

Test Number 100
Test Series 123

Name _____

**U.S. DEPARTMENT OF COMMERCE
UNITED STATES PATENT AND TRADEMARK OFFICE
REGISTRATION EXAMINATION
FOR PATENT ATTORNEYS AND AGENTS**

APRIL 12, 2000

Morning 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. Any reference to a practitioner is a reference to 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 subsequent court decision or a notice in the *Official Gazette*. 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 which 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," "PTO," or "Office" are used in this examination, they mean the U.S. 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 does not address or test any changes to the Patent Statute brought about by the enactment of the American Inventors Protection Act of 1999, Pub. L. No. 106-113 (“Act”). Accordingly, do not read the questions or answers as involving or being affected by the Act.

1. 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. However, in fact, “sufficient aeration” is necessarily an inherent element in the prior art blasting composition within the overlapping ranges inasmuch as the blasting composition explodes. 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) does not anticipate the claim because the prior art reference does not recognize an inherent ingredient, oxygen.
- (E) (B), (C) and (D).

2. 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 1.324 and appropriate fees were filed, and the petition was granted.
- (E) (A), (C) and (D).

3. A multiple dependent claim:

- (A) may indirectly serve as a basis for another multiple dependent claim.
- (B) added by amendment to a pending patent application should not be entered until the proper fee has been received by the PTO.
- (C) may directly serve as a basis for another multiple dependent claim.
- (D) is properly construed to incorporate by reference all the limitations of each of the particular claims to which it refers.
- (E) (B) and (D).

4. Buddy is a recent father and a machinist at a local machine shop that makes custom automotive parts. One day while driving to work, Buddy conceived an idea for an improved baby stroller. He quickly worked out many of the details of how to build such an improved stroller, but he still had questions. Buddy later explained his idea to his employer and showed the employer detailed preliminary drawings of the stroller without any agreement as to confidentiality. Buddy wanted use of his employer's machine shop to build a model. Buddy's employer was also excited about the stroller idea and its commercial potential, and the two quickly reached an oral agreement. Buddy would have free use of the machine shop equipment and supplies after regular business hours to work on his model. In exchange, Buddy agreed to assign any patent rights in his invention to the employer for \$1000.00. Only Buddy and, occasionally, his employer were ever present in the shop when Buddy was working on the stroller. Buddy finalized the design just over a year later, and a patent application was on file within a month of finalization along with a recently executed written assignment of the rights in the invention to Buddy's employer. During prosecution of the patent application, the examiner learned of the oral agreement between Buddy and his employer, and rejected the claims on the basis that the invention was on sale more than one year before the application filing date. Which of the following would provide the most reasonable basis for traversing the rejection?

- (A) The Examiner cannot properly make the rejection because it is not based on prior art patents or printed publications.
- (B) The oral agreement was a private transaction between Buddy and his employer and no private transaction can provide a basis for an on-sale bar.
- (C) An assignment or sale of the rights in an invention and potential patent rights is not a sale of "the invention" that would operate as a bar to patentability.
- (D) Because no one other than Buddy's employer was present in the shop when Buddy was working on the stroller and the oral agreement was not public, there can be no on-sale bar even though there was no express requirement of confidentiality.
- (E) Although the oral agreement to assign the patent to Buddy's employer was made more than a year before the filing date, the written assignment was less than a year before the filing date, and under the Statute of Frauds, sales for more than \$500.00 require a written agreement. A rejection based on the on-sale bar can never be made unless there is a binding contract for sale.

5. A patent application includes the following Claim 1:

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

- (i) heating a base made of carbon to a first temperature in the range of 1875°C to 1925°C;
- (ii) passing a first gas over said heated base, said first gas comprising a mixture of hydrogen, SiCl_4 , phosphorus, and methane, whereby said first gas decomposes over said heated base and thereby forms a first deposited layer of silicon, phosphorus and carbon on said heated base;
- (iii) heating said base having said deposited layer to a second temperature of approximately 1620°C; and
- (iv) passing a second gas over said base heated to said second temperature, said second gas consisting of a mixture of hydrogen, SiCl_4 , AlCl_3 , 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?

- (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, SiCl_4 and AlCl_3 only.

6. 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.

7. An application directed to hand shearing of sheep includes the following incomplete independent Claim 1 and dependent Claims 2-3.

