

Test Number 456
Test Series 101

Name _____

**UNITED STATES PATENT AND TRADEMARK OFFICE
REGISTRATION EXAMINATION
FOR PATENT ATTORNEYS AND AGENTS**

APRIL 18, 2001

Afternoon Session (50 Points)

Time: 3 Hours

DIRECTIONS

This session of the examination is an open book examination. You may use books, notes, or other written materials that you believe will be of help to you *except* you may not use prior registration examination questions and/or answers. Books, notes or other written materials containing prior registration examination questions and/or answers *cannot* be brought into or used in the room where this examination is being administered. If you have such materials, you must give them to the test administrator before this session of the examination begins.

All questions must be answered in SECTION 1 of the Answer Sheet which is provided to you by the test administrator. You must use a No. 2 pencil (or softer) lead pencil to record your answers on the Answer Sheet. Darken *completely* the circle corresponding to your answer. You must keep your mark within the circle. Erase *completely* all marks except your answer. Stray marks may be counted as answers. No points will be awarded for incorrect answers or unanswered questions. Questions answered by darkening more than one circle will be considered as being incorrectly answered.

This session of the examination consists of fifty (50) multiple choice questions, each worth one (1) point. Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the *Official Gazette*, or a notice in the *Federal Register*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

You may write anywhere on the examination booklet. However, do not remove any pages from the booklet. Only answers recorded in SECTION 1 of your Answer Sheet will be graded. YOUR COMBINED SCORE OF BOTH THE MORNING AND AFTERNOON SESSIONS MUST BE AT LEAST 70 POINTS TO PASS THE REGISTRATION EXAMINATION.

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO

This examination addresses provisions of the Patent Statute, regulations and MPEP which were not changed as a result of the enactment of the American Inventors Protection Act of 1999, Pub. L. No. 106-113 ("Act"). This examination also does address and test changes to the Patent Statute or regulations brought about by the enactment of the Act. Some, but not all, questions use the statute and rules, comments to the rules, and guidelines in place subsequent to November 28, 1999, including the following rule changes and guidelines in effect on or before January 20, 2001:

? Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule. 65 FR 50092 (Aug. 16, 2000) (including the adoption of changes set forth in Interim Rule, 65 FR 14865 (Mar. 20, 2000) to §§ 1.7, 1.17(e) and (i), 1.53(d)(1), 1.78(a)(3), 1.97(b), 1.104(c)(4), 1.113, 1.116, 1.198, 1.312, and 1.313(a), (b), (c)(1), (c)(3), and (d)).

? Changes to Permit Payment of Patent and Trademark Fees by Credit Card; Final Rule. 65 FR 33452 (May 24, 2000).

? Revision of Patent Fees for Fiscal Year 2001; Final Rule. 65 FR 49193 (Aug. 11, 2000).

? Changes To Implement the Patent Business Goals; Final Rules. 65 FR 54604 (Sept. 8, 2000).

? Changes to Implement the Patent Business Goals; Final Rule and corrections to final rules. 65 FR 78958 (Dec. 18, 2000).

? Changes to Implement Patent Business Goals; Final Rule, Correction. 65 Fed. Reg. 80755 (Dec. 22, 2000).

? Changes To Implement Patent Term Adjustment Under Twenty-Year Patent Term; Final Rules. 65 FR 56366, (Sept. 18, 2000).

? Changes to Implement Eighteen-Month Publication of Patent Applications; Final Rule. 65 FR 57024 (Sept. 20, 2000).

? Changes To Implement Eighteen-Month Publication of Patent Applications; Correction. Final Rule; correction. 65 FR 66502 (Nov. 6, 2000).

? Treatment of Unlocatable Patent Application and Patent Files; Final Rule. 65 FR 69446 (Nov. 17, 2000).

? Simplification of Certain Requirements in Patent Interference Practice; Final Rule. 65 FR 70489 (Nov. 24, 2000).

? Reestablishment of the Patent and Trademark Office as the United States Patent and Trademark Office, 65 Fed. Reg. 17858 (April 5, 2000).

? Guidelines Concerning the Implementation of Changes to 35 U.S.C. 102(g) and 103(c) and the Interpretation of the Term "Original Application" in the American Inventors

? Protection Act of 1999, 1233 O.G. 54-56 (April 11, 2000).

? Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, para. 6, 65 Fed. Reg. 38510-38516 (June 21, 2000); 1236 O.G. 98-104 (July 25, 2000).

? Guidelines Setting Forth a Modified Policy Concerning the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 U.S.C. 103(c), 1241 O.G. 96-97 (December 26, 2000).

? Assignment of Confirmation Number and Time Period for Filing a Copy of an Application by EFS for Eighteen-Month Publication Purposes, 1241 O.G. 97-98 (December 26, 2000).

? Utility Examination Guidelines, 66 F.R. 1092-1099 (January 5, 2001).

Guidelines for Examination of Patent Applications Under the 35 U.S.C. Sec. 112, para. 1

"Written Description" Requirement 66 F.R. 1099-1111 (January 5, 2001).

1. Which of the following is in accord with proper USPTO practice and procedure?
- (A) Upon request to convert a provisional application to a nonprovisional utility application, the nonprovisional application is accorded a filing date as of the date on which the request to convert was filed, but the original filing date of the provisional application is preserved.
 - (B) If a provisional application does not have a claim as filed, and a claim is not filed with a timely request to convert the provisional application to a nonprovisional utility application, the Office will notify the applicant and set a time period for submitting a claim for examination.
 - (C) A provisional application filed in November 2000 is entitled to the right of priority under 35 U.S.C. § 119 of a copending utility application for patent filed in Great Britain in January 2000.
 - (D) A request filed in January 2001, to convert a provisional application filed in the USPTO in April 2000, to a nonprovisional utility application is timely if filed after the abandonment of the provisional application, i.e., after the pendency of the provisional application, but within twelve months of the filing date of the provisional application provided no petition to revive has been filed and granted.
 - (E) A nonprovisional utility application filed under the provisions of 37 CFR § 1.53(b) in January 2001, and claiming the benefit of the earlier filing date of a provisional application must be filed during the pendency of the provisional application.
2. Select from the following an answer which completes the following statement, such that the completed statement accords with proper USPTO practice and procedure: “When the reference in question is a noncommonly owned U.S. patent claiming the same invention as applicant, and its issue date is _____”
- (A) less than one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of requesting an interference.
 - (B) exactly one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of requesting an interference.
 - (C) more than one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of requesting an interference.
 - (D) less than one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of affidavit or declaration “swearing back” of reference.
 - (E) less than one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of affidavit or declaration traversing the ground of rejection.

