 37 CFR 1.213(c) within the appropriate time. The applicant must now file a petition and fee to revive under 37 CFR 1.137(b).
- (E) The applicant could today notify the USPTO of the foreign filing. It is not necessary to file a petition and fee to revive for the application to continue to be examined in the USPTO.

(A) and (D) are accepted as the correct answers. Regarding answer (A), see 35 U.S.C. § 122(b)(2)(B)(iii); 37 CFR § 1.213; MPEP § 901.03 for information on nonpublication requests. See 37 CFR § 1.137(f); MPEP § 711.03(c), under the heading “3. Abandonment for Failure to Notify the Office of a Foreign Filing After Submission of a Non-Publication Request.” (D) was also accepted because the statement characterizes the status of the application as being abandoned,

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though the application has not necessarily attained abandoned status. The course of action postulated in (D) is a proper reply if the application was abandoned. Accordingly, (D) was accepted as a correct answer under these circumstances.

QUESTION 78

Following a restriction requirement and election, a registered practitioner received a first Office action dated Friday, December 1, 2000. The primary examiner indicated that claims 1 to 10 were rejected and claims 11 to 20 were withdrawn from consideration. The first Office action set a 3 month shortened statutory period for reply. On February 28, 2001, the practitioner properly filed an express abandonment in the application and at the same time filed a request for continuing application. In a non final Office action dated May 1, 2001 in the continuing application, the examiner indicated in that claims 1 to 20, all of the pending claims, are rejected. The practitioner filed a notice of appeal on Monday, July 2, 2001. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following most accurately describes the propriety of the practitioner's reply to the May 1st Office action?

- (A) The notice of appeal is not a proper response because the claims of the continuing application have not been finally rejected.
- (B) The notice of appeal is not a proper reply because all of the claims in the continuing application have not been twice rejected.
- (C) The filing of a notice of appeal is not a proper reply because not all the claims in the continuing application have been twice rejected.
- (D) A notice of appeal is never a proper response to a non final rejection.
- (E) The reply is proper.

(E) is the most correct answer. MPEP § 1205, under the heading "Appeal By Patent Applicant," states that "[a] notice of appeal may be filed after any of the claims has been twice rejected, regardless of whether the claim(s) has/have been finally rejected. The limitation of 'twice or finally...rejected' does not have to be related to a particular application. For example, if any claim was rejected in a parent application, and the claim is again rejected in a continuing application, then applicant will be entitled to file an appeal in the continuing application, even if the claim was rejected only once in the continuing application."

QUESTION 79

In accordance with the USPTO rules and procedures set forth in the MPEP, a Certificate of Correction effectuates correction of an issued patent where:

- (A) Through error and without deceptive intent, there is a failure to make reference to a prior copending application according to 37 CFR 1.78, and the failure does not otherwise affect what is claimed, but the prior copending application is referenced in the record of the application, and a petition under 37 CFR 1.324 and appropriate fees were filed.
- (B) Through error and without deceptive intent, a preferred embodiment that materially affects the scope of the patent was omitted in the original disclosure in the filed application, and a petition under 37 CFR 1.324 and appropriate fees were filed.
- (C) Through error and without deceptive intent, a prior copending application is incorrectly referenced in the application, the incorrect reference does not otherwise affect the claimed

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subject matter, and the prior copending application is correctly identified elsewhere in the application file, and a petition under 37 CFR 1.324 and appropriate fees were filed.

- (D) Through error and without deceptive intent, an inventor's name is omitted from an issued patent, a petition under 37 CFR 1.324 and appropriate fees were filed, and the petition was granted.
- (E) (A), (C) and (D).

(E) is the most correct answer.

QUESTION 80

The Potter patent application was filed on June 6, 2002, claiming subject matter invented by Potter. The Potter application properly claims priority to a German application filed on June 6, 2001. A first Office action contains a rejection of all the claims of the application under 35 USC 103(a) based on a U.S. patent application publication to Smith in view of a U.S. patent to Jones. A registered practitioner prosecuting the Potter application ascertains that the relevant subject matter in Smith's published application and Potter's claimed invention were, at the time Potter's invention was made, owned by ABC Company or subject to an obligation of assignment to ABC Company. The practitioner also observes that the Smith patent application was filed on April 10, 2001 and that the patent application was published on December 5, 2002. Smith and Potter do not claim the same patentable invention. To overcome the rejection without amending the claims, which of the following timely replies would comply with the USPTO rules and the procedures set forth in the MPEP to be an effective reply for overcoming the rejection?

- (A) A reply that only contains arguments that Smith fails to teach all the elements in the only independent claim, and which specifically points out the claimed element that Smith lacks.
- (B) A reply that properly states that the invention of the Potter application and the Smith application were commonly owned by ABC Company at the time of the invention of the Potter application.
- (C) A reply that consists of an affidavit or declaration under 37 CFR 1.132 stating that the affiant has never seen the invention in the Potter application before.
- (D) A reply that consists of an affidavit or declaration under 37 CFR 1.131 properly proving invention of the claimed subject matter of Potter application only prior to June 6, 2001.
- (E) A reply that consists of a proper terminal disclaimer and affidavit or declaration under 37 CFR 1.130.

(B) is the most correct answer. See 35 U.S.C. § 103(a); MPEP §§ 706.02(1)(1) and 2145. The prior art exception in 35 U.S.C. § 103(c) is applicable because the Smith reference is only prior art under 35 U.S.C. § 102(e), (f), or (g), was applied in a rejection under 35 U.S.C. § 103(a), and was commonly owned at the time Potter made the invention claimed by Potter. See MPEP § 706.02(1)(1).

QUESTION 81

In accordance with the USPTO rules and the procedures set forth in the MPEP, impermissible recapture in an application exists _____

- (A) if the limitation now being added in the present reissue was originally

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presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.

- (B) if the limitation now being omitted or broadened in the present continuation was originally presented/argued/stated in a parent application to make the claims allowable over a rejection or objection made in the parent application.
- (C) if the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.
- (D) if the limitation now being omitted or broadened in the present reissue was being broadened for the first time more than two years after the issuance of the original patent.
- (E) None of the above.

(C) is the most correct. See MPEP § 1412.02, Recapture.

QUESTION 82

Assuming that any rejection has been properly made final, which of the following statements is not in accordance with the USPTO rules and the procedures set forth in the MPEP?

- (A) An objection and requirement to delete new matter from the specification is subject to supervisory review by petition under 37 CFR 1.181.
- (B) A rejection of claims for lack of support by the specification (new matter) is reviewable by appeal to the Board of Patent Appeals and Interferences.
- (C) If both the claims and the specification contain the same new matter, and there has been both a rejection and objection by the primary examiner, the new matter issue should be decided by petition, and is not appealable.
- (D) If both the claims and the specification contain the same new matter, and there has been both a rejection and objection by the examiner, the new matter issue is appealable, and should not be decided by petition.
- (E) None of the above.

(C) is the most correct answer. MPEP § 2163.06, under the heading "Review Of New Matter Objections And Rejections," states "[a] rejection of claims is reviewable by the Board of Patent Appeals and Interferences, whereas an objection and requirement to delete new matter is subject to supervisory review by petition under 37 CFR 1.181. If both the claims and specification contain new matter either directly or indirectly, and there has been both a rejection and objection by the examiner, the issue becomes appealable and should not be decided by petition." Answer (C) is not in accordance with the USPTO rules and the procedures set forth in the MPEP.

QUESTION 83

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,

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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 USPTO rules and procedures set forth 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.

(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 Y. 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.

QUESTION 84

Which of the following is not prohibited conduct for a practitioner under the USPTO Code of

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Professional Responsibility?

- (A) Entering into an agreement with the client to limit the amount of any damages which the client may collect for any mistakes the practitioner may make during prosecution of the client's patent application in exchange for prosecuting the application at a reduced fee.
- (B) Encouraging the client to meet with an opposing party for settlement discussions.
- (C) Failing to disclose controlling legal authority which is adverse to the practitioner's 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 the practitioner has personally used the device and found it to be very efficient and better than the prior art.
- (E) Investing the funds the client advanced for the practitioner legal fees (not costs and expenses) in long term United States Treasury Bills in order to obtain guaranteed protection of the principal.

(B) is the most correct answer. See 37 CFR § 10.87.

QUESTION 85

In accordance with USPTO rules and procedures set forth in the MPEP, which of the following is not a proper basis on which the Board of Patent Appeals and Interferences may remand a case to the examiner?

- (A) Remand for a fuller description of the claimed invention.
- (B) Remand for a clearer explanation of the pertinence of the references.
- (C) Remand for a selection by the primary examiner of a preferred or best ground of rejection when multiple rejections of a cumulative nature have been made by the examiner.
- (D) Remand to the primary examiner with instructions to consider an affidavit not entered by the examiner which was filed after the final rejection but before the appeal.
- (E) Remand to the primary examiner to prepare a supplemental examiner's answer in response to a reply brief.

(D) is the most correct answer. See MPEP § 1211.02. (D) is not a proper basis for remand because the Board has no authority to require the examiner to consider an affidavit which has not been entered after final rejection and which was filed while the application was pending before the examiner. Pursuant to 37 CFR § 1.195, "[a]ffidavits... submitted after the case has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented." The facts are silent regarding whether such a showing was made. However, as discussed in MPEP § 715.09, "Review of an examiner's refusal to enter [and consider] an affidavit as untimely is by petition and not by appeal to the Board of Patent Appeals and Interferences. *In re Deters*, 515 F.2d 1152, 185 USPQ 644 (CCPA 1975); *Ex parte Hale*, 49 USPQ 209 (Bd. App. 1941)." Thus, remand by the Board cannot be expected.

QUESTION 86

A patent application includes the following Claim 1:

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

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heating a base made of carbon to a first temperature in the range of 1875°C to 1925°C;
passing a first gas over said heated base, said first gas comprising a mixture of hydrogen, SiC14, 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;
heating said base having said deposited layer to a second temperature of approximately 1620°C;
and
passing a second gas over said base heated to said second temperature, said second gas consisting of a mixture of hydrogen, SiC14, AlC13, 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, SiC14 and AlC13 only.

(B) is the most correct answer. 37 CFR § 1.75(c).

QUESTION 87

In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following documents, if any, must also contain a separate verification statement?

- (A) Small entity statements.
- (B) A petition to make an application special.
- (C) A claim for foreign priority.
- (D) An English translation of a non-English language document.
- (E) None of the above.

(E) is the most correct answer. MPEP § 410 makes clear that the certification requirement set forth in 37 CFR § 10.18(b) “has permitted the PTO to eliminate the separate verification requirement previously contained in 37 CFR ...1.27 [small entity statements], ...1.52 [English translations of non-English documents], ...1.55 [claim for foreign priority], [and] ...1.102 [petition to make an application special].”

QUESTION 88

A claim in a pending patent application for an electric toothbrush is rejected under 35 USC 102 as being anticipated by a U.S. Patent, which was issued to Lancer, the sole name inventor, for a similar electric toothbrush. The Lancer patent was issued one day before the filing date of the

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application in question. The claim in the pending application contains a limitation specifying the location of an on/off switch. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following arguments, if true, would overcome the rejection?

- (A) The Lancer patent discloses and claims an electric toothbrush, but does not mention whether its toothbrush includes a power supply.
- (B) Evidence is submitted to show the electric toothbrush claimed in the application is commercially successful.
- (C) The Lancer patent teaches away from the bristles of the claimed toothbrush.
- (D) Lancer is one of the three named inventors of the claimed toothbrush in the pending application.
- (E) The on/off switch in the Lancer patent is on a different side of the body than that recited in the claim for the electric toothbrush in the patent application.

(A) and (E) are accepted as correct answers. Regarding (E), see MPEP § 2131. To anticipate a claim, the elements of a reference “must be arranged as required by the claim....” See MPEP § 2131, citing *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). In (E), the on/off switch of Lancer’s toothbrush is arranged differently than that of the claimed toothbrush. (A) is accepted as correct because the given facts do not specify the location of the power supply as being included within the toothbrush. Though the description of the toothbrush as being electric can imply an inherent source of power, it may also imply an external power source for the electric toothbrush. Accordingly, (A) is also accepted as a correct answer in the circumstances.

QUESTION 89

Applicant properly appealed the primary examiner’s final rejection of the claims to the Board of Patent Appeals and Interferences (Board). Claims 1 to 10 were pending in the application. The examiner did not reject the subject matter of claims 7 to 10, but objected to these claims as being dependent on a rejected base claim. Claim 1 was the sole independent claim and the remaining claims, 2 through 10, were either directly or indirectly dependent thereon. After a thorough review of Appellant’s brief and the examiner’s answer, the Board affirmed the rejection of claims 1 to 6. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following is the appropriate action for the examiner to take upon return of the application to his jurisdiction when the time for appellant to take further action under 37 CFR 1.197 has expired?

- (A) Abandon the application since the Board affirmed the rejection of independent claim 1
- (B) Convert the dependent claims 7 to 10 into independent form by examiner’s amendment, cancel claims 1 to 6, and allow the application.
- (C) Mail an Office action to applicant setting a 1-month time limit in which the applicant may rewrite dependent claims 7 to 10 in independent form. If no timely reply is received, the examiner should amend the objected to claims, 7 to 10, and allow the application.
- (D) Mail an Office action to applicant with a new rejection of claims 7 to 10 based on the Board’s decision.
- (E) No action should be taken by the examiner since the Board affirmed the rejection of independent claim 1, the application was abandoned on the date the Board decision was mailed.

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(A) is the most correct answer. MPEP § 1214.06, under the heading "Examiner Sustained in Whole or in Part." Under the heading "No Claims Stand Allowed" it states "Claims indicated as allowable prior to appeal except for their dependency from rejected claims will be treated as if they were rejected."

QUESTION 90

In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following is true?

- (A) Once the issue fee has become due, provided an original application has not been pending more than three years, the applicant may request and the Office may grant a request for deferral of payment of the issue fee.
- (B) The time period set for the payment of the issue fee is statutory and cannot be extended. However, if payment is not timely made and the delay in making the payment is shown to be unavoidable, upon payment of a fee for delayed payment, it may be accepted as though no abandonment had occurred, but there will be a reduction on the patent term adjustment for the period of abandonment.
- (C) Upon written request, a person citing patents and printed publications to the Office that the person believes has a bearing on the patentability of a particular patent, may request that his or her name remain confidential.
- (D) To obtain benefit of priority based on an earlier filed U.S. patent application, an applicant in a later filed continuation application is not required to meet the conditions and requirements of 35 USC 120.
- (E) Each of statements (B) and (C) is true.

(E) is the most correct answer.

QUESTION 91

Which of the following practices or procedures may be employed in accordance with the USPTO rules and the procedures set forth in the MPEP to overcome a rejection properly based on 35 USC 102(e)?

- (A) Persuasively arguing that the claims are patentably distinguishable from the prior art.
- (B) Filing an affidavit or declaration under 37 CFR 1.132 showing that the reference invention is not by "another."
- (C) Filing an affidavit or declaration under 37 CFR 1.131 showing prior invention, if the reference is not a U.S. patent that either claims the same invention or claims an obvious variation of the subject matter in the rejected claim(s).
- (D) (A) and (C).
- (E) (A), (B) and (C).

(E) is the most correct answer. See MPEP § 706.02(b), under the heading "Overcoming A 35 U.S.C. § 102 Rejection Based On A Printed Publication Or Patent."

QUESTION 92

A claim in an application recites "[a] composition containing: (a) 35-55% polypropylene; and (b)

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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.

(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.*"

QUESTION 93

An examiner's answer, mailed on January 2, 2003, contains a new ground of rejection in violation of 37 CFR 1.193(a)(2). If an amendment or new evidence is needed to overcome the new ground of rejection, what is the best course of action the appellant should take in accordance with the USPTO rules and the procedures set forth in the MPEP?

- (A) File a reply brief bringing the new ground of rejection to the attention of the Board of Patent Appeals and Interferences and pointing out that 37 CFR 1.193(a)(2) prohibits entry of the new ground of rejection.
- (B) File a timely petition pursuant to 37 CFR 1.181 seeking supervisory review of the examiner's entry of an impermissible new ground of rejection in the answer, after efforts to persuade the examiner to reopen prosecution or remove the new ground of rejection are unsuccessful.
- (C) File a reply brief arguing the merits of the new ground of rejection.
- (D) File an amendment or new evidence to overcome the new ground of rejection.
- (E) Ignore the new ground of rejection.

(B) is the most correct answer. MPEP § 1208.01 states: "Any allegation that an examiner's

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answer contains an impermissible new ground of rejection is waived if not timely (37 CFR 1.181(f)) raised by way of a petition under 37 CFR 1.181(a)." Thus, to avoid waiver of the right to contest the examiner's action, the appellant must file a timely petition.

QUESTION 94

In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following does not constitute probative evidence of commercial success to support a contention of non-obviousness?

- (A) In a utility case, gross sales figures accompanied by evidence as to market share.
- (B) In a utility case, gross sales figures accompanied by evidence as to the time period during which the product was sold.
- (C) In a utility case, gross sales figures accompanied by evidence as to what sales would normally be expected in the market.
- (D) In a utility case, gross sales figures accompanied by evidence of brand name recognition.
- (E) In a design case, evidence of commercial success clearly attributable to the design, and not to improved performance of the device.

(D) is the most correct answer. Gross sales figures must be measured against a logical standard in order to determine whether or not there is commercial success.

QUESTION 95

The Office mailed an Office action containing a proper final rejection dated July 8, 2002. The Office action did not set a period for reply. On January 7, 2003, in reply to the final rejection, a registered practitioner filed a request for continued examination under 37 CFR 1.114, a request for a suspension of action under 37 CFR 1.103(c) to suspend action for three months, and proper payment all required fees. No submission in reply to the outstanding Office action accompanied the request for continued examination. No other paper was submitted and no communication with the Office was held until after Midnight, January 8, 2003. Which of the following statements accords with the USPTO rules and the procedures set forth in the MPEP?

- (A) If an appropriate reply is submitted within the three month period of suspension permitted under 37 CFR 1.103(c), the application will not be held abandoned.
- (B) The application will not be held abandoned if an appropriate reply is submitted within the three month period of suspension and it is accompanied by a showing that the reply could not have been submitted within the period set in the final rejection. For example, the reply includes a showing based on an experiment that required 8 months to conduct.
- (C) No reply will prevent the application from being held abandoned.
- (D) If, on January 10, 2003, the primary examiner and applicant agree to an examiner's amendment that places the application in condition for allowance and a notice of allowance is mailed within the three month period of suspension, application X will not be held abandoned.
- (E) No other submission by applicant is necessary because application X is still pending. The examiner is required to act on the request for continued examination after expiration of the three month period of suspension.

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(C) is the most correct answer. As stated in MPEP § 709, under the heading “Request By The Applicant,” subheading “Request for Suspension Under 37 CFR 1.103(b) or (c),” “The Office will not grant the requested suspension of action unless the following requirements are met: (A) the request must be filed with the filing of a CPA or an RCE...(1) if the request is filed with an RCE, the RCE must be in compliance with 37 CFR 1.114, i.e., the RCE must be accompanied by a submission and the fee set forth in 37 CFR 1.17(e). Note that the payment of the RCE filing fee may not be deferred and the request for suspension cannot substitute for the submission.” The RCE was improper because no submission in reply to the outstanding Office action accompanied the RCE. Since the RCE was improper, the Office will not recognize the request for suspension. The time period set in the final rejection continues to run from the mail date of the Office action. Since the Office action did not set a period for reply, applicant has a maximum period of six months for reply. A reply was due on February 8, 2003. Since the RCE was improper and the Office did not recognize the request for suspension, the application became abandoned at Midnight of February 8, 2003.

QUESTION 96

In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following is true?

- (A) Interferences will generally be declared even when the applications involved are owned by the same assignee since only one patent may issue for any given invention.
- (B) A senior party in an interference is necessarily the party who obtains the earliest actual filing date in the USPTO.
- (C) Reexamination proceedings may not be merged with reissue applications since third parties are not permitted in reissue applications.
- (D) After a reexamination proceeding is terminated and the certificate has issued, any member of the public may obtain a copy of the certificate by ordering a copy of the patent.
- (E) None of the above.

(D) is the most correct answer. See MPEP § 2292.

QUESTION 97

Prior to filing a patent application for a client, a registered practitioner determined that the client was entitled to claim small entity status under 37 CFR 1.27. The practitioner filed a patent application for the client on November 1, 2002 together with a claim for small entity status under 37 CFR 1.27. On December 2, 2002, a Notice to File Missing Parts was mailed setting a two month period for reply and requiring the basic filing fee and the surcharge under 37 CFR 1.16(e). The practitioner timely submitted the small entity fees for the basic filing fee and the surcharge as required in the Notice. Shortly thereafter, the practitioner discovered that on October 31, 2002, the day before the application was filed, the client, without advising the practitioner, had assigned all rights in the invention that is the subject of the application to an entity that would not qualify for small entity status under 37 CFR 1.27. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following actions would be the best action for the practitioner to take?

- (A) File a continuing application under 37 CFR 1.53(b) with the large entity filing fee and then

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file a letter of express abandonment under 37 CFR 1.138 in the original application after the continuing application has been accorded a filing date.

- (B) Promptly file a notification of loss of small entity status under 37 CFR 1.27(g) and, thereafter, pay large entity fees whenever any subsequent fees are required.
- (C) Wait until a Notice of Allowance is received and then timely submit the large entity issue fee along with a notification of loss of small entity status under 37 CFR 1.27(g).
- (D) File a paper under 37 CFR 1.28(c) requesting that the good faith error in claiming small entity status be excused and complying with the separate submission and itemization requirements of 37 CFR 1.28(c) and including payment of the deficiency owed.
- (E) Pay the difference between the large entity filing fee and small entity filing fee and the difference between the large entity surcharge and small entity surcharge within two months from the mail date of the Notice to File Missing Parts.

(D) is the most correct answer. MPEP § 509.03, under the heading "Correcting Errors In Small Entity Status," states "37 CFR 1.28(c) provides that if small entity status is established in good faith and the small entity fees are paid in good faith, and it is later discovered that such status as a small entity was established in error or through error the Office was not notified of a change of status, the error will be excused upon compliance with the separate submission and itemization requirements of 37 CFR 1.28(c)(1) and (c)(2), and the deficiency payment requirement of 37 CFR 1.28(c)(2)."

QUESTION 98

In accordance with the USPTO rules and the procedures set forth in the MPEP, a petition to make a patent application special may be filed without fee in which of the following cases?

- (A) The petition is supported by applicant's birth certificate showing applicant's age is 62.
- (B) The petition is supported by applicant's unverified statement that applicant's age is 65.
- (C) The petition is supported by applicant's statement that there is an infringing device actually on the market, that a rigid comparison of the alleged infringing device with the claims of the application has been made, and that applicant has made a careful and thorough search of the prior art.
- (D) The petition is accompanied by a statement under 37 CFR 1.102 by applicant explaining the relationship of the invention to safety of research in the field of recombinant DNA research.
- (E) The petition is accompanied by applicant's statement explaining how the invention contributes to the diagnosis, treatment or prevention of HIV/AIDS or cancer.

(B) is the most correct answer. See MPEP § 708.02, under the heading "IV. Applicant's Age."

QUESTION 99

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

1. Compound Y.

In the specification, Bloc explains that compound Y is an intermediate in the chemical manufacture

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of synthetic Z. With respect to synthetic Z, the specification discloses its structural formula and further states that synthetic Z is modeled on the natural form of Z to give it the same therapeutic ability to alleviate pain. The specification goes on to state that synthetic Z is also a cure for cancer. On June 2, 2001, the practitioner received an Office action from the primary examiner rejecting the claim. The claim is rejected under 35 USC 101 as being inoperative; that is, the synthetic Z does not operate to produce a cure for cancer (i.e., incredible utility). Bloc believes he is entitled to a patent to his compound Y. In accordance with USPTO rules and procedures set forth in the MPEP, how best should the practitioner reply to the rejection of the claim?

- (A) Advise Bloc that he should give up because a cure for cancer is indeed incredible and is unproven.
- (B) File a reply arguing that a cure for cancer is not incredible and he can prove it if given the chance.
- (C) File a reply arguing that whether or not a cure for cancer is incredible is superfluous since Bloc has disclosed another utility – alleviating pain, which is not incredible.
- (D) File a reply arguing that the claim is directed to compound Y, not synthetic Z.
- (E) File a reply arguing that synthetic Z is modeled on the natural form of Z.

(C) is the best answer. MPEP §§ 2107.01 and 2107.02. MPEP § 2107.01, under the heading “Therapeutic or Pharmacological Utility,” cites *In re Chilowsky*, 229 F.2d 457, 461-2, 108 USPQ 321, 325 (CCPA 1956); *In re Gazave*; and *Nelson v. Bowler*, as taking the position that “[i]nventions asserted to have utility in the treatment of human or animal disorders are subject to the same legal requirements for utility as inventions in any other field of technology.” MPEP § 2107.02, under the heading “The Claimed Invention Is The Focus Of The Utility Requirement,” states “...regardless of the category of invention that is claimed (e.g., product or process), an applicant need only make one credible assertion of specific utility for the claimed invention to satisfy 35 U.S.C. 101 and 35 U.S.C. 112; additional statements of utility, even if not “credible,” do not render the claimed invention lacking in utility. See, e.g.,...*In re Gottlieb*, 328 F.2d 1016, 1019, 140 USPQ 665, 668 (CCPA 1964) (‘Having found that the antibiotic is useful for some purpose, it becomes unnecessary to decide whether it is in fact useful for the other purposes ‘indicated’ in the specification as possibly useful.’).” The issue is whether Mr. Bloc has disclosed a specific utility for the claimed compound Y sufficient to satisfy the practical utility requirement of 35 U.S.C § 101. According to the set of facts, we know that compound Y is an intermediate in the chemical manufacture of synthetic Z. We are given two utilities for synthetic Z: 1) alleviating pain, a utility it shares with the natural form of Z; and, 2) curing cancer. The examiner focuses on the disclosure that synthetic Z is a cure for cancer. Even if one were to agree that synthetic Z’s ability to cure cancer amounts to an incredible utility, a claim to the intermediate compound Y would not run afoul of the utility requirement of 35 U.S.C. § 101 where another substantial, credible and specific utility is alternatively demonstrated. Here, the specification discloses that synthetic Z, like the natural form of Z, alleviates pain. The alleviation of pain is another substantial, credible and specific utility and serves to give compound Y an alternative utility to that of being used to make a cancer-curing substance. An applicant need not show that all disclosed utilities are credible. An applicant need only show that one of the disclosed utilities is in fact credible. *In re Gottlieb*, supra. The establishment of a credible, substantial and specific utility renders the disclosure of an additional incredible utility superfluous, and therefore ultimately irrelevant. Accordingly, Mr. Bloc’s best course of action is to make the argument that he has disclosed another substantial, credible, and specific utility, notwithstanding the disclosure of curing cancer.

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QUESTION 100

In accordance with USPTO rules and the procedures set forth in the MPEP, an amendment filed with or after a notice of appeal under 37 CFR 1.191(a), but before jurisdiction has passed to the Board of Patent Appeals and Interferences, should be entered by the primary examiner where the amendment:

- (A) requests unofficial consideration by the examiner.
- (B) is less than six pages long.
- (C) removes issues from appeal.
- (D) presents more specific claims, because it is believed that they may have a better chance of being allowable even though the claims do not adopt the examiner's suggestions.
- (E) introduces new issues, allowing the examiner to rethink his position.

(C) is the most correct answer. See 37 CFR § 1.116; MPEP § 1207, first paragraph.

QUESTION 101

In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following, if any, is true?

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

(B) is the most correct answer. Any person at any time may file a request for reexamination. 35 U.S.C. § 302. As to (A) loser may appeal to District Court under 35 U.S.C. § 146.

QUESTION 102

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.

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- (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.

(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.

QUESTION 103

In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following statements regarding a proper prior art reference is true?

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

(D) is the most correct answer. See 35 U.S.C. § 102(a). As explained in MPEP § 901.01, the "matter canceled from the application file wrapper of a U.S. patent may be used as prior art as of the patent date in that it then constitutes prior public knowledge under 35 U.S.C. 102(a), *In re Lund*, 376 F.2d 982, 153 USPQ 625 (CCPA 1967). See also MPEP 2127 and 2136.02."

QUESTION 104

In accordance with the MPEP and USPTO rules and procedure, an application for patent may be made on behalf of a joint inventor in certain situations. Who, by petition, may make application on behalf of a joint inventor who has refused to sign the application ("nonsigning inventor"), if the other joint inventor ("signing inventor") executes the application?

- (A) A person other than the signing inventor, to whom the nonsigning inventor has assigned the invention.
- (B) A person other than the signing inventor, with whom the nonsigning inventor has

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agreed in writing to assign the invention.

- (C) The signing inventor.
- (D) A person other than the signing inventor, who shows a strong proprietary interest in the invention.
- (E) All of the above.

(C) is the correct answer. MPEP § 409.03(a), and 37 C.F.R. § 1.47(a).

37 C.F.R. § 1.47(a) provides, "If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63."

QUESTION 105

To satisfy the written description requirement of the first paragraph of 35 USC 112, an applicant must show possession of the invention. An applicant's lack of possession of the invention may be evidenced by:

- (A) Describing an actual reduction to practice of the claimed invention.
- (B) Describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.
- (C) Requiring an essential feature in the original claims, where the feature is not described in the specification or the claims, and is not conventional in the art or known to one of ordinary skill in the art.
- (D) Amending a claim to add a limitation that is supported in the specification through implicit or inherent disclosure.
- (E) Amending a claim to correct an obvious error by the appropriate correction.

(C) is the most correct answer. See, "Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, 'Written Description' Requirement," 66 F.R. 1099, 1105 (Jan. 5, 2001) left column, first paragraph. "The claimed invention as a whole may not be adequately described if the claims require an essential or critical feature that is not described in the specification and is not conventional in the art or known to one of ordinary skill in the art."

QUESTION 106

According to USPTO rules and procedure, which of the following can be overcome by an affidavit under 37 CFR 1.131?

- (A) A rejection properly based on statutory double patenting.
- (B) A rejection properly made under 35 USC 102(d) based on a foreign patent granted in a non-WTO country.
- (C) A rejection properly made under 35 USC 102(a) based on a journal article dated one month prior to the effective filing date of the U.S. patent application.

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- (D) Applicant has clearly admitted on the record during the prosecution of the application that subject matter in the journal article relied on by the examiner is prior art.
- (E) A rejection properly made under 35 USC 102(b) based on a U.S. patent that issued 18 months before the effective filing date of the application. The patent discloses, but does not claim, the invention.

(E) is the correct answer. MPEP § 715.

QUESTION 107

Inventor A filed a patent application and assigned the entire interest in the application to his employer, MegaCorp. The application issued as a utility patent on July 9, 2002. In June 2004, MegaCorp's management first learns that a second inventor, Inventor B, should have been named as a co-inventor with respect to at least one claim of the issued patent. There was no deceptive intent in failing to name Inventor B in the original application. Inventor A, who is unfamiliar with patent law and concepts of inventorship, incorrectly believes that he should be the sole named inventor on the patent, and refuses to cooperate with any effort by MegaCorp to change the named inventive entity. The issued patent contains no other error. In accordance with the Manual of Patent Examining Procedure, which of the following procedures is/are available for MegaCorp to seek correction of the named inventive entity without any agreement, cooperation or action from Inventor A?

- (A) File, on or before July 9, 2004, a reissue application, made by MegaCorp only, that seeks to add Inventor B.
- (B) File, after July 9, 2004, a reissue application, made by MegaCorp only, that seeks to add Inventor B.
- (C) Request a Certificate of Correction to add Inventor B as a named inventor.
- (D) Submit in the issued patent file: a Request for Correction of Inventorship Under the Provisions of 37 CFR 1.48 that sets forth the desired inventorship change; a statement by Inventor B that the error in inventorship occurred without deceptive intention on her part; an oath or declaration executed by Inventor B; all required fees; and the written consent of MegaCorp.
- (E) A and B are each available procedures.

The best choice is (E). See MPEP § 1412.04. Reissue is a proper vehicle for correcting inventorship in a patent. Because correction of inventorship does not enlarge the scope of the patent claims, the reissue application may be filed more than two years after the patent issued.

QUESTION 108

Which of the following statements is true?

- (A) In the context of 35 USC 102(b), a magazine need only be placed in the mail to be effective as a printed publication.
- (B) The earliest date declassified printed material may be taken as *prima facie* evidence of prior knowledge under 35 USC 102(a) is as of the date the material is cataloged and placed on the shelf of a public library.

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- (C) Declassified printed material is effective as a printed publication under 35 USC 102(b) as of the date of its release following declassification.
- (D) The American Inventors Protection Act (AIPA) amended 35 USC 102(e) to provide that U.S. patents, U.S. application publications, and certain international application publications can be used as prior art under 35 USC 102(e) based on their earliest effective filing date only against applications filed on or after November 29, 2000.
- (E) The American Inventors Protection Act (AIPA) amended 35 USC 102(e) to provide that U.S. patents, U.S. application publications, and certain international application publications can be used as prior art under 35 USC 102(e) based on their earliest effective filing date only against applications filed prior to November 29, 2000 which have been voluntarily published.

(C) is correct. MPEP § 707.05(f) states, "In the use of [declassified material] ... as an anticipatory publication, the date of release following declassification is the effective date of publication within the meaning of the statute."