- Claim 1. An apparatus for shearing sheep, said apparatus comprising:
- (i) a first cutting member having a first cutting edge at one end and a thumb loop at the other end;
 - (ii) a second cutting member having a second cutting edge at one end and a finger loop at the other end;
 - (iii) _____;
 - (iv) said second cutting member additionally including a pointer loop between said finger loop and said mid-point, said pointer loop having a pointer loop center, said finger loop having a finger loop center and said pointer loop having a pointer loop center such that a plane through said finger loop center and said pointer loop center is generally parallel to said second cutting edge for improved balance.
- Claim 2. The apparatus of claim 1, wherein said first cutting member includes a threaded aperture extending entirely through said first cutting member between said thumb loop and said mid-point, and an adjusting screw that extends through said threaded aperture to engage a bearing surface below the pointer loop on said second cutting member.
- Claim 3. The apparatus of claim 2, wherein said connector is a rivet.

Which of the following most broadly completes missing paragraph (iii) of Claim 1?

- (A) “wherein said first cutting member and said second cutting member are pivotally secured to each other at respective mid-points, and wherein said finger loop is padded; and”
- (B) “said first cutting member having a mid-point between its ends and said second cutting member having a mid-point between its ends, wherein said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points by a connector; and”
- (C) “said first cutting member including a reservoir for dispensing disinfectant solution and having a mid-point between its ends, said second cutting member having a mid-point between its ends, and wherein said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points by a connector; and”
- (D) “said first cutting member and said second cutting member being pivotally secured to each other by a connector; and”
- (E) “said first cutting member having a mid-point between its ends and said second cutting member having a mid-point between its ends, and said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points; and”

8. 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 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. 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.

9. 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.

Please answer questions 10 and 11 based on the following facts. Mario Lepieux was a member of a Canadian national hockey team touring Europe. While travelling 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.

10. 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.

11. Which of the following statements is most correct?

- (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).

12. 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.

13. 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 examiner rejects the claims under 35 U.S.C. § 112, first paragraph, for lack of enablement citing a publication 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. The rejection is:

- (A) appropriate. 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. 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. 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. The claims are commensurate in scope with the breadth of enablement inasmuch as the claims are original, and therefore are self-supporting.
- (E) inappropriate. 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.

14. 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.

15. On February 1, 1999, while vacationing in Viet Nam (which is not a WTO member), Sal, a U.S. citizen, invents a spinning top with a spring mounted within the axle that flips the top every 10 revolutions. Sal sells several tops to Nat just prior to leaving Viet Nam on March 15, 1999. Nat immediately begins making and selling the tops in Viet Nam through the Vietnamese firm of Natasha. On March 1, 2000, Natasha begins selling the tops in the United States. On the way back from Viet Nam, Sal visits several remote islands and doesn't return to the U.S. until April 10, 2000, when he visits his your office to obtain advice as to filing a patent application. What do you, a registered practitioner, tell him on April 12, 2000, in accordance with proper PTO practice and procedure?

- (A) The public sale on March 15, 1999 does not operate as a statutory bar since it did not occur in the U.S., and less than one year has passed since the sale in the U.S. by Natasha, Sal may file a patent application in the PTO before March 1, 2001, and then file an affidavit and swear behind the March 1, 2000 sale by Natasha.
- (B) Since none of the acts by which the invention was derived were performed in the United States, Sal cannot prove a date of invention prior to April 2000. Therefore his patent is defeated by the knowledge of others as a result of the public sale in the U.S. by Natasha on March 1, 2000.
- (C) Since Sal is a U.S. citizen only temporarily visiting the foreign country of Viet Nam, he is entitled to claim a date of invention of February 1, 1998, since 35 U.S.C. § 102(a) is not limited to the U.S.
- (D) Since Sal did not authorize the sale of tops in the United States, the March 1, 2000 sale by Natasha cannot be used as prior art against him.
- (E) Sal is barred by the public sale on March 15, 1999, since under WTO, acts performed in a foreign country are considered as though they were performed in the U.S.

16. A patent specification discloses a personal computer comprising a microprocessor and a random access memory. There is no disclosure in the specification of the minimum amount of storage for the random access memory. In the disclosed preferred embodiment, the microprocessor has a clock speed of 100-200 megahertz. Claims 9 and 10, presented below, are original claims in the application. Claim 11, presented below, was added by amendment after an Office action.