3. Which of the following is an incorrect statement concerning the difference between the request for continued examination procedure under 37 CFR § 1.114 and the continued prosecution application (CPA) procedure under 37 CFR § 1.53(d)?

- (A) The filing of a CPA is the filing of a new application, whereas a request for continued examination under 37 CFR § 1.114 merely continues the examination of the same application.
- (B) The fee for a request for continued examination under 37 CFR § 1.114 does not have an additional claims fee component, but the filing fee for a CPA includes a fee based on the number of claims remaining in the application after entry of any amendment accompanying the request for CPA and entry of any amendments under 37 CFR § 1.116 unentered in the prior application which applicant has requested to be entered in the CPA.
- (C) A CPA may be filed before prosecution in the prior application is closed, but a request for continued examination under 37 CFR § 1.114 is not permitted unless prosecution in the application is closed.
- (D) None of the above are incorrect statements.
- (E) (B) and (C) are incorrect statements.

4. Which of the following may properly be required to submit information in reply to a requirement for information under 37 CFR § 1.105 in a patent application filed December 5, 2000?

- (A) A named inventor in the application.
- (B) An assignee of the entire interest in the application.
- (C) An attorney who prepares and prosecutes the application.
- (D) All of the above.
- (E) (A) or (C).

5. Which of the following is or are a factor that will be considered in disapproving a preliminary amendment in an application filed November 10, 2000?

- (A) The nature of any changes to the claims or specification that would result from entry of the preliminary amendment.
- (B) The state of preparation of a first Office action as of the date of receipt of the preliminary amendment by the Office.
- (C) The state of preparation of a first Office action as of the certificate of mailing date under 37 CFR § 1.8, of the preliminary amendment.
- (D) All of the above.
- (E) (A) and (B).

6. A patent application filed in the USPTO contains the following three original claims, including product by process Claim 3:

Claim 1. A method for making an Ethernet cable comprising the steps of A, B and C.

Claim 2. The method of claim 1, further characterized by the step of D.

Claim 3. The Ethernet cable as in any one of the preceding claims.

In the first Office action, the examiner objects to Claim 3 as being an improper dependent claim and requires cancellation of the claim. Following proper USPTO practices and procedures, which of the following replies best overcomes the examiner's objection and provides the client with the broadest patent protection?

- (A) Amend Claim 3 to read: "The Ethernet cable as made by the process set forth in claims 1-2."
- (B) Cancel Claim 3.
- (C) Cancel Claim 3 and add Claim 4, which reads: "An Ethernet cable made by a process comprising the steps of A, B and C."
- (D) Cancel Claim 3 and add Claim 4, which reads: "An Ethernet cable made by a process comprising the steps of A, B, C and D."
- (E) Cancel Claim 3. Add Claim 4, which reads: "An Ethernet cable made by a process comprising the steps of A, B and C." Add Claim 5, which reads: "An Ethernet cable made by a process comprising the steps of A, B, C and D."

7. Which of the following is not in accordance with proper USPTO practice and procedure regarding design patent applications filed in March 2001?

- (A) The elements of the design application, if applicable, should appear in the following order: (1) design application transmittal form; (2) fee transmittal form; (3) application data sheet; (4) specification; (5) drawings or photographs; and (6) executed oath or declaration.
- (B) The specification should include the following sections in order: (1) preamble, stating the name of the applicant, title of the design, and a brief description of the nature and intended use of the article in which the design is embodied; (2) cross-reference to related applications (unless included in the application data sheet); (3) statement regarding federally sponsored research or development; (4) description of the figure or figures of the drawing; (5) feature description; and (6) a single claim.
- (C) The text of the specification sections, if applicable, should be preceded by a section heading in uppercase letters without underlining or bold type.
- (D) The elements of the design application, if applicable, should appear in the following order: (1) design application transmittal form; (2) fee transmittal form; (3) photographs; (4) application data sheet; (5) specification; (6) drawings; and (7) executed oath or declaration.
- (E) None of the above.

8 – 9. The following facts apply to the following two questions.

While travelling through Germany (a WTO member country) in December 1999, Thomas (a Canadian citizen) conceived of binoculars for use in bird watching. The binoculars included a pattern recognition device that recognized birds and would display pertinent information on a display. Upon Thomas' return to Canada (a NAFTA country) in January 2000, he enlisted his brothers Joseph and Roland to help him market the product under the tradename "Birdoculars." On February 1, 2000, without Thomas' knowledge or permission, Joseph anonymously published a promotional article written by Thomas and fully disclosing how the Birdoculars were made and used. The promotional article was published in the Saskatoon Times, a regional Canadian magazine that is also widely distributed in the United States. Thomas first reduced the Birdoculars to practice on March 17, 2000 in Canada. A United States patent application properly naming Thomas as the sole inventor was filed September 17, 2000. That application has now been rejected as being anticipated by the Saskatoon Times article.

8. Which of the following statements is most correct?

- (A) The promotional article in the Saskatoon Times constituted an offer to sell that operates as an absolute bar against Thomas' patent application.
- (B) Thomas, as the inventor, can overcome the rejection by establishing he is also the author of the promotional article.
- (C) The Saskatoon Times article is not *prima facie* prior art because it was published without Thomas' knowledge or permission.
- (D) The Saskatoon Times article is not *prima facie* prior art because it does not evidence knowledge or use in the United States.
- (E) The promotional article cannot be used as prior art because the Birdoculars had not been reduced to practice at the time the article appeared in the Saskatoon Times.