QUESTION 109

Office policy has consistently been to follow *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), in the consideration and determination of obviousness under 35 USC 103. Each of the following are the four factual inquiries enunciated therein as a background for determining obviousness except:

- (A) Determining the scope and contents of the prior art.
- (B) Resolving any issue of indefiniteness in favor of clarity.
- (C) Ascertaining the differences between the prior art and the claims in issue.
- (D) Resolving the level of ordinary skill in the pertinent art.
- (E) Evaluating evidence of secondary considerations.

The most correct answer is (B). 35 U.S.C. § 103; *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966); MPEP § 2141. Resolving any issue of indefiniteness in favor of clarity is not among the factual inquiries enunciated in *Graham*.

QUESTION 110

In accordance with the MPEP, and USPTO rules and procedure, a patent application may be made by someone other than the inventor in certain situations. In which of the following situations would an application not be properly made by someone other than the inventor?

- (A) The inventor is deceased, and the application is made by the legal representative of the deceased inventor.
- (B) The inventor is deceased, and the application is made by one who has reason to believe that he or she will be appointed legal representative of the deceased inventor.
- (C) The inventor is a minor (under age 18) who understands and is willing to execute the declaration, but the application is made by the minor's legal representative.
- (D) The inventor is insane, and the application is made by the legal representative of the insane inventor.

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- (E) The inventor is legally incapacitated, and the application is made by the legal representative of the legally incapacitated inventor.

All answers accepted.

QUESTION 111

Jane files a nonprovisional application with the USPTO containing at least one drawing figure under 35 USC 113 (first sentence) and at least one claim. Subsequently, Jane receives a "Notice of Omitted Items" from the USPTO indicating that the application which Jane filed lacks page 5 of the specification. Assuming that the application without page 5 satisfies 35 USC 112, which of the following statements is true based on proper USPTO practice and procedure?

- (A) If Jane is willing to accept the application as filed, she need not respond to the Notice, and the Office will accord the filing date of the original application. Jane will need to file an amendment renumbering the pages consecutively and canceling incomplete sentences caused by the missing page 5.
- (B) Jane must promptly submit the omitted page and accept an application filing date as of the date of submission of the omitted page.
- (C) Jane must promptly submit the omitted page and will be accorded a filing date as of the date of filing the original application.
- (D) Within 3 months of the Notice date, Jane must file an affidavit asserting that page 5 was in fact deposited in the USPTO with the original application. Jane will be accorded the filing date of the original application.
- (E) Within 3 months of the Notice date, Jane must file a proper petition asserting that page 5 was in fact deposited in the USPTO with the original application, accompanied by the proper petition fee and evidence that page 5 was in fact deposited as alleged. Jane will be accorded the original filing date of the application.

(A) is correct. MPEP § 601.01(d).

QUESTION 112

Which of the following statements relevant to a third party submission in a published patent application accords with proper USPTO practice and procedure?

- (A) A submission of patents by a member of the public must be made within 2 months of the date of publication of the application.
- (B) A submission of patents by a member of the public must be made prior to the mailing of a Notice of Allowance.
- (C) A submission of patents by a member of the public must be made within 2 months of the date of publication of the application or prior to the mailing of a Notice of Allowance, whichever is later.
- (D) A submission of patents by a member of the public must be made within 2 months of the date of publication of the application or prior to the mailing of a Notice of Allowance, whichever is earlier.
- (E) Any submission not filed within the period set forth in the patent rules will be accepted

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provided it is accompanied by the processing fee set forth in 37 CFR 1.17(i).

(D) is correct. 37 C.F.R. § 1.99(e). (D) is correct because 37 C.F.R. § 1.99(e) provides, "A submission under this section must be filed within two months from the date of publication of the application (§ 1.215(a)) or prior to the mailing of a notice of allowance (§ 1.311), whichever is earlier."

QUESTION 113

In accordance with the MPEP and USPTO rules and procedure, correspondence transmitted to the USPTO by facsimile is not permitted in certain situations. Which of the following facsimile transmissions to the USPTO will be accorded a date of receipt by the USPTO?

- (A) Facsimile transmission of a request for reexamination under 37 CFR 1.510 or 1.913.
- (B) Facsimile transmission of drawings submitted under 37 CFR 1.81, 1.83 through 1.85, 1.152, 1.165, 1.174, or 1.437.
- (C) Facsimile transmission of a response to a Notice of Incomplete Nonprovisional Application for the purpose of obtaining an application filing date.
- (D) Facsimile transmission of a correspondence to be filed in a patent application subject to a secrecy order under 37 CFR 5.1 through 5.5 and directly related to the secrecy order content of the application.
- (E) Facsimile transmission of a continued prosecution application under 37 CFR 1.53(d) and an authorization to charge the basic filing fee to a deposit account.

Choice (E) is the correct answer. MPEP § 502.01, and 37 C.F.R. § 1.6(d)(3).

MPEP § 502.01 reads, "The date of receipt accorded to any correspondence permitted to be sent by facsimile transmission, including a continued prosecution application (CPA) filed under 37 C.F.R. § 1.53(d), is the date the complete transmission is received by an Office facsimile unit...An applicant filing a CPA by facsimile transmission must include an authorization to charge the basic filing fee to a deposit account or to a credit card."

QUESTION 114

If a reissue application is filed within two years of the original patent grant, the applicant may subsequently broaden the claims during prosecution of the pending reissue prosecution beyond the two year limit,

- (A) if the applicant indicates in the oath accompanying the reissue application that the claims will be broadened.
- (B) if an intent to broaden is indicated in the reissue application at any time within three years from the patent grant.
- (C) if the reissue application is filed on the 2-year anniversary date from the patent grant, even though an intent to broaden the claims was not indicated in the application at that time.
- (D) if the reissue application is a continuing reissue application of a parent reissue application, and neither reissue application contained an indication of an intent to broaden the claims until 4 years after the patent grant..

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- (E) provided, absent any prior indication of intent to broaden, an attempt is made to convert the reissue into a broadening reissue concurrent with the presentation of broadening claims beyond the two year limit.

(A) is correct. MPEP § 1412.03. *In re Doll*, 164 USPQ 218, 220 (CCPA 1970).

QUESTION 115

On September 12, 2001, Jill and Jack invent a new electrically charged brush that removes lint from black wool sweaters and coats. Jill and Jack draft a nonprovisional application and send it to the USPTO and the mailing envelope is postmarked September 13, 2001. They fail to use Express Mail and their application becomes delayed in the mail for over a month. The USPTO finally receives the Jill and Jack application on December 3, 2001. On September 14, 2001, Mike and Millie invent a new electrically charged brush that removes lint from black wool sweaters and coats. Mike and Millie had no knowledge of Jill and Jack and/or their invention on September 14, 2001. Mike and Millie draft a nonprovisional application and send it to the USPTO on September 15, 2001, using U.S. Postal Service Express Mail and include the Express Mail label number on the cover sheet of their application. The mailing envelope received by the U.S. Postal Service and the date-in is clearly marked on the Express Mail label as September 15, 2001. The application of Mike and Millie becomes delayed in the mail for two months. The USPTO receives the Mike and Millie application on December 5, 2001. Assume the inventions of Jill and Jack, and of Mike and Millie are the same. Also assume that no Postal Service Emergency was involved in the delivery of the mail. Which of the following is true?

- (A) The nonprovisional application of Mike and Millie will be accorded a filing date of September 15, 2001 upon receipt in the USPTO, and their filing date will be prior to that of Jill and Jack's application.
- (B) Since the time the application was lost in the mail was unforeseeable, Jill and Jack will be entitled upon petition the USPTO to the benefit of a filing date as of the time they mailed their application on September 13, 2001.
- (C) Since Jill and Jack were the first inventors, unless Jill and Jack draft their claims so as to read directly on or substantially for the same invention as Mike and Millie claim, both applications would issue as patents since the United States has a first to invent patent system.
- (D) The application for the invention of Jill and Jack will be accorded a September 13, 2001 filing date in the USPTO, since the postmark or date placed on the envelope by the U.S. Postal Service is the determinative date for the purposes of according a filing date.
- (E) Since the application of Mike and Millie sent by Express Mail was not received until December 5, 2001, Mike and Millie will need to certify that they mailed their application on September 15, 2001, before the USPTO will accord them a filing date of September 15, 2001.

(A). As to (A) see 37 C.F.R. § 1.10(a), which provides, "Any correspondence

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received by the [USPTO] that was delivered by the 'Express Mail Post Office to Addressee' service of the United States Postal Service (USPS) will be considered filed in the [USPTO] on the date of deposit with the USPS. The date of Deposit with the USPS is shown by the 'date-in' on the 'Express Mail' mailing label or other official USPS notation."

QUESTION 116

In 1995 Patent Agent filed a U.S. patent application containing five claims (Application 1). All five claims are fully supported under 35 U.S.C. § 112 by the disclosure of Application 1. In 2000, Patent Agent filed a U.S. patent application (Application 2) that was a continuation-in-part of Application 1. Application 2 adds new subject matter to the disclosure of Application 1, and ten additional claims. Of the fifteen claims in Application 2, claims 1-5 are exactly the same as Application 1, claims 6-10 are fully supported under 35 U.S.C. § 112 by the disclosure of Application 1, and claims 11-15 are fully supported under 35 U.S.C. § 112 only by the newly added subject matter of Application 2. The effective filing date for claims in Application 2 is:

- (A) 1-15 is 2000.
- (B) 1-15 is 1995.
- (C) 1-10 is 1995.
- (D) 11-15 is 2000.
- (E) (C) and (D).

(E) is the most correct answer. MPEP § 706.02 page 700-20 (8th ed.), under the heading "DETERMINING THE EFFECTIVE FILING DATE OF THE APPLICATION" states "[t]he effective filing date of a U.S. application may be determined as follows: ... (B) If the application is a continuation-in-part of an earlier U.S. application, any claims in the new application not supported by the specification and claims of the parent application have an effective filing date equal to the filing date of the new application. Any claims which are fully supported under 35 U.S.C. § 112 by the earlier parent application have the effective filing date of that earlier parent application." Accordingly, the effective filing date of claims 1-10 is 1995 and the effective filing date of claims 11-15 is 2000.

QUESTION 117

Applicant Einstein files a patent application on November 26, 1999, that claims a new type of football pads. Prosecution is conducted and the application issues as a patent to Einstein on April 3, 2001. A competitor, Weisman, who has been making and selling football pads since April of 1998, learns of Einstein's patent when Einstein approaches him on May 3, 2001, with charges of infringement of the Einstein patent. Weisman makes an appointment to see you to find out what he can do about Einstein's patent, since Weisman believes that he is the first inventor of the claimed subject matter. At your consultation on May 17, 2001, with Weisman, you discover that Weisman widely distributed printed publications containing a fully enabling disclosure of the invention and all claimed elements in the Einstein patent. Weisman used the printed publication for marketing his football pads in April of 1998. Weisman explains that he wishes to avoid litigation. Which of the following is a proper USPTO practice and procedure that is available to Weisman?

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- (A) Weisman should file a petition to correct inventorship under 37 CFR 1.324 in the patent, along with a statement by Weisman that such error arose without any deceptive intention on his part, requesting that a certificate of correction be issued for the patent under 35 U.S.C. § 256, naming the correct inventive entity, Weisman.
- (B) Weisman should file a reissue application under 35 U.S.C. § 251, requesting correction of inventorship as an error in the patent that arose or occurred without deceptive intention, wherein such error is corrected by adding the inventor Weisman and deleting the inventor Einstein, as well as citing Joe Weisman's April 1998 printed publication for the football pads as evidence that Weisman is the correct inventor.
- (C) Weisman should file a prior art citation under 35 U.S.C. § 301, citing the sales in April 1998 of football pads, and explain the pertinency and manner of applying such sales to at least one claim of the Einstein patent.
- (D) Weisman should file a request for ex parte reexamination of the Einstein patent under 35 U.S.C. § 302, citing the April 1998 printed publication of football pads in, and explain the pertinency and manner of applying such prior art to at least one claim of the Einstein patent.
- (E) Weisman should file a request for inter partes reexamination of the Einstein patent under 35 U.S.C. § 311, citing public use of the football pads in April 1998, and explain the pertinency and manner of applying such prior use to at least one claim of the Einstein patent.

(D) is correct. It is the only answer that proposes to use a practice and procedure that is available to Einstein. 35 U.S.C. § 302.

QUESTION 118

Applicant Kepler files a patent application on November 24, 1999, that claims a new type of football pads. Prosecution is conducted and the application issues as a patent to Einstein on April 3, 2001. A competitor, Able, who has been making and selling football pads since April of 1998, learns of Einstein's patent when Kepler approaches him on May 3, 2001, with charges of infringement of the Kepler patent. Able makes an appointment to see you to find out what he can do about Kepler's patent, since Able believes that he is the first inventor of the claimed subject matter. At your consultation on May 17, 2001, with Kepler, you discover that Able widely distributed printed publications containing a fully enabling disclosure of the invention and all claimed elements in the Kepler patent. Able used the printed publication for marketing his football pads in April of 1998. Able explains that he wishes to avoid litigation. Which of the following is a proper USPTO practice and procedure that is available to Weisman?

- (A) Able should file a petition to correct inventorship under 37 CFR 1.324 in the patent, along with a statement by Able that such error arose without any deceptive intention on his part, requesting that a certificate of correction be issued for the patent under 35 U.S.C. § 256, naming the correct inventive entity, Weisman.
- (B) Able should file a reissue application under 35 U.S.C. § 251, requesting correction of inventorship as an error in the patent that arose or occurred without deceptive intention,

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wherein such error is corrected by adding the inventor Weisman and deleting the inventor Kepler, as well as citing Able's April 1998 printed publication for the football pads as evidence that Able is the correct inventor.

- (C) Able should file a prior art citation under 35 U.S.C. § 301, citing the sales in April 1998 of football pads, and explain the pertinency and manner of applying such sales to at least one claim of the Kepler patent.
- (D) Able should file a request for *ex parte* reexamination of the Kepler patent under 35 U.S.C. § 302, citing the April 1998 printed publication of football pads in, and explain the pertinency and manner of applying such prior art to at least one claim of the Kepler patent.
- (E) Able should file a request for *inter partes* reexamination of the Kepler patent under 35 U.S.C. § 311, citing public use of the football pads in April 1998, and explain the pertinency and manner of applying such prior use to at least one claim of the Kepler patent.

(D) is correct. It is the only answer that proposes to use a practice and procedure that is available to Kepler. 35 U.S.C. § 302.

QUESTION 119

An amendment filed in January 8, 2002, in an unassigned nonprovisional application seeks to cancel claims so that fewer than all of the currently named inventors are the actual inventors of the invention being claimed. The amendment includes a request to delete the names of the persons who are not inventors. In accordance with proper USPTO rules and procedure, the request may be signed by which of the following?

- (A) A registered practitioner not of record who acts in a representative capacity under 37 CFR 1.34(a).
- (B) All of the applicants (37 CFR 1.41(b)) for patent.
- (C) A registered practitioner of record appointed pursuant to 37 CFR 1.34(b).
- (D) (B) and (C).
- (E) (A), (B), and (C).

(E) is the correct answer. 37 C.F.R. § 1.48(b) (effective November 7, 2000); "Changes To Implement the Patent Business Goals; Final Rule," 65 FR 54604, 54619 (September 8, 2000). As stated in 65 FR at 54619, middle column, "Sections 1.48(b) and (d) are revised to indicate that a request to correct the inventorship thereunder must be signed by a party as set forth in § 1.33(b)...".

QUESTION 120

Which of the following is not a USPTO recommendation or requirement?

- (A) Claims should be arranged in order of scope so that the first claim presented is the least restrictive.
- (B) Product and process claims should be separately grouped.
- (C) Every application should contain no more than three dependent claims.
- (D) A claim which depends from a dependent claim should not be separated from that dependent claim by any claim which does not also depend from the dependent claim.
- (E) Each claim should start with a capital letter and end with a period.

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(C). The USPTO does not require or recommend a minimum or maximum number of dependent claims. 37 C.F.R. § 1.75(c).

QUESTION 121

After filing a Notice of Appeal, an appeal brief is due. In accordance with proper USPTO practice and procedure:

- (A) The brief is due within two months of the date of appeal, the date indicated on any Certificate of Mailing under 37 CFR 1.8 attached to the Notice of Appeal is the date from which this two month period is measured.
- (B) The brief is due within two months of the date of appeal. The Office date of receipt of the Notice of Appeal is the date from which this two month period is measured.
- (C) Failure to file the appeal brief within the permissible time will result in dismissal of the appeal and abandonment of the application, including any allowed claims.
- (D) Failure to file the appeal brief within the permissible time will result in dismissal of the appeal and abandonment of the application containing no allowed claims, and an appeal brief will be due within two months after the date a petition is granted to revive the application and reinstate the appeal.
- (E) If the appellant is unable to file an appeal brief within the time allotted by the rules, appellant may file a petition, with fee, to the examining group, requesting additional time, and the time extended is added to the last day the appeal brief would have been due when said last day is a Saturday, Sunday, or Federal holiday.

(B) is the most correct answer. 37 CFR 1.192(a); MPEP § 1206, “Time For Filing Appeal Brief.”

QUESTION 122

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

- (A) Since the ABC application is at the Board of Patent Appeals and Interferences already, Sam need only request that the case be transferred to the Interference part of the Board where an interference can be declared between the ABC application and the XYZ patent.

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- (B) Sam should file an amendment adding the claims copied from the XYZ patent and the Board is required to enter the amendment.
 - (C) Sam should promptly file an amendment containing the claims copied from the XYZ patent and request entry. If the Board declines to enter the amendment, Sam should file a separate, continuation application no later than October 26, 2000, containing the claims copied from the XYZ patent as well as claims previously appealed, and then, to avoid the rendering of a decision of the Board, he should promptly inform the clerk of the Board in writing that they have decided to refile and abandon the application containing an appeal waiting a decision.
 - (D) Sam should file an amendment containing the claims copied from the XYZ patent and ask that the interference between the ABC application and the XYZ patent be considered while the case is at the Board.
 - (E) Sam should wait until the appeal is decided before filing an amendment to incorporate claims copied from the XYZ patent and to provoke an interference. There is no benefit to filing new claims since only allowable claims will be considered during an interference.
- (C). 35 U.S.C. § 135(b) requires that the claim be made in the ABC patent within one year of the issuance of the XYZ patent. MPEP § 1211.01 states that there is no obligation resting on the Board to consider new or amended claims submitted while the case is on appeal. MPEP § 1210 states that when an application is refiled, the Board should be promptly notified. Failure to notify the Board may result in the Board's refusing an otherwise proper request to vacate its decision. See also MPEP § 2307.03.

QUESTION 123

A nonprovisional patent application is filed on June 3, 1999, and on September 3, 1999, an Office action is mailed setting a 3 month shortened statutory period for reply. On March 3, 2000, a proper reply is filed together with a petition for a 3 month extension of time accompanied by the appropriate petition fee. A proper petition for conversion of the nonprovisional patent application to a provisional patent application along with the appropriate petition fee is deposited with the U.S. Postal Service as Express Mail pursuant to 37 C.F.R. § 1.10 on Saturday, June 3, 2000. Assuming the petition for conversion is granted shortly thereafter, which of the following statements is true?

- (A) The provisional application is entitled to a filing date of June 3, 1999.
- (B) The provisional application is entitled to a filing date of September 3, 1999.
- (C) The provisional application is entitled to a filing date of March 3, 2000.
- (D) The provisional application is entitled to a filing date of June 3, 2000.
- (E) None of the above.

(A). Under 37 C.F.R. § 1.53(c)(2), a nonprovisional patent application "may be converted to a provisional application and be accorded the original filing date of the" nonprovisional patent application. MPEP § 601.01(c).

QUESTION 124

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

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

(C). MPEP § 2113, page 2100-51, citing *In re Fessman*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974).

QUESTION 125

A non-final Office action contains, among other things, a restriction requirement between two groups of claims, (Group 1 and Group 2). Which of the following, if included in a timely reply under 37 C.F.R. § 1.111, preserves applicant's right to petition the Commissioner to review the restriction requirement?

- I. Applicant's entire reply to the restriction requirement is: "The examiner erred in distinguishing between Group 1 and Group 2, and therefore the restriction requirement is respectfully traversed and no election is being made, in order that applicant's right to petition the Commissioner to review the restriction requirement is preserved."
- II. Applicant's entire reply to the restriction requirement is: "Applicant elects Group 1 and respectfully traverses the restriction requirement, because the examiner erred in requiring a restriction between Group 1 and Group 2."
- III. Applicant's reply distinctly points out detailed reasons why applicant believes the examiner erred in requiring a restriction between Group 1 and Group 2, and additionally sets forth, "Applicant therefore respectfully traverses the restriction requirement and no election is being made, in order that applicant's right to petition the Commissioner to review the restriction requirement is preserved."
- IV. Applicant's reply distinctly points out detailed reasons why applicant believes the examiner erred in requiring a restriction between Group 1 and Group 2, and additionally sets forth, "Applicant therefore respectfully traverses the restriction requirement and elects Group 2."

- (A) I.
- (B) II.
- (C) III.
- (D) IV.
- (E) None of the above.

(D). 37 C.F.R. § 1.111(b); MPEP §§ 818.03(a)-(c). (I) is incorrect since the traversal does not distinctly point out the supposed errors in the examiner's action, and no

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election is made. 37 C.F.R. § 1.143. (II) is incorrect since the traversal does not distinctly point out the supposed errors in the examiner's action. (III) is incorrect since no election is made.

QUESTION 126

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

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

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

QUESTION 127

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

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and immediately file a divisional application directed to the invention of claims 10-19. Claim 20 was omitted from the divisional application. The divisional application includes a specific reference to the original application and is filed with an inventor's oath executed by Tommie only. The divisional application incorporated the original application by reference.

Which of the following statements is correct?

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

(C). The original mistake in omitting Tommie from the list of inventors was automatically corrected by filing the oath executed by both Jo and Tommie. 37 C.F.R. §1.48(f)(1). Under 37 C.F.R. §1.48(b), a change in inventive entity is thereafter required upon cancellation of the non-elected claims.

QUESTION 128

From the above fact pattern, which of the following statements is most correct?

- (A) Since claim 20 was omitted from the divisional application as filed, it cannot be added to the divisional application by a subsequent Amendment because such an
- (B) Amendment would constitute new matter.
It was improper to include Tommie and Jo as joint inventors in the parent application.
- (C) The examiner may properly make a provisional obviousness-type double patenting rejection in the divisional application based on the parent application, but that rejection may be readily overcome with the filing of a terminal disclaimer.
- (D) Because the inventive entity of the amended parent application is different than the inventive entity of the divisional application, the examiner may reject the claims of the divisional application under the provisions of 35 U.S.C. § 102(e).
- (E) Statements (A), (B), (C) and (D) are each incorrect.

(E). Statement (A) is incorrect at least because the parent application, which included claim 20, was incorporated by reference. Therefore, adding claim 20 does not constitute the addition of new matter. Statement (B) is wrong because at least claim 20 is properly viewed as a joint invention (“Jo and Tommie collaborated to invent a method to cleanup toxic waste spills using the chemical made according to the unobvious technique invented by Jo”). MPEP §§ 605.07, item (E), and 2137.01. Under 35 U.S.C. § 116, inventors may apply for a patent jointly even if they did not make the same type or amount of contribution and did not each make a contribution to the subject matter of every claim of the patent. Statement (C) is wrong because 35 U.S.C. § 121 precludes such a rejection. Statement (D) is wrong at least because Tommie is entitled to the filing date of the parent application.

QUESTION 129

Nonobviousness of a claimed invention may be demonstrated by:

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

(B). See *Ex parte Mead Johnson & Co.*, 227 USPQ 78 (Bd. Pat. App. & Int. 1985); MPEP 716.02(a) page 700-155 (Absence of Expected Property is Evidence of Nonobviousness).

QUESTION 130

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

- (A) The rejection is not supported by the reference.
- (B) The publication is not available as a reference because it did not become available to the general public until after the filing date of your patent application.
- (C) The publication is prima facie evidence of prior knowledge even though it was

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available only for limited distribution as of its printing date.

(D) The publication constitutes an absolute statutory bar.

(E) It is not possible to use a Rule 131 affidavit or declaration to antedate the printing date of the publication.

(C). As stated in MPEP § 707.05(f), "For the purpose of anticipation predicated upon prior knowledge under 35 U.S.C. 102(a), the above noted declassified material may be taken as prima facie evidence of such prior knowledge as of its printing date even though such material was classified at that time."

QUESTION 131

A petition to make a patent application special may be filed without fee in which of the following cases?

- (A) The petition is supported by applicant's birth certificate showing applicant's age is 62.
- (B) The petition is supported by applicant's unverified statement that applicant's age is 65.
- (C) The petition is supported by applicant's statement that there is an infringing device actually on the market, that a rigid comparison of the alleged infringing device with the claims of the application has been made, and that applicant has made a careful and thorough search of the prior art.
- (D) The petition is accompanied by a statement under 37 C.F.R. § 1.102 by applicant explaining the relationship of the invention to safety of research in the field of recombinant DNA research.
- (E) The petition is accompanied by applicant's statement explaining how the invention contributes to the diagnosis, treatment or prevention of HIV/AIDS or cancer.

(B) is correct.

QUESTION 132

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.

(E) is correct since the reference is not by "another."

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QUESTION 133

Which of the following, if any, is true?

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

(B) Any person at any time may file a request for reexamination. 35 U.S.C. §302.

QUESTION 134

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

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

(E). Roberts is not entitled to a patent because he did not himself invent the subject matter sought to be patented. 35 U.S.C. § 102(f).

QUESTION 135

Which of the following may not be properly used as prior art for purposes of rejecting a claim under 35 U.S.C. § 102(b) in an application having an effective filing date of Monday, May 3, 1999?

- (A) A journal article, published Saturday, May 2, 1998, disclosing all the claimed elements and fully teaching how to make and use the invention as claimed.
- (B) A foreign patent, published March 3, 1998, which applicant referenced in the application when claiming foreign priority based on the foreign application date, and applicant submitted a certified copy of the original foreign application.
- (C) Applicant's statement in a declaration under 37 C.F.R. § 1.132 that although the invention as claimed had been offered for sale in department stores in New York during 1997, this was done only to analyze consumer acceptance of the packaging in which the invention is marketed.
- (D) A journal article, published May 1, 1997, disclosing all the elements of the claim and teaching how to make and use the claimed invention. The examiner used the article in combination with another journal article in a previous non-final Office action to reject the same claim under 35 U.S.C. § 103.
- (E) All of the above.

(A). MPEP 706.02(a).

QUESTION 136

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.

(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.

QUESTION 137

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

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

The correct answer is (E). MPEP § 716.10. There is no requirement that a publication describe something that has actually been reduced to practice before the publication can act as a prior art reference.

QUESTION 138

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

Which of the following statements is most correct?

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- (A) In a priority contest against another inventor, Mario can rely on his activities in Canada in establishing a date of invention.
- (B) In a priority contest against another inventor, Mario can rely on his activities in Germany in establishing a date of invention.
- (C) Mario can rely on his activities in Canada in establishing a date of invention prior to publication of the regional Canadian magazine article.
- (D) (A) and (C).
- (E) (A), (B), and (C).

The answer is (E). Mario may rely on activities in both Germany (a WTO member country) and Canada (a NAFTA country) in establishing a date of invention prior to publication of the Moose Jaw Monthly article or in establishing priority. 35 U.S.C. § 104; see also MPEP § 715.01(c).

QUESTION 139

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

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

(B). MPEP 715.04.

QUESTION 140

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?

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- (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.

(C). MPEP § 2111.02. (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 141

Which of the following is true?

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

(B) is the most correct answer. see MPEP 2286, page 2200-97, stating, "[t]he issuance of a final district court decision upholding validity during a reexamination also will have no binding effect on the examination of the reexamination."

QUESTION 142

The applicant asserted the claims do not rise or fail together, and the Examiner's Answer stated

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that they do. What will the Board do as to the rejected claims?

1206 Appeal Brief. In the absence of a separate statement that the claims do not stand or fall together, the Board panel assigned to the case will normally select the broadest claim in a group and will consider only that claim, even though the group may contain two broad claims, such as “ABCDE” and “ABCDF.” The same would be true in a case where there are both broad method and apparatus claims on appeal in the same group. The rationale behind the rule, as amended, is to make the appeal process as efficient as possible. Thus, while the Board will consider each separately argued claim, the work of the Board can be done in a more efficient manner by selecting a single claim from a group of claims when the appellant does not meet the requirements of 37 CFR 1.192(c)(7).

It should be noted that 37 CFR 1.192(c)(7) requires the appellant to perform two affirmative acts in his or her brief in order to have the separate patentability of a plurality of claims subject to the same rejection considered. The appellant must (A) state that the claims do not stand or fall together and (B) present arguments why the claims subject to the same rejection are separately patentable. Where the appellant does neither, the claims will be treated as standing or falling together. Where, however, the appellant (A) omits the statement required by 37 CFR 1.192(c)(7) yet presents arguments in the argument section of the brief, or (B) includes the statement required by 37 CFR 1.192(c)(7) to the effect that one or more claims do not stand or fall together (i.e., that they are separately patentable) yet does not offer argument in support thereof in the “Argument” section of the brief, the appellant should be notified of the noncompliance as per 37 CFR 1.192(d).

QUESTION 143

Which of the following is true?

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

(E). See MPEP 1414 Content of Reissue Oath/Declaration and 37 CFR 1.175(a) which states that reissue oaths/declarations must meet the requirements of 37 CFR 1.63, including 1.63(c) relating to a claim for foreign priority.

QUESTION 144

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

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

(D). 35 U.S.C. § 102(a). As explained in MPEP § 901.01, the “matter canceled from the application file wrapper of a U.S. patent may be used as prior art as of the patent date in that it then constitutes prior public knowledge under 35 U.S.C. 102(a), *In re Lund*, 376 F.2d 982, 153 USPQ 625 (CCPA 1967). See also MPEP § 2127 and § 2136.02.”

QUESTION 145

Mitch and Mac are named inventors on an international application that is filed in the USPTO Receiving Office, and designates the United States of America. Mac now indicates that he will not sign the Request for the international application. Mitch wishes to proceed with the Request and seeks the advice of their patent agent. Which of the following answers accords with the provisions of the Patent Cooperation Treaty?

- (A) Mitch’s agent should sign the Request and accompany it with a statement indicating why it is believed that Mac refuses to proceed with the Request.
- (B) Mitch should sign the request for himself and also sign on behalf of Mac.
- (C) Mitch should sign the request and seek a court order to obtain Mac’s signature.
- (D) Mitch should sign the Request and accompany it with a statement providing a satisfactory explanation for the lack of Mac’s signature.
- (E) Mitch should sign the Request and Mitch’s agent should sign on behalf of Mac, since he continues to represent Mac.

(D) is the correct answer because the advice is consistent with 37 C.F.R. § 1.425.

QUESTION 146

In June 1998, Jack and Jill, a married couple, are vacationing in Vietnam (not a WTO country) when they encounter a man selling bamboo knives for cleaning fish. The particular curvature of the bamboo both lends support to the knife to prevent it from bending and breaking and facilitates cleaning inside the fish. Jill takes a picture of Jack with the knife cleaning the fish. Subsequently, in November 1998, when Jack returns to the United States he begins to make and sell an identical knife to the one seen in Vietnam. In July 1999, he files a patent

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application claiming the nearly identical knife. Jack discloses no prior art during the prosecution of his application and fails to mention the knife he saw in Vietnam. The examiner finds no prior art similar to the claimed knife, and Jack is awarded a patent in December 2000. Meanwhile, Jill divorces Jack, and associates with Sam. Unfortunately, Sam is penniless. To raise cash, Sam and Jill begin selling a knife identical to the one Jack produces, only Sam and Jill make their knife out of plastic. The knives of Sam and Jill sell like hotcakes. Jack sues for infringement. Jill and Sam come to you for advice. Which of the following is not true?

- (A) Jack is entitled to patent protection since Vietnam is not a WTO country and evidence of the Vietnamese knife cannot be used against him to reject his patent claims.
- (B) Jack had a duty under 37 C.F.R. § 1.56 to disclose his discovery of the bamboo knife in Vietnam to the examiner during the original patent prosecution.
- (C) Since the use in Vietnam was not in this country, it does not constitute a public use bar under 35 U.S.C. § 102(b).
- (D) If Jill's attorney files a request for reexamination, it will be denied because the picture is not a patent or printed publication.
- (E) Although Jack marketed the invention before obtaining a patent, the patent claims cannot be invalidated under 35 U.S.C. § 102(a) since Jack's making and selling of the knife cannot be used against him under 35 U.S.C. § 102(a).

(A) is the most correct answer. Answer (A) is not true since Jack did not invent the knife, therefore he is not entitled to a patent. Jack derived the invention from another, and the picture of Jack with the Vietnamese knife is evidence of derivation. 35 U.S.C. § 102(f); MPEP § 2137.

QUESTION 147

Sally, an employee of Ted, conceived of and reduced to practice a spot remover for Ted on May 1, 1998. Sally's spot remover was made from water, chlorine, and lemon juice. On June 2, 1998, Sally filed a nonprovisional U.S. patent application for the spot remover, and assigned the entire rights in the application to Ted. Sally's assignment was not recorded in the USPTO, but was referenced in her application. On June 12, 1999, Jane, also an employee of Ted, having no knowledge of Sally's spot remover, conceived of and reduced to practice a spot remover for Ted. Jane's spot remover was made from carbonated water, chlorine, and lemon juice. On May 25, 1999, the USPTO granted Sally a patent. On November 5, 1998, Jane filed a nonprovisional U.S. patent application for the spot remover. As noted in Jane's application, Jane assigned the entire rights in her application to Ted. Jane's assignment was duly recorded in the USPTO. The examiner mailed a non-final Office action rejection under 35 U.S.C. § 103 to Jane in March 2001, citing the patent to Sally as prior art. Which of the following, if timely filed by Jane, would be effective in disqualifying Sally's patent?