- 9. A personal computer comprising a microprocessor and a random access memory including at least 1 gigabyte of storage.
- 10. The personal computer of Claim 9, wherein the microprocessor has a clock speed of 100-200 megahertz.
- 11. The personal computer of Claim 10, wherein the random access memory is greater than $\frac{1}{2}$ gigabyte of storage.

Which of the following statements is or are **true** about the respective claims under 35 U.S.C. § 112, fourth paragraph?

- (A) Claim 9 is a proper independent claim, and Claims 10 and 11 are proper dependent claims.
- (B) Claim 9 is a proper independent claim, and Claims 10 and 11 are improper dependent claims.
- (C) Claim 9 is an improper independent claim, and Claims 10 and 11 are improper dependent claims.
- (D) Claim 9 is an improper independent claim, and Claims 10 and 11 are proper dependent claims.
- (E) Claim 9 is a proper independent claim, Claim 10 is a proper dependent claim, and Claim 11 is an improper dependent claim.

17. 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) 1. A laminate comprising a transparent protective layer and a light-sensitive layer.
- (B) 1. 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) 1. 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).

18. Which of the following is NOT a policy underlying the public use bar of 35 U.S.C. § 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 period greater than the statutorily prescribed time.

19. On February 1, 1999, you filed an application on behalf of Williams directed to a system for detecting expired parking meters. The specification fully supports original Claim 1, the sole claim. 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.” Claim 1 of the Williams application is as follows:

Claim 1. 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 coupled to the infrared sensor and the timer mechanism.

You received a final Office action, dated February 1, 2000, containing an indication that claim 1 is allowable subject matter, but objecting to the specification, on the grounds that the subject matter of the electronics control unit, though adequately described in the original specification, was required to be shown in the drawings. Which of the following actions, if any, comports with proper PTO practice and procedure for overcoming the objection?

- (A) On April 1, 2000, file a Notice of Appeal, appropriate fees, and a brief pointing out that a patent should issue since the subject matter of the electronics control unit was adequately described in the original specification.
- (B) On April 1, 2000, file in the PTO a drawing illustrating only the portion of the electronics control unit that was described in the original specification.
- (C) On April 1, 2000, file a Notice of Appeal, 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, 2000, file a petition 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.

20. In the course of prosecuting a patent application, you receive a final rejection wherein the examiner has set a 3 month shortened statutory period for reply. You file an initial reply with a Certificate of Mailing in accordance with 37 C.F.R. § 1.8 within 2 months of the final rejection mail date. The examiner responds with an Advisory Action having a mail date before the end of the 3 month shortened statutory period. In accordance with proper PTO practice and procedure, the fee for an extension of time for applicant to take subsequent appropriate action in the PTO is calculated from:

- (A) the mail date of the Advisory Action.
- (B) the date your reply is received by the PTO.
- (C) the date your reply is mailed with a Certificate of Mailing in accordance with 37 C.F.R. § 1.8.
- (D) the mail date of the Final Rejection.
- (E) the date the shortened statutory period expires.

21. All of the following portions of a patent application can be used for interpreting the scope of the claims in the application except the _____

- (A) description of the preferred embodiment.
- (B) abstract of the disclosure.
- (C) background of the invention.
- (D) drawings.
- (E) detailed description of the drawings.

22. Which of the following rejections can properly be overcome using a 37 C.F.R. § 1.131 affidavit?

- I. A rejection under 35 U.S.C. § 102(a) based on a journal article that describes the invention as claimed.
 - II. A rejection under 35 U.S.C. § 102(b) based on a patent that discloses but does not claim the invention.
 - III. A rejection based on statutory double patenting.
 - IV. A rejection under 35 U.S.C. § 102(e) based on a patent that discloses but does not claim the same patentable invention.
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- (A) I.
 - (B) II.
 - (C) III.
 - (D) IV.
 - (E) I and IV.

Please answer questions 23 and 24 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, 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.

23. 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.

24. 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 Amendment would constitute new matter.
- (B) 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.