9. Which of the following statements is most correct?

- (A) Thomas can rely on his activities in Canada in establishing a date of invention prior to publication of the Saskatoon Times article.
- (B) In a priority contest against another inventor, Thomas can rely on his activities in Canada in establishing a date of invention.
- (C) In a priority contest against another inventor, Thomas can rely on his activities in Germany in establishing a date of invention.
- (D) Statements (A) and (B) are correct, but statement (C) is incorrect.
- (E) Statements (A), (B), and (C) are each correct.

10. 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 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.

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

- (A) If a claim limitation invokes the sixth paragraph of 35 U.S.C. § 112, it must be interpreted to cover the corresponding structure, material, or acts in the specification and "equivalents thereof."
- (B) If means-plus-function language is employed in a claim, the specification must set forth an adequate disclosure showing what that language means.
- (C) A means-plus-function claim limitation satisfies the second paragraph of 35 U.S.C. § 112 if the written description links or associates particular structure, material, or acts to the function recited in a means-plus-function claim limitation.
- (D) A step-plus-function claim limitation satisfies the second paragraph of 35 U.S.C. § 112 if it is clearly based on the disclosure in the application that one skilled in the art would have known what structure, material, or acts perform the function recited in a step-plus-function limitation.
- (E) The invocation of the sixth paragraph of 35 U.S.C. § 112 exempts an applicant from compliance with the first and second paragraphs of 35 U.S.C. § 112.

12. Which of the following is in accordance with proper USPTO practice and procedure regarding patent applications filed in March 2001?

- (A) An applicant in a nonprovisional application may only claim the benefit of the filing date of the earliest one of prior foreign applications under the conditions specified in 35 U.S.C. §§ 119(a) through (d) and (f), 172, and 365(a) and (b).
- (B) In an original application filed under 35 U.S.C. § 111(a), the claim for priority must be presented within either four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application, whichever occurs earlier.
- (C) Notwithstanding the fact that the claim for foreign priority was not filed within either four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application, if the claim for priority and the certified copy of the foreign application specified in 35 U.S.C. § 119(b) or PCT Rule 17 is filed before the patent is granted and the claim was unintentionally delayed, a petition to accept a delayed claim for priority, with the appropriate fee and statement, may be filed.
- (D) The claim for foreign priority need only identify foreign applications for which priority is claimed.
- (E) A claim for foreign priority may be based upon an inventor's certificate provided it is accompanied by a statement by the applicant that patent coverage was not available.

13. In August 2000, a recently registered patent agent, who is not an attorney, asked a registered patent attorney to help the agent establish a practice. Considering the additional facts in the following choices separately, which choice best comports with the professional responsibilities of both the agent and the attorney?

- (A) The agent advertises as a registered practitioner authorized to practice before the Office in patent and trademark cases. The attorney supervises all the trademark work done by the agent.
- (B) The attorney has the agent prosecute trademark applications before the Office and the attorney signs all the papers submitted to the Office without reading the papers.
- (C) The attorney and agent enter into a partnership agreement that has no health or retirement benefits, but specifies that after termination of the partnership, the agent and the attorney will not practice in each other's neighborhoods or accept each other's established clients.
- (D) The agent advertises on television and radio as a registered patent agent and accepts patent cases on a reasonable contingent fee.
- (E) Without receiving anything of value from the agent, the attorney refers patent application clients to the agent, the agent informs the clients that the agent is a registered patent attorney, and the agent competently represents the clients in patent cases.

14. Which of the following statements concerning a restriction requirement in a reissue application filed January 10, 2001, is in accordance with proper USPTO rules and procedure?

- (A) The Office cannot properly make a restriction requirement in the reissue application between claims added in the reissue application and the original patent claims, where the added claims are directed to an invention which is separate and distinct from the invention defined by the original patent claims.
- (B) The Office cannot properly make a restriction requirement involving only subject matter of the original patent claims.
- (C) If restriction is required by the Office, the subject matter of the original patent claims will not be held to be constructively elected unless a disclaimer of all the patent claims is filed in the reissue application, which disclaimer cannot be withdrawn by applicant.
- (D) (A) and (B)
- (E) None of the above.

15. Joe and Jim, local businessmen, conceived the idea of an improved fishing pole. Thereafter, they had a prototype made, and after successfully testing the pole, they filed a patent application on their invention. Both men are widowers, Joe with a grown son, and Jim with a grown daughter. Joe and Jim invite their children to come to the next Lions Club social event, and it isn't long before the children are thinking in terms of wedding bells. Ecstatic at the thought of the upcoming marriage, Joe and Jim decide to assign their patent application to their children as a wedding present. Accordingly, they execute a document properly assigning their patent application to their children effective on the date of their marriage, and mail it to the USPTO with a cover letter requesting that the document be recorded. Shortly after the document is recorded, Joe's son meets another woman, and breaks off his engagement to Jim's daughter. In light of this scenario, which of the following statements is true?

- (A) Since the assignment was conditioned on the marriage of the children, and the condition was not fulfilled, the USPTO will regard the assignment as without effect for Office purposes.
- (B) Since the assignment was recorded, the USPTO will require the parties to certify that the marriage condition was fulfilled before the assignment will be effective for Office purposes.
- (C) Since the assignment was recorded, the USPTO will not determine whether the marriage condition was fulfilled and will regard the assignment as absolute.
- (D) Since the USPTO does not record conditional assignments, the recording of the assignment document will be regarded as inadvertent, and without effect for Office purposes.
- (E) Since the assignment was recorded, the USPTO will regard it as a determination of the validity of the document and the effect that the document has on the title to the patent application.

16. In June 1998 Michael buys a television set with a remote control for automatically changing channels on the television set. In June 2000, Michael moves to a new neighborhood and discovers while watching television that the remote control for his television not only changes the channels on his television set but also operates to open his neighbor's garage door. Michael, believing that people no longer need to have separate devices for operating their television and opening their garage doors, goes to a registered practitioner to seek patent protection on his new idea. The practitioner files a patent application in 2000. During the prosecution of the patent for the circuit board device, the practitioner files the following claims 11 and 12:

11. An electronic device comprising: circuitry; said circuitry operating to emit signals of a predetermined waveform; said signals being used to automatically change channels on a television set and automatically open the door of a garage.

12. A method for opening a garage door comprising using a television remote control device to emit signals, comprising the steps of:

- a) adapting a television remote control device to emit signals to open a garage door;
- b) pointing said television remote control device at said garage door; and
- c) actuating said television remote control to cause said garage door to open.