- I. An affidavit by Jane stating that the application files of Sally and Jane both refer to assignments to Ted.
- II. A copy of Sally's assignment to Ted, clearly indicating that common ownership of Jane's and Sally's inventions existed at the time Jane's invention was made.
- III. An affidavit by Ted stating sufficient facts to show that there is common ownership of

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the Sally and Jane inventions and that common ownership existed at the time the Jane invention was made.

- (A) I.
- (B) II.
- (C) III.
- (D) II and III.
- (E) None of the above.

All answers accepted.

QUESTION 148

You have agreed to represent an independent inventor in connection with a patent application that was filed in the USPTO by the inventor on a pro se basis. As filed, the application included a detailed written description that, when viewed together with four accompanying color photographs, enabled one of ordinary skill in the pertinent art to make and use the invention. The application was filed with an inventor's declaration in compliance with 37 CFR 1.63, a small entity statement (independent inventor) under 37 CFR 1.27, and all necessary small entity filing fees. MEGACORP, a very large multi-national corporation, licensed rights in the invention after the application was filed. You have been asked to suggest steps to remove any formal objections that can be expected from the patent examiner, without incurring unnecessary government fees. You determine that the first color photograph is the only practical medium by which to disclose certain aspects of the claimed invention, but that the substance of the remaining photographs could readily be illustrated through ordinary ink drawings. You correctly recall that the Office announced in the Official Gazette in May 2001 (1246 OG 106) that it is sua sponte waiving 37 CFR 1.84(a)(2)(iii), and is no longer requiring a black and white photocopy of any color drawing or color photograph. Which of the following represents the most reasonable advice to the independent inventor?

- (A) Submit a request for approval of drawing changes wherein the first photograph is labeled "Figure 1" and the remaining photographs are cancelled in favor of corresponding ink drawings labeled Figures 2 through 4; and immediately withdraw the claim for small entity status because of the license to MEGACORP.
- (B) Submit a request for approval of drawing changes wherein the first photograph is labeled "Figure 1" and the remaining photographs are cancelled in favor of corresponding ink drawings labeled Figures 2 through 4; and submit a petition for acceptance of Figure 1 in the form of a color photograph along with three sets of the color photograph, a proposed amendment to insert language concerning the color photograph as the first paragraph of the specification and the required petition fee. The photographs must be sufficient quality that all details in the photographs are reproducible in a printed patent.
- (C) Submit a request for approval of drawing changes wherein the first photograph is labeled "Figure 1" and the remaining photographs are cancelled in favor of corresponding ink drawings labeled Figures 2 through 4.
- (D) Immediately withdraw the claim for small entity status because of the license to MEGACORP and submit to the USPTO the difference between the small entity

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filing fee and the large entity filing fee.

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

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

QUESTION 149

In connection with the utility of an invention described in a patent application, which of the following conforms to proper USPTO practice and procedure?

- (A) A deficiency under 35 U.S.C. § 101 also creates a deficiency under 35 U.S.C. § 112, first paragraph.
- (B) To overcome a rejection under 35 U.S.C. § 101, it must be shown that the claimed device is capable of achieving a useful result on all occasions and under all conditions.
- (C) A claimed invention is properly rejected under 35 U.S.C. § 101 as lacking utility if the particular embodiment disclosed in the patent lacks perfection or performs crudely.
- (D) To overcome a rejection under 35 U.S.C. § 101, it is essential to show that the claimed invention accomplishes all its intended functions.
- (E) A claimed invention lacks utility if it is not commercially successful.

The most correct answer is (A). As stated in MPEP § 2107.01 (IV). A deficiency under 35 U.S.C. § 101 also creates a deficiency under 35 U.S.C. § 112, first paragraph. See *In re Brana*; *In re Fouche*, ("If such compositions are in fact useless, appellant's specification cannot have taught how to use them.").

QUESTION 150

In which of the following final Office action rejections is the finality of the Office action rejection proper?

- (A) The final Office action rejection is in a second Office action and uses newly cited art under 35 U.S.C. § 102(b) to reject unamended claims that were objected to but not rejected in a first Office action.
- (B) The final Office action rejection is in a first Office action in a continuation- in-part application where at least one claim includes subject matter not present in the parent application.
- (C) The final Office action rejection is in a first Office action in a continuing application, all claims are drawn to the same invention claimed in the parent application, and the claims would have been properly finally rejected on the

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grounds and art of record in the next Office action if they had been entered in the parent application.

(D) The final Office action rejection is in a first Office action in a substitute application that contains material that was presented after final rejection in an earlier application but was denied entry because the issue of new matter was raised.

(E) None of the above.

(C) is the correct answer. MPEP § 706.07(b).

QUESTION 151

Which of the following is not in accord with proper USPTO practice and procedure?

(A) A written description as filed in a nonprovisional patent application is presumed adequate under 35 U.S.C. § 112 in the absence of evidence or reasoning to the contrary.

(B) An examiner may show that a written description as filed in a nonprovisional patent application is not adequate by presenting a preponderance of evidence why a person of ordinary skill in the art would not recognize in the applicant's disclosure a description of the invention defined by the claims.

(C) A general allegation of "unpredictability in the art" is sufficient to support a rejection of a claim for lack of an adequate written description.

(D) When filing an amendment, a practitioner should show support in the original disclosure for new or amended claims.

(E) When there is substantial variation within a genus, an applicant must describe a sufficient variety of species to reflect the variation within the genus.

(C), not being in accord with proper USPTO practice and procedure, is the most correct answer. As stated in "Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, 'Written Description' Requirement," 66 F.R. 1099, 1107 (Jan. 5, 2001), middle column, "A general allegation of 'unpredictability in the art' is not a sufficient reason to support a rejection for lack of adequate written description"; MPEP § 2163, paragraph III. A. (pg. 2100-166) (8th Ed.).

QUESTION 152

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

(A) For Able and Baker to properly execute an oath or declaration under 37 CFR 1.63 in a patent application claiming not only the grille, but also the two

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subcombinations, Able and Baker must be joint inventors of the grille, and each of the two subcombinations.

(B) A characteristic of U.S. patent law that is generally shared by other countries is that the applicant for a patent must be the inventor.

(C) If Able and Baker execute an oath or declaration under 37 CFR 1.63 as joint inventors and file an application claiming the grille (a combination of elements A, B, C, D, E, F, G, H, I, J, K, L, M and N), the existence of the claim to the grille is evidence of their joint inventorship of the individual elements.

(D) Able and Baker may properly execute an oath or declaration under 37 CFR 1.63 as joint inventors and file an application containing claims to the grille (a combination of elements A, B, C, D, E, F, G, H, I, J, K, L, M and N), claims to the subcombination conceived by Able, and claims to the subcombination conceived by Baker.

(E) Able and Baker could not properly claim the combination unless they successfully and personally reduced the grille to practice.

(D) MPEP 2137.01 "Inventorship".

QUESTION 153

Which of the following is most likely to be considered in a proper obviousness determination?

(A) Evidence demonstrating the manner in which the invention was made.

(B) Evidence that a combination of prior art teachings, although technically compatible, would not be made by businessmen for economic reasons.

(C) Evidence demonstrating the level of ordinary skill in the art.

(D) Evidence that one of ordinary skill in the art, after reading Kat's application, would readily be able to make and use Kat's invention without undue experimentation.

(E) Evidence that the distance finder described in the July 2000 golf magazine has enjoyed great commercial success.

The most correct answer is (C). The level of ordinary skill in the art is one of the factors that must be considered in any obviousness determination. *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).

QUESTION 154

A U.S. patent application discloses a first embodiment of an invention, a composition made of known materials in equal amounts by weight of A, B, and C. The application discloses a second embodiment of the invention comprising equal amounts by weight of A, B, and C, and an effective amount of D, a known material, to reduce excess moisture from the composition. The application also discloses a third embodiment of the invention comprising equal amounts by weight of A, B, and C, and an effective amount of D to reduce the acidity of the composition. The application fully discloses guidelines for determining an effective amount of D to reduce excess moisture from the composition, and determining an effective amount of D to reduce the acidity of the composition. The application discloses that the amount of D needed to reduce

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excess moisture from the composition differs from the amount of D needed to reduce the acidity of the composition. Which of the following claims, if included in the application, provides a proper basis for a rejection under 35 U.S.C. § 112, second paragraph?

- (A) Claim 1. A composition comprising: equal amounts by weight of A, B, and C, and an effective amount of D to reduce the acidity of the composition.
- (B) Claim 1. A composition comprising: equal amounts by weight of A, B, and C, and an effective amount of D.
- (C) Claim 1. A composition comprising: equal amounts by weight of A, B, and C, and an effective amount of D to reduce excess moisture from the composition.
- (D) Claim 1. A composition comprising: equal amounts by weight of A, B, and C.
- (E) None of the above.

(B) is the correct answer. 35 U.S.C. § 112, second paragraph and MPEP § 2173.05(c)(III). The claim presented in (B) is improper as “an effective amount” has been held to be indefinite when the claim fails to state the function that is to be achieved and more than one effect can be implied from the specification. In re Fredericksen 213 F.2d 547, 102 USPQ 35 (CCPA 1954). It is unclear whether “an effective amount” in (B) is an effective amount to reduce acidity or an effective amount to reduce moisture.

QUESTION 155

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

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

(D). Under 37 CFR 1.85(a), correcting the drawings to comply with 37 CFR 1.84(a)(1) and (k), and making them suitable for reproduction is a bona fide response.

QUESTION 156

According to USPTO rules and procedure, which of the following can be overcome by an affidavit under 37 CFR 1.131?

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- (A) A rejection properly based on statutory double patenting.
- (B) A rejection properly made under 35 U.S.C. § 102(d) based on a foreign patent granted in a non-WTO country.
- (C) A rejection properly made under 35 U.S.C. § 102(a) based on a journal article dated one month prior to the effective filing date of the U.S. patent application. Applicant has clearly admitted on the record during the prosecution of the application that subject matter in the journal article relied on by the examiner is prior art.
- (D) A rejection properly made under 35 U.S.C. § 102(b) based on a U.S. patent that issued 18 months before the effective filing date of the application. The patent discloses, but does not claim, the invention.
- (E) None of the above.

(E) is the correct answer. MPEP § 715.

QUESTION 157

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

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

(B) is the most correct answer. 35 U.S.C. § 102(e)(1) provides that a USPTO published application, based on an earlier international application, has prior art effect as of its international filing date, if the international application designated the United States, and was published in English. Because in the above fact pattern, the international application designated the United States and was published in English, the USPTO published application is entitled to its international filing date of February 27, 1997 for prior art purposes.

QUESTION 158

Jill, a registered patent agent, receives a Notice of Allowance from the USPTO with a mail date of November 13, 2001, regarding a utility patent application for an improved garden hose which she had filed on behalf of one of her small entity clients. The Notice of Allowance specifies a sum that must be paid within three months of the mailing date to avoid abandonment. The sum specified includes both the issue fee and the publication fee. As a result of a small fire in her office building, Jill is unable to resurrect her files until the last day of the three month period. Jill mails a letter to the USPTO on February 13, 2002 using the U.S. Postal Service. Jill does not employ the procedures of 37 CFR 1.8 or 1.10 to mail the letter. The letter is received in the USPTO on February 15, 2002. The letter correctly identifies the application. The letter

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authorizes the USPTO to charge the proper issue fee for a small entity to her deposit account. The account has been identified in a previously filed authorization to charge fees. At the time the letter was filed in the USPTO, the account had a balance of \$1000.00 in funds. Nothing in the letter authorized payment of the publication fee, no petition for an extension of time was filed, and an Office-provided issue fee transmittal form was not filed. No postal emergency was involved in filing the letter. Which of the following statements accords with proper USPTO practice and procedure?

- (A) The application will become abandoned because Jill did not authorize payment of the publication fee.
- (B) The application will not become abandoned because the authorization to charge fees operates as a request to charge the correct fees to any deposit account identified in a previously filed authorization to charge fees.
- (C) The application will become abandoned because Jill's letter did not include a petition for an extension of time accompanied by the proper fee.
- (D) The application will become abandoned because a completed Office-provided issue fee transmittal form, PTOL-85B, did not accompany Jill's letter.
- (E) The application will become abandoned because Jill's letter was not timely filed in the USPTO and it was not mailed in accordance with the provisions of 37 CFR 1.8 or 1.10.

(E) is correct. A communication mailed within the time given for response in accordance with the procedure of 37 C.F.R. § 1.8 or 1.10 is considered timely filed even if it is received after the date a reply is due. In (E), the letter was not mail in accordance with 37 C.F.R. § 1.8 or 1.10. Therefore, the letter would be considered filed when it is received in the USPTO. 37 C.F.R. § 1.311(a) states, "This three month period is not extendable." Without complying with 37 C.F.R. § 1.8 or 1.10, the filing date of the letter is the date it was received in the USPTO, i.e., February 15, 2002, which is after the due date for payment of the issue fee, February 13, 2002.

QUESTION 159

Johnnie owns a supermarket store in Cleveland, Ohio, and is constantly frustrated when little children drop their chewing gum on Johnnie's clean floor in the supermarket. In her spare time, Johnnie develops an entirely novel type of coating material that she applies to floor tile. The coating material resists adhesion to chewing gum. In order to check out the effectiveness of the floor tile coating material, on December 31, 2000, she secretly covers the floor tiles in her supermarket with the new chewing gum resistant floor tile coating material. Johnnie is amazed at the results inasmuch as cleaning the floor was never easier. On January 30, 2001, Johnnie, satisfied with the experimental use results, ceased testing the use of the coating material. The ability of the coating material to withstand chewing gum adhesion continued unabated throughout the remainder of 2001. On January 1, 2002, one of Johnnie's many customers, James, remarked at how clean the floor looked. Johnnie then told James of her invention. James thinks for one moment and suggests that the floor tile coating material may be useful in microwave ovens, so that food will not stick to the interior sides of the microwave oven. James discusses getting patent protection with Johnnie. Which of the following is true?

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- (A) Johnnie could never be entitled to a patent on a floor tile in combination with a coating material affixed to the outer surface of the tile.
 - (B) James can be named as a coinventor with Johnnie in a patent application claiming a microwave oven wherein the internal surfaces of the oven are coated with the coating material.
 - (C) Since for one year Johnnie told nobody that the floor tile in her supermarket contained the new chewing gum resistant coating material, she would never be barred from obtaining patent protection for the floor coating material.
 - (D) Use of the floor tile coating material in microwave ovens would have been obvious to one of ordinary skill in the art, since James thought of it within seconds after first learning of the floor tile coating material, and James was not skilled in the art.
 - (E) The floor tile having the coating material affixed to the outer surface of the tile, an article of manufacture, would not be patentable as of January 1, 2002 inasmuch as the article was in public use on the supermarket floor for one year.
- (B). Since Johnnie developed the material and James thought of the idea to use it in microwave ovens, they rightfully could be considered coinventors of the new article of manufacture.

QUESTION 160

Which of the following is not a USPTO recommendation or requirement?

- (A) Claims should be arranged in order of scope so that the first claim presented is the least restrictive.
 - (B) Product and process claims should be separately grouped.
 - (C) Every application should contain no more than three dependent claims.
 - (D) A claim which depends from a dependent claim should not be separated from that dependent claim by any claim which does not also depend from the dependent claim.
 - (E) Each claim should start with a capital letter and end with a period.
- (C). The USPTO does not require or recommend a minimum or maximum number of dependent claims. 37 C.F.R. § 1.75(c).

QUESTION 161

While vacationing in Mexico on April 14, 2001, Henrietta invented a camera that operated at high temperature and is waterproof. She carefully documented her invention and filed a provisional application in the USPTO on April 30, 2001. She conducted tests in which the camera withstood temperatures of up to 350 degrees Fahrenheit. However, when the camera was placed in the water leaks were discovered rendering the camera inoperable. On April 12, 2002, Henrietta conceived of means that she rightfully believed will fix the leakage issue. Henrietta came to you and asked whether she can file another application. Henrietta desires to obtain the broadest patent protection available to her.

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Which of the following is the best manner in accordance with proper USPTO practice and procedure for obtaining the patent covering both aspects of her invention?

- (A) She can file a nonprovisional application on April 30, 2002 claiming benefit of the filing date of the provisional application, disclosing the means for fixing the leak and presenting a claim covering a camera that operates at high temperatures and a claim covering a camera that is waterproof, or presenting a claim covering a camera that both operates at high temperatures and is waterproof.
- (B) Henrietta cannot rightfully claim a camera that is waterproof in a nonprovisional application filed on April 30, 2002, since she tested the camera and the camera developed leaks.
- (C) Henrietta can file another provisional application on April 30, 2002 and obtain benefit of the filing of the provisional application filed on April 30, 2001.
- (D) Henrietta may establish a date of April 14, 2001 for a reduction to practice of her invention for claims directed to the waterproofing feature.
- (E) Henrietta should file a nonprovisional application on April 30, 2002 having claims directed only to a camera that withstands high temperatures since the camera that she tested developed leaks.

(A) is the answer. A provisional holds your place in line for whatever it includes in its disclosure. If you add to it when the non-provisional is filed you can still obtain the benefit of whatever the two applications shared.

QUESTION 162

Roger Rocket is a designer of paper cups at Paper America. During his free time, he likes to attend baseball games at Yankee Stadium. One day, while seated in the stands, he caught a fly ball. He took the baseball home and played catch with his friends Andy Cannon, Orlando Torpedo, and Mariano Missile. Unfortunately for Rocket, Cannon has a problem with accuracy. Cannon threw the ball over Rocket's head and straight through a neighbor's front window. The shattered glass ripped the lining off of the baseball. Instantly, Rocket conceived a more durable baseball with an exterior similar to that of a golf ball. Rocket worked for months on his invention in Missile's garage. His new baseball was comprised of a titanium core, and a plastic shell having circular dimples and V-shaped laces. Torpedo realized and told Rocket that Y-shaped laces would enable baseball players to throw the ball faster. Cannon, an engineer in a radar gun laboratory, tested the velocity of the baseball with both V and Y-shaped laces. To Cannon's surprise, the baseball traveled 10 M.P.H. faster with the Y-shaped laces. Rocket wanted patent protection for a baseball having a titanium core, and a plastic shell having circular dimples and Y-shaped laces, so he approached Yogi Practitioner for assistance. Rocket has no obligation, contractual or otherwise, to assign his inventions to Paper America.

In accordance with proper USPTO practice and procedure, who should execute the oath?

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- (A) Rocket
- (B) Rocket and Torpedo
- (C) Rocket and Cannon
- (D) Rocket, Torpedo, and Cannon
- (E) Rocket, Torpedo, Cannon, and Missile

(B). Joint inventorship is based on conception only, not reduction to practice. Rocket conceived of the basic titanium ball and Torpedo came up with the laces.

QUESTION 163

Roger Rocket is a designer of paper cups at Paper America. During his free time, he likes to attend baseball games at Yankee Stadium. One day, while seated in the stands, he caught a fly ball. He took the baseball home and played catch with his friends Andy Cannon, Orlando Torpedo, and Mariano Missile. Unfortunately for Rocket, Cannon has a problem with accuracy. Cannon threw the ball over Rocket's head and straight through a neighbor's front window. The shattered glass ripped the lining off of the baseball. Instantly, Rocket conceived a more durable baseball with an exterior similar to that of a golf ball. Rocket worked for months on his invention in Missile's garage. His new baseball was comprised of a titanium core, and a plastic shell having circular dimples and V-shaped laces. Torpedo realized and told Rocket that Y-shaped laces would enable baseball players to throw the ball faster. Cannon, an engineer in a radar gun laboratory, tested the velocity of the baseball with both V and Y-shaped laces. To Cannon's surprise, the baseball traveled 10 M.P.H. faster with the Y-shaped laces. Rocket wanted patent protection for a baseball having a titanium core, and a plastic shell having circular dimples and Y-shaped laces, so he approached Yogi Practitioner for assistance. Rocket has no obligation, contractual or otherwise, to assign his inventions to Paper America. Before executing the oath, Rocket wanted to ask Practitioner a question. On his way to Practitioner's office, Rocket was instantly killed when a drunk driver hit his car. The officers or employees of Paper America are not related to Rocket. Who can execute an oath on Rocket's behalf?

- (A) The President of Paper America
- (B) The CEO of Paper America
- (C) Rocket's manager at Paper America
- (D) Rocket's legal representative
- (E) None of the above

(D). An estate representative can sign for Rocket since Paper America is completely out of the picture.

QUESTION 163

Roger Rocket is a designer of paper cups at Paper America. During his free time, he likes to attend baseball games at Yankee Stadium. One day, while seated in the stands, he caught a fly ball. He took the baseball home and played catch with his friends Andy Cannon, Orlando Torpedo, and Mariano Missile. Unfortunately for Rocket, Cannon has a problem with accuracy. Cannon threw the ball over Rocket's head and straight through a

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neighbor's front window. The shattered glass ripped the lining off of the baseball. Instantly, Rocket conceived a more durable baseball with an exterior similar to that of a golf ball. Rocket worked for months on his invention in Missile's garage. His new baseball was comprised of a titanium core, and a plastic shell having circular dimples and V-shaped laces. Torpedo realized and told Rocket that Y-shaped laces would enable baseball players to throw the ball faster. Cannon, an engineer in a radar gun laboratory, tested the velocity of the baseball with both V and Y-shaped laces. To Cannon's surprise, the baseball traveled 10 M.P.H. faster with the Y-shaped laces. Rocket wanted patent protection for a baseball having a titanium core, and a plastic shell having circular dimples and Y-shaped laces, so he approached Yogi Practitioner for assistance. Rocket has no obligation, contractual or otherwise, to assign his inventions to Paper America. Practitioner received all of the proper papers required to receive a filing date. However, due to an unexpected emergency, he had to fly out of the country that evening to conduct discovery in another matter. Practitioner knew that he would be out of the office for at least 4 weeks, so before leaving, he left a note instructing his assistant to file the Rocket application on October 13, 2001, using an Express Mailing label. His assistant did not see the note until 8:00 P.M. on Friday, October 19, 2001. On Monday, October 22, 2001, Rocket's assistant deposited the Rocket application in the United States Postal Service with a proper Express Mailing label. The Postal Service properly completed a legible label showing an October 22, 2001 date in. The correspondence was received in the USPTO on October 27, 2001. What is the filing date of the Rocket application absent any Postal Service Emergency?

- (A) October 12, 2001
- (B) October 13, 2001
- (C) October 19, 2001
- (D) October 22, 2001
- (E) October 27, 2001

(D). Express Mail "date in" is the filing date.

QUESTION 164

Patentee, Iam Smarter, filed and prosecuted his own nonprovisional patent application on November 29, 1999, and received a patent for his novel cellular phone on June 5, 2001. He was very eager to market his invention and spent the summer meeting with potential licensees of his cellular phone patent. Throughout the summer of 2001, all of the potential licensees expressed concern that the claim coverage that Smarter obtained in his cellular phone patent was not broad enough to corner the market on this technology, and therefore indicated to him that they feel it was not lucrative enough to meet their financial aspirations. By the end of the summer, Smarter is discouraged. On September 5, 2001, Smarter consults with you to find out if there is anything he can do at this point to improve his ability to market his invention. At your consultation with Smarter, you learn the foregoing, and that in his original patent application, Smarter had a number of claims that were subjected to a restriction requirement, but were nonelected and withdrawn from further consideration. You also learn that Smarter has no currently pending application, that the specification discloses Smart's invention more broadly than

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he ever claimed, and that the claims, in fact, are narrower than the supporting disclosure in the specification. Which of the following will be the best recommendation in accordance with proper USPTO practice and procedure?

- (A) Smarter should immediately file a divisional application under 37 CFR 1.53(b) including the nonelected claims that were subjected to a restriction requirement in the nonprovisional application that issued as the patent.
- (B) Smarter should file a reissue application under 35 U.S.C. § 251, including the nonelected claims that were subjected to the restriction requirement in the nonprovisional application that issued as the patent.
- (C) Smarter should file a reissue application under 35 U.S.C. § 251, broadening the scope of the claims of the issued patent, and then file a divisional reissue application presenting only the nonelected claims that were subjected to a restriction requirement in the nonprovisional application which issued as the patent.
- (D) Smarter should simultaneously file two separate reissue applications under 35 U.S.C. § 251, one including broadening amendments of the claims in the original patent, and one including the nonelected claims that were subjected to a restriction requirement in the nonprovisional application which issued as the patent.
- (E) Smarter should file a reissue application under 35 U.S.C. § 251 on or before June 5, 2003, broadening the scope of the claims of the issued patent.

(E). Smarter cannot recapture because he failed to file a divisional application for even under the new more flexible reissue approach.

QUESTION 165

Which of the following can correct the inventorship of a patent application in accordance with proper USPTO practice and procedure?

- (A) An unexecuted nonprovisional application was filed January 3, 2001 naming Jones and Smith as inventors. Smith was named an inventor in error. A Notice to File Missing Parts of Application was mailed by the Office, that requested a surcharge and an executed oath or declaration under 37 CFR 1.63 by Jones and Smith. A registered practitioner in timely response to the Notice submitted the requested surcharge and a declaration under 37 CFR 1.63 that named only Jones as the inventor, which declaration was only executed by Jones. The registered practitioner had determined that a request to correct inventorship under 37 CFR 1.48(a) was unnecessary. No papers were submitted, by Smith, clarifying that she is not an inventor.
- (B) A nonprovisional application was filed January 3, 2001 with a declaration under 37 CFR 1.63 naming Jones and Smith as inventors, which declaration was signed only by Jones. Smith was named an inventor in error. A Notice to File Missing Parts of Application was mailed by the

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Office that requested a surcharge and an executed oath or declaration by Smith. A registered practitioner timely responded to the Notice by submitting the requested surcharge and a new declaration under 37 CFR 1.63 that identified Jones as the sole inventor, which declaration was executed only by Jones.

(C) A nonprovisional application was filed February 28, 2000 that improperly named Jones as the sole inventor in a declaration under 37 CFR 1.63.

Only Jones executed the declaration. Applicant need only re- file the application as a continued prosecution application naming the correct inventorship of Jones and Smith in the new application's transmittal letter.

(D) A continuation application was filed under 37 CFR 1.53(b) using a copy of an executed declaration from the prior application for which a continuation was filed to correct the inventorship. The continuation application papers were accompanied by a request by a registered practitioner, in the continuation application transmittal paper, that Smith, named as an inventor in the prior application, be deleted as an inventor in the continuation application.

(E) (A) and (D).

(E). C is obviously wrong since it is a CPA and not a 53(b) filing. B is wrong since the PTO will presume Jones signed on behalf of Smith, even though Smith's signature is missing. A and D are okay.

QUESTION 166

The MPEP and USPTO rules and procedure provide for ways that a nonstatutory double patenting rejection can be overcome. Which of the following is an effective way to overcome a nonstatutory double patenting rejection?

(A) Filing a 37 CFR 1.131 affidavit to swear behind the patent on which the rejection is based.

(B) Filing a terminal disclaimer under 37 CFR 1.321(c).

(C) Filing a 37 CFR 1.131 affidavit arguing that the claims are for different inventions that are not patentably distinct.

(D) Filing a reply arguing that there is only one common inventor regarding the claims of the application and the claims of the patent.

(E) All of the above.

Choice (B) is the correct answer. MPEP § 804.02, subpart (II) reads, "A rejection based on a nonstatutory type of double patenting can be avoided by filing a terminal disclaimer in the application or proceeding in which the rejection is made."

QUESTION 167

Inventor A filed a patent application and assigned the entire interest in the application to his employer, MegaCorp. The application issued as a utility patent on July 9, 2002. In June 2004, MegaCorp's management first learns that a second inventor, Inventor B, should have been named as a co-inventor with respect to at least one claim of the issued patent. There was no deceptive intent in failing to name Inventor B in the original application. Inventor A, who is

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unfamiliar with patent law and concepts of inventorship, incorrectly believes that he should be the sole named inventor on the patent, and refuses to cooperate with any effort by MegaCorp to change the named inventive entity. The issued patent contains no other error. In accordance with the Manual of Patent Examining Procedure, which of the following procedures is/are available for MegaCorp to seek correction of the named inventive entity without any agreement, cooperation or action from Inventor A?

(A) File, on or before July 9, 2004, a reissue application, made by MegaCorp only, that seeks to add Inventor B.

(B) File, after July 9, 2004, a reissue application, made by MegaCorp only, that seeks to add Inventor B.

(C) Request a Certificate of Correction to add Inventor B as a named inventor.

(D) Submit in the issued patent file: a Request for Correction of Inventorship Under the Provisions of 37 CFR 1.48 that sets forth the desired inventorship change; a statement by Inventor B that the error in inventorship occurred without deceptive intention on her part; an oath or declaration executed by Inventor B; all required fees; and the written consent of MegaCorp.

(E) A and B are each available procedures.

(E). MPEP § 1412.04. Reissue is a proper vehicle for correcting inventorship in a patent. Because correction of inventorship does not enlarge the scope of the patent claims, the reissue application may be filed more than two years after the patent issued. Answers (A) and (B) are therefore both correct, and (E) is the best response. Although a certificate of correction may be used to correct inventorship where all parties are in agreement, the facts of the question show that Inventor A is not in agreement.

Variation - (filing a reissue outside the two year limitation is fine if there is no broadening; just add inventor)...same concept tested.

QUESTION 168

Where a reference relied upon in a 35 U.S.C. § 103 rejection qualifies as prior art only under 35 U.S.C. § 102(f), or (g), which of the following represents the most comprehensive answer in accord with proper USPTO practice and procedure as to the action an applicant should take to overcome the rejection?

(A) Present proof that the subject matter relied upon and the claimed invention are currently commonly owned.

(B) Present proof that the subject matter relied upon and the claimed invention were commonly owned at the time the later invention was made.

(C) Present proof that the subject matter relied upon and the claimed invention were subject to an obligation to assign to the same person at the time the later invention was made.

(D) (A) and (B).

(E) (C) and (D).

All answers accepted.

QUESTION 169

For purposes of determining whether a request for continued examination is in accordance with proper USPTO rules and procedure, in which of the following situations will prosecution be considered closed?

- (A) The last Office action is a final rejection.
- (B) The last Office action is an Office action under *Ex Parte Quayle*.
- (C) A notice of allowance has issued following a reply to a first Office action.
- (D) The application is under appeal.
- (E) All of the above.

(E) is the correct answer. 37 C.F.R. § 1.114 (effective August 16, 2000); "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 FR 50092, 50097 (August 16, 2000). (A) is a final action (§ 1.113). 65 FR 50097, column 1, states in pertinent part, "...an action that otherwise closes prosecution in the application (e.g., an Office action under *Ex Parte Quayle*, 1935 Comm'r Dec. 11 (1935))." Thus (A), (B), (C) and (D) are individually correct, and (E), being the most inclusive, is the most correct answer.

QUESTION 170

Assume that conception of applicant's complex invention occurred prior to the date of the reference, but reduction to practice occurred after the date of the reference. Which of the following is sufficient to overcome the reference in accordance with proper USPTO practice and procedure?

- (A) In a 37 CFR 1.131 affidavit or declaration, it is sufficient to allege that applicant or patent owner has been diligent.
- (B) In a 37 CFR 1.131 affidavit or declaration, it is sufficient to clearly establish conception of the invention prior to the effective date of the reference, and diligence from just prior to the effective date of the reference to actual reduction to practice. The presence of a lapse of time between the reduction to practice of an invention and the filing of an application thereon is not relevant.
- (C) In a 37 CFR 1.131 affidavit or declaration, it is sufficient to clearly establish conception of the invention prior to the effective date of the reference. Diligence need not be considered.
- (D) In a 37 CFR 1.131 affidavit or declaration, it is sufficient to show conception and reduction to practice in any country.
- (E) In a 37 CFR 1.131 affidavit or declaration, it is always sufficient to prove actual reduction to practice for all mechanical inventions by showing plans for the construction of the claimed apparatus.

(B) is the most correct answer. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947) (holding that the "lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon" is not relevant to an affidavit or declaration under 37 C.F.R. § 1.131(b)); MPEP § 715.07(a).

QUESTION 171

Which of the following documents is not open to public inspection?

- (A) The abandoned parent application of a divisional application. A patent was granted on the divisional application, which refers to the abandoned parent application.
- (B) Assignment document relating to both an issued patent and a patent application not published under 35 USC 122(b).
- (C) Assignment document relating to a pending reissue application.
- (D) Copy of assignment record relating to both a pending patent application and an abandoned patent application not published under 35 USC 122(b).
- (E) Assignment document relating to both an abandoned patent application not published under 35 USC 122(b) and a pending reissue application.

(D) is correct. (A) is wrong. 37 C.F.R. § 1.14(e)(2); MPEP § 103, application files are available upon request because the divisional application refers to the abandoned parent application, and the division issued as a patent, causing the application to be open to inspection.

QUESTION 172

In accordance with the MPEP, and USPTO rules and procedure, a patent application may be made by someone other than the inventor in certain situations. In which of the following situations would an application not be properly made by someone other than the inventor?

- (A) The inventor is deceased, and the application is made by the legal representative of the deceased inventor.
- (B) The inventor is deceased, and the application is made by one who has reason to believe that he or she will be appointed legal representative of the deceased inventor.
- (C) The inventor is a minor (under age 18) who understands and is willing to execute the declaration, but the application is made by the minor's legal representative.
- (D) The inventor is insane, and the application is made by the legal representative of the insane inventor.
- (E) The inventor is legally incapacitated, and the application is made by the legal representative of the legally incapacitated inventor.