25. GMD Corp. files a patent application on a computer with a display screen which powers itself by solar panels. The examiner restricts the claims into two groups. Group 1 contains claims 1-5 directed to the combination of the computer and display screen. Group 2 contains claims 6-10 directed solely to the display screen. Practitioner Sam advises GMD Corp. that (a) the restriction requirement could be traversed since the inventions are not separate and distinct and (b) the restriction requirement may be traversed by adding patentable claims linking the two inventions. Nonetheless, GMD instructs Sam to delete claims 6-10 and file a divisional application incorporating claims 6-10. Sam deletes the claims 6-10, and the patent is granted on May 4, 1999 for claims 1-5. However, Sam inadvertently failed to file a divisional application. Today, April 12, 2000, GMD's president comes to you for advice as to how they can obtain patent protection for the subject matter in claims 6-10. Which of the following is the best advice you can offer in accordance with proper PTO practice and procedure?

- (A) GMD is barred from filing an application for claims 6-10 since during the original prosecution they deleted the very same claims following a restriction requirement.
- (B) Since GMD instructed Sam to file a divisional application and because his failure to do so was inadvertent, GMD may file a reissue application to obtain patent protection for those claims based upon inadvertent error without deceptive intent.
- (C) Since the restriction was made in the original case and not contested, a divisional reissue and appropriate fees must be filed to obtain patent coverage for claims 6-10.
- (D) Since the inventions were not separate and distinct, a reissue application and appropriate fees may be filed in which the restriction requirement may be traversed, and if successful, claims 6-10 can be added and entered.
- (E) Before one year transpires from the issuance of the patent, GMD should file a patent application containing claims directed to the same subject matter as deleted claims 6-10, and the appropriate fee.

26. 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 U.S.C. §112, first paragraph.
- (C) A process is reduced to actual practice when it is successfully performed.
- (D) The diligence of 35 U.S.C. § 102(g) requires an inventor to drop all other work and concentrate on the particular invention.
- (E) The diligence of 35 U.S.C. § 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.

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

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

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

- (A) Filing a reply, on March 9, 2000, with a petition for a three-month extension and the fee for a three-month extension, traversing the rejection on the ground that Gold does not disclose using the composition for bonding semiconductor materials to metals, and therefore does not disclose all the elements of Claim 1.
- (B) Filing a reply, on September 9, 1999, traversing the rejection on the ground that Gold does not disclose using the composition for bonding semi-conductor materials to metals, and therefore does not disclose all the elements of Claim 1.
- (C) Filing a reply on October 9, 1999, amending Claim 1 to state as follows: “Claim 1. A composition comprising: 20%A, 20%B, and 60%D.” In the reply, pointing out why the amendment gives the claim patentable novelty.
- (D) Filing a reply on October 9, 1999, traversing the rejection on the grounds that the patent to Gold teaches away from using the invention in the manner taught in Bond’s application.
- (E) Filing (i) a 37 C.F.R. § 1.132 affidavit objectively demonstrating the commercial success of the invention as claimed, and (ii) a reply containing an argument why the claimed invention is patentable, but no amendment to Claim 1.

28. Which of the following three statements is(are) **true**?

- (i) An applicant cannot use a patent to prove the state of the art for the purpose of satisfying the enablement requirement if the patent has an issue date later than the effective filing date of the applicant's application.
 - (ii) A publication dated after the effective filing date of an application may be properly used to demonstrate that an application is nonenabling if the publication provides evidence of what one skilled in the art would have known on or before the application's effective filing date.
 - (iii) The state of the art existing at the issue date of the patent is used to determine whether a particular disclosure in the patent is enabling.
- (A) (i), (ii) and (iii).
 - (B) (i) and (ii).
 - (C) (i).
 - (D) (ii) and (iii).
 - (E) None of the above.

29. You are attorney of record appointed by XYZ Corp. to prosecute a patent application directed to an invention assigned to the XYZ Corp. by an employee-inventor. In the course of prosecution, you receive an Office action rejecting all the claims as anticipated by a patent to Williams. After carefully reviewing the Office action and discussing the same with XYZ officers, it is concluded that the rejection is sound. In accordance with instructions from XYZ officers, you file in the PTO a certification by XYZ Corp. that it is the assignee of the invention, and an express abandonment signed by you under 37 C.F.R. § 1.138. An appropriate PTO official acknowledges receipt and accepts the express abandonment. Shortly thereafter, you receive an urgent call from the employee-inventor, who informs you that she just learned of the action taken to abandon the application, and that she has reviewed the Williams patent and concluded that her invention differs therefrom in a subtle but significant manner. Which of the following courses of action, if any, are properly available to you to successfully revive the application in accordance with proper PTO practice and procedure?