Which of the following is true?

- (A) Since the television and remote control were sold in June 1998, claims 11 and 12 are barred by 35 U.S.C. § 102(b) since the device was on sale more than one year prior to the invention by Michael.
- (B) Since the television remote control device was in public use more than one year prior to the filing date of the application, Michael may obtain the patent coverage for the method claim 12 but not the device of claim 11.
- (C) Although the device was bought in June 1998, Michael did not use it to open a garage door until 2000. Since claim 11 requires that the signals of the remote control operate to open the garage door, the limitations of claim 11 are not met by the device bought in 1998, and 35 U.S.C. § 102(b) does not apply.
- (D) Since Michael did not make the remote control himself and only inadvertently discovered that his neighbor's garage door opens when changing the channel on his television set, this is merely an inadvertent discovery and not entitled to patent protection.
- (E) Whether or not claim 11 is patentable is solely a question of obviousness. Michael need only produce evidence of commercial success to overcome an obviousness rejection.

17. To satisfy the written description requirement of the first paragraph of 35 U.S.C. § 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.

18. Which of the following is not required in order for a foreign application that has matured into a foreign patent to qualify as a reference under 35 U.S.C. § 102(d)?

- (A) The foreign application must have actually been published before the filing of an application in the United States, but the patent rights granted need not be enforceable.
- (B) The foreign application must be filed more than 12 months before the effective filing date of the United States application.
- (C) The foreign and United States applications must be filed by the same applicant, his or her legal representatives or assigns.
- (D) The foreign application must have actually issued as a patent or inventor's certificate before the filing of an application in the United States. It need not be published but the patent rights granted must be enforceable.
- (E) The same invention must be involved.

19. An application is transmitted to the USPTO on January 12, 2001, without an oath or declaration by any of the inventors. Which of the following, prior to the filing of an oath or declaration, may properly change the address to which the Office will direct all notices, official letters, and other communications relating to the application?

- (A) A registered practitioner that filed the application.
- (B) Any registered practitioner named in the transmittal papers accompanying the original application, if the application was filed by a registered practitioner.
- (C) One inventor who solely filed the application, where two inventors are named in the transmittal papers accompanying the original application.
- (D) (A), (B), and (C).
- (E) (A) and (B).

20. In July 2000, Pete Practitioner files a reissue application for Sam's patent on a combination washing machine and dryer, which issued on August 4, 1998. The original 20 claims are filed in the reissue application along with two additional dependent claims. The declaration indicates that there was error without deceptive intent in that applicant failed to claim the subject matter of the two newly added dependent claims. Sam also indicates in the declaration that he has no intention doing anything other than adding the two dependent claims. In September 1999 the examiner allows claims 1-10 of the reissue but rejects claims 11-22. Sam is eager to enforce claims 1-10 against a competitor but does not want to give up prosecuting claims 11-22. Sam also wants to add additional claims 23-30 directed to an entirely different invention, which was disclosed in the patent but not claimed. To claim the new invention, Sam must file new independent claims, which claim subject matter not previously claimed. Pete practitioner has retired and Sam comes to you for advice. Which of the following is true?

- (A) Although Sam's reissue application was filed within two years, Sam did not indicate his intention to broaden the claims until after the two year period had expired. Sam may not now file broader reissue claims.
- (B) Sam may file a second continuing reissue application with claims 11-20 as well as new claims 23-30. Sam would then cancel claims 11-20 from the first reissue application. The second reissue application would then issue and Sam could file a Notice of Appeal to the Board of Patent Appeals and Interferences in the first reissue application. Since the first application was filed within the two year time limit, Sam would not be subjected to a rejection for broadening his claims.
- (C) Since Sam's reissue application was filed within the two-year statutory time limit on broadening, Sam may add the additional claims 23 -30 to the reissue application.
- (D) Since Sam had only one patent and all reissue applications for the same patent must issue simultaneously, it would not be advantageous to file two reissue applications since they must issue at the same time.
- (E) Since the new invention was disclosed but not claimed in the original application, Sam may file claims directed to this new invention at any time during the life of the patent since claiming entirely different subject matter in entirely new claims does not constitute broadening as long as the original claims are not broadened.

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

- (A) Every application should contain no more than three dependent claims.
- (B) Claims should be arranged in order of scope so that the first claim presented is the least restrictive.
- (C) Product and process claims should be separately grouped.
- (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.

22. A rejection based on 35 U.S.C. § 102(a) cannot be overcome by:

- (A) Filing an affidavit under 37 C.F.R. § 1.131 “swearing back” of a U.S. patent which substantially shows or describes, and claims the same patentable invention as the rejected invention.
- (B) Filing an affidavit under 37 C.F.R. § 1.132 showing that the reference invention is not by “another.”
- (C) Perfecting a claim to priority under 35 U.S.C. § 119(a)-(d).
- (D) Amending the claims to patentably distinguish over the prior art.
- (E) Persuasively arguing that the claims are patentably distinguishable from the prior art.

23. Mr. and Mrs. Noteworthy (Henry and Alice) are registered patent practitioners maintaining an office. After completing their busiest year since opening their practice, the Notworthys decide to take a break from their hectic business routine and embark on a two week vacation in Acapulco, Mexico. On the third day of their vacation, Henry fell ill, and was laid up in bed for two days. Feeling somewhat better on the second day of his illness, and bored while Alice was on the beach, Henry phoned his office and learned from his secretary that an Office action in a case that he had overlooked contained a shortened statutory period (SSP) which expires on the very same day. He immediately had the Office action faxed to him, and upon receipt, he worked feverishly to prepare a reply. Upon completion of the reply, Henry prepared a certificate of mailing in accordance with the suggested format set forth in MPEP § 512 and deposited the reply accompanied by the certificate of mailing, properly addressed to the USPTO, in the local post office on the very same day before the post office closed. On the 5th day of their vacation, Alice became ill and required bed rest. While Henry was on the beach, Alice called her office and learned that one of her cases had a SSP expiring on the same day. Alice immediately had the Office action faxed to her. Upon receipt of the fax, Alice prepared a proper response and forwarded same to the USPTO by facsimile accompanied by a certificate of transmission in accordance with the suggested format set forth in MPEP § 512 and in compliance with 37 C.F.R. § 1.6(d). Assume the certificate of mailing and the certificate of transmission recite deposit and transmission dates that are the same as their respective SSP expiration dates. Also assume that both communications are received in the USPTO after their respective SSP expiration dates and are stamped with the actual date of receipt. Which of the following statements is true?