All answers accepted.

QUESTION 173

Which of the following is not in accordance with the provisions of the MPEP?

- (A) Where joint inventors are named, the examiner should not inquire of the patent applicant concerning the inventors and the invention dates for the subject matter of the various claims until it becomes necessary to do so in order to properly examine the application.

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(B) Under 35 USC 119(a), the foreign priority benefit may be claimed to any foreign application that names a U.S. inventor as long as the U.S. named inventor was the inventor of the foreign application invention and 35 USC 119(a)-(d) requirements are met.

(C) Where two or more foreign applications are combined in a single U.S. application, to take advantage of the changes to 35 USC 103 or 35 USC 116, the U.S. application may claim benefit under 35 USC 119(a) to each of the foreign applications provided all the requirements of 35 USC 119(a)-(d) are met.

(D) One of the conditions for benefit under 35 USC 119(a) is that the foreign application must be for the same or a nonobvious improvement of the invention described in the United States application.

(E) If a foreign application for which priority is being claimed under 35 USC 119 is filed in a country which does not afford similar privileges in the case of applications filed in the United States or to citizens of the United States and the foreign country is not a WTO member country, any claim for the foreign priority thereto by a U.S. application will not be effective.

(D) is the best answer as the inventions must be the same in the foreign and U.S. applications.

QUESTION 174

In accordance with the MPEP and USPTO rules and procedure, certain individuals owe a duty to the USPTO to disclose all information known to be material to patentability of the claim(s) pending in an application. Which of the following parties does not have the duty?

(A) An inventor named in the application who relies on a patent attorney to prepare and prosecute the application.

(B) A corporation to which an assignment of the entire interest in the application is on record at the USPTO.

(C) An agent who prepares the application.

(D) An attorney who prosecutes the application.

(E) A person, who is not an inventor named in the application, who is substantively involved in the preparation and prosecution of the application, and who is associated with an inventor named in the application.

Choice (B) is the correct answer. MPEP § 2001.01, and 37 C.F.R. § 1.56(c).

MPEP § 2001.01 states that “the duty applies only to individuals, not to organizations...the duty of disclosure would not apply to a corporation or institution as such.”

QUESTION 176

An application includes independent claims 1 and 2. Which of the following, in a reply to a non-final Office action, provides the proper basis for a rejection under 35 USC 112, first paragraph?

(A) Applicant amends claim 2 of the originally filed application by adding a limitation which was previously written only in claim 1 of the originally filed application,

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and one of ordinary skill in the art is enabled by the original disclosure to make and use the invention as claimed in amended claim 2.

(B) Applicant amends claim 1 of the originally filed application by adding a limitation that was written in the original disclosure of the application, but the original disclosure does not enable one of ordinary skill in the art to make or use the invention as claimed in amended claim 1.

(C) Applicant amends and broadens claim 2 by removing a limitation which was written in the original disclosure of the application, and one of ordinary skill in the art is enabled by the original disclosure to make and use the invention as claimed in amended claim 2.

(D) Applicant adds new matter to the disclosure, but does not amend the claims of the originally filed application, and one of ordinary skill in the art is enabled by the original disclosure to make and use the invention as described in each of the claims.

(E) None of the above.

The most correct answer is (B). MPEP § 2163.01.

QUESTION 177

Which of the following timely actions should you take to accord maximum patent protection at minimum government fees for your client whose invention is described in a provisional patent application that was filed 6 months ago with no claim?

(A) File a request to convert the provisional application to a nonprovisional application, accompanied by a proper executed declaration, an amendment including at least one claim as prescribed by paragraph 2 of 35 USC 112 and the proper fee set forth in 37 CFR 1.17(i).

(B) File a request to convert the provisional application to a nonprovisional application, accompanied by a proper executed declaration, an amendment including at least one claim as prescribed by paragraph 2 of 35 USC 112, the proper fee set forth in 37 CFR 1.17(i), and the basic filing fee for the nonprovisional application.

(C) File a request to convert the provisional application to a nonprovisional application, accompanied by a proper executed declaration, an amendment including at least one claim as prescribed by paragraph 2 of 35 USC 112, the proper fee set forth in 37 CFR 1.17(i), the basic filing fee for the nonprovisional application, and the surcharge required by 37 CFR 1.16(e).

(D) File a nonprovisional application including at least one claim accompanied by a proper executed declaration, and the basic filing fee. The application contains a specific reference to the provisional application in compliance with 37 CFR 1.78(a)(5).

(E) File a nonprovisional application including at least one claim accompanied by a proper executed declaration but without the basic filing fee. The application contains a specific reference to the provisional application in compliance with 37 CFR 1.78(a)(5).

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(D) is correct. MPEP § 601.01(c) states, “In addition, if the provisional application was not filed with an executed oath or declaration and the filing fee for a non-provisional application, the surcharge set forth in 37 C.F.R. § 1.16(e) is required.

QUESTION 178

In which of the following situations, considered independently of each other, is the original, new, or amended claim supported in the application as filed?

(A) An amendment to the specification changing the definition of “holder” from “is a hook” to “is a hook, clasp, crimp, or tong” and no amendment is made of the claim, which uses the term “holder.” The amendment is filed one month after the application was filed. There was no previous supporting disclosure in the specification of the holder being a clasp, crimp, or tong.

(B) An amendment to the specification and claims changing the definition of “holder” from “is a hook” to “is a hook, clasp, crimp, or tong.” The amendment is filed one month after the application was filed. There was no previous supporting disclosure in the specification of the holder being a clasp, crimp, or tong.

(C) Original claim 1 in the application refers to “a holder,” and original claim 2 depends from and refers to claim 1 stating, “said holder is a hook, clasp, crimp, or tong.” There is no disclosure in the specification preceding the claims in the application as filed for the holder to be a clasp, crimp, or tong.

(D) An amendment is filed presenting a claim to an electrical insulating device, copied from a patent for the purpose of provoking an interference. The claim refers to “nonconductive plastic holder.” The application as filed contains a broad generic disclosure describing electrical insulating devices. The holder is described in the specification of the application as “conducting electricity.” There is no disclosure in the specification of the holder being “nonconductive.”

(E) All of the above.

(C). MPEP 2163.03, item I. Original claims constitute their own description.

QUESTION 179

On Monday, May 13, 2002, John’s secretary deposited in an “Express Mail” drop box prior to the last scheduled pick-up for that day, an envelope properly addressed to the USPTO for delivery to the USPTO by the “Express Mail Post Office to Addressee” service. The envelope was received by the USPTO on Wednesday, May 15, 2002, containing a reply to an Office action which set a shortened statutory period (“SSP”) for reply ending on Tuesday, May 14, 2002. The reply was marked by the Office as being received on May 15, 2002. The number of the “Express Mail” mailing label had not been placed on the response papers, and upon receipt of the “Express Mail” mailing label John learned that the “date in” was not clearly marked. John promptly filed a petition requesting the filing date to be the date of deposit. The petition included a showing that the date of deposit accompanied by evidence of USPS corroboration of the deposit. Accordingly,

(A) The reply will be regarded as timely filed in the USPTO on May 15, 2002.

(B) The reply will be regarded as timely filed in the USPTO on May 14, 2002.

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- (C) The reply will be regarded as timely filed in the USPTO on May 13, 2002.
- (D) The reply will be regarded as timely filed in the USPTO if a petition with proper fee for a one month extension of time is filed in the USPTO on or before June 14, 2002.
- (E) The reply will be regarded as timely filed in the USPTO if the number of the "Express Mail" mailing label is placed on each page of a copy of the original response and hand carried to the USPTO on May 15, 2002, rather than being sent by "Express Mail."

(D) is correct. 37 C.F.R. § 1.136(a). 37 C.F.R. § 1.136(a) states, "[A]pplicant may extend the time period for reply up to the earlier of the expiration of any maximum period set by statute or five months after the time period set for reply, if a petition for an extension of time and the fee set in § 1.17(a) are filed..." .

QUESTION 180

A patent application filed in the USPTO claims a nylon rope coated with element E for the purpose of preventing breakage of the rope. In the first Office action, the examiner rejects the claim as obvious over P in view of a trade journal publication, T. P teaches a nylon rope coated with resin for the purpose of making the rope waterproof. T teaches a nylon tent fabric coated with element E for the purpose of making the tent waterproof, and suggests the use of element E for making other nylon products waterproof. Following proper USPTO practices and procedures, the combination of P and T:

- (A) cannot support a prima facie case of obviousness because T lacks a suggestion to combine with P for the purpose of preventing breakage in nylon rope.
- (B) cannot support a prima facie case of obviousness because P lacks a suggestion to combine with T for the purpose of preventing breakage in nylon rope.
- (C) cannot support a prima facie case of obviousness because T only contains a suggestion to combine with P for the purpose of waterproofing nylon rope.
- (D) can support a prima facie case of obviousness, even though T only contains a suggestion to combine with P for the purpose of waterproofing nylon rope.
- (E) can support a prima facie case of obviousness because the applicant is always under an obligation to submit evidence of non-obviousness regardless of whether the examiner fully establishes a prima facie case of obviousness.

(D). "It is not necessary in order to establish a prima facie case of obviousness...that there be a suggestion or expectation from the prior art that the claimed [invention] will have the same or a similar utility as one newly discovered by the applicant." In *re* Dillon, 919 F.2d 688, 692, 16 USPQ2d 1897, 1900 (Fed. Cir. 1990) (emphasis in original). Thus, "[i]t is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant." MPEP § 2144 ("Rationale Different from Applicant's is Permissible"). Here, T suggests the combination with P to achieve a different advantage or result, i.e., waterproofing, from that discovered by applicant, i.e., reducing breakage.

QUESTION 181

Which of the following statements does not accord with proper USPTO practice and procedure?

- (A) A protest may be filed by an attorney or other representative on behalf of an unnamed principal.
- (B) Information which may be relied on in a protest includes information indicating violation of the duty of disclosure under 37 CFR 1.56.
- (C) While a protest must be complete and contain a copy of every document relied on by the protestor, a protest without copies of prior art documents will not necessarily be ignored.
- (D) A protest must be submitted prior to the date the application was published or the mailing of a notice of allowance, whichever occurs later, provided the application is pending.
- (E) Since a protestor is not authorized to participate in the prosecution of a pending application, the examiner must not communicate in any manner with the protestor.

(D) is the best answer. MPEP § 1901.04.

QUESTION 182

A registered practitioner's client, Apex Mfg. Corporation, bought the entire assets of Pinnacle Mfg. Corporation. Pinnacle gave Apex a list of its patent applications but did not maintain records of the patent assignments. Apex wishes to know which of the assignment documents, if any, of the pending patent applications in Pinnacle's patent portfolio were never recorded. In accordance with the MPEP, which of the following actions could the practitioner rely upon to most expeditiously answer this question?

- (A) Request certified copies of the patent applications as filed.
- (B) Request certified copies of the assignment documents of record of the patent applications.
- (C) Request certified copies of the patent applications as filed accompanied by the fees set forth in 37 CFR 1.19(b)(1)(i).
- (D) Request certified copies of the patent applications as filed accompanied by the fees set forth in 37 CFR 1.19(b)(1)(ii).
- (E) Request certified copies of the assignment documents of record of the patent applications accompanied by the fees set forth in 37 CFR 1.19(b)(5).

(E) is correct. As MPEP § 303 states:

"Certified copies of patent applications as filed do not include an indication of assignment documents. Applicants desiring an indication of assignment documents of record should request separately certified copies of assignment documents and submit the fees required by 37 C.F.R. § 1.19."

QUESTION 183

In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following statements is most correct?

- (A) The same evidence sufficient to establish a constructive reduction to practice is necessarily also sufficient to establish actual reduction to practice.
- (B) Proof of constructive reduction to practice does not require sufficient disclosure to satisfy the “how to use” and “how to make” requirements of 35 USC 112, first paragraph.
- (C) A process is reduced to actual practice when it is successfully performed.
- (D) The diligence of 35 USC 102(g) requires an inventor to drop all other work and concentrate on the particular invention.
- (E) The diligence of 35 USC 102(g) does not impose on a registered practitioner any need for diligence in preparing and filing a patent application inasmuch as such the practitioner’s acts do not inure to the benefit of the inventor.

(C) is the most correct. *Corona v. Dovan* 273 U.S. 692, 1928 CD 252 (1928); MPEP § 2138.05 under the heading “Requirements To Establish Actual Reduction To Practice.”

QUESTION 184

A registered practitioner filed in the USPTO a client’s utility patent application on December 30, 2002. The application was filed with a request for nonpublication, certifying that the invention disclosed in the U.S. application has not and will not be the subject of an application in another country, or under a multilateral international agreement, that requires eighteen month publication. Subsequently, the client files an application in Japan on the invention and some recent improvements to the invention. The improvements are not disclosed or supported in the utility application. Japan is a country that requires eighteen month publication. Two months after filing the application in Japan, and before filing any other papers in the USPTO, the client remembers that a nonpublication request was filed and informs the practitioner about the application that was filed in Japan. Which of the following courses of action is in accordance with the USPTO rules and the procedures set forth in the MPEP?

- (A) The application is abandoned because the practitioner did not rescind the nonpublication request and provide notice of foreign filing within 45 days of having filed the application in Japan. The applicant must now file a petition and fee to revive under 37 CFR 1.137(b).
- (B) The application is abandoned because the applicant did not rescind the nonpublication request before filing the application in Japan. The applicant must now file a petition and fee to revive under 37 CFR 1.137(b).
- (C) The applicant should file an amendment to the specification of the U.S. application, adding the recent improvements to the disclosure in the specification.
- (D) The application is abandoned because the applicant did not rescind the nonpublication request by notifying the Office under 37 CFR 1.213(c) within the appropriate time. The applicant must now file a petition and fee to revive under 37 CFR 1.137(b).
- (E) The applicant could today notify the USPTO of the foreign filing. It is not

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necessary to file a petition and fee to revive for the application to continue to be examined in the USPTO.

(A) and (D) are accepted as the correct answers. Regarding answer (A), see 35 U.S.C. § 122(b)(2)(B)(iii); 37 CFR § 1.213; MPEP § 901.03 for information on nonpublication requests. See 37 CFR § 1.137(f); MPEP § 711.03(c), under the heading “3. Abandonment for Failure to Notify the Office of a Foreign Filing After Submission of a Non-Publication Request.” (D) was also accepted because the statement characterizes the status of the application as being abandoned, though the application has not necessarily attained abandoned status. The course of action postulated in (D) is a proper reply if the application was abandoned. Accordingly, (D) was accepted as a correct answer under these circumstances.

QUESTION 185

In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following may not be filed by facsimile transmission?

- (A) A request for continued examination under 37 CFR 1.114 along with a submission.
- (B) A continued prosecution application under 37 CFR 1.53(d).
- (C) An amendment in reply to a non-final Office action.
- (D) The filing of a provisional patent application specification and drawing for the purpose of obtaining an application filing date.
- (E) (B) and (D).

(D) is the most correct answer. 37 CFR § 1.6(d)(3); MPEP § 502.01. MPEP § 501.01, under the heading “Correspondence Relative To Patents And Patent Applications Where Filing By Facsimile Transmission Is Not Permitted,” identifies among the correspondence not permitted to be filed by facsimile transmission “ (B) A national patent application specification and drawing (provisional or nonprovisional) or other correspondence for the purpose of obtaining an application filing date, other than a continued prosecution application filed under 37 CFR 1.53(d)”

QUESTION 186

Following a restriction requirement and election, a registered practitioner received a first Office action dated Friday, December 1, 2000. The primary examiner indicated that claims 1 to 10 were rejected and claims 11 to 20 were withdrawn from consideration. The first Office action set a 3 month shortened statutory period for reply. On February 28, 2001, the practitioner properly filed an express abandonment in the application and at the same time filed a request for continuing application. In a non-final Office action dated May 1, 2001 in the continuing application, the examiner indicated in that claims 1 to 20, all of the pending claims, are rejected. The practitioner filed a notice of appeal on Monday, July 2, 2001. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following most accurately describes the propriety of the practitioner’s reply to the May 1st Office action?

- (A) The notice of appeal is not a proper response because the claims of the continuing application have not been finally rejected.

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- (B) The notice of appeal is not a proper reply because all of the claims in the continuing application have not been twice rejected.
- (C) The filing of a notice of appeal is not a proper reply because not all the claims in the continuing application have been twice rejected.
- (D) A notice of appeal is never a proper response to a non-final rejection.
- (E) The reply is proper.

(E) is the most correct answer. MPEP § 1205, under the heading “Appeal By Patent Applicant,” states that “[a] notice of appeal may be filed after any of the claims has been twice rejected, regardless of whether the claim(s) has/have been finally rejected. The limitation of ‘twice or finally...rejected’ does not have to be related to a particular application. For example, if any claim was rejected in a parent application, and the claim is again rejected in a continuing application, then applicant will be entitled to file an appeal ...”

QUESTION 187

In accordance with the USPTO rules and procedures set forth in the MPEP, a Certificate of Correction effectuates correction of an issued patent where:

- (A) Through error and without deceptive intent, there is a failure to make reference to a prior copending application according to 37 CFR 1.78, and the failure does not otherwise affect what is claimed, but the prior copending application is referenced in the record of the application, and a petition under 37 CFR 1.324 and appropriate fees were filed.
- (B) Through error and without deceptive intent, a preferred embodiment that materially affects the scope of the patent was omitted in the original disclosure in the filed application, and a petition under 37 CFR 1.324 and appropriate fees were filed.
- (C) Through error and without deceptive intent, a prior copending application is incorrectly referenced in the application, the incorrect reference does not otherwise affect the claimed subject matter, and the prior copending application is correctly identified elsewhere in the application file, and a petition under 37 CFR 1.324 and appropriate fees were filed.
- (D) Through error and without deceptive intent, an inventor’s name is omitted from an issued patent, a petition under 37 CFR 1.324 and appropriate fees were filed, and the petition was granted.
- (E) (A), (C) and (D).

(E) is the most correct answer. (A) and (C) can be corrected by a certificate of Correction. MPEP § 1481. (D) can be corrected by a Certificate of Correction. 37 CFR § 1.324; MPEP § 1481.

QUESTION 188

The Potter patent application was filed on June 6, 2002, claiming subject matter invented by Potter. The Potter application properly claims priority to a German application filed on June 6, 2001. A first Office action contains a rejection of all the claims of the application under 35 USC 103(a) based on a U.S. patent application publication to Smith in view of a U.S. patent

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to Jones. A registered practitioner prosecuting the Potter application ascertains that the relevant subject matter in Smith's published application and Potter's claimed invention were, at the time Potter's invention was made, owned by ABC Company or subject to an obligation of assignment to ABC Company. The practitioner also observes that the Smith patent application was filed on April 10, 2001 and that the patent application was published on December 5, 2002. Smith and Potter do not claim the same patentable invention. To overcome the rejection without amending the claims, which of the following timely replies would comply with the USPTO rules and the procedures set forth in the MPEP to be an effective reply for overcoming the rejection?

(A) A reply that only contains arguments that Smith fails to teach all the elements in the only independent claim, and which specifically points out the claimed element that Smith lacks.

(B) A reply that properly states that the invention of the Potter application and the Smith application were commonly owned by ABC Company at the time of the invention of the Potter application.

(C) A reply that consists of an affidavit or declaration under 37 CFR 1.132 stating that the affiant has never seen the invention in the Potter application before.

(D) A reply that consists of an affidavit or declaration under 37 CFR 1.131 properly proving invention of the claimed subject matter of Potter application only prior to June 6, 2001.

(E) A reply that consists of a proper terminal disclaimer and affidavit or declaration under 37 CFR 1.130.

(B) is the most correct answer. See 35 U.S.C. § 103(a); MPEP §§ 706.02(I)(1) and 2145. The prior art exception in 35 U.S.C. § 103(c) is applicable because the Smith reference is only prior art under 35 U.S.C. § 102(e), (f), or (g), was applied in a rejection under 35 U.S.C. § 103(a), and was commonly owned at the time Potter made the invention claimed by Potter. See MPEP § 706.02(I)(1).

QUESTION 189

In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following is true?

(A) A claim to a process omitting a step in a disclosed process, where the step is disclosed in the specification to be essential to the invention, may not be properly rejected under 35 USC 112, first paragraph, for lack of enablement where the specification provides an enabling disclosure only for the process which includes the essential step.

(B) Failure to disclose the best mode must rise to the level of active concealment or grossly inequitable conduct in order to support a rejection under 35 USC 112, first paragraph.

(C) A claim failing to interrelate essential elements of the invention, as defined by the applicant in the specification, where the interrelation is critical to the invention may be properly rejected under 35 USC 112, second paragraph, for failure to properly point out and distinctly claim the invention.

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(D) Where the best mode contemplated by the inventor at the time of filing the application is not disclosed, a proposed amendment adding a specific mode of practicing the invention would not be new matter.

(E) The best mode requirement is the same as the enablement requirement of the first paragraph of 35 USC 112.

(C) is the most correct answer. As stated in MPEP § 2172.01, “a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968).”

QUESTION 190

Which of the following requests by the registered practitioner of record for an interview with an examiner concerning an application will be granted in accordance with proper USPTO rules and procedure?

(A) A request for an interview in a substitute application prior to the first Office action, for the examiner and attorney of record to meet in the practitioner’s office without the authority of the Commissioner.

(B) A request for an interview in a continued prosecution application prior to the first Office action, to be held in the examiner’s office.

(C) A request for an interview in a non-continuing and non-substitute application, prior to the first Office action to be held in the examiner’s office.

(D) All of the above.

(E) None of the above.

(B) is the most correct answer. 37 CFR § 1.133; MPEP § 713.02. As stated in MPEP § 713.02, “[a] request for an interview prior to the first Office action is ordinarily granted in continuing or substitute applications. A request for an interview in all other applications before the first action is untimely and will not be acknowledged if written, or granted if oral. 37 CFR 1.133(a).”

QUESTION 191

Assuming that any rejection has been properly made final, which of the following statements is not in accordance with the USPTO rules and the procedures set forth in the MPEP?

(A) An objection and requirement to delete new matter from the specification is subject to supervisory review by petition under 37 CFR 1.181.

(B) A rejection of claims for lack of support by the specification (new matter) is reviewable by appeal to the Board of Patent Appeals and Interferences.

(C) If both the claims and the specification contain the same new matter, and there has been both a rejection and objection by the primary examiner, the new matter issue should be decided by petition, and is not appealable.

(D) If both the claims and the specification contain the same new matter, and there has been both a rejection and objection by the examiner, the new matter issue is

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appealable, and should not be decided by petition.

(E) None of the above.

(C) is the most correct answer. MPEP § 2163.06, under the heading “Review Of New Matter Objections And Rejections,” states “[a] rejection of claims is reviewable by the Board of Patent Appeals and Interferences, whereas an objection and requirement to delete new matter is subject to supervisory review by petition under 37 CFR 1.181. If both the claims and specification contain new matter either directly or indirectly, and there has been both a rejection and objection by the examiner, the issue becomes appealable and should not be decided by petition.”

QUESTION 192

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 USPTO rules and procedures set forth 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.

(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 Y. 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.

QUESTION 193

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

- (A) Entering into an agreement with the client to limit the amount of any damages which the client may collect for any mistakes the practitioner may make during prosecution of the client’s patent application in exchange for prosecuting the application at a reduced fee.
- (B) Encouraging the client to meet with an opposing party for settlement discussions.
- (C) Failing to disclose controlling legal authority which is adverse to the practitioner’s 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 the practitioner has personally used the device and found it to be very efficient and better than the prior art.
- (E) Investing the funds the client advanced for the practitioner legal fees (not costs and expenses) in long term United States Treasury Bills in order to obtain guaranteed protection of the principal.

(B) is the most correct answer. See 37 CFR § 10.87.

QUESTION 194

A registered practitioner filed a utility application on February 11, 2002. On April 4, 2002, the practitioner filed an information disclosure statement (IDS) in the application. The

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practitioner received a notice of allowance dated January 3, 2003 soon after it was mailed. When discussing the application with the practitioner on January 21, 2003, and before paying the issue fee, the client notices for the first time that a reference, which is one of many patents obtained by the client's competitor, was inadvertently omitted from the IDS. The client has been aware of this reference since before the application was filed. The client is anxious to have this reference appear on the face of the patent as having been considered by the USPTO. Which of the following actions, if taken by the practitioner, would not be in accord with the USPTO rules and the procedures set forth in the MPEP?

- (A) Before paying the issue fee, timely file an IDS citing the reference, along with the certification specified in 37 CFR 1.97(e), and any necessary fees.
- (B) Within three months of the mail date of the notice of allowance, without paying the issue fee, timely file a Request for Continued Examination (RCE) under 37 CFR 1.114, accompanied by the fee for filing an RCE, and an IDS citing the reference.
- (C) Within three months of the mail date of the notice of allowance, without paying the issue fee, timely file a continuing application under 37 CFR 1.53(b), an IDS citing the reference, and any necessary fees.
- (D) After paying the issue fee, timely file a petition to withdraw the application from issue to permit the express abandonment of the application in favor of a continuing application, a continuation application under 37 CFR 1.53(b), an IDS citing the reference, and any necessary fees.
- (E) After paying the issue fee, timely file a petition to withdraw the application from issue to permit consideration of a Request for Continued Examination (RCE) under 37 CFR 1.114, the fee for filing an RCE, and an IDS citing the reference.

Answer (A), describing a procedure that is not in accordance with the USPTO rules and the procedures set forth in the MPEP, is the most correct answer. See MPEP § 609, under the heading "Minimum Requirements for an Information Disclosure Statement," and subheading "B(3). Information Disclosure Statement Filed After B(2), but Prior to Payment of Issue Fee 37 CFR 1.97 (d)", and subheading "B(5) Statement Under 37 CFR 1.97(e)." The statement specified in 37 CFR § 1.97(e) requires that the practitioner certify, after reasonable inquiry, that no item of information contained in the IDS was known to any individual designated in 37 CFR § 1.56(c) more than three months prior to the filing of the information disclosure statement. The practitioner cannot certify this because the reference was known to the client before February 11, 2002, the time of filing of the utility application, which was more than three months prior to the filing of the information disclosure statement.

QUESTION 195

In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following papers is precluded from receiving the benefit of a certificate of mailing or transmission under 37 CFR 1.8?

- (A) An amendment, replying to an Office action setting a period for reply, transmitted by mail with a certificate of mailing to the USPTO from a foreign country.
- (B) An amendment, replying to an Office action setting a period for reply, transmitted

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by facsimile with a certificate of transmission to the USPTO from a foreign country.

(C) An information disclosure statement (IDS) under 37 CFR 1.97 and 1.98 transmitted after the first Office action.

(D) A request for continued examination (RCE) under 37 CFR 1.114.

(E) An appeal brief.

(A) is the most correct answer. See MPEP § 512, which states “The Certificate of Mailing procedure does not apply to papers mailed in a foreign country.” (B) is not correct. See MPEP § 512. Certificate of transmission procedure applies to correspondence transmitted to the Office from a foreign country and an amendment is not prohibited from being transmitted by facsimile and is not precluded from receiving the benefits under 37 CFR § 1.8.

QUESTION 196

Mike and Alice, who are not related, are shipwrecked on a heretofore uninhabited and undiscovered island in the middle of the Atlantic Ocean. In order to signal for help, Mike invents a signaling device using bamboo shoots. Alice witnesses but does not assist in any way in the development of the invention. The signaling device works and a helicopter comes and rescues Alice. However, Mike remains on the island due to overcrowding on the helicopter. Unfavorable weather conditions have prevented Mike’s rescue to date. Alice comes to you, a registered patent practitioner, to file an application for a patent and offers to pay you in advance.

Which of the following, in accordance with the USPTO rules and the procedures set forth in the MPEP, is true?

(A) Since Mike invented the invention, Alice cannot properly file an application for a patent in her name even though Mike is unavailable.

(B) Since Mike is unavailable, you may properly file an application for a patent without his consent. You can accept the money from Alice as payment for the application.

(C) Since Mike is not available and cannot be reached, Alice may properly sign the declaration on his behalf since she has witnessed the invention and knows how to make and use it.

(D) Alice should file an application in her name since she has witnessed the invention and knows how to make and use it. Subsequently, when Mike becomes available, the inventorship may be changed to the correct inventorship.

(E) Even though Mike and Alice are not related, Alice may properly file an application on Mike’s behalf.

(A) is the most correct answer. (A) is true since only the inventor may file for a patent. 35 U.S.C. § 101.

QUESTION 197

Applicant received a Final Rejection with a mail date of Tuesday, February 29, 2000. The Final Rejection set a 3 month shortened statutory period for reply. Applicant files an

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Amendment and a Notice of Appeal on Monday, March 27, 2000. The examiner indicates in an Advisory Action that the Amendment will be entered for appeal purposes, and how the individual rejection(s) set forth in the final Office action will be used to reject any added or amended claim(s). The mail date of the examiner's Advisory Action is Wednesday, May 31, 2000. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following dates is the last date for filing a Brief on Appeal without an extension of time?

- (A) Saturday, May 27, 2000.
- (B) Monday, May 29, 2000 (a Federal holiday, Memorial Day).
- (C) Tuesday, May 30, 2000.
- (D) Wednesday, May 31, 2000.
- (E) Tuesday, August 29, 2000.

(D). MPEP § 710.02(e), under the heading "Final Rejection – Time For Reply" states, "If an applicant initially replies within 2 months from the date of mailing of any final rejection setting a 3-month shortened statutory period for reply and the Office does not mail an advisory action until after the end of the 3-month shortened statutory period, the period for reply for purposes of determining the amount of any extension fee will be the date on which the Office mails the Advisory Action advising applicant of the status of the application..." Hence, since no extension fee was paid in the fact pattern, the time allowed applicant for reply to the action from which the appeal was taken is the mail date of the Advisory Action, *i.e.*, May 31, 2000. 37 CFR § 1.192(a) recites, in pertinent part, "Appellant must, within two months from the date of the notice of appeal under § 1.191 or within the time allowed for reply to the action from which the appeal was taken, if such time is later, file a brief in triplicate."

QUESTION 198

In accordance with USPTO rules and the procedure set forth in the MPEP, which one of the following is not required for a provisional application filed in the USPTO?

- (A) A specification.
- (B) A drawing as prescribed by 35 USC 113.
- (C) An application fee.
- (D) A claim.
- (E) A cover sheet complying with the rule.

(D) is the most correct answer. See 35 U.S.C. § 111(b)(2); 37 CFR § 1.51(c); MPEP §§ 601 and 601.01(b). 35 U.S.C. § 111(b)(2) states that "[a] claim, as required by the second through fifth paragraphs of section 112, shall not be required in a provisional application."

QUESTION 199

A claim in a pending patent application is rejected under 35 USC 103(a) as being obvious over Barry in view of Foreman. The Barry reference is a U.S. Patent that was issued on an application filed before the date of the application in question. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following arguments, if true, would overcome the rejection?

- (A) The Foreman reference is nonanalogous art, but the reference may be reasonably pertinent to Barry's endeavor to solving the particular problem with which Barry was concerned.
- (B) The rejection does not address a claimed limitation, and neither of the references teaches the claimed limitation.
- (C) The Barry patent issued after the filing date of the pending patent application.
- (D) The original specification states that the results achieved by the claimed invention are unexpected. (The statement is unsubstantiated by evidence).
- (E) The Foreman patent issued 105 years before the filing date of the pending patent application.

(B) is the most correct answer. See MPEP § 2143.03. To establish *prima facie* obviousness of a claimed invention, all of the claimed limitations must be taught or suggested by the prior art.

QUESTION 200

In accordance with USPTO rules and the procedures set forth in the MPEP, claims in a patent application may not contain:

- (A) chemical formulas.
- (B) mathematical equations.
- (C) drawings or flow diagrams.
- (D) only one sentence.
- (E) tables not necessary to conform with 35 USC 112.

(C) is the most correct answer. MPEP § 608.01, under the heading "Illustrations In The Specification," states "[t]he specification, including any claims...may not contain drawings or flow diagrams."

QUESTION 201

An examiner has advanced a reasonable basis for questioning the adequacy of the enabling disclosure in the specification of your client's patent application, and has properly rejected all the claims in the application. The claims in the application are drawn to a computer program system. In accordance with the USPTO rules and the procedures set forth in the MPEP, the rejection should be overcome by submitting _____

- (A) factual evidence directed to the amount of time and effort and level of knowledge required for the practice of the invention from the disclosure alone.
- (B) arguments by you (counsel) alone, inasmuch as they can take the place of evidence in the record.
- (C) an affidavit under 37 CFR 1.132 by an affiant, who is more than a routineer in the art, submitting few facts to support his conclusions on the ultimate legal question of sufficiency, *i.e.*, that the system "could be constructed."
- (D) opinion evidence directed to the ultimate legal issue of enablement.
- (E) patents to show the state of the art for purposes of enablement where these patents have an issue date later than the effective filing date of the application under

consideration.

(A) is the most correct answer. See MPEP § 2106.02 under the heading “Affidavit Practice (37 CFR 1.132).” Factual evidence directed to the amount of time and effort and level of knowledge required for the practice of the invention from the disclosure alone can rebut a *prima facie* case of nonenablement.

QUESTION 202

In accordance with the USPTO rules and the procedures in the MPEP, in which of the following instances is the reference properly available as prior art under 35 USC 102(d)?