- (A) Request reconsideration of the abandonment on the ground that the filing of the express abandonment was without the inventor's consent.
- (B) Request reconsideration of the abandonment on the ground that the filing of the express abandonment was the result of a mistake.
- (C) File a petition to revive the application with all the elements required under 37 C.F.R. § 1.137(a) on the ground that the filing of the express abandonment was unavoidable.
- (D) File a petition to revive the application with all the elements required under 37 C.F.R. § 1.137(b) on the ground that the filing of the express abandonment was unintentional.
- (E) None of the above.

30. On February 8, 1999, you prepared and filed a patent application for Smith disclosing and claiming a new method for heating automobile windshields. The specification disclosed connecting a variable voltage source to a resistive heating element, connecting the heating element to the windshield, and adjusting the voltage of the voltage source to an effective amount. The specification stated certain advantages of heating automobile windshields by the invention's method, including protecting the internal structure of the glass from cracking, and defrosting the glass. The specification also fully disclosed guidelines adequately explaining that an effective amount of voltage to protect windshield glass from cracking was at least 0.5 volts, regardless of the outside temperature. The specification disclosed that an effective amount of voltage for defrosting windshields was at least 1.0 volt, regardless of the outside temperature. Claim 1 stated the following:

Claim 1. A method for heating an automobile windshield, comprising: connecting a variable voltage source to a resistive heating element; connecting the resistive heating element to the automobile windshield; and adjusting the voltage source to an effective amount of voltage.

You received a non-final Office action, dated February 4, 2000, rejecting claim 1 only under 35 U.S.C. § 112, second paragraph. The rejection stated that the use of the limitation, "an effective amount of voltage," rendered the claim indefinite. Which, if any, of the following actions, taken by you, comport with proper PTO rules and procedure, and will overcome the rejection?

- I. Filing an appeal with a brief, on August 3, 2000, arguing that the only remaining issue is the definiteness of claim 1, and that the claim is not rendered indefinite by the use of the limitation, "an effective amount of voltage," since guidelines in the specification fully disclosed what "an effective voltage" would be.
- II. Filing a reply on May 4, 2000, traversing the rejection on the grounds that claim 1 is not rendered indefinite by the use of the limitation, "an effective amount of voltage," since guidelines in the specification fully disclosed what "an effective voltage" would be.
- III. Filing a reply on May 4, 2000, amending the limitation, "an effective amount of voltage" to read, "an effective amount of voltage for defrosting the automobile windshield".

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

31. A prima facie case of obviousness requires a suggestion, teaching, or motivation to modify the references to produce the claimed invention. The suggestion, teaching, or motivation is established:

- (A) only if the suggestion, teaching, or motivation to do so is found in the references themselves.
- (B) if the claimed invention is within the capabilities of one of ordinary skill in the art.
- (C) by the mere fact that the references can be combined.
- (D) if the suggestion, teaching, or motivation is found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.
- (E) (A), (B), (C) and (D).

32. 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).

33. Applicant filed a utility patent application in the PTO on Wednesday, June 8, 1994, and the examiner issued a requirement for restriction to one of two inventions claimed. On Wednesday, June 7, 1995, applicant then elected one of the inventions and filed a divisional application thereon in compliance with the requirements of 35 U.S.C. § 120. During prosecution of the divisional application, the examiner issued a Final Rejection, and following a successful appeal to the Board of Patent Appeals and Interferences by applicant, the application issued as a patent on Tuesday, February 11, 1997. Assuming all required maintenance fees are timely paid, on which of the following dates will the patent term end?

- (A) Tuesday, February 11, 2014.
- (B) Sunday, June 8, 2014.
- (C) Sunday, June 7, 2015.
- (D) Friday, August 8, 2014.
- (E) Friday, August 7, 2015.

34. 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 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.