- (A) The application wherein Henry filed a reply is abandoned because the USPTO stamped date is controlling.
- (B) The application wherein Henry filed a reply is not abandoned because the certificate of mailing date is controlling.
- (C) The application wherein Alice filed a reply is abandoned because the USPTO stamped date is controlling.
- (D) Both the application wherein Henry filed a reply and the application wherein Alice filed a reply are abandoned.
- (E) Neither the application wherein Henry filed a reply nor the application wherein Alice filed a reply is abandoned.

24. Which of the following is entitled to the benefit of a certificate of mailing under 37 CFR § 1.8?

- (A) Filing a request for continued examination under 37 CFR § 1.114.
- (B) Filing a request for a continued prosecution application under 37 CFR § 1.53(d).
- (C) Filing a reply under 37 CFR § 1.111 in a non-provisional patent application.
- (D) (A) and (C).
- (E) All of the above.

25. Which of the following is in accordance with proper USPTO practice and procedure?

- (A) The filing of a request for continued examination and payment of the fee for the request in a nonprovisional utility application that was filed in January 2000, is sufficient to toll the running of any time period set in a final rejection for reply to avoid abandonment of the application.
- (B) Where a request for continued examination, a submission, and requisite fee are filed in April 2001 for a nonprovisional utility application that was filed in January 2000, the submission will be considered though it was filed after the application became abandoned in February 2001.
- (C) An applicant in a utility application originally filed on or after June 8, 1995, and before May 29, 2000, may obtain further examination either by timely filing a request for continued examination, a proper submission, and requisite fee, or by timely filing a continued prosecution application.
- (D) An applicant in a utility application originally filed on or after June 8, 1995, and before May 29, 2000, may obtain further examination by timely filing in April 2001 a request for continued examination, a proper submission, and requisite fee, and the application is entitled to patent term adjustment provisions of the Patent Statute.
- (E) An applicant in a utility application originally filed on or after June 8, 1995, and before May 29, 2000, may obtain further examination by timely filing in April 2001 a continued prosecution application under 37 C.F.R. § 1.53(d), but the CPA application is not entitled to patent term adjustment provisions of the Patent Statute.

26. In accordance with proper USPTO practice and procedure, a submission for a request for continued examination does not include:

- (A) An appeal brief or reply brief (or related papers).
- (B) New arguments in support of patentability.
- (C) New evidence in support of patentability.
- (D) An amendment of the drawings.
- (E) An amendment of the claims.

27. Which of the following properly creates a statutory bar to patentability of applicant's claimed invention?

- I. Applicant's invention was sold in Tokyo and New York more than one year prior to the effective U.S. filing date, but the sales were merely attempts at market penetration.
 - II. Applicant's invention was experimented with and tested to further develop the invention more than one year prior to the effective U.S. filing date, but important modifications resulted from the experimentation causing the invention to be reduced to practice after the effective U.S. filing date.
 - III. Applicant's invention was sold in Tokyo more than one year prior to the effective U.S. filing date, but the sale was merely market testing of the invention to determine product acceptance.
- (A) I.
 - (B) II.
 - (C) III.
 - (D) I and III.
 - (E) None of the above.

28. In December 1988, Molly invents a new potato cutter that cuts the potatoes into shapes having a star cross section. Because of the proximity of the star outer surface to the inter core of the potato, the shape achieves optimal cooking of the potato when fried without resulting in an overly cooked outer surface. Molly, thinking that the invention is important, has two people, Sue and Tom, both sworn to secrecy, witness a drawing of the invention. Molly then locks the drawing in a safe deposit box where it remains for the next twelve years. Neither Molly, Sue, or Tom discloses the invention to anyone for the next twelve years. In December 2000, Troy invents a new potato cutter which produces potatoes having a star cross section, and the potatoes are then fried. The invention becomes an overnight success. Troy files a patent application on February 1, 2001. Molly, after seeing the success of Troy's invention in the marketplace, decides to file an application, also on February 1, 2001. The examiner is unable to find any prior art and no other prior art is cited by either applicant. Which of the following is true?

- (A) Since Molly effectively concealed her invention, Troy is entitled to a patent since although Molly conceived of the idea prior to Troy, she effectively abandoned the invention by not filing for twelve years.
- (B) Since Troy conceived of the idea after Molly and because Troy did not file a patent application before Molly, he is not entitled to priority over Molly.
- (C) Since Molly disclosed the invention to Sue and Tom, the invention was known by others prior to the invention by Troy. Therefore, Troy is precluded by 35 U.S.C. § 102(a) from obtaining a patent on his idea.
- (D) Since Molly invented the cutter before Troy, she is entitled to a patent and not Troy.
- (E) None of the above.

29. Which of the following is true?

- (A) The statement, “Whether claims 1 and 2 are unpatentable,” complies with the requirement of 37 C.F.R. § 1.192(c)(6) for a concise statement in the appeal brief of the issues presented for review.
- (B) Following a new ground of rejection raised by the Board of Patent Appeals and Interferences, the applicant may request a rehearing, or submit an appropriate amendment of the rejected claims or a showing of facts relating to the rejected claims.
- (C) A reissue application may be filed in order to broaden claims back to their original form where the claims were mistakenly narrowed during the original prosecution to avoid the prior art provided that the narrowing of the claims was made without deceptive intent on the part of the applicant.
- (D) If the Board of Patent Appeals and Interferences decides to require an appellant to address a particular matter, and the appellant cannot respond within the time period set, he may obtain an extension of time by paying the requisite fee.
- (E) In an ex parte reexamination proceeding of a patent that arises from an application filed in the United States before November 29, 1999, a third party requester who is dissatisfied with a decision of the Board of Patent Appeals and Interferences may seek judicial review by appeal to either the U.S. Court of Appeals for the Federal Circuit or by civil action in the U.S. District Court for the District of Columbia.