- (A) A U.S. patent application is filed within the one year anniversary date of the filing date of the foreign application. The reference is the foreign application.
- (B) The applicant files a foreign application, later timely files a U.S. application claiming priority based on the foreign application, and then files a continuation-in-part (CIP) application, and the claims in the CIP are not entitled to the filing date of the U.S. parent application. The foreign application issues as a patent before the filing date of the CIP application and is used to reject the claims directed to the added subject matter under 35 USC 102(d)/103. The reference is the foreign application.
- (C) The applicant files a foreign application, and later timely files a U.S. application claiming priority based on the foreign application. The examined foreign application has been allowed by the examiner and has not been published before the U.S. application was filed. The reference is the foreign application.
- (D) The reference is a defensive publication.
- (E) All of the above.

(B) is the most correct answer. See 35 U.S.C. § 102(d); MPEP § 2135.01, under the heading “A Continuation - In - Part Breaks The Chain Of Priority As To Foreign As Well As U.S. Parents.” If an applicant files a foreign application, later files a U.S. application claiming priority based on the foreign application, and then files a continuation - in - part (CIP) application whose claims are not entitled to the filing date of the U.S. parent, the effective filing date of the CIP application is the filing date of the CIP. The applicant cannot obtain the benefit of either the U.S. parent or foreign application filing dates.

QUESTION 203

Which of the following practices or procedures may be properly employed in accordance with the USPTO rules and the procedures set forth in the MPEP to overcome a rejection properly based on 35 USC 102(a)?

- (A) Perfecting a claim to priority under 35 USC 119(a)-(d) based on a foreign application having a foreign priority filing date that antedates the reference.
- (B) Filing a declaration under 37 CFR 1.131 showing that the cited prior art antedates the invention.
- (C) Filing a declaration under 37 CFR 1.132 showing that the reference invention is by “others.”

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(D) Perfecting priority under 35 USC 119(e) or 120 by, in part, amending the declaration of the application to contain a specific reference to a prior application having a filing date prior to the reference.

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

(A) is the most correct answer. See MPEP § 706.02(b), under the heading “Overcoming a 35 U.S.C. § 102 Rejection Based on a Printed Publication or Patent.”

QUESTION 204

Mark Twine obtains a patent directed to a machine for manufacturing string. The patent contains a single claim (Claim 1) which recites six claim elements. The entire interest in Twine’s patent is assigned to the S. Clemens String Co., and Twine is available and willing to cooperate with S. Clemens String Co. to file a reissue application. A subsequent reissue application includes Claim 2, which is similar to original Claim 1. However, one of the elements recited in Claim 2 is broader than its counterpart element in the original claim. The remaining five elements are narrower than their respective counterpart elements in the original patent claim.

Which of the following scenarios accords with the USPTO rules and the procedures set forth in the MPEP?

(A) The S. Clemens String Co. files the reissue application more than 2 years after the issue date of the original patent application.

(B) The S. Clemens String Co. files the reissue application less than 2 years after the issue date of the original patent but more than 2 years after original application filing date.

(C) Mark Twine files the reissue application less than 2 years after the issue date of the original patent but more than 2 years after original application filing date.

(D) Mark Twine files the reissue application more than 2 years after the issue date of the original patent.

(E) Mark Twine and the S. Clemens String Co. jointly file the reissue application more than 2 years after the issue date of the original patent.

(C) is the most correct answer. Answers (A), (D) and (E) are incorrect because a broadening reissue application must be filed within two years of issuance of the original patent. 35 U.S.C. § 251; MPEP § 1412.03. Answer (B) is incorrect because the assignee may not file a broadening reissue application. MPEP § 706.03(x).

QUESTION 205

Able conceived the invention claimed in a patent application. In conceiving the invention, Able used and adopted ideas and materials known in the art and invented by others. Ben, Able’s employee, reduced the invention to practice at Able’s request and totally pursuant to Able’s suggestions. Being unable to afford a patent practitioner’s fees to prepare and prosecute the application, Able convinced John to pay for the practitioner’s services in return for an interest in the invention. John did nothing more than provide the funds for the practitioner. Which of the following is in accordance with the USPTO rules and the procedures set forth in the

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- (A) Able need not be the one to reduce the invention to practice so long as the reduction to practice occurred on his or her behalf. Able can be properly named as inventor in the application.
- (B) To be named an inventor, it is not necessary for John to have contributed to the conception of the invention. Ben, not Able, can be named as inventor in the application.
- (C) In conceiving the invention, Able may not consider and adopt ideas and materials derived from any sources, such as ideas of previous inventors. Able cannot be properly named as inventor in the application.
- (D) John and Able may be properly named as joint inventors of the invention in the application.
- (E) John, Ben, and Able may be properly named as joint inventors of the invention in the application.

(A) is the most correct answer. See MPEP § 2137.01, under the heading “The Inventor Is Not Required To Reduce The Invention To Practice,” citing *In re DeBaun*, 214 USPQ 933, 936 (CCPA 1982).

QUESTION 206

In connection with the utility of an invention described in a patent application, which of the following conforms to the USPTO rules and the procedure set forth in the MPEP?

- (A) A deficiency under 35 USC 101 also creates a deficiency under 35 USC 112, first paragraph.
- (B) To overcome a rejection under 35 USC 101, it must be shown that the claimed device is capable of achieving a useful result on all occasions and under all conditions.
- (C) A claimed invention is properly rejected under 35 USC 101 as lacking utility if the particular embodiment disclosed in the patent lacks perfection or performs crudely.
- (D) To overcome a rejection under 35 USC 101, it is essential to show that the claimed invention accomplishes all its intended functions.
- (E) A claimed invention lacks utility if it is not commercially successful.

(A) is the most correct answer. As stated in MPEP § 2107.01 under the heading “IV. Relationship Between 35 U.S.C. 112, First Paragraph, And 35 U.S.C. 101,” “A deficiency under 35 U.S.C. § 101 also creates a deficiency under 35 U.S.C. § 112, first paragraph. See *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995); *In re Jolles*, 628 F.2d 1322, 1326 n.10, 206 USPQ 885, 889 n.11 (CCPA 1980); *In re Fouche*, 439 F.2d 1237, 1243, 169 USPQ 429, 434 (CCPA 1971) (‘If such compositions are in fact useless, appellant’s specification cannot have taught how to use them.’).”

QUESTION 207

Inventor Joe is anxious to get a patent with the broadest claim coverage possible for the

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invention. Joe retained a registered practitioner, Jane, to obtain the advantage of legal counsel in obtaining broad protection. Jane filed a patent application for the invention. The inventor heard that, although patent prosecution is conducted in writing, it is possible to get interviews with examiners. Joe believes an interview might hasten the grant of a patent by providing the examiner a better understanding of the true novelty of the invention. Which of the following are consistent with the USPTO rules and the procedures set forth in the MPEP regarding usage of interviews?

- (A) Prior to the first Office action being mailed the inventor calls the examiner to whom the application is docketed to offer help in understanding the specification.
- (B) After receiving the first Office action Jane calls the examiner for an interview for the purpose of clarifying the structure and operation of the invention as claimed and disclosed, because the examiner's analysis regarding patentability in the rejection is novel and suggests that the examiner is interpreting the claimed invention in a manner very different from the inventor's intent.
- (C) Jane has Larry, a registered practitioner in the Washington D.C. area, who is more familiar with interview practice to call the examiner. Jane gives Larry a copy of the first Office action, which suggests that the primary examiner's analysis is incorrect, and offers to explain why. Jane instructs Larry that because Larry is unfamiliar with the inventor, Larry should not agree to possible ways in which the claims could be modified, or at least indicate to the examiner that Jane would have to approve of any such agreement.
- (D) Jane calls the primary examiner after receiving the final rejection, demanding that the examiner withdraw the finality of the final action. When the examiner states that the final rejection is proper, Jane demands an interview as a matter of right to explain the arguments.
- (E) (B) and (D).

(B) is the most correct answer. See MPEP § 713.01. An interview should be had only when the nature of the case is such that the interview could serve to develop and clarify specific issues and lead to a mutual understanding between the examiner and the applicant, and thereby advance the prosecution of the application.

QUESTION 208

The Potter patent application was filed on June 6, 2002, claiming subject matter invented by Potter. The Potter application properly claims priority to a German application filed on June 6, 2001. In a first Office action all the claims of the Potter application are rejected under 35 USC 102(e) based on a U.S. patent application publication to Smith et al ("Smith"). A registered practitioner prosecuting the Potter application ascertains that the relevant subject matter in Smith's published application and Potter's claimed invention were, at the time Potter's invention was made, owned by ABC Company or subject to an obligation of assignment to ABC Company. The practitioner ascertains that the Smith application was filed on April 10, 2001 and that the Smith application was published on December 5, 2002. Smith and Potter do not claim the same patentable invention. To overcome the rejection without amending the claims which of the following replies would not comply with the USPTO rules and the procedures set forth in the MPEP to be an effective reply for overcoming the rejection?

- (A) A reply that only contains arguments that Smith fails to teach all the elements in the only independent claim, and which specifically points out the claimed element that Smith lacks.
- (B) A reply that consists of an affidavit or declaration under 37 CFR 1.131 properly proving invention of the claimed subject matter of the Potter application prior to April 10, 2001.
- (C) A reply that consists of an affidavit or declaration under 37 CFR 1.132 properly showing that Smith's invention is not by "another."
- (D) A reply that properly states that the invention of the Potter application and the Smith application were commonly owned by ABC Company at the time of the invention of the Potter application.
- (E) All of the above.

(D) is the most correct answer. See 35 USC §§ 102(e) and 103(c); MPEP § 706.02(I)(1). The prior art exception in 35 U.S.C. § 103(c) only applies to references that are only prior art under 35 U.S.C. § 102(e), (f), or (g), and that are applied in a rejection under 35 U.S.C. § 103(a). In this situation, the Smith reference was applied in a rejection under 35 U.S.C. § 102(e) and not under 35 U.S.C. § 103(a). See MPEP § 706.02(I)(1). Therefore, the reply in answer (D) would not overcome the rejection.

QUESTION 209

The claims in a patent application having been twice or finally rejected, the applicant files a timely Notice of Appeal on January 2, 2003. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following situations should the USPTO not notify the applicant that the Appeal Brief is defective and allow him an opportunity to correct the deficiency?

- (A) The Appeal Brief is filed on July 10, 2003, without a request for extension of time under 37 CFR 1.136.
- (B) The Appeal Brief is submitted unsigned.
- (C) The Appeal Brief states that the claims do not stand or fall together, and presents argument as to why the claims are separately patentable, but the primary examiner does not agree with the applicant's argument.
- (D) The Appeal Brief does not state whether the claims stand or fall together, but presents arguments why the claims subject to the same rejection are separately patentable.
- (E) The Appeal Brief does not address one of the grounds of rejection stated by the primary examiner.

(C) is the most correct answer. See MPEP § 1206, specifically the Examiner Note for Form Paragraph 12.69.01 ("This form paragraph should be used only when no supporting reasons are presented in the brief."). If the examiner disagrees with the reasons given, the reason for disagreement should be addressed in the Examiner's Answer. As discussed at MPEP § 1208, in the Examiner Note 2 for Form Paragraph 12.55.01 "If the brief includes a statement that a grouping of claims does not stand or fall together but does not provide

reasons, as set forth in 37 CFR 1.192(c)(7), [the examiner is to] notify appellant of the non-compliance using form paragraphs 12.69, 12.69.01 and 12.78.” As discussed at MPEP § 1208, in the Examiner Note for Form Paragraph 12.55.02, if the examiner disagrees with appellant’s statement in the brief that certain claims do not stand or fall together, the examiner explains in the examiner’s answer why the claim grouping listed in the brief is not agreed with and why, if appropriate, *e.g.*, the claims as listed by the appellant are not separately patentable.

QUESTION 210

Ben hires a registered practitioner to prosecute his patent application. The practitioner drafted an application having fifteen claims. Claim 1 is independent, and each of claims 2-15 are singularly dependent upon claim 1. A proper non-final Office action is mailed to the practitioner. Following consultation with Ben, the practitioner timely prepared, signed, and filed a reply to the Office action containing an amendment that does not add new matter, but does add claims 16-27. Each of claims 16-27 is directed to the same invention sought to be patented through claims 1-15. The dependency of each of claims 16-27 reads “any of claims 5-15.” For purposes of fee calculation in accordance with the USPTO rules and the procedures set forth in the MPEP, how many total claims are contained in the application after the amendment is entered?

- (A) One hundred thirty-six.
- (B) One hundred thirty-five.
- (C) Twenty-seven.
- (D) One hundred forty-seven.
- (E) Fifteen.

(D) is the most correct answer. 37 CFR § 1.75; MPEP § 608.01(n). As explained in MPEP § 608.01(n), under the heading “Multiple Dependent Claims,” subheading “Acceptable Multiple Dependent Claim Wording” the multiple dependent claim wording of new claims 16-27 is proper. See, for example, “any one of the preceding claims,” and “in any of claims 1-3 or 7-9.” 37 CFR § 1.75(c) states “For fee calculation purposes under § 1.16, a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein.” Therefore, claims 16-27 would each have a claim value of eleven and the total number of claims for fee calculation is one hundred forty-seven ($12 \times 11 = 132 + 15 = 147$).

QUESTION 211

Which of the following is not a policy underlying the public use bar of 35 USC 102(b)?

- (A) Discouraging the removal, from the public domain, of inventions that the public reasonably has come to believe are freely available.
- (B) Favoring the prompt and widespread disclosure of inventions.
- (C) Allowing the inventor(s) a reasonable amount of time following sales activity to determine the potential economic value of a patent.
- (D) Increasing the economic value of a patent by extending the effective term of the patent up to one year.
- (E) Prohibiting the inventor(s) from commercially exploiting the invention for a

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period greater than the statutorily prescribed time.

(D) is the most correct answer. Extending patent term is not a policy underlying any section of 35 U.S.C. § 102.

QUESTION 212

Which of the following is not a proper incorporation by reference in an application prior to allowance according to the USPTO rules and the procedures set forth in the MPEP?

- (A) Incorporating material necessary to describe the best mode of the claimed invention by reference to a commonly owned, abandoned U.S. application that is less than 20 years old.
- (B) Incorporating non-essential material by reference to a prior filed, commonly owned pending U.S. application.
- (C) Incorporating material that is necessary to provide an enabling disclosure of the claimed invention by reference to a U.S. patent.
- (D) Incorporating non-essential material by reference to a hyperlink.
- (E) Incorporating material indicating the background of the invention by reference to a U.S. patent which incorporates essential material.

(D) is the correct answer. See MPEP § 608.01(p).

QUESTION 213

Evidence that a claim may not comply with the second paragraph of 35 USC 112 occurs in accordance with the USPTO rules and the procedure set forth in the MPEP where:

- (A) Remarks filed by applicant in a reply or brief regarding the scope of the invention differ and do not correspond in scope with the claim.
- (B) There is a lack of agreement between the language in the claims and the language set forth in the specification.
- (C) The scope of the claimed subject matter is narrowed during pendency of the application by deleting the originally much broader claims, and presenting claims to only the preferred embodiment within the originally much broader claims.
- (D) Claims in a continuation application are directed to originally disclosed subject matter (in the parent and continuation applications) which applicants did not regard as part of their invention when the parent application was filed.
- (E) All of the above.

(A) is the most correct answer. In accordance with MPEP § 2172, under the heading “II. Evidence To The Contrary,” states that evidence that shows a claim does not correspond in scope with that which applicant regards as applicant’s invention may be found, for example, in contentions or admissions contained in briefs or remarks filed by applicant.

QUESTION 214

AI files an application for a patent. After the Notice of Allowance is mailed and the issue

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fee has been paid AI discovers a prior art reference which is material to patentability. What should AI do in accordance with the USPTO rules and the procedures set forth in the MPEP?

- (A) AI should file a prior art statement under 37 CFR 1.501 that will be placed in the patent file upon issuance of the application as a patent.
- (B) Since the issue fee has been paid, AI no longer has a duty to disclose to the Office material prior art. He is under no obligation to submit the prior art reference to the Office.
- (C) Since the issue fee has been paid, it is too late to have the examiner consider the reference in this application. AI should file a continuation application to have the reference considered and allow the original patent application to issue as a patent.
- (D) AI should file a petition to have the application withdrawn from issuance, citing the finding of additional material prior art as the reason for withdrawal. A continuation application should also be filed with an information disclosure statement containing the reference in order to have the reference considered.
- (E) AI should file an amendment under 37 CFR. 1.312 deleting all of the claims which are unpatentable over the reference since an amendment deleting claims is entitled to entry as a matter of right.

(D) is the most correct answer. See 37 CFR § 1.313(b); MPEP §§ 609, subpart (B)(4) and 1308. After payment of the issue fee it is impractical for the Office to consider any information disclosures.

QUESTION 215

In accordance with USPTO rules and procedures set forth in 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 and intended to remain confidential.
- (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.

(C) is the most correct answer. 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.

QUESTION 216

Application A was filed after November 29, 2000. Reference X and application A were commonly owned at the time the invention of application A was made. In accordance with the patent laws, rules and procedures as related in the MPEP the prior art exclusion of 35 USC 103(c) can be properly invoked to obviate which of the following rejections?

- (A) A rejection under 35 USC 102(e) based on reference X, if reference X is prior art only under 35 USC 102(e).
- (B) A double patenting rejection based on reference X, if reference X is available as prior art only under 35 USC 102(e).
- (C) A rejection under 35 USC 103(a) based on reference X, if reference X is available as prior art only under 35 USC 102(e).
- (D) (B) and (C).
- (E) All of the above.

The correct answer is (C). See MPEP § 706.02(l) *et seq.* In accordance with proper USPTO policy and procedure, the prior art exclusion of 35 U.S.C. § 103(c) can only be invoked when the reference only qualifies as prior art under 35 U.S.C. § 102(f), 35 U.S.C. § 102(g), or 35 USC 102(e) for applications filed on or after November 29, 1999, the application and the reference were commonly owned, or subject to an assignment to the same person, at the time the invention was made, and the reference was used in an obviousness rejection under 35 U.S.C. § 103(a).

QUESTION 217

A utility application filed in May 2001 has been prosecuted through a second action final rejection. In the final rejection some claims were allowed and other claims were finally rejected. Which of the following accords with the patent laws, rules and the procedures as related in the MPEP for a proper reply to a second action final rejection in the utility application?

- (A) An amendment canceling all rejected claims and complying with 37 CFR 1.116.
- (B) Only a Notice of Appeal.
- (C) The appropriate fee for a request for continued examination (RCE).
- (D) A continued prosecution application (CPA) under 37 CFR 1.53(d).
- (E) All of the above.

(A) is the most correct answer. The filing of an amendment complying with 37 CFR § 1.116 is a proper reply under 37 CFR § 1.113 to a final rejection. See MPEP § 714.13, under the heading "Entry Not A Matter of Right," which states, in pertinent part, "A reply under 37 CFR 1.113 is limited to: (A) an amendment complying with 37 CFR 1.116."

QUESTION 218

A registered practitioner filed a first patent application wherein claims 1-10 are directed to a widget and claims 11-20 are directed to a method of making a widget. Following a proper restriction requirement, claims 1-10 were elected for prosecution. The primary examiner rejected claims 1-10. The practitioner filed a reply that only consisted of argument. The

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examiner was unpersuaded by the argument, and entered a final rejection of claims 1-10. In reply, the practitioner filed a continuing application containing claims 1-10 directed to a widget, and claims 11-20 directed to a method of using a widget. In the continuing application, the examiner enters a new written restriction requirement requiring a provisional election between claims 1-10 and claims 11-20. The practitioner believes the new restriction requirement is improper and would like the rejection in the parent application reviewed as well. The new restriction requirement has not been made final. Which of the following best describes whether and why, in accordance with the patent laws, rules, and procedures as related by the MPEP, the reply to the restriction requirement may be by appeal to the Board of Patent Appeals and Interferences?

- (A) Yes. An immediate appeal to the Board can be filed to review the restriction requirement if any claims have been twice rejected.
- (B) No. An immediate appeal cannot be filed to the Board because the new claims directed to a method of using a widget have not been twice rejected.
- (C) Yes. An immediate appeal can be filed for any claims that have been twice rejected because the Board can also review any second restriction requirement made against the same claims.
- (D) No. An immediate appeal to the Board cannot be lodged because a provisional election has not been made of either the claims to a widget or claims to a method of use of the widget.
- (E) No. An immediate appeal cannot be taken because no claims are currently under rejection. Review of a final restriction requirement is only possible as a petitionable matter before a Technology Center Director. It is not an appealable matter to the Board.

(E) is the most correct answer. MPEP § 1002.02(c) identifies among the matters petitionable to and decided by the Technology Center Directors “Petitions from a final decision of examiner requiring restriction in patent applications, 37 CFR 1.144, MPEP § 818.03(c).”

QUESTION 219

Inventor files an application for a non-theoretical metal alloy. The application as originally filed contains the following Claim 1:

1. A metal alloy comprising at least 20% by volume of iron; at least 10% by volume of gallium, and at least 10% by volume of copper.

In accordance with the patent law, rules and procedures as related by the MPEP, which of the following claims would be properly held indefinite under 35 USC 112(2)?

- (A) Claim 2: The alloy of claim 1 containing 66% by volume of gallium and 14% by volume of copper.
- (B) Claim 2: The alloy of claim 1 containing at least 21% by volume of iron, 11% by volume of gallium, and 10.01% by volume of copper.
- (C) Claim 2: The alloy of claim 1 containing 20% by volume of iron, 10% by

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volume of gallium, and 10% by volume of copper.

(D) Claim 2: The alloy of claim 1 containing 54% by volume of copper and 27% by volume of gallium.

(E) Claim 2: The alloy of claim 1 containing at least 1% by volume of silver.

(D) is the correct answer. See MPEP § 2173.05(c), under the heading “Open-Ended Numerical Ranges.” Paraphrasing the explanation therein, when an independent claim recites a composition comprising “at least 20% iron” and a dependent claim sets forth specific amounts of non-iron ingredients which add up to 100%, apparently to the exclusion of iron, an ambiguity is created with regard to the “at least” limitation unless the percentages of the non-iron ingredients are based on the weight of the non-iron ingredients. On the other hand, a composition claimed to have a theoretical content greater than 100% (i.e., 20-80% of iron, 20-80% of gallium, and 1-25% of copper) is not necessarily indefinite simply because the claims may be read in theory to include compositions that are impossible in fact to formulate. Here, because the invention is a non-theoretical alloy, the sum of the claimed constituents cannot exceed 100% unless the percentage is based on weight. In (D), the sum of elements (B) and (C) is 81% by volume, leaving only 19% for iron. Claim 1, however, requires “at least 20% iron,” rendering Claim 2 ambiguous as to the percentage of element A.

QUESTION 220

Co-inventors Smith and Jones filed an application for a patent on a cell phone, on May 15, 2002. They received a first Office action from a primary examiner rejecting the claims under 35 USC 102(a) over a publication by Bell and Watson, published on April 5, 2002, describing a cell phone having all the same features as is claimed in the patent application. In reply, the co-inventors each submitted a declaration under 37 CFR 1.131 stating that they had actually reduced the invention to practice no later than March 13, 2002. However, the declarations failed to include two claimed features. Neither the particular antenna needed to enable the cell phone could receive transmissions from the local cellular transmitting tower, nor a detachable carrying strap was included in the declarations. As evidence of their prior reduction to practice, Smith and Jones submitted their co-authored journal article. The journal article contained a figure of the cell phone as described in the declarations. That is, the cell phone shown in the figure of the article lacked an antenna and a detachable strap. The article was received by the journal on March 13, 2002, and was published on April 30, 2002. The cell phones shown in the figure in the Bell and Watson publication, and in the Smith and Jones patent application have the particular antenna and a detachable strap. Which of the following actions, if taken by the examiner, would be the most proper in accordance with the patent laws, rules and the procedures as related in the MPEP?

(A) The examiner should maintain the rejection of the claims under 35 USC 102(a) and make the rejection final.

(B) The examiner should withdraw the rejection and look for references which have a publication date prior to May 15, 2001.

(C) The examiner should withdraw the rejection and notify Smith and Jones that their application is in condition for allowance.

(D) The examiner should maintain the rejection, but indicate that the claims would be allowable if Smith and Jones provided an original copy of the figure published in

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their journal article as factual support for their declarations.

(E) The examiner should maintain the rejection and inform Smith and Jones that the declarations are insufficient because they cannot “swear behind” a reference which is a statutory bar.

(A) is the correct answer. MPEP § 715.07, under the heading “Facts and Documentary Evidence” states that “The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. ... The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country (MPEP § 715.07(c)) at least the conception being at a date prior to the effective date of the reference.

...

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose.” Here, the co-inventors admit, and the documentary exhibits relied upon demonstrate that they failed to reduce the claimed invention to practice prior to the publication date of the Bell and Watson reference. It is also apparent that due to the lack of an antenna in the cell phone described in Smith’s and Jones’s declarations and journal article, that the cell phone which was reduced to practice prior to the publication date of the Bell and Watson article would not have worked for its intended purpose. Accordingly, the examiner should maintain the rejection and make it final.

QUESTION 221

After the Board makes a new rejection under 37 CFR 41.50(b), If an appellant files an new evidence as to less than all of the claims rejected by the Board under 37 CFR 41.50(b), and a request for rehearing as to the remainder of the claims so rejected, which one is correct?

- (A) The examiner will not consider the claims for which rehearing was requested before rehearing.
- (B) The request for rehearing and examiner's prosecution will be considered at the same time.
- (C) The request for rehearing will be considered by the Board after prosecution before the examiner.
- (D) The request for rehearing will not be considered by the Board after prosecution before the examiner.
- (E) None of the above answers are correct.

The correct answer is (C). See MPEP § 1214.01.

QUESTION 222

X files a German application (it might even be an international application designating Germany). X later files a US application and forgets to claim priority from the earlier filed foreign application to get the benefit of the earlier filing date. The US patent issues and then person realizes that he/she did not make a claim for priority from the earlier German application or submit the certified copy. Assuming that all the timing requirements were met in order for the US patent to get the benefit of the German application how can the person perfect priority

based on the German application?

There were several certificate of correction answers and reissue answers. the answer was: C) file a reissue application along with the necessary fees, certified copy of the priority document (German Application) and a claim for priority. While Brenner (MPEP 1402) clearly spells out that a claim for priority can be perfected via reissue by a submission of certified copy of the priority document and the claim for priority it does not state whether the document had to be in English in order to get the benefit of the earlier filed application. C is correct because according to MPEP 201.13, when claiming priority o a foreign application, a translation is not necessary unless needed for interference, needed to overcome a specific reference in a rejection, or asked for by the examiner.

QUESTION 223

Question regarding applications having many claims and when it would appropriate to limit the number or nature of the initial inquiry. Some situations exist where examination of an application appears best accomplished by limiting action on the claim thereof to a particular issue. These situations include the following:

- (A)Where an application is too informal for a complete action on the merits.
- (B)Where there is an undue multiplicity of claims, and there has been no successful telephone request for election of a limited number of claims for full examination.
- (C)Where there is a misjoinder of inventions and there has been no successful telephone request for election.
- (D)Where disclosure is directed to perpetual motion.
- (E)All of the above.

The correct answer is (E), see MPEP 707.07(g).

QUESTION 224

Question regarding claim number 4 that was canceled via a pre-examination amendment in a set of 6 claims, but the registered practitioner wanted to later reinstate the exact same claim; answers were (approximately);

- (A) Submit an amendment uncanceled claim number 4.
- (B) Submit an amendment adding claim number 7 with the exact words of the original claim number 4.
- (C) It is not possible to reinstate claim number 4 because once it is canceled the matter cannot be reclaimed.
- (D) [Another answer changing the claim number inappropriately]
- (E) [Another answer changing the claim number inappropriately]

The correct answer is (B), see MPEP 714 Reinstatement of previously canceled claim.

QUESTION 225

52 tables were divided into two portions; 1-26 and 27-52. Is this proper? One of the answer choices includes that CD-ROM have to be submitted in duplicate. However, this answer is

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misleading because only tables LONGER than 50 pages can be submitted on compact disk.

Answer: 37 CFR 1.52. Language, paper, writing, margins, compact disc specifications.
[...]

(4) Any compact disc must be submitted in duplicate unless it contains only the "Sequence Listing" in computer readable form required by § 1.821(e). The compact disc and duplicate copy must be labeled "Copy 1" and "Copy 2," respectively.

608.05(b) Compact Disc Submissions of Large Tables [R-2]

A single table contained on fifty pages or less must be submitted either as drawings (in compliance with 37 CFR 1.84) or as part of the specification in paper (in compliance with 37 CFR 1.52). A single table contained on 51 pages or more may be submitted on a CD-ROM or CD-R (in compliance with 37 CFR 1.52(e) and 37 CFR 1.58). The presentation of a subheading to divide a large table into smaller sections of less than 51 pages should not be used to prevent an applicant from submitting the table on a compact disc unless the subdivided tables are presented as numerous files on the compact disc so as to lose their relationship to the overall large table.

If you look at 37 CFR 1.52(e), there is at least one other circumstance (maybe not mentioned in the question) that a set of tables is permitted to be sent on a CD:

(e) Electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding.

(1) The following documents may be submitted to the Office on a compact disc in compliance with this paragraph:

(iii) Any individual table (see § 1.58) if the table is more than 50 pages in length, or if the total number of pages of all of the tables in an application exceeds 100 pages in length, where a table page is a page printed on paper in conformance with paragraph (b) of this section and § 1.58(c).

QUESTION 226

Can an examiner use clean black ink to make an amendment in something related to a reissue.

"Clean red ink" (not clean blue or black ink) must be used in correcting originally filed papers.

MPEP 1302.04 Examiner's Amendments and Changes. The question appears to be asked in the form "which is not correct". Thus, the answer was using black ink (should be done with red).

QUESTION 227

A question involving a baseball and accompanying article about a special titanium baseball put on public display in a museum. Basic issue - Is something public use if ONLY the people having skill in the art can see it?

June 20: Article printed, not distributed at all

June 25: put in library open only to wealthy museum patrons, none of whom have skill in the art

June 30: Museum library opens to public

July 1: TV advertisement of grand opening of museum library

July 4: Grand opening

The answer is the date it is indexed and cataloged. While the museum was open to varying degrees, the material was not cataloged and on the shelves until the last date - July 4th. 102(b).

QUESTION 228

question involving whether the reflective qualities of a mirror should be included in the specification. You were to choose from a list of choices that comported with USPTO practice and procedure.

Enablement requirement involved because the specification is conflicting. Because the mirror in one part of the specification is "parallel," and in another part "perpendicular," the specification is conflicting. So, one who has knowledge in the art would not be able to tell the difference, therefore amend the specification.

QUESTION 229

A question involving the inventor Tribell and an Aroma Therapy Kit, but with the name periodically swapped out with another name.

Deals with a broadening reissue. Reissue applications that seek to broaden claims must be filed within two years of the issue date. A "divisional reissue" cannot be filed. Failing to file a divisional application claiming restricted claims during the pendency of the application subject to a restriction requirement is not an "error" that can be remedied in a reissue application. See MPEP 1402, Grounds for Filing.

QUESTION 230

A question about whether the International Searching Authority could amend/write an abstract if one were not supplied in an International Application.

MPEP 1844.01. The International Searching Authority shall establish an Abstract (if missing), and the applicant may, within one month from the date of mailing of the international search report, submit comments on the abstract established by the International Searching Authority. For a US national application the examiner is not allowed to supply an abstract if one isn't present, but can amend an existing abstract if that's the only thing preventing allowance.

QUESTION 231

A question regarding the USPTO policy given *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. 103. The four factual inquiries enunciated therein as a background for determining obviousness are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: The

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claimed invention must be considered as a whole; The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and Reasonable expectation of success is the standard with which obviousness is determined.

QUESTION 232

Office policy has consistently been to follow *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), in the consideration and determination of obviousness under 35 USC 103. Each of the following are the four factual inquiries enunciated therein as a background for determining obviousness except:

- (A) Determining the scope and contents of the prior art.
- (B) Resolving any issue of indefiniteness in favor of clarity.
- (C) Ascertaining the differences between the prior art and the claims in issue.
- (D) Resolving the level of ordinary skill in the pertinent art.
- (E) Evaluating evidence of secondary considerations.

The most correct answer is (B). 35 U.S.C. § 103; *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966); MPEP § 2141. Resolving any issue of indefiniteness in favor of clarity is not among the factual inquiries enunciated in *Graham*. The four factual inquiries are set forth in answers (A), (C), (D), and (E).

QUESTION 233

A product by process question dealing with “obviousness/anticipation”. One of the answers states that a case for “anticipation” is easier to show when product by process claims are used as compared to traditional claims.

The correct answer is that product by process should ONLY be used when traditional claiming techniques are inappropriate.

QUESTION 234

Test takers report a question involving a claim for sweet smelling paint with six colors, fragrance, and skim milk. This claim is rejected as obvious over eight prior references (one for each of six colors individually, one for fragrance, and one for skim milk). The agent rebuts on the basis of too many references.

Answer - there is no fixed limit. MPEP 2145. Reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. In re Gorman, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991) (Court affirmed a rejection of a detailed claim to a candy sucker shaped like a thumb on a stick based on thirteen prior art references.).

QUESTION 235

Which of the following does not constitute probative evidence of commercial success to support a contention of non-obviousness?

- A) In a utility case, gross sales figures accompanied by evidence as to market share.
- B) In a utility case, gross sales figures accompanied by evidence as to the time period during which the product was sold.
- C) In a utility case, gross sales figures accompanied by evidence as to what sales would normally be expected in the market.
- D) In a utility case, gross sales figures accompanied by evidence of brand name recognition.
- E) In a design case, evidence of commercial success clearly attributable to the design, and not to improve performance of the device.