35. On July 1, 1998, a registered practitioner files an application containing 10 claims that are directed to a computer. The practitioner thereafter receives an Office action wherein claims 1 - 5 are properly rejected under 35 U.S.C. § 102 based upon reference A dated January 3, 1999. Reference A is an abstract identifying a computer, the computer's vendor, and information informing potential buyers whom to contact, price terms, documentation, warranties, training and maintenance programs, and the date of the computer's release to the public. In sufficient detail to meet the requirements of 35 U.S.C. § 112, reference A describes a computer having all of the elements of the rejected claims. According to reference A, the computer described therein was publicly sold in the United States in June 1997. As a practitioner, what should you advise your client to do in accordance with proper PTO practice and procedure?

- (A) File a reply arguing that Reference A cannot constitute prior art since it is dated subsequent to the filing date of the application.
- (B) File an amendment canceling the rejected claims and argue patentability of the remaining claims.
- (C) Argue that reference A constitutes hearsay evidence because there is no direct evidence that the computer of Reference A was actually in existence in June 1997.
- (D) Argue that even if the computer of Reference A was in existence in June 1997, the failure to disclose the invention until 1999 constituted abandonment of the invention.
- (E) Request a public use hearing to determine if there actually was public use in June 1997.

36. 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.

37. You are preparing a patent application for your client, Perry. The invention is disclosed in the specification as a doodad making machine comprising elements A, B, and means C for performing a function. The specification discloses two specific embodiments for performing the function defined by means C, namely C' and C". The specification also discloses that components D or E may be combined with A, B, and means C to form: (i) A, B, D, and means C; or (ii) to form A, B, E, and means C. The specification also discloses that component G may be used, but with only means C' to improve the machine's performance. The specification also states that the machine is rendered inoperative if component G is used with C", or whenever components D or E are present. The first three claims in the application are:

- 1. A doodad making machine comprising A, B, and means C for performing a function.
- 2. A doodad making machine as claimed in Claim 1 wherein means C is C'.
- 3. A doodad making machine as claimed in Claim 1 or 2 further comprising D.

Which of the following would be a proper claim 4 and be supported by the specification?

- (A) A doodad making machine as claimed in Claim 2, further comprising E.
- (B) A doodad making machine consisting essentially of A, B, means C for performing a function, D and G.
- (C) A doodad making machine as claimed in Claim 1 or 2, further comprising D.
- (D) A doodad making machine as claimed in Claims 1 and 2, further comprising G.
- (E) A doodad making machine as claimed in any of the following claims, wherein means C is C", and further comprising G.

38. Inventor Charles patented a whirlwind device for defeathering poultry. Although the scope of the claims never changed substantively during original prosecution of the patent application, practitioner Roberts repeatedly argued that limitations appearing in the original claims distinguished the claimed subject matter from prior art relied upon by the examiner in rejecting the claims. After the patent issued, Charles realized that the claims were unduly narrow, and that the limitations argued by Roberts were not necessary to patentability of the invention. Accordingly, a timely application was made for a broadened reissue patent in which Charles sought claims without limitations relied upon by Roberts during original prosecution. The new claims were properly supported by the original patent specification. Charles asserted in his reissue oath that there was an error in the original patent resulting from Roberts' failure to appreciate the full scope of the invention during original prosecution of the application. No supporting declaration from Roberts was submitted in the reissue application. Based on the foregoing facts and controlling law, which of the following statements is most accurate?

- (A) Although the scope of the claims was not changed substantively during prosecution of the original patent, the recapture doctrine may preclude Charles from obtaining the requested reissue because of the repeated arguments made by practitioner Roberts.
- (B) The recapture doctrine cannot apply because the claims were not amended substantively during original prosecution.
- (C) The reissue application will not be given a filing date because no supporting declaration from practitioner Roberts was submitted.
- (D) The doctrine of prosecution history estoppel prevents Charles from seeking by reissue an effective claim scope that is broader than the literal scope of the original claims.
- (E) The doctrine of late claiming prevents Charles from seeking an effective claim scope broader than the literal scope of the original claims.

39. Impermissible recapture in an application exists _____

- (A) if the limitation now being added 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.
- (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.

40. Which of the following is **true**?

- (A) Once the claims of a patent application are determined to be invalid by the Board of Patent Appeals and Interferences, an applicant may not thereafter file another patent application regarding the same invention with narrower claims.
- (B) Once the claims of a patent application are determined to be invalid by the Court of Appeals for the Federal Circuit, an applicant may not thereafter file another patent application regarding the same invention with narrower claims.
- (C) Collateral estoppel bars an applicant from filing several applications for obvious improvements of the same invention.
- (D) The failure of an independent claim in a patent to claim a feature of the invention, which is not found in a genus, results in Jepson estoppel against the inventor claiming the invention with the feature in another patent application.
- (E) During reexamination, if the independent claims of a patent are not broadened, then amendments to the dependent claims cannot broaden the scope of the invention covered by the claims.