30. 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 C.F.R. 1.131 affidavit or declaration, it is sufficient to allege that applicant or patent owner has been diligent.
- (B) In a 37 C.F.R. 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 C.F.R. 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 C.F.R. 1.131 affidavit or declaration, it is sufficient to show conception and reduction to practice in any country.
- (E) In a 37 C.F.R. 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.

31. Assuming that each of the following claims is in a separate application, and there is no preceding multiple dependent claim in any of the applications, which claim is in acceptable multiple dependent claim form?

- (A) Claim 8. A machine according to any one of the preceding claims wherein...
- (B) Claim 5. A device as in one of claims 1-4, wherein...
- (C) Claim 10. A device as in any of claims 1-4 or 6-9, in which...
- (D) Claim 4. A machine according to claim 2 or 3, also comprising...
- (E) The claim form in (A), (B), (C) and (D) is acceptable.

32. Your client, Bill, disclosed to you the following. While hiking, he found a natural specimen of tree sap that had bonded rock material to a log, and was impervious to water. Bill realized that the sap would be an excellent roofing material for bonding asphalt shingles to wooden sheathing. Bill performed a chemical analysis of the sap and determined it was 10% A, 30% B, and 60% C. Bill experimented and found that he could synthetically produce the sap by mixing one part A by weight and three parts B by weight at 20 degrees Celsius, heating the mixture of A and B to 100 degrees Celsius, adding six parts C by weight, and cooling the mixture of A, B, and C to 20 degrees Celsius. Bill further experimented and found that if he added an effective amount of D to the mixture of A, B, and C, prior to cooling, the viscosity of the product would decrease, making it easier for roofers to apply it to wooden sheathing. You draft a patent application with a specification having all the information disclosed to you by Bill, including guidelines that explained that an effective amount of D for decreasing the viscosity is between 1% to 2% of the total weight of the mixture of A, B, and C, after cooling. The guidelines also explained that an effective amount of D for brightening the color of the composition is between 3% to 4% of the total weight of the mixture of A, B, and C, after cooling. Which if any of the following claims, included in Bill's application, would not be properly rejected pursuant to 35 U.S.C. § 101?

Claim 1. A composition for bonding asphalt shingles to wood sheathing and a method, comprising: a mixture of 10%A, 30%B, and 60%C, and adding an effective amount of D to decrease the viscosity of the mixture.

Claim 2. A composition produced by the steps of: mixing one part A by weight with three parts B by weight at 20 degrees Celsius to form a mixture of A and B; heating the mixture of A and B to 100 degrees Celsius; adding six parts C by weight to form a mixture of A, B, and C; cooling the mixture of A, B, and C to 20 degrees Celsius; and adding an effective amount of D to decrease the viscosity of the composition.

Claim 3. A composition for bonding asphalt shingles to wood sheathing, comprising 10% A, 30% B, and 60% C.

- (A) Claim 1.
- (B) Claim 2.
- (C) Claim 3.
- (D) Claims 2 and 3.
- (E) None of the above.

33. Which of the following statements concerning reliance by an examiner on common knowledge in the art, in a rejection under 35 U.S.C. § 103 is correct?

- I. An examiner's statement of common knowledge in the art is taken as admitted prior art, if applicant does not seasonably traverse the well known statement during examination.
- II. Applicant can traverse an examiner's statement of common knowledge in the art, at any time during the prosecution of an application to properly rebut the statement.
- III. If applicant rebuts an examiner's statement of common knowledge in the art in the next reply after the Office action in which the statement was made, the examiner can never provide a reference to support the statement of common knowledge in the next Office action and make the next Office action final.

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

34. Registered practitioner Mike files a utility patent application in the USPTO having one claim on May 6, 1998. Following a proper final rejection dated June 28, 2000, of claim 1, Mike files a notice of appeal with the appropriate fee on September 12, 2000, and an appeal brief with the appropriate fee on October 12, 2000. On February 14, 2001, Mike learns about a publication (the "Valentine reference") which he knows to be material to patentability of claim 1. The Valentine reference was not considered by the examiner during prosecution of the application. According to proper USPTO rules and procedure, which of the following actions if taken by Mike on February 16, 2001, prior to a decision on the appeal, will be treated by the USPTO as a request to withdraw the appeal?

- (A) Filing a request for continued examination of the application with an information disclosure statement that complies with the provisions of 37 CFR § 1.98, listing the Valentine reference, submitting the fee set forth in 37 CFR § 1.17(e), and notifying the Board of Patent Appeals and Interferences of the same.
- (B) Filing a request for continued examination of the application, and submitting the fee set forth in 37 CFR § 1.17(e), without filing any other submission, and notifying the Board of Patent Appeals and Interferences of the same.
- (C) Filing a request for continued examination of the application, and filing an information disclosure statement that complies with the provisions of 37 CFR § 1.98, listing the Valentine reference, without submitting the fee set forth in 37 CFR § 1.17(e), and notifying the Board of Patent Appeals and Interferences of the same.
- (D) Filing a request for continued examination of the application, without submitting the fee set forth in 37 CFR § 1.17(e), and without filing any other submission, and notifying the Board of Patent Appeals and Interferences of the same.
- (E) All of the above.

35. A patent application filed in the USPTO contains the following dependent claim:

Claim 2. The method of Claim 1, further consisting of the step of cooling the mixture to a temperature of 32° F.

Following proper USPTO practices and procedures, from which of the following claims does Claim 2 not properly depend?

- (A) Claim 1. A method of making liquid compound A comprising the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (B) Claim 1. A method of making liquid compound A consisting of the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (C) Claim 1. A method of making liquid compound A including the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (D) Claim 1. A method of making liquid compound A characterized by the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (E) (C) and (D).

36. A member of the public submits a protest under 37 CFR § 1.291 relating to a public sale of the subject matter of a patent application (effective filing date June 1, 1999). The protest includes submission of a business circular authored by the assignee of the invention. In a first Office action dated January 10, 2001, the examiner includes a requirement for information requesting the date of publication of the business circular. The reply to the requirement for information states that the publication date is “approximately June 1, 2000.” Which of the following would be proper for the examiner to include in the next Office action?