716.03(b) Commercial Success Derived From Claimed Invention

QUESTION 236

A biotechnology question that really deals with obviousness/anticipation; Nucleotide and chemical claims with regard to anticipation.

2144.05. A prima facie case of obviousness may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. A past exam question involving a chemical formula is obvious with 34.9% compared to 35% in prior art or 34.9% and 65.1% (obviousness). Obviousness Type Double Patenting Rejection, of course that is possible, but that's what terminal disclaimers are for. Almost all continuing and divisional applications filed on the applicant's initiative are subject to a terminal disclaimer, as they should be.

QUESTION 237

You represent Z, who files a nonprovisional application which claims the benefit of a priority claim filed under 120. You receive a Notice of Allowance and Z decides that he wants to extend the term of his patent and remove the benefit. How do you enter an amendment to do this?

- A) Pay the issue fee then file a RCE with the amendment.
- B) Don't pay the issue fee, and file a RCE with the amendment.
- C) Juggle watermelons (not really, but something out there)
- D) Pay the issue fee then file an the amendment.
- E) Don't pay the issue fee, and file the amendment.

Answer B, don't pay the issue fee and file an RCE with the amendment. After the notice of allowance, entry of an amendment or ADS is not a matter of right, so in order to be sure that it is entered you would need to file an RCE.

MPEP 201.11 reads that removing a filing benefit can be done by amendment (by amending specification or submitting a new application data sheet to delete any references to prior applicants) before the notice of allowance, but this is a matter of grace and not a matter of right. If the amendment or ADS is submitted after the application has been allowed, the amendment or ADS will be treated under MPEP 714.16.

MPEP 714.16. To get an RCE prosecution must be CLOSED (Notice of Allowance), and applicant must request RCE by filing a submission and fee PRIOR TO the earliest of the: 1) payment of the

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issue fee (unless petition to withdraw is granted); 2) abandonment of application; or 3) filing of notice of appeal or start of civil suit (unless terminated while application is still pending).

QUESTION 238

Two questions on how to extend your patent life by deleting a claim of benefit. File an RCE. In the second question you are required to understand the 4 months/16 months deadlines are exceeded (see 1.55(a) and 1.78(a)(2)(ii)), and realize that because the applicant removed the claim himself he cannot avail himself of adding the claim as unintentional.

In 201.11 G. Deleting Benefit Claims. As a result of the 20-year patent term, it is expected, in certain circumstances, that applicants may cancel their claim to priority by amending the specification or submitting a new application data sheet (no supplemental declaration is necessary) to delete any references to prior applications. A cancellation of a benefit claim to a prior application may be considered as a showing that the applicant is intentionally waiving the benefit claim to the prior application in the instant application. If the applicant later files a petition to accept an unintentionally delayed claim to add the benefit claim to the prior application in the same application from which the benefit claim was canceled, the Office may refuse to accept such benefit claim because the delay was not unintentional.

QUESTION 239

Applicant deletes benefit a claim then the examiner rejects it with prior art. The applicant now wants to reclaim the benefit. How can he do it?

MPEP 201.11. File an RCE.

QUESTION 240

What are you required to submit when entering the national stage in case USPTO was the receiving office of the international application?

Pay the fee because if you file with the USPTO as an Receiving Office you do not need to submit the application or wait for it to be transferred from IB. In 1893.01(a)(1) Submissions Required by 30 Months from the Priority Date, where the international application was filed with the United States Receiving Office as the competent receiving Office, the copy of the international application referred to in 37 CFR 1.495(b) is not required. Payment of the basic national fee will indicate applicant's intention to enter the national stage and will provide a U.S. correspondence address in most instances.

QUESTION 241

Question dealing with filing a international application via fax.

MPEP 1834.01 (Use of Telegraph, Teleprinter, or Facsimile machine) – you are not allowed to file a PCT application or copy of application and fee to enter national stage by fax.

QUESTION 242

Where in an application can you claim the benefit of an earlier application. The answer options

were - in the first sentence of the specification; in the application data sheet; and in the oath or declaration.

MPEP 201.11. An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet.

QUESTION 243

PCT question with two missing parts of the specification. The applicant filed the missing parts at two intervals.

Answer – there are only 30 days to do submit the missing parts, and the applicant's 2nd submission was not timely.

QUESTION 244

What if there are no claims in a PCT application and that PCT application claims the benefit of a provisional application. How can these claims be sent to the USPTO?

send the claims by facsimile.
by express mail.
by certificate of mailing.

The office will alert you that you have no claims. You cannot use a certificate of mailing for PCT. You can use a fax as long as you're not submitting documents to enter the national stage of an application. If you submit them via express mail, you get "date in." If you send them via fax you get date of receipt by PTO.

QUESTION 245

What may be done if a page or pages of drawings have been inadvertently omitted from an international application?

MPEP 1810. The applicant should submit the drawings within the 1 month time limit set by the Receiving Office, and before 12 months from any priority date if that date is earlier.

QUESTION 246

How much time do you have to correct a PCT application with no address after you are invited to correct the problem.

PCT Rule 20.6(b). The receiving Office shall promptly mail the invitation to the applicant and shall fix a time limit, reasonable under the circumstances of the case, for filing the correction. The time limit shall not be less than 10 days, and shall not exceed one month, from the date of the invitation. If such time limit expires after the expiration of one year from the filing date of any application whose priority is claimed, the receiving Office may call this circumstance to the attention of the applicant.

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MPEP 1810. The International Application (PCT) filing date accorded the application is the date of compliance with the invitation to correct.

QUESTION 247

The applicant submits three different amendments to the UPSTO as the Receiving Office of a PCT application. What will the USPTO do?

- (A) Correcting a misspelled word "ccar"
- (B) Adding a drawing that was accidentally left out but is in earlier filed provisional or non-provisional application benefit of which is claimed.
- (C) Adding a page to explain in the specification something clearly shown on a drawing.

MPEP 1836 - rectification of obvious errors. Obvious errors in the international application or other papers submitted by the applicant may generally be rectified under PCT Rule 91, if the rectification is authorized, as required, within the applicable time limit. [...] The omission of entire sheets of the description cannot be rectified, even if resulting from inattention at the stage of copying or assembling sheets. Applicants often attempt to rely upon the priority application to establish a basis for obvious error. The priority document (application) cannot be used to support obvious error corrections. The rectification is obvious only in the sense that anyone would immediately realize that nothing else could have been intended than what is offered as rectification. Examples of obvious errors that are rectifiable include linguistic errors, spelling errors and grammatical errors so long as the meaning of the disclosure does not change upon entry of the rectification. Changes to chemical or mathematical formulas would not generally be rectifiable unless they would be common knowledge to anyone. A missing chemical formula or missing line of text would not be considered >to be an< obvious error subject to rectification.

QUESTION 248

What USPTO will do if a Japanese citizen currently residing in US files PCT application with USPTO but application is in Japanes?

- (A) not given a filing date
- (B) sent to International Bureau for processing
- (C) sent to Japanese PTO

MPEP 1805. The United States Receiving Office will forward the application to the International bureau for processing, if the application was filed using USPTO but not in English, or if applicant not a resident/citizen of US at the time. The date of US filing will be date given the PCT application by the International Bureau - if all other requirements met - which is the date the application was received by the US office. "The Receiving Office of the International Bureau will consider the international application to be received as of the date accorded by the United States Receiving Office."

QUESTION 249

PCT designating USA filed in English claiming priority to Japanese application. Filing date was

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after Nov 29, 2000. IA published in English, and entered the National Stage. US application publication was published. Subsequently, the application was patented. When is the 102(e) prior art date?

MPEP 2136 35 U.S.C. 102(e). Allows the use of certain international application publications and U.S. patent application publications, and certain U.S. patents as prior art under 35 U.S.C. 102(e) as of their respective U.S. filing dates, including certain international filing dates. The prior art date of a reference under 35 U.S.C. 102(e) may be the international filing date if the international filing date was on or after November 29, 2000, the international application designated the United States, and the international application was published by the World Intellectual Property Organization (WIPO) under the Patent Cooperation Treaty (PCT) Article 21(2) in the English language.

MPEP § 706.02(f)(1) for examination guidelines on the application of 35 U.S.C. 102(e).

(1) If the international application meets the following three conditions:

(a) an international filing date on or after November 29, 2000;

(b) designated the United States; and

(c) published under PCT Article 21(2) in English,

then the international filing date is a U.S. filing date for prior art purposes under 35 U.S.C. 102(e).

706.02(f)(1)

(3) If the international application has an international filing date prior to November 29, 2000, apply the reference under the provisions of 35 U.S.C. 102 and 374, prior to the AIPA amendments:

(a) For U.S. patents, apply the reference under 35 U.S.C. 102(e) as of the earlier of the date of completion of the requirements of 35 U.S.C. 371(c)(1), (2) and (4) or the filing date of the later filed U.S. application that claimed the benefit of the international application;

(b) For U.S. application publications and WIPO publications directly resulting from international applications under PCT Article 21(2), never apply these references under 35 U.S.C. 102(e). These references may be applied as of their publication dates under 35 U.S.C. 102(a) or (b);

(c) For U.S. application publications of applications that claim the benefit under 35 U.S.C. 120 or 365(c) of an international application filed prior to November 29, 2000, apply the reference under 35 U.S.C. 102(e) as of the actual filing date of the later-filed U.S. application that claimed the benefit of the international application.

QUESTION 250

Where is the PTO supposed to send an office action if the concerned patent attorney/agent is suspended?

Answer - The USPTO will NOT correspond with suspended practitioners. Correspondence will be mailed to the applicant or another practitioner designated by the applicant. The Office does not communicate with attorneys or agents who have been suspended or excluded from practice. Accordingly, the Office action is being mailed to you as the inventor. Sole Practitioner/Sole Inventor - The Office action is to be mailed only to the inventor at his/her current address of record. Attorney/Agent Suspended (Sole Practitioner, Joint Inventors) - The Office action is to be

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mailed only to the inventor first named in the declaration at his or her current address of record. Attorney/Agent Suspended (Plural Practitioners) - The Office action is to be mailed both to the first named registered attorney or agent of record (who is not suspended or excluded) at the address currently listed in the Attorney's Roster, and to the inventor first named in the declaration at his or her current address of record. CFR 10.158 (2) Within 30 days of entry of the order of suspension or exclusion, surrender a client's active Office case files to (i) the client or (ii) another practitioner designated by the client.

QUESTION 251

Question on suspended practitioners, "which one is incorrect".

Know that the USPTO will not appoint a new practitioner for a child or an incapacitated adult who is deemed incapable of representing himself, if the one in the power of attorney is suspended.

QUESTION 252

How many and what kind of digital media do you have to submit with a gene sequence.

MPEP 2421.02 Summary of the Requirements of the Sequence Rules. The applicant must provide 1) a paper copy of the sequence, 2) a computer-readable copy of the sequence, and 3) a statement that the paper copy and computer readable copy are identical with an application that discloses nucleotide and/or amino acid sequence.

QUESTION 253

Who can sign a 1.132 petition showing that a previous invention was not by another. The subject matter of the question is "Application A" and "Patent X".

- (A) declarations or statements from -the owner of Application A,
- (B) the inventor of Application A,
- (C) the inventor of Patent X,
- (D) the attorney

Two answers were accepted because the inventor is in a position to have the best knowledge of ownership of the invention, but the the attorney can send in a statement.

37 CFR 10.18(a). For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature, personally signed by such practitioner, in compliance with § 1.4(d)(1) of this chapter. The oath or declaration may not be signed by an attorney on behalf of the inventor, even if the attorney has been given a power of attorney to do so.

QUESTION 254

What responses overcome certain rejections such as when 1.131 and 1.132 affidavit appropriate?

MPEP 715.01. When an applicant cannot swear behind a 1.131 or 1.132 affidavit. 1.131 can't swear behind 102(b) art; 1.131 can't swear behind same patentable invention; and 1.132 "unexpected result" irrelevant for 102 art. "Swearing Back or Behind" means that under some circumstances the applicant can file an affidavit (under 37 CFR 1.131 or sometimes 37 CFR 1.132) that the applicant actually invented the matter that is discussed in the prior art before the prior art was published (swearing back in time before the prior art was published). The date sworn back to will actually be earlier than the effective filing date of the patent.

QUESTION 255

How must the applicant reply after receiving an International Search Report.

You must reply within one month and the ISA is not obligated to give any sort of reply. If you want a Chapter I international search report (and written opinion for applications filed after Jan 01, 2004), you must "establish" it before either 3 months from receipt by the ISA of the search copy (generated by the office in which the PCT application was filed), or 9 months from the earliest priority date, whichever is later. If you want to demand a Chapter II search, you must do so before i) if the IA is filed on or after 1/1/04, either 3 months from the transmittal of the international search or 22 months from the priority date, whichever is later; or ii) if the IA is filed before 1/1/04, 19 months from the priority date.

QUESTION 256

Can you FAX your national stage application to the USRO?

MPEP 1834.01. Generally, any paper may be filed by facsimile transmission with certain exceptions which are identified in 37 CFR 1.6(d). It should be noted that a facsimile transmission of a document is not permitted and, if submitted, will not be accorded a date of receipt if the document is:

- (A) Required by statute to be certified;
- (B) A drawing submitted under 37 CFR 1.437;
- (C) An international application for patent; or
- (D) A copy of the international application and the basic national fee necessary to enter the national stage, as specified in 37 CFR 1.495(b).

Facsimile transmission may be used to submit substitute sheets (other than drawings), extensions of time, power of attorney, fee authorizations (other than the basic national fee), confirmation of precautionary designations, Demands, response to written opinions, oaths or declarations, petitions, and translations in international applications.

QUESTION 257

Question on submitting 52 tables in CD-ROM. The 52 tables were divided into two portions; 1-26 and 27-52. Is this proper? Also, another question about having many small tables in your specification.

37 CFR 1.52(4). Any compact disc must be submitted in duplicate unless it contains only the

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“Sequence Listing” in computer readable form required by § 1.821(e). The compact disc and duplicate copy must be labeled “Copy 1” and “Copy 2,” respectively.

MPEP 608.05(b). A single table contained on fifty pages or less must be submitted either as drawings (in compliance with 37 CFR 1.84) or as part of the specification in paper (in compliance with 37 CFR 1.52). A single table contained on 51 pages or more may be submitted on a CD-ROM or CD-R (in compliance with 37 CFR 1.52(e) and 37 CFR 1.58). The presentation of a subheading to divide a large table into smaller sections of less than 51 pages should not be used to prevent an applicant from submitting the table on a compact disc unless the subdivided tables are presented as numerous files on the compact disc so as to lose their relationship to the overall large table.

QUESTION 258

Question on Trade secret, Proprietary, protective order materials.

MPEP 724. Wherever possible, trade secret law and patent laws should be administered in such manner that the former will not deter an inventor from seeking the benefit of the latter, because, the public is most benefited by the early disclosure of the invention in consideration of the patent grant. If a patent applicant is unwilling to pursue his right to a patent at the risk of certain loss of trade secret protection, the two systems will conflict, the public will be deprived of knowledge of the invention in many cases, and inventors will be reluctant to bring unsettled legal questions of significant current interest . . . for resolution.

QUESTION 259

What happens to the trade secret information in reexam if the Examiner finds it material to the patentability of the invention, and what if there is/or isn't a request to expunge the info?

MPEP 724.04. Any materials submitted under MPEP § 724.02 in a reexamination file open to the public under 37 CFR 1.11(d) will be treated in the following manner: (A) Materials submitted under MPEP § 724.02 will only be released to the public with any other papers in the reexamination file if no petition to expunge (37 CFR 1.59) was filed prior to the mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC), or if a petition to expunge was filed and the petition was denied.< The submitted information will be maintained separate from the reexamination file and will not be publicly available until a determination has been made as to whether or not the information is important to a reasonable examiner in deciding whether or not a claim is patentable. (B) >Prior to the mailing of a NIRC, the examiner will review the reexamination file and determine if a petition to expunge is in the reexamination file but not acted upon.< The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all of the information submitted is important to a reasonable examiner in deciding whether or not a claim is patentable. (C) If any portion or all of the submitted information is found important to a reasonable examiner in deciding whether or not a claim is patentable, **>the petition to expunge will be denied and the information< will thereafter become a permanent part of the reexamination file and open to the public. (D) If any portion or all of the submitted information is found not to be important to a reasonable examiner in deciding whether or not a claim is patentable,>the petition to expunge will be granted and the information expunged. (E) >If a

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petition to expunge is not filed prior to the mailing of the NIRC, the materials submitted under MPEP § 724.02 will become a permanent part of the reexamination file and open to the public under 37 CFR 1.11(d).<

QUESTION 260

When is a supplemental oath or declaration treated as an amendment?

Answer: After Notice of Allowance in reissue application. MPEP 714.16. With the exception of a supplemental oath or declaration submitted in a reissue, a supplemental oath or declaration is not treated as an amendment under 37 CFR 1.312. See MPEP § 603.01. A supplemental reissue oath or declaration is treated as an amendment under 37 CFR 1.312 because the correction of the patent which it provides is an amendment of the patent, even though no amendment is physically entered into the specification or claim(s). Thus, for a reissue oath or declaration submitted after allowance to be entered, the reissue applicant must comply with 37 CFR 1.312 in the manner set forth in this section.

QUESTION 261

What happens if applicant doesn't designate a best mode, but puts forth several embodiments?

The application does not require a statement which specifically points out the best mode.

MPEP 2165.01. There is no requirement in the statute that applicants point out which of their embodiments they consider to be their best; that the disclosure includes the best mode contemplated by applicants is enough to satisfy the statute.

QUESTION 262

A French application was filed, then PCT application designating US filed claiming French application and IA was published in French. At some point within 30 months, without entering National Stage, applicant files continuation from PCT application, is the claim for French priority proper? Is it perfected?

The claim for French priority is proper, but not perfected, since the filed continuation and USPTO only has the French application, they need to file translation to USPTO.

MPEP 1895.01. "A certified copy of the international application (and an English translation) of the international application may be required by the examiner to perfect the claim for benefit under 35 U.S.C. 120 and 365(c) if the international application did not originate in the United States and such is necessary, for example, where an intervening reference is found and applied in a rejection of one or more claims. If the international application was published by the International Bureau pursuant to PCT Article 21, then a certified copy would not normally be necessary". Rather than submitting national stage application papers under 35 U.S.C. 371, a continuing application (i.e., continuation, C-I-P, or division) under 35 U.S.C. 111(a) of the international (PCT) application may be filed. Pursuant to 35 U.S.C. 365(c), a regular national application filed under 35 U.S.C. 111(a) and 37 CFR 1.53(b) (not under 37 CFR 1.53(d)**) may claim benefit of the filing date of an international application which designates the United States. If benefit under 35 U.S.C. 119(e), 120 and 365(c) is also being claimed to an earlier filed national application (or international application designating the U.S.) via an intermediate

international application designating the U.S., the examiner must examine the intermediate international application to see if it contains a proper reference to the earlier application. The reference will usually be included on the cover page of the published international application and/or may appear in the first sentence(s) of the description of the published application. A lack of a proper reference in the published international application does not necessarily mean that a proper reference is not contained in the second international application.

QUESTION 263

A PCT application was filed in Germany before Nov 29, 2000 (95 or 96), determining the US patent term?

MPEP 2701. A patent granted on an international application filed on or after June 8, 1995 and which enters the national stage under 35 U.S.C. 371 will have a term which ends twenty years from the filing date of the international application. A continuation or a continuation-in-part application claiming benefit under 35 U.S.C. 365(c) of an international application filed under 35 U.S.C. 363 designating the United States will have a term which ends twenty years from the filing date of the parent international application. Foreign priority under 35 U.S.C. 119(a)-(d), 365(a), or 365(b) is not considered in determining the term of a patent. Accordingly, an application claiming priority under 35 U.S.C. 365(a) or 365(b) has a term which ends twenty years from the filing date of the application in the United States and not the prior international application.

QUESTION 264

Applicant claims a toy plane whose wings are covered in aluminum foil. The specification describes a toy plane whose wings are covered in foil but whose body isn't. Reference discloses a plane that is covered entirely in chewing gum wrapper, which includes aluminum foil and another material. Claim is rejected, and applicant responds by arguing that covering only the wings in foil provides useful aerodynamic properties, and therefore the claimed invention is distinguishable from the reference. How should the examiner respond?

The examiner should maintain the rejection in view of practitioner's arguments. The answer description points out that the claim is open-ended ("...comprising wings covered in aluminum foil"). Thus, the prior art anticipates the claim.

QUESTION 265

Company A gave their agent B, the competitor's patent application number, and asked if the agent B could get the information on the competitor's patent application - whether it has been published and the publication date. By telephoning the office, how do you get such information?

MPEP 101. When handling an incoming telephone call or an in person request for information regarding an unpublished pending or abandoned patent application, no information should be disclosed until the identity of the requester can be adequately verified as set forth below. Particular care must be exercised when a request is made for the publication date or publication number, or issue date and patent number assigned to a pending patent application. If the publication or issue date is later than the current date (i.e., the date of the request), such

information may be given only to the applicant, or the assignee of record, or the attorney or agent of record.

QUESTION 266

If you had a Certificate of Correction in the parent, and want to file preliminary amendment in a reissue application, what do you do type of question

MPEP 1411.01. The applicant should include any changes, additions, or deletions that were made by a Certificate of Correction to the original patent grant in the reissue application without underlining or bracketing. The examiner should * make certain that all Certificate of Correction changes in the patent have been properly incorporated into the reissue application. Certificate of Correction changes and disclaimer of claim(s) under 37 CFR 1.321(a) should be made without using underlining or brackets. Since these are part of the original patent and were made before the reissue was filed, they should show up in the printed reissue >patent< document as part of the original patent, i.e., not in italics or bracketed. If the changes are extensive and/or applicant has submitted them improperly with underlining and brackets, a clean copy of the specification with the Certificate of Correction changes in it may be requested by the examiner.

QUESTION 267

Who do you contact when you are filing petition under CFR 1. 183?

MPEP 1002.01. Petitions, together with the respective application files, are sent to the official having the delegated authority to decide the petition. The petition may be referred to the examiner for a formal statement under 37 CFR 1.181(c) or for an informal memorandum.

QUESTION 268

What do you do with a PCT application where there were two missing parts of the specification, and the applicant filed them at two intervals.

The international filing date will be the date the timely filed correction is received by the receiving office.

MPEP 1810. There are only 30 days to do this, and so his 2nd submission was not entered.

QUESTION 269

Question on the rules about including trademarked names in an application.

- (A) maintain the VELCRO rejection because sufficient structure is not recited
- (B) maintain the rejection because VELCRO is a recognized prior art fastener, and this fastener would be obvious to replace with the current fastener
- (C) object to the trademark for being a trademark and request the applicant to modify the specification to include further structure

7.35.01 Trademark or Trade Name as a Limitation in the Claim. Claim [1] contains the

trademark/trade name [2]. Where a trademark or trade name 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. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe [3] and, accordingly, the identification/ description is indefinite.

QUESTION 270

Question on the experimental use and a 102(b) rejection.

Know that experimental use doesn't start the 1 year for a 102(b), but using it in a non-experimental way, even in a stupid way, starts the 1 year for 102(b). It does not matter if no one knew or could tell that the use was "public"

QUESTION 271

A phone was made in Spain. A US application covering the utility of the phone was filed within the appropriate time period. Later, the patent issues for the phone in Spain. Some time later, while the application is still at the USPTO, the inventors realize that they have a great looking phone and they want to get a patent for the design. What can they do?

- (A) File a design app claiming priority to the US application
- (B) File file a CIP of the utility application
- (C) Give up
- (D) File a design application with priority based off the Spanish patent application

(C). Give up since they only have 6 months for design patents under 35 U.S.C. 172.

QUESTION 272

An oath stating non-broadening is filed before two-year date, and then inventors decide to broaden it, right on the two-year anniversary. In one variant, they failed to use a Certificate of Mailing.

MPEP1412.03. Where any intent to broaden is indicated in the reissue application within the two years from the patent grant, a broadened claim can subsequently be presented in the reissue after the two year period. >Thus, a broadened claim may be presented in a reissue application after the two years, even though the broadened claim presented after the two years is different than the broadened claim presented within the two years.<

QUESTION 273

Applicant asserts that the claims do not rise or fail together, and the Examiner's Answer states that they do. What will the Board do as to the rejected claims?

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MPEP 1206. In the absence of a separate statement that the claims do not stand or fall together, the Board panel assigned to the case will normally select the broadest claim in a group and will consider only that claim, even though the group may contain two broad claims, such as “ABCDE” and “ABCDF.” The same would be true in a case where there are both broad method and apparatus claims on appeal in the same group. The rationale behind the rule, as amended, is to make the appeal process as efficient as possible. Thus, while the Board will consider each separately argued claim, the work of the Board can be done in a more efficient manner by selecting a single claim from a group of claims when the appellant does not meet the requirements of 37 CFR 1.192(c)(7). It should be noted that 37 CFR 1.192(c)(7) requires the appellant to perform two affirmative acts in his or her brief in order to have the separate patentability of a plurality of claims subject to the same rejection considered. The appellant must (A) state that the claims do not stand or fall together and (B) present arguments why the claims subject to the same rejection are separately patentable. Where the appellant does neither, the claims will be treated as standing or falling together. Where, however, the appellant (A) omits the statement required by 37 CFR 1.192(c)(7) yet presents arguments in the argument section of the brief, or (B) includes the statement required by 37 CFR 1.192(c)(7) to the effect that one or more claims do not stand or fall together (i.e., that they are separately patentable) yet does not offer argument in support thereof in the “Argument” section of the brief, the appellant should be notified of the noncompliance.

QUESTION 274

How can an applicant withdraw his appeal once the Examiner's Answer was filed, and have some new prior art considered?

- (A) file an RCE.
- (B) filing a Continuation.

MPEP 1215.01. Prior to a decision by the Board, if an applicant wishes to withdraw an application from appeal and to reopen the prosecution of the application, applicant can file a request for continued examination (RCE) under 37 CFR 1.114, accompanied by a submission (i.e., a reply responsive within the meaning of 37 CFR 1.111 to the last outstanding Office action) and the RCE fee set forth under 37 CFR 1.17(e). Note that the RCE practice under 37 CFR 1.114 does not apply to utility or plant patent applications filed before June 8, 1995, design applications, or reexamination proceedings. To avoid the rendering of decisions by the Board in applications which have already been refiled as continuations, applicants should promptly inform the clerk of the Board in writing as soon as they have positively decided to refile or to abandon an application containing an appeal awaiting a decision. Applicants also should advise the Board when an RCE is filed in an application containing an appeal awaiting decision. Failure to exercise appropriate diligence in this matter may result in the Board refusing an otherwise proper request to vacate its decision.

QUESTION 275

To what extent is a Federal Court decision binding on the Office: if the Court finds it valid, or if the Court finds it invalid?

MPEP 2286. The issuance of a final Federal Court decision upholding validity during an ex parte

reexamination also will have no binding effect on the examination of the reexamination. [...] The Office is not bound by a court's holding of patent validity and should continue the reexamination. The court notes that district courts and the Office use different standards of proof in determining invalidity, and thus, on the same evidence, could quite correctly come to different conclusions. Specifically, invalidity in a district court must be shown by "clear and convincing" evidence, whereas in the Office, it is sufficient to show nonpatentability by a "preponderance of evidence." Since the "clear and convincing" standard is harder to satisfy than the "preponderance" standard, deference will ordinarily be accorded to the factual findings of the court where the evidence before the Office and the court is the same. If sufficient reasons are present, claims held valid by the court may be rejected in reexamination. On the other hand, a final Federal Court holding of invalidity or unenforceability (after all appeals), is binding on the Office. Upon the issuance of a final holding of invalidity or unenforceability, the claims held invalid or unenforceable will be withdrawn from consideration in the reexamination. The reexamination will continue as to any remaining claims.

QUESTION 276

The Board having remanded the application to the Examiner with new grounds for rejection, and the applicant wanted to reinstate his appeal. Does he need to file a new Appeal Brief or can he proceed without one?

MPEP 1214.01. When the Board makes a new rejection under 37 CFR 1.196(b), the appellant, as to each claim so rejected, has the option of: (A) submitting an appropriate amendment and/or a showing of facts (37 CFR 1.196(b)(1)); or (B) requesting rehearing (37 CFR 1.196(b)(2)).

QUESTION 277

A continuation application where a restriction requirement has been made. Can the applicant file the application with all the original claims?

804.01. A restriction requirement in an earlier-filed application does not carry over to claims of a continuation application in which the examiner does not reinstate or refer to the restriction requirement in the parent application. Reliance on a patent issued from such a continuation application to reject claims in a later-filed divisional application is not prohibited under 35 U.S.C. 121.

QUESTION 278

Who can sign the assertion of small entity status, and what happens if the status changes before the issuance?

509.03. Parties who can sign and file the written assertion. The written assertion can be signed by: an attorney or agent registered with the Office), who can also file the written assertion; At least one of the individuals identified as an inventor (even though an executed oath or declaration has not been submitted), who can also file the written assertion pursuant to the exception under § 1.33(b) of this part; or An assignee of an undivided part interest, but the partial assignee cannot file the assertion without resort to a party identified above. New determination of entitlement to small entity status is needed when issue and maintenance fees

are due. Once status as a small entity has been established in an application or patent, fees as a small entity may thereafter be paid in that application or patent without regard to a change in status until the issue fee is due or any maintenance fee is due.

QUESTION 279

What can an assignee sign if he has never properly recorded his ownership?

37 CFR 3.71. Patents — conducting of prosecution. One or more assignees as defined in paragraph (b) of this section may, after becoming of record pursuant to paragraph (c) of this section, conduct prosecution of a national patent application or a reexamination proceeding to the exclusion of either the inventive entity, or the assignee(s) previously entitled to conduct prosecution.

(b) Patents — assignee(s) who can prosecute. The assignee(s) who may conduct either the prosecution of a national application for patent or a reexamination proceeding are:

(1) A single assignee. An assignee of the entire right, title and interest in the application or patent being reexamined who is of record, or

(2) Partial assignee(s) together or with inventor(s). All partial assignees, or all partial assignees and inventors who have not assigned their right, title and interest in the application or patent being reexamined, who together own the entire right, title and interest in the application or patent being reexamined. A partial assignee is any assignee of record having less than the entire right, title and interest in the application or patent being reexamined.

(c) Patents — Becoming of record. An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.

MPEP 324. Examples of situations where ownership need not be established under 37 CFR 3.73(b) are when the assignee: signs a request for a continued prosecution application under 37 CFR 1.53(d), where papers establishing ownership under 37 CFR 3.73(b) were filed in the prior application and ownership has not changed; signs a small entity statement; signs a statement of common ownership of two inventions; signs a NASA or DOE property rights statement; signs an affidavit under 37 CFR 1.131 where the inventor is unavailable; signs a certificate under 37 CFR 1.8; or files a request for reexamination of a patent under 37 CFR 1.510.

QUESTION 280

A claim with a door having a doorknob, using “means” language, and the cited prior art discloses a handle, and how do you overcome the reference?

Answer, an amendment to the claim substituting for the term "means for pulling the door open" the structure of a handle and a knob.

35 U.S.C. 112, paragraph 6. An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

2173.05(i). The current view of the courts is that there is nothing inherently ambiguous or

uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph. [...] 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.

QUESTION 281

Do you have to file an English translation of a foreign-language reference?

§ 1.98 Content of information disclosure statement. (3)(i) A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from applicant's specification or incorporated therein. (ii) A copy of the translation if a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c).

QUESTION 282

Variation 1. X invented a fishing device but passed away before application is filed. The heir is 13 years old and legally incapacitated. There is the attorney, Y, in living will. Can the Y file application?

409.01. In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent. Where the inventor dies during the time intervening between the filing of the application and the granting of a patent thereon, the letters patent may be issued to the legal representative upon proper intervention.

Variation 2. Inventor is dead, appointed best friend as executor/administrator of will. Son thinks that he will be one of the heirs of the estate. Wants to go ahead and file for patent application using Dad's invention. The estate is over the minimum sum required by state law for the appointment of administrator.

409.01. Executor/legal representative has to be the one to file application (sign oath etc.) in this case. Heirs can file only if there is no will, or no executor is appointed in will and estate was under the sum required by the state for appointing an executor.

Variation 3. Death of inventor AFTER application is filed, and AFTER assignment of all rights, BEFORE allowance

409.01(e). When an applicant who has prosecuted an application after assignment, dies, the administrator of the deceased applicant's estate may carry on the prosecution upon filing letters of administration unless and until the assignee intervenes.

QUESTION 283

How long do you have to correct a PCT application with no address after you are invited to correct the problem.

PCT Rule 20.6. Invitation to Correct ... (b) The receiving Office shall promptly mail the invitation to the applicant and shall fix a time limit, reasonable under the circumstances of the case, for filing the correction. The time limit shall not be less than 10 days, and shall not exceed one month, from the date of the invitation. If such time limit expires after the expiration of one year from the filing date of any application whose priority is claimed, the receiving Office may call this circumstance to the attention of the applicant.

MPEP 1810. The International Application (PCT) filing date accorded the application is the date of compliance with the invitation to correct. It should be noted that, based on my reading of this section, an applicant can apparently lose his/her rights to priority if the deficiency in the IA is not cleared up within 12 months from the date of priority, if any, claimed in the International Application EVEN IF the time to respond to the invitation to correct has not expired.

QUESTION 284

What is required if you don't make a demand and want to proceed straight to the national stage?