41. On July 1, 1998, you file an application wherein the inventors are listed as Mae, Bea and Seya. The application is filed with an unexecuted declaration. On July 15, 1998, Mae and Bea sell their patent rights by assignment of the application to Seya. On July 25, 1998, Seya advises the practitioner that Bea has died, and Mae has moved to the West Indies. On July 27, 1998, you receive a notice from the PTO indicating that declaration was not executed and an executed declaration must be submitted. As a registered practitioner, what would you do in accordance with proper PTO practice and procedure to file a proper reply?

- (A) Find out who is the executor or administrator of the estate of Bea, and file a declaration (naming Mae, Bea, and Seya as inventors) executed by the executor or administrator in the signature block for Bea.
- (B) Since Bea and Mae assigned their rights in the patent application to Seya, only Seya needs to sign the declaration. A declaration should be filed with the PTO, which is signed only by Seya with the names of Bea, and Mae deleted, and with an explanation that they no longer have rights in the application and should no longer be listed as inventors.
- (C) Attempt to contact Mae and, if after a diligent effort, no response is forthcoming, file a statement executed by practitioner stating the diligent effort made to obtain the signature of Mae, and that she could not be located and no response ensued. File a declaration (naming Mae, Bea, and Seya as inventors) signed by Seya in the signature block for Seya's signature.
- (D) Have Seya sign the declaration on his own behalf and on behalf of the missing inventors.
- (E) Both (A) and (C) are required.

42. 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.

43. On January 3, 2000, inventor Jones became aware of a patent issued to Smith that was directed to subject matter very similar to that claimed in Jones’ pending application. Smith’s patent issued on February 2, 1999, but was based on an application filed after Jones’ application. On January 14, 2000, Jones sent a letter to registered practitioner Wilson requesting that Wilson copy claims 1-5 of the Smith patent and seek to have an interference declared between Jones and Smith. The letter arrived in Wilson’s office on January 18. However, Wilson was away on an extended vacation, and did not see Jones’ letter until his return to the office on February 7, 2000. The next day Wilson filed an Amendment adding to Jones’ application claims 21-25, which were directed to the same invention as Smith’s claims 1-5. Wilson informed the PTO that these claims were copied from Smith’s patent for the purpose of instituting an interference. However, the examiner rejected the claims and refused to declare an interference because the copied claims were not presented in a timely manner. Which of the following should help Jones obtain priority in the PTO to the commonly claimed subject matter?

- (A) Jones petitions the Commissioner under 37 C.F.R. § 1.183 for acceptance of the copied claims on the basis that any delay in presenting the claims was unavoidable, and requesting that an interference then be declared. Jones pays the appropriate fee.
- (B) Jones petitions the Commissioner under 37 C.F.R. § 1.183 for acceptance of the copied claims on the basis that any delay in presenting the claims was unintentional, and requesting that an interference then be declared. Jones pays the appropriate fee.
- (C) While his application is still pending, Jones files a civil action against Smith in U.S. District Court under 35 U.S.C. § 291 seeking to adjudge the validity of the Smith patent.
- (D) Jones files with the examiner a request for reconsideration noting that Smith’s filing date is subsequent to Jones’ filing date and, therefore, an interference should be declared and Jones named the senior party.
- (E) None of the above.

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

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

45. Which of the following presents a Markush group in accordance with proper PTO practice and procedure?

- (A) R is selected from the group consisting of A, B, C, or D.
- (B) R is selected from the group consisting of A, B, C, and D.
- (C) R is selected from the group comprising A, B, C, and D.
- (D) R is selected from the group comprising A, B, C or D.
- (E) R is A, B, C, and D.

46. Which of the following statements regarding amending a reissue application is not correct?

- (A) In a claim, hand entry of an amendment of five words or less is permitted.
- (B) Each amendment submission must set forth the status, on the date of the amendment, of all patent claims and of all added claims.
- (C) An entire paragraph in the specification other than the claims may be deleted by a statement deleting the paragraph without presentation of the text of the paragraph.
- (D) When responding to an Office action, each amendment when originally submitted must be accompanied by an explanation of the support in the disclosure of the patent for the amendment.
- (E) A new claim added by amendment must be presented with underlining throughout the claim.