- (A) A requirement that the date in the reply be made more specific.
- (B) A holding that the previous reply is incomplete.
- (C) A requirement seeking confirmation that “approximately June 1, 2000” is the most specific date that was obtained or can be obtained based on a reasonable inquiry if that is not already clear from the reply.
- (D) (A) and (C).
- (E) None of the above.

37. Which of the following is not in accordance with proper USPTO practice and procedure regarding patent applications filed in March 2001?

- (A) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed before the examiner allows the claims.
- (B) If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by the processing fee set forth in 37 CFR § 1.17(i), but the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and 37 CFR § 1.323.
- (C) In an application that entered the national stage from an international application after compliance with 35 U.S.C. § 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT.
- (D) If a U.S. patent application publication or patent incorporates by reference, or includes a specific reference under 35 U.S.C. §§ 119(e) or 120 to, a pending or abandoned application, a copy of that application-as-filed may be provided to any person upon written request including the fee set forth in 37 CFR § 1.19(b)(1).
- (E) If an international application, which designates the U.S. and which has been published in accordance with PCT Article 21(2), incorporates by reference or claims priority under PCT Article 8 to a pending or abandoned U.S. application, a copy of that application-as-filed may be provided to any person upon written request including a showing that the publication of the application in accordance with PCT Article 21(2) has occurred and that the U.S. was designated, and upon payment of the appropriate.

38. Which of the following statements concerning preliminary amendments is/are in accordance with proper USPTO rules and procedure?

- (A) A preliminary amendment filed in a continuation-in-part application cannot be disapproved if it is filed within three months from the December 7, 2000, filing date.
- (B) A preliminary amendment filed in a continued prosecution application cannot be disapproved if it is filed four months from the December 7, 2000, filing date with a petition for a one month extension of time.
- (C) A preliminary amendment filed in a continued prosecution application cannot be disapproved if it is filed four months from the December 7, 2000, filing date with a petition for a one month extension of time and the appropriate fee for the extension.
- (D) A preliminary amendment filed in a continuation prosecution application after the filing date of the application cannot be disapproved.
- (E) None of the above.

39. 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) None of the above.
- (E) All of the above.

40. You filed a patent application for a client containing a claim to a composition consisting of X, water and plaster. In the claim X is defined as follows: "X is a member selected from the group consisting of elements A, B, and C." The claim is properly rejected under 35 U.S.C. § 102(b) as being anticipated by a reference describing the composition made of A, water and plaster. The rejection may be properly overcome by:

- (A) Amending the claim by canceling elements B and C because the reference is concerned only with element A.
- (B) Amending the claim by canceling element A from the Markush group.
- (C) Arguing that the reference is not relevant because it lacks elements B and C.
- (D) Amending the claim by changing "consisting of" to "consisting essentially of."
- (E) Amending the claim to redefine X as "being a member selected from the group comprising elements A, B, and C."

41. A nonprovisional patent application was filed on December 1, 2000, including a patent application declaration and an application data sheet. The application data sheet that includes the applicant's full name, residence, mailing address, and citizenship. The application data sheet does not include any foreign priority information. Which of the following must be identified in the declaration?

- (A) Applicant's mailing address.
- (B) Applicant's citizenship.
- (C) Any foreign application for patent for which a claim for priority is made by Applicant pursuant to 37 CFR § 1.55.
- (D) (B) and (C).
- (E) All of the above.

42. You prepare and file a patent application directed to an invention for improving the safety of research in the field of recombinant DNA. Your client, Inventor Joe, informs you he has licensed exclusive rights to his invention to a major pharmaceutical company. Inventor Joe also informs you that he is aware that another pharmaceutical company, Titan Pharmaceuticals, learned of the invention from a paper he presented at a technical conference, and is preparing to use the technology in its commercial research labs in the United States. Inventor Joe demonstrates that Titan is about to begin practicing the invention by showing you a rigid comparison of Titan's intended activities and the claims of the application. He also informs you that although he is currently in very good health, he is 67 years old and fears he will not be in good health when the invention reaches its peak commercial value. Accordingly, if possible he would like for you to expedite prosecution in the simplest, most inexpensive way. Given the foregoing circumstances, which of the following statements is most correct?

- (A) You should recommend filing a petition to make special on the basis of Inventor Joe's age.
- (B) Since the invention relates to improving the safety of research in the field of recombinant DNA, you should recommend filing a petition to make special on that basis.
- (C) Since Titan is actually practicing the invention set forth in the pending claims, you should recommend filing a petition to make special on that basis.
- (D) Statements (A), (B) and (C) are equally correct.
- (E) Statements (A), (B) and (C) are each incorrect.

43. Claims 1 and 2 in a patent application state the following:

Claim 1. An apparatus for sitting comprising:

- (i) a square shaped base member;
- (ii) four elongated members mounted to the bottom of the base member; and
- (iii) a circular back member mounted to the base member.

Claim 2. An apparatus as in claim 1, further comprising a spring connected to the back member and to the base member.

Which, if any, of the following claims fully supported by the specification and presented in the application, is in accordance with USPTO rules and procedure?

- (A) 3. An apparatus as in claim 1, wherein the base member is rectangularly shaped.
- (B) 3. An apparatus as in claim 2, wherein the wheels connected to each of the elongated members are plastic.
- (C) 3. An apparatus as in any of the preceding claims, in which the circular back member is wooden.
- (D) 3. An apparatus as in the preceding claims, further comprising a pressure-sensing device connected to the base member.
- (E) None of the above.

44. Which of the following is true?

- (A) A claim to a process omitting a step in a process, where the step is disclosed in the specification to be essential to the invention, may not be properly rejected under 35 U.S.C. 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 U.S.C. 112, first paragraph.
- (C) The best mode requirement is the same as the enablement requirement of the first paragraph of 35 U.S.C. 112.
- (D) If 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) 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 U.S.C. 112, second paragraph, for failure to properly point out and distinctly claim the invention.

45. The USPTO mails a final Office action dated November 8, 2000, in a utility patent application filed May 5, 1999, to registered practitioner Ted. The final Office action includes claim rejections and objections. Which of the following, with a request for continued examination along with the required fee filed by Ted on January 8, 2001, is a proper submission in accordance with the provisions of 37 CFR § 1.114?