MPEP 1893.01. In the absence of an express request for early processing of an international application the U.S. national stage will commence upon expiration of 30 months from the priority date of the international application. The national stage may commence earlier than 30 months from the priority date, provided applicant makes an express request for early processing and has complied with the applicable requirements.

QUESTION 285

Claims 1 and 2 rejected and appealed to the board. The board affirms rejection on 1, but overturns the rejection on 2. The Board then enters new rejection on 2. The applicant chooses to reopen prosecution on 2, and claim 2 rejected again. What should applicant do - file new appeal on 2, or file new appeal on 2 and get judicial review on rejection 1 at the same time?

MPEP 1214.01. If the appellant elects to proceed before the examiner with regard to the new rejection, the Board's affirmance of the examiner's rejection will be treated as nonfinal for purposes of seeking judicial review, and no request for reconsideration of the affirmance need be filed at that time. The new ground of rejection raised by the Board does not reopen prosecution except as to that subject matter to which the new rejection was applied. If the Board's decision in which the rejection under 37 CFR 41.50(b) was made includes an affirmance of the examiner's rejection, the basis of the affirmed rejection is not open to further prosecution. If the appellant elects to proceed before the examiner with regard to the new rejection, the Board's affirmance of the examiner's rejection will be treated as nonfinal for purposes of seeking judicial review, and no request for reconsideration of the affirmance need be filed at that time. Prosecution before the examiner of the 37 CFR 41.50(b) rejection can incidentally result in overcoming the affirmed rejection even though the affirmed rejection is

not open to further prosecution. Therefore, it is possible for the application to be allowed as a result of the limited prosecution before the examiner of the 37 CFR 41.50(b) rejection. If the application becomes allowed, the application should not be returned to the Board. Likewise, if the application is abandoned for any reason, the application should not be returned to the Board. If the rejection under 37 CFR 41.50(b) is not overcome, the applicant can file a second appeal (as discussed below). Such appeal must be limited to the 37 CFR 41.50(b) rejection and may not include the affirmed rejection. If the application does not become allowed or abandoned as discussed above, once prosecution of the claims which were rejected under 37 CFR 41.50(b) is terminated before the examiner, the application file must be returned to the Board so that a decision making the original affirmance final can be entered.

QUESTION 286

A Canadian patent agent is living in America, can he file patent on behalf of inventor X living in the US?

MPEP 402. A power of attorney or authorization given to a registered Canadian patent agent, to be valid, must be given by the applicants, all of whom are located in Canada. See 37 CFR 10.6(c). 37 CFR 10.6 (c). Any foreigner not a resident of the United States who shall file proof to the satisfaction of the Director that he or she is registered and in good standing before the patent office of the country in which he or she resides and practices and who is possessed of the qualifications stated in § 10.7, may be registered as a patent agent to practice before the Office for the limited purpose of presenting and prosecuting patent applications of applicants located in such country, provided: The patent office of such country allows substantially reciprocal privileges to those admitted to practice before the United States Patent and Trademark Office. Registration as a patent agent under this paragraph shall continue only during the period that the conditions specified in this paragraph obtain. . . . Upon ceasing to reside in such country, the patent agent registered under this section is no longer qualified to be registered under this section, and the OED Director shall promptly remove the name of the patent agent from the register and publish the fact of removal.

QUESTION 287

Practitioner submitted a Information Disclosure Statement within three months after receiving communication from a foreign patent office. Application has already been allowed, but issue fee hasn't been paid yet. In the required 37 CFR 1.97(e) statement the wording doesn't explicitly mention that the information from the foreign patent office was the first such citation from a foreign patent office in a counterpart application.

MPEP 609. If an information disclosure statement includes a copy of a dated communication from a foreign patent office which clearly shows that the statement is being submitted within 3 months of the date on the communication, the copy will be accepted as the required *>statement under 37 CFR 1.97(e)(1)<. It will be assumed, in the absence of evidence to the contrary, that the communication was for a counterpart foreign application.

Since you're after a notice of allowance, merely filing the IDS with appropriate fee and statement within 30 days of the applicant's receipt of allowance may deduct from the accumulated PTA (filing an IDS after allowance is a delaying action that reduces PTA). However,

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filing within 30 days of a foreign office's sending of a notification does not trigger the PTA reduction.

QUESTION 288

Where in an application do you claim benefit of an earlier application?

in the first sentence of the specification
in the application data sheet
in the oath or declaration.

MPEP 201.11. An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)).

QUESTION 289

Applicant submits three different amendments to the UPSTO as the Receiving Office of a PCT application. One correcting a misspelled word "ccar"; one adding a drawing that was accidentally left out but is in earlier filed provisional or non-provisional application benefit of which is claimed; and one adding a page to explain in the specification something clearly shown on a drawing. What will the USPTO do?

MPEP 1836. Obvious errors in the international application or other papers submitted by the applicant may generally be rectified under PCT Rule 91, if the rectification is authorized, as required, within the applicable time limit. [...] The omission of entire sheets of the description cannot be rectified, even if resulting from inattention at the stage of copying or assembling sheets. Applicants often attempt to rely upon the priority application to establish a basis for obvious error. The priority document (application) cannot be used to support obvious error corrections. The rectification is obvious only in the sense that anyone would immediately realize that nothing else could have been intended than what is offered as rectification.

Examples of obvious errors that are rectifiable include linguistic errors, spelling errors and grammatical errors so long as the meaning of the disclosure does not change upon entry of the rectification. Changes to chemical or mathematical formulas would not generally be rectifiable unless they would be common knowledge to anyone. < A missing chemical formula or missing line of text would not be considered > to be an < obvious error subject to rectification. **

QUESTION 290

Applicant accidentally paid large entity filing fee even though entitled to small entity status. Can he get a refund and how long does he have to apply?

37 CFR 1.28(a). A refund pursuant to § 1.26, based on establishment of small entity status, of a portion of fees timely paid in full prior to establishing status as a small entity may only be obtained if an assertion under § 1.27(c) and a request for a refund of the excess amount are filed within three months of the date of the timely payment of the full fee. The three-month time period is not extendable under § 1.136. Status as a small entity is waived for any fee by the

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failure to establish the status prior to paying, at the time of paying, or within three months of the date of payment of, the full fee.

QUESTION 291

Applicant has one utility claim and more than 700 claims covering small ornamental differences.

Answer - the examiner should call the applicant and have him select a few claims for examination. MPEP 2173.05. If a rejection on multiplicity is in order the examiner should make a telephone call explaining that the claims are unduly multiplied and will be rejected on that ground. MPEP 408. The examiner should request selection of a specified number of claims for purposes of examination.

QUESTION 292

Examiner finds a new prior art reference based on which the claim should be rejected - but the notice of allowance has already been sent. Now what?

MPEP 1308.01. A claim noted as allowable shall thereafter be rejected only with the approval of the primary examiner. Great care should be exercised in authorizing such rejection. MPEP 706.04. When a new reference is discovered, which obviously is applicable to one or more of the allowed claims in an application in issue, a memorandum is addressed to the Technology Center Director, requesting that the application be withdrawn from issue for the purpose of applying the new reference. This memorandum should cite the reference, and, if need be, briefly state its application. The memorandum should be submitted with the reference and the file wrapper, if the application file is in paper.

QUESTION 293

Prior art exclusion on an application that was filed in October of 1998, what to do?

706.02(l)(1). Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." This change to 35 U.S.C. 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.53(b), continued prosecution application filed under 37 CFR 1.53(d), and reissues. The amendment to 35 U.S.C. 103(c) does not affect any application filed before November 29, 1999, a request for examination under 37 CFR 1.129 of such an application, nor a request for continued examination under 37 CFR 1.114 of such an application.

QUESTION 294

A maintenance fee was paid, but the patent was not identified correctly with the payment, so the USPTO mailed the check back. What to do?

1.377. (a) Any patentee who is dissatisfied with the refusal of the Patent and Trademark Office to accept and record a maintenance fee which was filed prior to the expiration of the patent

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may petition the Director to accept and record the maintenance fee. (b) Any petition under this section must be filed within two months of the action complained of, or within such other time as may be set in the action complained of, and must be accompanied by the fee set forth in § 1.17(g). The petition may include a request that the petition fee be refunded if the refusal to accept and record the maintenance fee is determined to result from an error by the Patent and Trademark Office. (c) Any petition filed under this section must comply with the requirements of § 1.181(b) and must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest.

MPEP 2580. Any correspondence not containing such identification will be returned to the sender where a return address is available. The returned correspondence will be accompanied with a cover letter which will indicate to the sender that if the returned correspondence is resubmitted to the Patent and Trademark Office within two weeks of the mail date on the cover letter, the original date of receipt of the correspondence will be considered by the Patent and Trademark Office as the date of receipt of the correspondence.

This petition [under §1.377] may be used, for example, in situations where an error is present in the identifying data required by 37 CFR 1.366(c) with the maintenance fee payment, i.e., either the patent number or the application number * >is< incorrect." However, "A petition under 37 CFR 1.377 would not be appropriate where the patentee paid a maintenance fee on one patent when the patentee intended to pay the maintenance fee on a different patent but through error identified the wrong patent number and application number."

QUESTION 295

Was a claim indefinite because it used the word 'high' instead of a range?

No, as long as there is enough description in the specification that would allow one of ordinary skill in the art to know what 'high' means. MPEP 2181.

QUESTION 296

Applicant filed Japanese app. Then file PCT app, correctly claiming priority. Then file USA national stage app. But there is prior art against USA application. The prior art may be overcome if applicant can make a claim of priority to the Japanese National application. Can the claim of priority be made?

MPEP1828. Effective July 1, 1998, applicant may correct or add a priority claim by a notice submitted to the Receiving Office or the International Bureau within 16 months from the priority date, or where the priority date is changed, within 16 months from the priority date so changed, whichever period expires first, provided that a notice correcting or adding a priority claim may in any event be submitted until the expiration of 4 months from the international filing date.

QUESTION 297

Number of Rejections Required for Appeal purposes when count from parent to continuation have a certain number of claims.

MPEP 1204. The limitation of "twice rejected" does not have to be related to a particular application.... For example, if any claim was rejected in a parent application, and the claim is again rejected in a continuing application, then applicant can choose to file an appeal in the continuing application, even if the claim was rejected only once in the continuing application. >Applicant cannot file an appeal in a continuing application, or after filing a request for continued examination (RCE) under 37 CFR 1.114, until the application is under a rejection.

QUESTION 298

A patent containing claims 1-10 has issued. The subject matter of claims 1-5 was invented by inventor A, who has assigned his rights to your client, company C. The subject matter of claims 6-10 was invented by inventor B, who refuses to cooperate with company C unless he is the sole named inventor of his own patent. Company C wishes to divide the claims such that one patent contains only claims 1-5 and has inventor A as the sole inventor, and another patent contains claims 6-10 and has inventor B as the sole inventor. How should you advise your client?

- A) this is impossible
- B) use a certificate of correction to cancel claims 6-10 and remove inventor B from the patent, and file a divisional application on claims 6-10 listing B as the inventor
- C) file a reissue, cancel claims 6-10, and remove B as an inventor
- D) file a reissue of the original application along with a divisional reissue, cancel claims 1-5 and remove inventor A from the first reissue, move claims 6-10 and inventor B to the divisional reissue
- E) file two simultaneous reissue applications from the same patent, cancel claims 1-5 and remove inventor A from the first reissue, cancel claims 6-10 and remove inventor B from the second reissue.

MPEP 1451. 37 CFR 1.176(b) permits the examiner to require restriction in a reissue application between the original claims of the patent and any newly added claims which are directed to a separate and distinct invention(s). As a result of such a restriction requirement, divisional applications may be filed for each of the inventions identified in the restriction requirement. Applicant may initiate a division of the claims by filing more than one reissue application in accordance with 37 CFR 1.177. The multiple reissue applications which are filed may contain different groups of claims from among the original patent claims, or some of the reissue applications may contain newly added groups (not present in the original patent).

QUESTION 300

A hairdresser found that his competitor received a patent for a product that he was selling on year before the patent was issued. He has an advertisement to prove this. What should he do?

MPEP 2609. Reissue and certificates of correction have to be requested by the inventors or the assignee (consent of inventors needed for broadening reissue). A competitor can request reexam (either inter partes or ex parte) only if there is a patent or printed publication raising a substantial new question of patentability. If the advertisement constitutes a printed publication (with sufficient disclosure to raise substantial new question of patentability), then ex parte reexam would be available to the competitor, based on facts above. Inter partes reexam would

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be available only if the application was filed on or after Nov 29, 1999.

QUESTION 301

How do you determine equivalence in a means-plus-function situation?

MPEP 2183. If the examiner finds that a prior art element (A) performs the function specified in the claim, (B) is not excluded by any explicit definition provided in the specification for an equivalent, and (C) is an equivalent of the means- (or step-) plus-function limitation, the examiner should provide an explanation and rationale in the Office action as to why the prior art element is an equivalent. Factors that will support a conclusion that the prior art element is an equivalent are: (A) the prior art element performs the identical function specified in the claim in substantially the same way, and produces substantially the same results as the corresponding element disclosed in the specification. ... (B) a person of ordinary skill in the art would have recognized the interchangeability of the element shown in the prior art for the corresponding element disclosed in the specification... (C) there are insubstantial differences between the prior art element and the corresponding element disclosed in the specification... (D) the prior art element is a structural equivalent of the corresponding element disclosed in the specification...

QUESTION 302

In what situation does the PTO still investigate violations of 37 CFR 1.56?

MPEP 1448. The Office no longer investigates and rejects reissue applications under 37 CFR 1.56. The Office will not comment upon duty of disclosure issues which are brought to the attention of the Office in reissue applications except to note in the application, in appropriate circumstances, that such issues are no longer considered by the Office during its examination of patent applications.

...Form paragraph 14.21.09 should be used where the examiner becomes aware of a judicial determination of fraud, inequitable conduct or violation of the duty of disclosure on the part of the applicant independently of the record of the case, i.e., the examiner has external knowledge of the judicial determination. Form paragraph 14.22 should be used where, in the application record, there is (a) an explicit, unequivocal admission by applicant of fraud, inequitable conduct or violation of the duty of disclosure which is not subject to other interpretation, or (b) information as to a judicial determination of fraud, inequitable conduct or violation of the duty of disclosure on the part of the applicant. External information which the examiner believes to be an admission by applicant should never be used by the examiner, and such external information should never be made of record in the reissue application.

QUESTION 303

Extension fees when the Applicant has replied to a final Office action before 2 months after the mailing date of the Office action.

The date of mailing of the Examiner Advisory action resets the 3 month date for calculating extensions of time. If you respond to the final office action within 2 months and the examiner gives an advisory action after the 3 month deadline, then the extensions run from that point.

QUESTION 304

An application claimed a chemical that was useful for relieving headaches. The application did not disclose how to make the chemical. Examiner rejected the claim on enablement and written description. Applicant shows that a PHOSITA would know how to make said chemical and points formulas and technical data in the specification.

Examiner should withdraw both rejections in light of applicant's submissions.

QUESTION 305

After the Board makes a new rejection under 37 CFR 41.50(b), If an appellant files a new evidence as to less than all of the claims rejected by the Board under 37 CFR 41.50(b), and a request for rehearing as to the remainder of the claims so rejected, which one is correct?

MPEP 1214.01. The request for rehearing will be considered by the Board after prosecution before the examiner.

QUESTION 306

Person files a German application. Person later files a US application and forgets to claim priority from the earlier filed foreign application to get the benefit of the earlier filing date. The US patent issues and then person realizes that he/she did not make a claim for priority from the earlier German application or submit the certified copy. Assuming that all the timing requirements were met in order for the US patent to get the benefit of the German application how can the person perfect priority based on the German application?

Answer - file a reissue application along with the necessary fees, certified copy of the priority document (German Application), and English translation and a claim for priority.

MPEP 1402. A claim for priority can be perfected via reissue by a submission of certified copy of the priority document and the claim for priority it does not state whether the document had to be in English in order to get the benefit of the earlier filed application.

MPEP 201.13. When claiming priority to a foreign application, a translation is not necessary unless needed for interference, needed to overcome a specific reference in a rejection, or asked for by the examiner.

QUESTION 307

In an application having many claims, when would it be appropriate to limit the number or nature of the initial inquiry. Some situations exist where examination of an application appears best accomplished by limiting action on the claim thereof to a particular issue. These situations include the following:

MPEP 707.07(g). Where an application is too informal for a complete action on the merits; where there is an undue multiplicity of claims, and there has been no successful telephone request for election of a limited number of claims for full examination; where there is a misjoinder of inventions and there has been no successful telephone request for election; and where disclosure is directed to perpetual motion.

QUESTION 308

Claim number 4 in a set of 6 claims in an application was canceled via a pre-examination amendment, but the registered practitioner wanted to later reinstate the exact same claim. What to do?

MPEP 714. Submit an amendment adding claim number 7 with the exact words of the original claim number 4.

QUESTION 309

Which is not allowed – red ink?

MPEP 1302.04. Showing the proposed changes in RED for approval by the examiner.

MPEP 605.04(g). When the **>request is granted to add or delete inventors< under 37 CFR 1.48, the change should be noted in red ink in the left margin of the original oath or declaration > MPEP 714. The proposed drawing correction practice has been eliminated. No proposed changes in red ink should be submitted.

QUESTION 310

Variation 1. An article about a special titanium baseball put on public display in a museum is published. Is it public use if only "wealthy museum patrons who have no interest or skill to make baseballs" see it, when the general public sees it, or people who have the interest/skill to make baseballs can see it?

Variation 2. Article is published on Date W though not distributed. Article is put on display at museum on Date X, museum is only accessed at this time by wealthy museum patrons who don't have the skills to make baseballs (but the museum is a baseball museum). On Date Y, museum has a big PR event with news media etc. On Date Z, articles in museum are indexed and sorted. which date is the prior art date of the publication?

MPEP 2133.03(a)(2.). The person to whom the invention is publicly disclosed need not understand the significance and technical complexities of the invention.

A key to this question is also understanding that if a publication is only viewed by a few select members of the museum club, then it is not PUBLIC and therefore does NOT qualify as a 102(a) or 102(b) publication. It doesn't matter if it is properly shelved and catalogued.

Variation 3. The wealthy museum patrons who were allowed to view the baseball prior to the public grand opening were museum *members*, and the first viewing was opened to *members only*.

MPEP 2128.01, IV. In resolving whether or not a temporarily displayed reference that was neither distributed nor indexed was nonetheless made sufficiently publicly accessible to count as a "printed publication" under 35 U.S.C. 102(b), the court considered the following factors: "the length of time the display was exhibited, the expertise of the target audience, the existence (or lack thereof) of reasonable expectations that the material displayed would not be copied, and the simplicity or ease with which the material displayed could have been copied." Note that

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"printed publication" as used above applies to 102(a) as well.

Prior art date and public use date are two entirely separate issues. If the question asks for prior art date, then the answer is the date it is indexed and cataloged so someone can actually find it. If the question asks for the date of first public use, then the answer is the date the thing was displayed for museum patrons to see it, regardless whether the museum is semi private.

QUESTION 311

The use of "mirror" in the claims and whether its "reflective qualities" should be discussed in the specification.

Answer. The mirror in one part of the specification is "parallel," and the mirror in another part is "perpendicular," the specification is conflicting and one who has knowledge in the art would not be able to tell the difference so you amend the specification.

QUESTION 312

The inventor Tribell and an Aroma Therapy Kit, but with the name periodically swapped out with another name.

MPEP 1402. Broadening reissue as to the claims. No reissue for failure to file a divisional. Reissue applications that seek to broaden claims must be filed within two years of the issue date. Failing to file a divisional application claiming restricted claims during the pendency of the application subject to a restriction requirement is not an "error" that can be remedied in a reissue application.

QUESTION 313

Can the International Searching Authority amend/write an abstract if one were not supplied in an International Application.

MPEP 1844.01. The International Searching Authority shall establish an Abstract (if missing), and the applicant may within one month from the date of mailing of the international search report, submit comments on the abstract established by the International Searching Authority. MPEP 608.01(b). For a US national application the examiner is not allowed to supply an abstract if one isn't present, but can amend an existing abstract if that's the only thing preventing allowance.

QUESTION 314

Obviousness question.

2144.05. A prima facie case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention.

QUESTION 315

How do you extend your patent life by deleting a claim of benefit?

Answer. File an RCE.

Variation 2. In this version the applicant removed the claim himself?

201.11 G. He cannot avail himself of adding the claim as unintentional. As a result of the 20-year patent term, it is expected, in certain circumstances, that applicants may cancel their claim to priority by amending the specification or submitting a new application data sheet (no supplemental declaration is necessary) to delete any references to prior applications. [...] A cancellation of a benefit claim to a prior application may be considered as a showing that the applicant is intentionally waiving the benefit claim to the prior application in the instant application. If the applicant later files a petition to accept an unintentionally delayed claim to add the benefit claim to the prior application in the same application from which the benefit claim was canceled, the Office may refuse to accept such benefit claim because the delay was not unintentional.

QUESTION 316

What do you need to submit when entering the national stage in the case where the USPTO was the receiving office of the international application.

Only the fee, because if the USPTO is the RO you do not need to submit the application or wait for it to be transferred from IB. 1893.01(a)(1). Where the international application was filed with the United States Receiving Office as the competent receiving Office, the copy of the international application referred to in 37 CFR 1.495(b) is not required. Payment of the basic national fee will indicate applicant's intention to enter the national stage and will provide a U.S. correspondence address in most instances.

QUESTION 317

What can be faxed in PCT entering the stage in US?

MPEP 1834.01. You cannot file a PCT application or copy of application and fee to enter national stage by fax.

QUESTION 318

What will the USPTO do if: Japanese citizen currently residing in US files PCT application with USPTO but application is in Japanese - the choices were as follows:

MPEP 1805. The US RO will forward the application to the International bureau for processing, if the application was filed using USPTO but not in English, or if applicant not a resident/citizen of US at the time. The date of US filing will be date given the PCT application by the International Bureau, if all other requirements met, which is the date the application was received by the US office.

QUESTION 319

PCT designating USA filed in English claiming priority to JP application. Filing date was after Nov 29, 2000. IA published in English, and entered the National Stage. US application publication was published. Subsequently, the application was patented. When is the 102(e) prior art date?

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MPEP 2136. Revised 35 U.S.C. 102(e) allows the use of certain international application publications and U.S. patent application publications, and certain U.S. patents as prior art under 35 U.S.C. 102(e) as of their respective U.S. filing dates, including certain international filing dates. The prior art date of a reference under 35 U.S.C. 102(e) may be the international filing date if the international filing date was on or after November 29, 2000, the international application designated the United States, and the international application was published by the World Intellectual Property Organization (WIPO) under the Patent Cooperation Treaty (PCT) Article 21(2) in the English language.

MPEP § 706.02(f)(1). (1) If the international application meets the following three conditions: (a) an international filing date on or after November 29, 2000; (b) designated the United States; and (c) published under PCT Article 21(2) in English, then the international filing date is a U.S. filing date for prior art purposes under 35 U.S.C. 102(e). (3) If the international application has an international filing date prior to November 29, 2000, apply the reference under the provisions of 35 U.S.C. 102 and 374, prior to the AIPA amendments: (a) For U.S. patents, apply the reference under 35 U.S.C. 102(e) as of the earlier of the date of completion of the requirements of 35 U.S.C. 371(c)(1), (2) and (4) or the filing date of the later filed U.S. application that claimed the benefit of the international application; (b) For U.S. application publications and WIPO publications directly resulting from international applications under PCT Article 21(2), never apply these references under 35 U.S.C. 102(e). These references may be applied as of their publication dates under 35 U.S.C. 102(a) or (b); (c) For U.S. application publications of applications that claim the benefit under 35 U.S.C. 120 or 365(c) of an international application filed prior to November 29, 2000, apply the reference under 35 U.S.C. 102(e) as of the actual filing date of the later-filed U.S. application that claimed the benefit of the international application.

QUESTION 320

Suspended practitioner attempts to represent applicant, what will the USPTO do?

MPEP 105. The USPTO will not "ad litem" appoint a new practitioner if the one in the power of attorney is suspended. U.S. Patent and Trademark Office (USPTO) employees are forbidden to hold either oral or written communication with an attorney or agent who has been suspended or excluded from practice by the USPTO regarding an application unless it is one in which said attorney or agent is the applicant. Power to inspect given to such an attorney or agent will not be accepted.

QUESTION 321

How many and what kind of digital media do you have to submit with a gene sequence?

MPEP 2421.02 Basically, the sequence rules define a set of symbols and procedures that are both mandatory and the only way that an applicant is permitted to describe information about a sequence that falls within the definitions used in the rules. Thus, 37 CFR 1.821 defines a "sequence" and a "Sequence Listing" for the purpose of the rules, the requirements for specific symbols, and formats for the "Sequence Listing," the requirement for a computer readable form (CRF) of the "Sequence Listing," and the deadlines for complying with the requirements. 37 CFR

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1.822 to 37 CFR 1.824 set forth detailed descriptions of the requirements that are mandatory for the presentation of sequence data, and 37 CFR 1.825 sets forth procedures that are available to an applicant in the event that amendments to the sequence information or replacement of the computer readable copy become necessary.

§ 1.824. Form and format for nucleotide and/or amino acid sequence submissions in computer readable form. (a) The computer readable form required by § 1.821(e) shall meet the following requirements: (1) Diskette: 3.50 inch, 1.44 Mb storage; 3.50 inch, 720 Kb storage; 5.25 inch, 1.2 Mb storage; 5.25 inch, 360 Kb storage. (2) Magnetic tape: 0.5 inch, up to 24000 feet; Density: 1600 or 6250 bits per inch, 9 track; Format: Unix tar command; specify blocking factor (not "block size"); Line Terminator: ASCII Carriage Return plus ASCII Line Feed. (3) 8mm Data Cartridge: Format: Unix tar command; specify blocking factor (not "block size"); Line Terminator: ASCII Carriage Return plus ASCII Line Feed. (4) Compact disc: Format: ISO 9660 or High Sierra Format. (5) Magneto Optical Disk: Size/Storage Specifications: 5.25 inch, 640 Mb.

QUESTION 322

Who can sign a 1.132 petition showing that a previous invention was not by another?

Answer. The inventor is in a position to have the best knowledge of ownership of the invention, but the attorney can send in a statement.

37 CFR 10.18. For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature, personally signed by such practitioner, in compliance with § 1.4(d)(1) of this chapter. The oath or declaration may not be signed by an attorney on behalf of the inventor, even if the attorney has been given a power of attorney to do so.

37 CFR 1.33. (b) Amendments and other papers. Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by: (1) A patent practitioner of record appointed in compliance with § 1.32(b); (2) A patent practitioner not of record who acts in a representative capacity under the provisions of § 1.34; (3) An assignee as provided for under § 3.71(b) of this chapter; or (4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

QUESTION 323

Can you FAX your national stage application to the USRO?

Answer. No, it cannot.

1834.01. Generally, any paper may be filed by facsimile transmission with certain exceptions which are identified in 37 CFR 1.6(d). It should be noted that a facsimile transmission of a document is not permitted and, if submitted, will not be accorded a date of receipt if the document is: (A) Required by statute to be certified; (B) A drawing submitted under 37 CFR 1.437; (C) An international application for patent; or (D) A copy of the international application

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and the basic national fee necessary to enter the national stage, as specified in ** 37 CFR 1.495(b). Facsimile transmission may be used to submit substitute sheets (other than drawings), extensions of time, power of attorney, fee authorizations (other than the basic national fee), confirmation of precautionary designations, Demands, response to written opinions, oaths or declarations, petitions, and translations in international applications.

QUESTION 324

Question on submitting 52 tables in CD-ROM. 52 tables were divided into two portions; 1-26 and 27-52. Is this proper?

37 CFR 1.52. (4) Any compact disc must be submitted in duplicate unless it contains only the "Sequence Listing" in computer readable form required by § 1.821(e). The compact disc and duplicate copy must be labeled "Copy 1" and "Copy 2," respectively.

608.05(b). A single table contained on fifty pages or less must be submitted either as drawings (in compliance with 37 CFR 1.84) or as part of the specification in paper (in compliance with 37 CFR 1.52). A single table contained on 51 pages or more may be submitted on a CD-ROM or CD-R (in compliance with 37 CFR 1.52(e) and 37 CFR 1.58). The presentation of a subheading to divide a large table into smaller sections of less than 51 pages should not be used to prevent an applicant from submitting the table on a compact disc unless the subdivided tables are presented as numerous files on the compact disc so as to lose their relationship to the overall large table.

37 CFR 1.52. (e)(1)The following documents may be submitted to the Office on a compact disc in compliance with this paragraph: (iii)Any individual table (see § 1.58) if the table is more than 50 pages in length, or if the total number of pages of all of the tables in an application exceeds 100 pages in length, where a table page is a page printed on paper in conformance with paragraph (b) of this section and § 1.58(c).

QUESTION 325

What happens to the trade secret information in reexam if the Examiner finds it material to the patentability of the invention, and what if there is/or isn't a request to expunge the information?

MPEP 724. That wherever possible, trade secret law and patent laws should be administered in such manner that the former will not deter an inventor from seeking the benefit of the latter, because, the public is most benefited by the early disclosure of the invention in consideration of the patent grant. If a patent applicant is unwilling to pursue his right to a patent at the risk of certain loss of trade secret protection, the two systems will conflict, the public will be deprived of knowledge of the invention in many cases, and inventors will be reluctant to bring unsettled legal questions of significant current interest . . . for resolution.

MPEP 724.04. Any materials submitted under MPEP § 724.02 in a reexamination file open to the public under 37 CFR 1.11(d) will be treated in the following manner: (A) >Materials submitted under MPEP § 724.02 will only be released to the public with any other papers in the reexamination file if no petition to expunge (37 CFR 1.59) was filed prior to the mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC), or if a petition to expunge was filed

and the petition was denied.< The submitted information will be maintained separate from the reexamination file and will not be publicly available until a determination has been made as to whether or not the information is important to a reasonable examiner in deciding whether or not a claim is patentable. (B) >Prior to the mailing of a NIRC, the examiner will review the reexamination file and determine if a petition to expunge is in the reexamination file but not acted upon.< The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all of the information submitted is important to a reasonable examiner in deciding whether or not a claim is patentable. (C) If any portion or all of the submitted information is found important to a reasonable examiner in deciding whether or not a claim is patentable, **>the petition to expunge will be denied and the information< will thereafter become a permanent part of the reexamination file and open to the public. (D) If any portion or all of the submitted information is found not to be important to a reasonable examiner in deciding whether or not a claim is patentable,>the petition to expunge will be granted and the information expunged.< (E) >If a petition to expunge is not filed prior to the mailing of the NIRC, the materials submitted under MPEP § 724.02 will become a permanent part of the reexamination file and open to the public under 37 CFR 1.11(d).<

QUESTION 326

When is a supplemental oath or declaration treated as an amendment?

MPEP 714.16. With the exception of a supplemental oath or declaration submitted in a reissue, a supplemental oath or declaration is not treated as an amendment under 37 CFR 1.312. See MPEP § 603.01. A supplemental reissue oath or declaration is treated as an amendment under 37 CFR 1.312 because the correction of the patent which it provides is an amendment of the patent, even though no amendment is physically entered into the specification or claim(s). Thus, for a reissue oath or declaration submitted after allowance to be entered, the reissue applicant must comply with 37 CFR 1.312 in the manner set forth in this section.

QUESTION 327

Best mode question.

MPEP 2165.01. There is no requirement in the statute that applicants point out which of their embodiments they consider to be their best; that the disclosure includes the best mode contemplated by applicants is enough to satisfy the statute.

QUESTION 328

French application filed, then PCT application designating US filed claiming French application and IA was published in French. At some point within 30 months, without entering National Stage, applicant files continuation from PCT application, is the claim for French priority proper, and if so is it perfected?

MPEP 1895.01. A claim for foreign priority under 35 U.S.C. 119 (a)-(d) must be made in the continuing application in order to obtain the benefit of the filing date of the prior filed foreign application...A foreign priority claim is proper in the continuing application if the foreign

application was filed within 12 months prior to the filing of the continuing application or within 12 months prior to the international filing date of the parent international application. In addition, the required claim must be made within the time period set forth in 37 CFR 1.55 (a)(1)...A certified copy of any foreign priority document must be provided by the applicant unless the parent international application has entered the national stage under 35 U.S.C. 371 and the national stage application contains a photocopy of the priority document from the International Bureau.

So, the claim is proper, but not perfected because you still need to file the copy of the French national application because the parent IA hasn't entered the national stage as stated in the question (don't need translation until you need to rely on it for priority). The IB publishing the IA does not prevent need for the certified copy for 119(a) (foreign) priority.

QUESTION 329

A PCT application was filed in Germany before Nov 29, 2000, when to measure the US patent term?

MPEP 2701. A patent granted on an international application filed on or after June 8, 1995 and which enters the national stage under 35 U.S.C. 371 will have a term which ends twenty years from the filing date of the international application. A continuation or a continuation-in-part application claiming benefit under 35 U.S.C. 365(c) of an international application filed under 35 U.S.C. 363 designating the United States will have a term which ends twenty years from the filing date of the parent international application. Foreign priority under 35 U.S.C. 119(a)-(d), 365(a), or 365(b) is not considered in determining the term of a patent. Accordingly, an application claiming priority under 35 U.S.C. 365(a) or 365(b) has a term which ends twenty years from the filing date of the application in the United States and not the prior international application.