47. 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.

48. Kevin invents a solar energy device for cooking food having a parabolic reflector with a rod connected along the center axis of the reflector, and a cooking grill connected to the top of the rod. A thorough search of the prior art results in locating Bill's United States patent, issued July 22, 1997. Bill's patent discloses a parabolic reflector having a cut-out portion from the base of the reflector with a rod connected along the center axis of the reflector, and a grill for cooking connected to the top of rod. Figures in Bill's patent show the invention with (Fig. 2) and without (Fig. 1) the cut-out portion, respectively. Bill's patent specifically teaches away from making the device by omitting the cut-out portion because the base portion of the reflector would unnecessarily gather fat and grease when the device is used to cook meat. On July 1, 1998, you, a registered practitioner, discuss the patent with Kevin, who states that his invention would be advantageous, since by leaving out the cut-out portion, the invention could be used to collect fat and grease, which could be sold. On July 20, 1998, you file a patent application for Kevin disclosing the solar energy device and its advantages, and claiming the device. During examination of the application, an examiner finds a publication disclosing a solar energy cooking device having a reflector without a cut-out portion. Which of the following accurately describes the duty to disclose Bill's patent to the PTO?

- (A) Only you have a duty to disclose the patent to the PTO.
- (B) Both you and Kevin have a duty to disclose the patent to the PTO, but the disclosure need not be in writing.
- (C) Both you and Kevin have a duty to disclose the patent to the PTO, and the disclosure must be in writing.
- (D) There is no duty to disclose the patent to the PTO, since it is a United States patent, and the examiners already independently have access to electronically search the database with all the United States patents.
- (E) There is no duty to disclose the patent to the PTO, because the patent is not material to patentability since it teaches away from the inventive concept of Kevin's invention.

49. Which of the following statements is NOT true?

- (A) In representation of a client, a patent practitioner may not refuse a client's request that the practitioner aid or participate in conduct that the practitioner believes to be unlawful so long as there is some support for an argument that the conduct is legal.
- (B) A patent practitioner may not form a partnership with a non-practitioner if any of the activities of the partnership consists of the practice of patent law before the PTO.
- (C) In a patent case, a practitioner may take an interest in the patent as part or all of his or her fee.
- (D) If a practitioner receives information clearly establishing that a client has, in the course of representation, perpetrated a fraud on the PTO that the client refuses or is unable to reveal, the practitioner must reveal the fraud to the PTO.
- (E) A patent practitioner may not accept compensation from a friend of a client for legal services performed by the practitioner for the client, unless the client consents after full disclosure.

50. On Saturday, February 6, 1999, in Texas, inventor Smith successfully tested a wireless telephone. On Sunday, February 7, 1999, Smith began testing the market place by offering to sell the wireless telephone in a variety of urban and rural regions, throughout Texas. On Tuesday, February 8, 2000, registered practitioner Bill filed a patent application for inventor Smith fully disclosing and claiming the same wireless telephone he tested on February 6, 1999, and offered for sale on February 7, 1999. Bill received a non-final Office action rejection of the claim under 35 U.S.C. § 102(b) based on Smith's activities in testing the wireless telephone, and testing the market place. Which, if any, of the following actions taken by Bill comport with proper PTO rules and procedure, and will overcome the rejection?

- (A) Filing a timely reply traversing the rejection on the grounds that February 7, 1999 was a Sunday, that Smith could not file an application on the one-year anniversary Sunday because the PTO is closed, so Smith's activities must be measured from Monday, February 8, 1999, which is not more than one year prior to the application date.
- (B) Filing a timely reply traversing the rejection on the grounds that Smith's activities were experimental only and therefore excepted from 35 U.S.C. § 102(b).
- (C) Filing a timely reply with an affidavit under 37 C.F.R. § 1.131 presenting statements by Smith that the activities were by Smith, himself, as opposed to another, and the activities were experimental.
- (D) Filing a timely reply with an affidavit under 37 C.F.R. § 1.132 demonstrating by objective evidence of the commercial success of the wireless telephone.
- (E) None of the above.