- (A) A telephone call from Ted to the examiner on January 8, 2001, wherein Ted distinctly and specifically points out the supposed errors in the examiner's action, and wherein Ted presents arguments addressing each ground of objection and rejection in the Office action dated November 8, 2000.
- (B) A written reply to the Office action dated November 8, 2000, with no amendments or new claims, which distinctly and specifically points out the supposed errors in the examiner's action, addresses each ground of objection and rejection in the Office action, and presents arguments pointing out the specific distinctions believed to render the claims patentable over the references applied by the examiner.
- (C) A written reply to the Office action dated November 8, 2000, which does not present arguments pointing out the specific distinctions believed to render the claims patentable over the references applied by the examiner, and which requests that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated.
- (D) All of the above.
- (E) None of the above.

46. Which of the following is in accordance with proper USPTO practice and procedure?

- (A) The fee an applicant must pay to request continued examination of an application is set in an amount equal to the basic filing fee the same applicant must pay for a utility patent application.
- (B) A Certificate of Mailing or Transmission under 37 C.F.R. § 1.8 is proper for filing a Continued Prosecution Application under 37 C.F.R. § 1.53(d) to obtain the date of the Certificate as the filing date for the application.
- (C) The Office does not charge a fee for processing a fee paid by a check that has been refused, i.e., dishonored and returned, by a financial institution.
- (D) To first request conversion of a provisional application containing a claim to a nonprovisional application after the provisional application has become abandoned, a petition to revive, accompanied by the appropriate fees, a showing of unavoidable delay, and a request for the conversion must be filed within one year of the date of abandonment.
- (E) The conversion of a provisional application, for which a basic filing fee was properly paid, to a nonprovisional application will result in the savings of filing and other fees over the filing of a nonprovisional application claiming the benefit under 35 U.S.C. § 119(e) and 37 C.F.R. § 1.78 of the earlier provisional filing date.

47. Applicant receives a rejection and objection in a non-final Office action dated December 12, 2000. Applicant timely files a reply dated February 12, 2001, that distinctly and specifically points out the supposed errors in the examiner's action. The reply addresses every ground of objection and rejection in the Office action dated December 12, 2000, by presenting arguments pointing out specific distinctions believed to render the claims, including any newly presented claims, patentable over the applied references. Applicant mails a second reply. Thereafter, Applicant mails a third reply to the USPTO, which would result in a change to the specification only, if entered. In accordance with proper USPTO rules and procedure, which of the following are factors that will be considered in deciding whether to disapprove Applicant's third reply?

- (A) Whether Applicant's reply dated February 12, 2001, includes a request that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated.
- (B) The state of preparation of an Office action responsive to the Applicant's reply dated February 12, 2001, as of the date of receipt of Applicant's third reply.
- (C) The nature of any changes to the specification that would result from entry of Applicant's second reply.
- (D) (A), (B), and (C).
- (E) (B) and (C).

48. Which of the following is in accord with proper USPTO practice and procedure for filing a reissue application in April 2001?

- (A) The specification, including the claims, of the patent for which reissue is requested must be furnished in the form of a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper.
- (B) The specification, including the claims, of the patent for which reissue is requested must be furnished in the form of cut-up soft copies of the printed patent, with only a single column of the printed patent securely mounted on a separate sheet of paper.
- (C) The specification, including the claims, of the patent for which reissue is requested must be furnished in the form of a copy of the printed patent, in single column format, each page on only one side of a single sheet of paper.
- (D) The specification, including the claims, of the patent for which reissue is requested must be furnished in the form of a copy of the printed patent, in double column format, each page on both sides of a single sheet of paper.
- (E) The specification, including the claims, of the patent for which reissue is requested must be furnished in the form of cut-up soft copies of the printed patent, with only a single column of the printed patent securely mounted on both sides of a single sheet of paper.

49. Which of the following is not in accordance with proper USPTO practice and procedure regarding patent applications filed in March 2001?

- (A) Status information is available for Application B, that is a continuation of an application A, when application A has been published under 35 U.S.C. § 122(b).
- (B) A person requesting status information may be provided the filing date if the eight-digit numerical identifier is not available and the last six digits of the numerical identifier is available.
- (C) If a U.S. patent application publication or patent incorporates by reference, or includes a specific reference under 35 U.S.C. §§ 119(e) or 120 to, a pending or abandoned application, a copy of that application-as-filed may be provided to any person upon written request including the fee set forth in 37 CFR § 1.19(b)(1).
- (D) A coinventor in a pending application may gain access to the application if his name appears as an inventor in the application, even if he did not sign the oath or declaration.
- (E) Notwithstanding the fact that only a redacted copy of an application has been published, a member of the public is entitled to see the entire application upon written request.

50. If an application is deposited with the U.S. Postal Service in the manner recited in each of the following answers, and there is a dispute as the filing date of the application, which will result in the earliest filing date?

- (A) As “Express Mail Post Office to Post Office” without the Express Mail mailing label number being placed on the application and with the “date-in” entered by the USPS on Friday, March 9, 2001, and the application being received in the USPTO on Monday, March 12, 2001.
- (B) As “Express Mail Post Office to Addressee” without the Express Mail mailing label number being placed on the application and with the “date-in” entered by the USPS on Saturday, March 10, 2001, and the application being received in the USPTO on Tuesday, March 13, 2001.
- (C) As “Express Mail Post Office to Addressee” without the Express Mail mailing label number being placed on the application and with the “date-in” entered by the applicant on Thursday, March 8, 2001, and the application being received in the USPTO on Wednesday, March 14, 2001.
- (D) As “Express Mail Post Office to Addressee” with the Express Mail mailing label number being placed on the application and with the “date-in” entered by the applicant on Thursday, March 22, 2001, and the application being received in the USPTO on Monday, March 26, 2001.
- (E) As “Express Mail Post Office to Post Office” with the Express Mail mailing label number being placed on the application and with the “date-in” entered by the USPS on Saturday, March 24, 2001, and the application being received in the USPTO on Monday, March 26, 2001.

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