QUESTION 330

Applicant claims a toy plane whose wings are covered in aluminum foil. The spec describes a toy plane whose wings are covered in foil but whose body isn't. Reference discloses a plane that is covered entirely in chewing gum wrapper, which includes aluminum foil and another material. Claim is rejected, and applicant responds by arguing that covering only the wings in foil provides useful aerodynamic properties, and therefore the claimed invention is distinguishable from the reference. How should the examiner respond?

The examiner should maintain the rejection in view of practitioner's arguments. The claim is open-ended ("...comprising wings covered in aluminum foil"). Thus, the prior art anticipates the claim.

QUESTION 331

Company X gave their agent Y, the competitor's patent application number, and asked if the agent Y could get the information on the competitor's patent application; whether it has been published and publication date. By telephoning the office, how do you get such information?

MPEP 101. When handling an incoming telephone call or an in person request for information regarding an unpublished pending or abandoned patent application, no information should be disclosed until the identity of the requester can be adequately verified as set forth below. Particular care must be exercised when a request is made for the publication date or publication number, or issue date and patent number assigned to a pending patent application. If the publication or issue date is later than the current date (i.e., the date of the request), such information may be given only to the applicant, or the assignee of record, or the attorney or agent of record.

QUESTION 332

If you had a Certificate of Correction in the parent, and want to file preliminary amendment in a reissue application, what do you need to do?

1411.01. The applicant should include any changes, additions, or deletions that were made by a Certificate of Correction to the original patent grant in the reissue application without underlining or bracketing. The examiner should * make certain that all Certificate of Correction changes in the patent have been properly incorporated into the reissue application. Certificate of Correction changes and disclaimer of claim(s) under 37 CFR 1.321(a) should be made without using underlining or brackets. Since these are part of the original patent and were made before the reissue was filed, they should show up in the printed reissue >patent< document as part of the original patent, i.e., not in italics or bracketed. If the changes are extensive and/or applicant has submitted them improperly with underlining and brackets, a clean copy of the specification with the Certificate of Correction changes in it may be requested by the examiner.

QUESTION 333

Who do you need to contact when you are filing petition under CFR 1. 183 (Suspension of Rules)?

1002.01. Petitions, together with the respective application files, are sent to the official having the delegated authority to decide the petition.

1002.02. In accordance with 37 CFR 1.181(g), the authority to decide petitions to the Director of the USPTO ... has been delegated to various Office officials. Generally, these officials will decide petitions as specified in the following sections for the effective operation of the Office.

QUESTION 334

Can Velcro include trademarked names in an application?

2173.05(u). Claim [1] contains the trademark/trade name [2]. Where a trademark or trade name 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. The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the

trademark/trade name is used to identify/describe [3] and, accordingly, the identification/description is indefinite.

Thus, maintain the VELCRO rejection because sufficient structure is not recited.

QUESTION 335

What is experimental use and does it start 102(b) 1 year clock?

Experimental use doesn't start the 1 year for a 102(b), but using it in a non-experimental way, even in a stupid way, starts the 1 year for 102(b). It doesn't matter if no one knew or could tell that the use was "public".

QUESTION 336

A phone was made in Spain. A US application covering the utility of the phone was filed within the appropriate time period. Later, the patent issues for the phone in Spain. Some time later, while the application is still at the USPTO, the inventors realize that they have a great looking phone and they want to get a patent for the design. What can they do?

Give up since you only have 6 months for design patents under 35 U.S.C. 172.

35 U.S.C. 172. The right of priority provided for by subsections (a) through (d) of section 119 of this title and the time specified in section 102(d) shall be six months in the case of designs. The right of priority provided for by section 119(e) of this title shall not apply to designs.

MPEP 1504.10. The provisions of 35 U.S.C. 119(a)-(d) apply to design patent applications. However, in order to obtain the benefit of an earlier foreign filing date, the United States application must be filed within 6 months of the earliest date on which any foreign application for the same design was filed. Design applications may not make a claim for priority of a provisional application under 35 U.S.C. 119(e).

QUESTION 337

When an oath stating non-broadening is filed before two-year date, and then inventors decide to broaden it, right on the two-year anniversary, what result? In one variant, they failed to use a Certificate of Mailing.

1412.03. Where any intent to broaden is indicated in the reissue application within the two years from the patent grant, a broadened claim can subsequently be presented in the reissue after the two year period. >Thus, a broadened claim may be presented in a reissue application after the two years, even though the broadened claim presented after the two years is different than the broadened claim presented within the two years.<

QUESTION 338

Applicant asserts the claims do not rise or fail together, and the Examiner's Answer states that they do. What will the Board do as to the rejected claims?

MPEP 1206. In the absence of a separate statement that the claims do not stand or fall

together, the Board panel assigned to the case will normally select the broadest claim in a group and will consider only that claim, even though the group may contain two broad claims, such as “ABCDE” and “ABCDF.” The same would be true in a case where there are both broad method and apparatus claims on appeal in the same group. The rationale behind the rule, as amended, is to make the appeal process as efficient as possible. Thus, while the Board will consider each separately argued claim, the work of the Board can be done in a more efficient manner by selecting a single claim from a group of claims when the appellant does not meet the requirements of 37 CFR 1.192(c)(7). It should be noted that 37 CFR 1.192(c)(7) requires the appellant to perform two affirmative acts in his or her brief in order to have the separate patentability of a plurality of claims subject to the same rejection considered. The appellant must (A) state that the claims do not stand or fall together and (B) present arguments why the claims subject to the same rejection are separately patentable. Where the appellant does neither, the claims will be treated as standing or falling together. Where, however, the appellant (A) omits the statement required by 37 CFR 1.192(c)(7) yet presents arguments in the argument section of the brief, or (B) includes the statement required by 37 CFR 1.192(c)(7) to the effect that one or more claims do not stand or fall together (i.e., that they are separately patentable) yet does not offer argument in support thereof in the “Argument” section of the brief, the appellant should be notified of the noncompliance as per 37 CFR 1.192(d).

QUESTION 339

How can the applicant withdraw his appeal once the Examiner’s Answer is filed, and have some new prior art considered?

1215.01. Prior to a decision by the Board, if an applicant wishes to withdraw an application from appeal and to reopen the prosecution of the application, applicant can file a request for continued examination (RCE) under 37 CFR 1.114, accompanied by a submission (i.e., a reply responsive within the meaning of 37 CFR 1.111 to the last outstanding Office action) and the RCE fee set forth under 37 CFR 1.17(e). Note that the RCE practice under 37 CFR 1.114 does not apply to utility or plant patent applications filed before June 8, 1995, design applications, or reexamination proceedings. To avoid the rendering of decisions by the Board in applications which have already been refiled as continuations, applicants should promptly inform the clerk of the Board in writing as soon as they have positively decided to refile or to abandon an application containing an appeal awaiting a decision. Applicants also should advise the Board when an RCE is filed in an application containing an appeal awaiting decision. Failure to exercise appropriate diligence in this matter may result in the Board refusing an otherwise proper request to vacate its decision.

QUESTION 340

To what extent is a Federal Court decision binding on the Office if the Court finds it valid/invalid?

MPEP 2286. The issuance of a final Federal Court decision upholding validity during an ex parte reexamination also will have no binding effect on the examination of the reexamination. [...] The Office is not bound by a court’s holding of patent validity and should continue the reexamination. The court notes that district courts and the Office use different standards of proof in determining invalidity, and thus, on the same evidence, could quite correctly come to

different conclusions. Specifically, invalidity in a district court must be shown by “clear and convincing” evidence, whereas in the Office, it is sufficient to show nonpatentability by a “preponderance of evidence.” Since the “clear and convincing” standard is harder to satisfy than the “preponderance” standard, deference will ordinarily be accorded to the factual findings of the court where the evidence before the Office and the court is the same. If sufficient reasons are present, claims held valid by the court may be rejected in reexamination.

On the other hand, a final Federal Court holding of invalidity or unenforceability (after all appeals), is binding on the Office. Upon the issuance of a final holding of invalidity or unenforceability, the claims held invalid or unenforceable will be withdrawn from consideration in the reexamination. The reexamination will continue as to any remaining claims.

QUESTION 341

The Board remanded to the Examiner with a new ground of rejection, and the applicant wants to reinstate his appeal – does he need to file a new Appeal Brief or can he proceed without one?

1214.01. When the Board makes a new rejection under 37 CFR 1.196(b), the appellant, as to each claim so rejected, has the option of: (A) submitting an appropriate amendment and/or a showing of facts (37 CFR 1.196(b)(1)); or (B) requesting rehearing (37 CFR 1.196(b)(2)).

QUESTION 342

Applicant reopened prosecution (with amendment/evidence) as to some of the claims under the Board's New Grounds rejection, and requested Rehearing as to the rest of the claims under the Board's New Grounds rejection. So what happens, following Applicant's actions, and in what order?

1214.01 Prosecution is reopened as to the claims Applicant brought back before the Examiner, and only after termination of that prosecution, will the Board consider the request for rehearing.

QUESTION 343

One had to do with a Continuation of an application where a restriction requirement had been made, and the applicant had ignored the requirement and filed with all the original claims.

804.01. A restriction requirement in an earlier-filed application does not carry over to claims of a continuation application in which the examiner does not reinstate or refer to the restriction requirement in the parent application. Reliance on a patent issued from such a continuation application to reject claims in a later-filed divisional application is not prohibited under 35 U.S.C. 121.

QUESTION 344

Who can sign the assertion off on small entity status? What if status changes before issuance?

509.03. (2) Parties who can sign and file the written assertion. The written assertion can be signed by: (i) One of the parties identified in § 1.33(b) (e.g., an attorney or agent registered with

the Office), § 3.73(b) of this chapter notwithstanding, who can also file the written assertion; (ii) At least one of the individuals identified as an inventor (even though a § 1.63 executed oath or declaration has not been submitted), notwithstanding § 1.33(b)(4), who can also file the written assertion pursuant to the exception under § 1.33(b) of this part; or (iii) An assignee of an undivided part interest, notwithstanding §§ 1.33(b)(3) and 3.73(b) of this chapter, but the partial assignee cannot file the assertion without resort to a party identified under § 1.33(b) of this part. (g)(1) New determination of entitlement to small entity status is needed when issue and maintenance fees are due. Once status as a small entity has been established in an application or patent, fees as a small entity may thereafter be paid in that application or patent without regard to a change in status until the issue fee is due or any maintenance fee is due.

QUESTION 345

What can an assignee sign, if he has never properly recorded his ownership?

MPEP 324. Examples of situations where ownership need not be established under 37 CFR 3.73(b) are when the assignee: signs a request for a continued prosecution application under 37 CFR 1.53(d), where papers establishing ownership under 37 CFR 3.73(b) were filed in the prior application and ownership has not changed (MPEP § 201.06(d)); signs a small entity statement (MPEP § 509.03); signs a statement of common ownership of two inventions (MPEP § 706.02(l)(2)); signs a NASA or DOE property rights statement (MPEP § 151); signs an affidavit under 37 CFR 1.131 where the inventor is unavailable (MPEP § 715.04); signs a certificate under 37 CFR 1.8 (MPEP § 512); or files a request for reexamination of a patent under 37 CFR 1.510 (MPEP § 2210).

QUESTION 346

A claim with a door having a "means for opening the door", using "means-function" language, and the cited prior art discloses a pull-bar for opening a door, and how do you overcome the reference?

Answer. An amendment to the claim substituting for the term "means for pulling the door open" the structure of a handle and a knob. 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, the answer overcomes the lack of novelty rejection under these circumstances.

QUESTION 347

Do you have to file an English translation of a foreign-language reference.

§ 1.98. (3)(i) A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from applicant's specification or incorporated therein. (ii) A copy of the translation if a written English-language translation of a non-English-

language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c).

QUESTION 348

Death of inventor BEFORE application filed - many facts indicated that inventor had possession of invention prior to death. The heir is 13 years old and legally incapacitated. Barbara is the attorney in living will.

37 CFR 1.42. In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent. Where the inventor dies during the time intervening between the filing of the application and the granting of a patent thereon, the letters patent may be issued to the legal representative upon proper intervention.

QUESTION 349

The Inventor is dead, but has appointed his best friend as executor/administrator of will. The inventor's son thinks that he will be one of the heirs of the estate and wants to file a patent application using Dad's invention. The estate is over the minimum sum required by state law for the appointment of administrator.

409.01. Executor/legal representative has to be the one to file application (sign oath etc) in this case. Heirs can file only if there is no will, or no executor appointed in will and estate was under the sum required by the state for appointing an executor.

QUESTION 350

Death of inventor after the application is filed, and after the assignment of all rights, but before the allowance.

409.01(e). When an applicant who has prosecuted an application after assignment, dies, the administrator of the deceased applicant's estate may carry on the prosecution upon filing letters of administration unless and until the assignee intervenes.

QUESTION 351

Inventor dies after filing application and assigning partial interest to his patent attorney, what result?

Answer. Prosecution may continue without any filing by the inventor's estate.

QUESTION 352

How long do you have to correct a PCT application with no address after you are invited to correct the problem?

PCT Rule 20.6. (b) The receiving Office shall promptly mail the invitation to the applicant and shall fix a time limit, reasonable under the circumstances of the case, for filing the correction. The time limit shall not be less than 10 days, and shall not exceed one month, from the date of

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the invitation. If such time limit expires after the expiration of one year from the filing date of any application whose priority is claimed, the receiving Office may call this circumstance to the attention of the applicant.

MPEP 1810. The International Application (PCT) filing date accorded the application is the date of compliance with the invitation to correct. It should be noted that, based on my reading of this section, an applicant can apparently lose his/her rights to priority if the deficiency in the IA is not cleared up within 12 months from the date of priority, if any, claimed in the International Application--EVEN IF the time to respond to the invitation to correct has not expired.

QUESTION 353

What is required if you don't make a demand and want to proceed straight to the national stage?

MPEP 1893.01: "Thus, in the absence of an express request for early processing of an international application under 35 U.S.C. 371(f) and compliance with the conditions provided therein, the U.S. national stage will commence upon expiration of 30 months from the priority date of the international application. Pursuant to 35 U.S.C. 371(f), the national stage may commence earlier than 30 months from the priority date, provided applicant makes an express request for early processing and has complied with the applicable requirements under 35 U.S.C. 371(c)."

QUESTION 354

Two claims 1 and 2 rejected and appealed to the board. Board affirms rejection on 1. Board overturns rejection on 2. Board enters new rejection on 2. Applicant chooses to reopen prosecution on 2. Claim 2 is rejected again. What should the applicant do?

MPEP 1214.01. The new ground of rejection raised by the Board does not reopen prosecution except as to that subject matter to which the new rejection was applied. If the Board's decision in which the rejection under 37 CFR 41.50(b) was made includes an affirmance of the examiner's rejection, the basis of the affirmed rejection is not open to further prosecution. If the appellant elects to proceed before the examiner with regard to the new rejection, the Board's affirmance of the examiner's rejection will be treated as nonfinal for purposes of seeking judicial review, and no request for reconsideration of the affirmance need be filed at that time. Prosecution before the examiner of the 37 CFR 41.50(b) rejection can incidentally result in overcoming the affirmed rejection even though the affirmed rejection is not open to further prosecution. Therefore, it is possible for the application to be allowed as a result of the limited prosecution before the examiner of the 37 CFR 41.50(b) rejection. If the application becomes allowed, the application should not be returned to the Board. Likewise, if the application is abandoned for any reason, the application should not be returned to the Board. If the rejection under 37 CFR 41.50(b) is not overcome, the applicant can file a second appeal. Such appeal must be limited to the 37 CFR 41.50(b) rejection and may not include the affirmed rejection. If the application does not become allowed or abandoned as discussed above, once prosecution of the claims which were rejected under 37 CFR 41.50(b) is terminated before the examiner, the application file must be returned to the Board so that a decision making the original affirmance final can be entered.

QUESTION 355

Canadian patent agent living in America?

MPEP 402. A power of attorney or authorization given to a registered Canadian patent agent, to be valid, must be given by the applicants, all of whom are located in Canada.

37 CFR 10.6. (c) Foreigners. Any foreigner not a resident of the United States who shall file proof to the satisfaction of the Director that he or she is registered and in good standing before the patent office of the country in which he or she resides and practices and who is possessed of the qualifications stated in § 10.7, may be registered as a patent agent to practice before the Office for the limited purpose of presenting and prosecuting patent applications of applicants located in such country, provided: The patent office of such country allows substantially reciprocal privileges to those admitted to practice before the United States Patent and Trademark Office. Registration as a patent agent under this paragraph shall continue only during the period that the conditions specified in this paragraph obtain. . . Upon ceasing to reside in such country, the patent agent registered under this section is no longer qualified to be registered under this section, and the OED Director shall promptly remove the name of the patent agent from the register and publish the fact of removal.

QUESTION 356

Practitioner submitted a Information Disclosure Statement within three months after receiving communication from a foreign patent office. Application has already been allowed, but issue fee hasn't been paid yet. In the required 37 CFR 1.97(e) statement the wording doesn't explicitly mention that the information from the foreign patent office was the **first** such citation from a foreign patent office in a counterpart application.

MPEP 609. If an information disclosure statement includes a copy of a dated communication from a foreign patent office which clearly shows that the statement is being submitted within 3 months of the date on the communication, the copy will be accepted as the required *>statement under 37 CFR 1.97(e)(1)<. It will be assumed, in the absence of evidence to the contrary, that the communication was for a counterpart foreign application.

QUESTION 357

Question about where in an application you claim benefit of an earlier application. I believe answer options were combinations of a) in the first sentence of the specification, b) in the application data sheet and c) in the oath or declaration.

MPEP 201.11. An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) **in the first sentence of the specification or in an application data sheet** (37 CFR 1.78(a)(2) and (a)(5)).

QUESTION 358

How many claims does the basic filing fee involve?

MPEP 607. 37 CFR 1.16(h) sets forth the excess claims fee for each independent claim in excess

of three. 37 CFR 1.16(i) sets forth the excess claims fee for each claim (whether independent or dependent) in excess of twenty. The Consolidated Appropriations Act provides that the excess claims fees specified in 35 U.S.C. 41(a)(2) shall apply only as to those claims (independent or dependent) that, after taking into account any claims that have been canceled, are in excess of the number of claims for which the excess claims fee specified in 35 U.S.C. 41 was paid before December 8, 2004. Thus, the Office will charge the excess claims fees specified in 37 CFR 1.16(h) and (i) if an applicant in an application filed before and pending on or after December 8, 2004, adds a claim (independent or total) in excess of the number of claims (independent or total) for which the excess claims fee was previously paid (under the current or previous fee schedule). The excess claims fees specified in 37 CFR 1.16(h) and (i) apply to any excess claims fee paid on or after December 8, 2004, regardless of the filing date of the application and regardless of the date on which the claim necessitating the excess claims fee payment was added to the application.

QUESTION 359

Applicant submits three different amendments to the UPSTO as the Receiving Office of a PCT application: one correcting a misspelled word "ccar"; another adding a drawing that was accidentally left out but is in earlier filed provisional or non-provisional application benefit of which is claimed; and another adding a page to explain in the specification something clearly shown on a drawing. What will the USPTO do?

MPEP 1836. Obvious errors in the international application or other papers submitted by the applicant may generally be rectified under PCT Rule 91, if the rectification is authorized, as required, within the applicable time limit. [...] **The omission of entire sheets of the description cannot be rectified**, even if resulting from inattention at the stage of copying or assembling sheets. Applicants often attempt to rely upon the priority application to establish a basis for obvious error. The priority document (application) cannot be used to support obvious error corrections. The rectification is obvious only in the sense that anyone would immediately realize that nothing else could have been intended than what is offered as rectification.

Examples of obvious errors that are rectifiable include linguistic errors, **spelling errors** and grammatical errors so long as the meaning of the disclosure does not change upon entry of the rectification. Changes to chemical or mathematical formulas would not generally be rectifiable unless they would be common knowledge to anyone. < A missing chemical formula or missing line of text would not be considered >to be an< obvious error subject to rectification. **

QUESTION 360

Applicant accidentally paid large entity filing fee even though entitled to small entity status. Can he get a refund and how long does he have to apply?

37 CFR 1.28(a). A refund pursuant to § 1.26, based on establishment of small entity status, of a portion of fees timely paid in full prior to establishing status as a small entity may only be obtained if an assertion under § 1.27(c) and a request for a refund of the excess amount are filed **within three months** of the date of the timely payment of the full fee. The three-month time period is not extendable under § 1.136. Status as a small entity is waived for any fee by the failure to establish the status prior to paying, at the time of paying, or within three months of

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the date of payment of, the full fee.

QUESTION 361

Applicant has one utility claim and more than 900 claims covering small ornamental differences.

MPEP 2173.05(n). If a rejection on multiplicity is in order the examiner should make a telephone call explaining that the claims are unduly multiplied and will be rejected on that ground. Note MPEP Section 408. The examiner should request selection of a specified number of claims for purposes of examination.

QUESTION 362

Examiner finds a new prior art reference based on which the claim should be rejected, but the notice of allowance has already been sent. Now what?

MPEP 1308.01. A claim noted as allowable shall thereafter be rejected only with the approval of the primary examiner. Great care should be exercised in authorizing such rejection. When a new reference is discovered, which obviously is applicable to one or more of the allowed claims in an application in issue, a * >memorandum< is addressed to the Technology Center (TC) Director, requesting that the application be withdrawn from issue for the purpose of applying the new reference. This * >memorandum< should cite the reference, and, if need be, briefly state its application. The * >memorandum< should be submitted with the reference and the file wrapper>, if the application file is in paper<.

QUESTION 363

One question requires you to know that 35 U.S.C. 103(c) prior art exclusion only applies to applications filed on or after November 29, 1999.

706.02(l)(1). Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." This change to 35 U.S.C. 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.53(b), continued prosecution application filed under 37 CFR 1.53(d), and reissues. The amendment to 35 U.S.C. 103(c) does not affect any application filed before November 29, 1999, a request for examination under 37 CFR 1.129 of such an application, nor a request for continued examination under 37 CFR 1.114 of such an application.

The amendment to 35 U.S.C. 103(c) made by the AIPA to change "subsection (f) or (g)" to "one of more of subsections (e), (f), or (g)" applies to applications filed on or after November 29, 1999.

QUESTION 364

Maintenance fee was paid, but the patent was not identified correctly with the payment, so the USPTO mailed the check back. What are the options?

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Answer options refer to 37 CFR 1.377. *Review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of patent* and 37 CFR 1.378. *Acceptance of delayed payment of maintenance fee in expired patent to reinstate patent.*

37 CFR 1.5. Any correspondence not containing such identification will be returned to the sender where a return address is available. The returned correspondence will be accompanied with a cover letter which will indicate to the sender that **if the returned correspondence is resubmitted to the Patent and Trademark Office within two weeks of the mail date on the cover letter, the original date of receipt of the correspondence will be considered by the Patent and Trademark Office as the date of receipt of the correspondence.**

1.377. Review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of patent. (a) Any patentee who is dissatisfied with the refusal of the Patent and Trademark Office to accept and record a maintenance fee which was filed prior to the expiration of the patent may petition the Director to accept and record the maintenance fee. (b) **Any petition under this section must be filed within two months of the action complained of,** or within such other time as may be set in the action complained of, and must be accompanied by the fee set forth in § 1.17(g). The petition may include a request that the petition fee be refunded if the refusal to accept and record the maintenance fee is determined to result from an error by the Patent and Trademark Office. (c) Any petition filed under this section must comply with the requirements of § 1.181(b) and must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest.

MPEP 2580: "This petition [under §1.377] may be used, for example, in situations where an error is present in the identifying data required by 37 CFR 1.366(c) with the maintenance fee payment, i.e., either the patent number or the application number * >is< incorrect." However, "A petition under 37 CFR 1.377 would not be appropriate where the patentee paid a maintenance fee on one patent when the patentee intended to pay the maintenance fee on a different patent but through error identified the wrong patent number and application number."

QUESTION 365

What can an assignee do before taking ownership?

MPEP 324 part VII. Sign a small entity statement.

QUESTION 366

Invention has 2 layers x + z "congruous all the way" in between the layers. Prior art has 2 layers x + z + "something" in between the layers. Which claim is anticipated?

Answer. The claim is mentioned because it's broad enough to be read as Prior Art.

QUESTION 367

Applicant filed Japanese application, then he filed a PCT application, correctly claiming priority. Then he filed a USA national stage application, but there is prior art against USA application. Can the prior art be overcome if applicant can make a claim of priority to the Japanese National application?

MPEP1828. Effective July 1, 1998, applicant may correct or add a priority claim by a notice submitted to the Receiving Office or the International Bureau within 16 months from the priority date, or where the priority date is changed, within 16 months from the priority date so changed, whichever period expires first, provided that a notice correcting or adding a priority claim may in any event be submitted until the expiration of 4 months from the international filing date.

QUESTION 368

Have X # of claims. All rejected. File continuation with same X claims. rejected in continuation. Can you appeal to board?

MPEP 1204. The limitation of "twice rejected" does not have to be related to a particular application.... For example, if any claim was rejected in a parent application, and the claim is again rejected in a continuing application, then applicant can choose to file an appeal in the continuing application, even if the claim was rejected only once in the continuing application. >Applicant cannot file an appeal in a continuing application, or after filing a request for continued examination (RCE) under 37 CFR 1.114, until the application is under a rejection.

QUESTION 369

A patent containing claims 1-10 has issued. The subject matter of claims 1-5 was invented by inventor A, who has assigned his rights to your client, company C. The subject matter of claims 6-10 was invented by inventor B, who refuses to cooperate with company C unless he is the sole named inventor of his own patent. Company C wishes to divide the claims such that one patent contains only claims 1-5 and has inventor A as the sole inventor, and another patent contains claims 6-10 and has inventor B as the sole inventor. How should you advise your client?

- A) this is impossible
- B) use a certificate of correction to cancel claims 6-10 and remove inventor B from the patent, and file a divisional application on claims 6-10 listing B as the inventor
- C) file a reissue, cancel claims 6-10, and remove B as an inventor
- D) file a reissue of the original application along with a divisional reissue, cancel claims 1-5 and remove inventor A from the first reissue, move claims 6-10 and inventor B to the divisional reissue
- E) file two simultaneous reissue applications from the same patent, cancel claims 1-5 and remove inventor A from the first reissue, cancel claims 6-10 and remove inventor B from the second reissue.

MPEP 1402. "The correction of misjoinder of inventors in divisional reissues has been held to be a ground for reissue." Thus, the statutory error that allows reissue is that if there 2 separable

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inventions by two separate inventors, there should be two separate patents. Therefore, D is the correct method of reissue.

QUESTION 370

A hairdresser finds his competitor gets a patent, but hairdresser has an advertisement that he was selling the patented product one year before the competitor got his patent to that product."

MPEP 2609. Reissue and certificates of correction have to be requested by the inventors or the assignee (consent of inventors needed for broadening reissue). A competitor can request reexam (either inter partes or ex parte) only if there is a patent or printed publication raising a substantial new question of patentability. Thus, unless the advertisement constitutes a printed publication (with sufficient disclosure to raise substantial new question of patentability), the competitor has no recourse. If the ad qualified, then ex parte reexam would be available to the competitor, based on facts above. Inter partes reexam would be available only if the application was filed on or after Nov 29, 1999.

QUESTION 371

How do you determine equivalence in a means-plus-function situation?

MPEP 2183. If the examiner finds that a prior art element (A) performs the function specified in the claim, (B) is not excluded by any explicit definition provided in the specification for an equivalent, and (C) is an equivalent of the means- (or step-) plus-function limitation, the examiner should provide an explanation and rationale in the Office action as to why the prior art element is an equivalent. Factors that will support a conclusion that the prior art element is an equivalent are: (A) the prior art element performs the identical function specified in the claim in substantially the same way, and produces substantially the same results as the corresponding element disclosed in the specification. ... (B) a person of ordinary skill in the art would have recognized the interchangeability of the element shown in the prior art for the corresponding element disclosed in the specification... (C) there are insubstantial differences between the prior art element and the corresponding element disclosed in the specification... (D) the prior art element is a structural equivalent of the corresponding element disclosed in the specification... .

QUESTION 372

In what situation does the PTO still investigate violations of 37 CFR 1.56?

MPEP 1448. The Office no longer investigates and rejects reissue applications under 37 CFR 1.56. The Office will not comment upon duty of disclosure issues which are brought to the attention of the Office in reissue applications except to note in the application, in appropriate circumstances, that such issues are no longer considered by the Office during its examination of patent applications.

QUESTION 373

The Applicant has replied to a final Office action before 2 months after the mailing date of the Office action. Are any extension fees required?

Answer. The date of mailing of the Examiner Advisory action resets the 3 month date for calculating extensions of time. If you respond to the final office action within 2 months and the

examiner gives an advisory action after the 3 month deadline then the extensions basically run from that point. You must respond before 2 months though and he must respond after 3. Look out for the 6 month statutory bar, which supercedes the 3 month deadline above. In the event that the Advisory Action is mailed out after the 6 month bar, it is too late – the Applicant would have had to submit an Notice of Appeal or file continuation before the Advisory Action.

QUESTION 374

An application claimed a chemical that was useful for relieving headaches. The application did not disclose how to make said chemical. Examiner rejects claim on enablement and written description. Applicant shows that a PHOSITA would know how to make said chemical and points formulas and technical data in the spec.

Examiner should withdraw both rejections in light of applicant's submissions.

Examiner should withdraw enablement rejection, but keep written description as the application does not show how to make said chemical.

Examiner should withdraw both rejections as neither were proper to begin with.

MPEP 2161. The Federal Circuit reaffirmed that under 35 U.S.C. 112, first paragraph, the written description requirement is separate and distinct from the enablement requirement and gave an example thereof.). An invention may be described without the disclosure being enabling (e.g., a chemical compound for which there is no disclosed or apparent method of making), and a disclosure could be enabling without describing the invention (e.g., a specification describing a method of making and using a paint composition made of functionally defined ingredients within broad ranges would be enabling for formulations falling within the description but would not describe any specific formulation).

Thus, by showing that a Phosita can make and use the chemical, the enablement requirement is satisfied and so that rejection should be dropped. However, the above facts do not tell us if the written disclosure requirement is satisfied, so that rejection may stay. So B is the correct answer.

QUESTION 375

Can an examiner make an obviousness rejection where prior art cites chemical amounts of 34.9% and the applicant's range starts at 35%?

MPEP 2144.05. A prima facie case of obviousness exists where the claimed ranges and the prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties.

QUESTION 376

If there are three claims, in which claim 1 is an independent claim and claims 2-3 are dependent claims and the judge affirms the examiner rejection of claim 1, but not claims 2-3, then what is the next process. “

Answer. Claim 1 will be cancelled, and claims 2-3 can be rewritten as an independent claim by the examiner writing an examiner's amendment to be allowed or the examiner will let the appellant to do it.

QUESTION 377

If you use a fax to file a CPA and do not include the fee, what result?

Answer: It will be treated as CPA with no fee.

QUESTION 378

A practitioner files design patent application with a base connected to a fan connected to a lamp. They are connected in their center. The drawing is shown as three saucers connected to each other. The Examiner finds reference with same design. The Practitioner argues that the size of the saucers shown in the reference are not the same as that in his drawing.

Answer: Examiner must maintain the rejection because the scale of drawing does not have to be the same.

MPEP 2125. When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. See *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) (The disclosure gave no indication that the drawings were drawn to scale. “[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.”). ...

QUESTION 379

Can an examiner use clean black ink to make an amendment in something related to a reissue.

MPEP 1302.04. “Clean red ink” must be used in correcting originally filed papers. If the question is asked in the form “which is not correct” the answer was using black ink.

QUESTION 380

There are no claims in a PCT application and that PCT application claims the benefit of a provisional application. How can these claims be sent to the USPTO?

Answer. Submit them via express mail to get a “date in” filing date.

QUESTION 380

Where does the USPTO send an office action if the concerned patent attorney/agent is suspended?

Answer. The USPTO will NOT correspond with suspended practitioners. Correspondence will be mailed to the applicant or another practitioner designated by the applicant.

MPEP 4.06 Attorney/Agent Suspended. The instant application contains a power of attorney to [1] who has been [2] from practice before the Patent and Trademark Office (Office). The Office does not communicate with attorneys or agents who have been suspended or excluded from practice. Accordingly, the Office action is being mailed to you as the inventor.

QUESTION 380

Two PCT questions regarding 102(e) date, one in which the filing date was november 20, 2000 and an identical one in which the filing date was in december 2000. There were also a two PCT questions regarding filing dates of PCT applications in USRO where applicants are not citizens - the inventors are from costa rica and Sweden respectively.

Answer. The filing date is the date received at US/RO, but the sweden question is written to make you think that they will not be afforded a filing date as of the date received at US/RO.

QUESTION 381

PCT Questions

- 1) Filing date is same as filed at RO/US when everything's right but all apps are non-US citizens
- 2) There is NO 102(e) date for a PCT national stage patent or publication filed after Nov. 29, 2000 that does not publish in English (even if Fee/Oath/Translation submitted)
- 3) Pre-Nov. 29, 2000 PCTs get a 102(e) date as of receipt of last of Fee/Oath/Translation
- 4) When an applicant doesn't file a complete spec with the International RO, an invitation to correct will be sent, giving between 10 days and 1 month to correct (see PCT rule 26.2). However, the filing date accorded the application, much like with a Notice of Omitted Items, will be when the error is corrected; thus, if the 1-year term from the priority app sought to be claimed in the PCT expires DURING the 1-month period to correct, the latest you can really file the missing spec pieces is the 1-year deadline, regardless of how much time is left in the 1-month invitation. (Again, see PCT Rule 26.2 and MPEP 1810).

