

Test Number 100
Test Series 456

Name _____

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

APRIL 12, 2000

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

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

2. Which of the following statements is **true** based on current PTO practice and procedure?

- (A) Where claims in an application on appeal have been rejected on prior art, the Board cannot consider a reference having a publication date after the effective date of the application.
- (B) Objective indicia of non-obviousness cannot depend on facts developed after the effective date of the application under consideration.
- (C) Evidence that has developed only after the filing date of an application cannot be used to show non-obviousness.
- (D) The scope of objective evidence of non-obviousness is independent of the scope of the claim for which the evidence is offered to support.
- (E) Objective evidence of non-obviousness must be commensurate in scope with the claims for which the evidence is offered to support.

3. 100. Which of the following is **true**?

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

4. A patent application includes the following incomplete Claim 1:

Claim 1. A shaving implement comprising

- (i) _____;
- (ii) a shaving head arranged perpendicular to said handle and including a razor, said shaving head being connected to said handle at said first end;
- (iii) a collapsible tube of shaving cream positioned in and substantially filling said dispensing chamber, said tube including a neck having a dispensing opening provided in proximity to said razor;
- (iv) a removable dispensing chamber plug provided at said second end such that when said plug is removed said collapsible tube of shaving cream may be replaced; and
- (v) a tube squeezing slide positioned within said channel and said dispensing chamber, said slide including opposed slots thereon, said slots being in sliding engagement with said longitudinal sides of said channel.

Which of the following, if included as paragraph (i) of Claim 1, properly completes the claim?

- (A) an elongated handle including a dispensing chamber and a channel formed in said handle, said channel being defined by longitudinal sides within said handle and communicating over substantially its entire length with said dispensing chamber;
- (B) an elongated handle having a first end, said handle including a chamber and a channel formed in said handle, said channel being defined by longitudinal sides within said handle and communicating over substantially its entire length with said chamber;
- (C) an elongated handle having a first end, said handle including a dispensing chamber and an elongated channel formed in said handle, said channel communicating over substantially its entire length with said chamber;
- (D) an elongated handle having a first end and a second end, said handle including a dispensing chamber and a channel formed in said handle, said channel being defined by longitudinal sides within said handle and communicating over substantially its entire length with said dispensing chamber;
- (E) an elongated handle having a first end and a second end, said handle including a channel formed in said handle, said channel being defined by longitudinal sides within said handle and communicating over substantially its entire length with said chamber;

5. Beverly, who was already well known for her research work in the shampoo industry, was working toward a Ph.D. in chemistry from a university near Berlin, Germany. As part of her doctoral program, Beverly prepared (in German) a thesis directed to her work on a new formulation for an “all-in-one” shampoo and conditioner. Following approval of the thesis by her faculty advisor on December 21, 1998, the sole copy of Beverly’s thesis was placed on the shelves of the university library on January 29, 1999, where it was accessible to the faculty and students of the university as well as to the general public. At that time, the thesis was indexed in a general user’s catalog maintained locally at the university library by author, title and subject. On March 4, 1999, the general user’s catalog was made freely available on an Internet web page maintained by the university. Which of the following statements is most correct?

- (A) Beverly’s thesis may be used under 35 U.S.C. § 102(b) as a prior art printed publication against a United States application for patent filed January 15, 2000.
- (B) Beverly’s thesis may be used under 35 U.S.C. § 102(b) as a prior art printed publication against a United States application for patent filed February 26, 2000.
- (C) Beverly’s thesis may be used under 35 U.S.C. § 102(b) as a prior art printed publication against a United States application for patent filed March 8, 2000.
- (D) (A), (B) and (C).
- (E) (B) and (C).

6. In the course of prosecuting a patent application for his client, Smith did not receive a Notice of Allowance and Issue Fee Due from the PTO. Fifteen months after submitting a reply to a final rejection, Smith received from the PTO a Notice of Abandonment advising that the application became abandoned for failure to pay the issue fee. Which of the following actions, if any, accords with proper PTO practice and procedure, and is most likely to succeed in protecting the interests of Smith’s client?

- (A) File a petition to revive the application including a statement that the entire delay in paying the issue fee, from the due date for the payment of the fee until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(a), was unavoidable, accompanied by the issue fee then in effect, and any required terminal disclaimer.
- (B) File a petition to revive the application including a statement that the entire delay in paying the issue fee, from the due date for the payment of the fee until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b), was unintentional, and required terminal disclaimer.
- (C) File a timely petition to withdraw the holding of abandonment accompanied by a statement that the Notice of Allowance and Issue Fee Due was not received, and that a search of the file jacket and docket records indicates that the Notice of Allowance and Issue Fee Due was not received. Include with the petition a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed.
- (D) All of the above.
- (E) None of the above.

7. A potential new client XYZ Corp. calls you for representation. The President of XYZ informs you that XYZ has been accused by ANY Corp. of infringing ANY's soon to be issued patent. The President indicates that XYZ has been making the accused infringing device for three months, and want to file their own patent application on the device themselves. You determine that your law partner, also a registered practitioner, represents ANY before the PTO in regard to the patent application filed by ANY, and that you and the partner have a power of attorney in the application from ANY. Which of the following should you do and/or advise XYZ, to do in accordance with the PTO Disciplinary Rules?

- (A) Decline to accept employment from XYZ.
- (B) Perform a patent search, and upon locating a published PCT application referencing the patent application filed by ANY, you decide that no information about the ANY application is confidential. Thus, you can ask your partner for information regarding the ANY application to relay to your client, XYZ.
- (C) Advise XYZ that you can file a patent application for the device on behalf of XYZ. Even though ANY was the first to file, an interference may be declared to determine priority of invention if the claims are the same or substantially similar.
- (D) Advise XYZ that because your partner has had experience with similar types of cases, that it will be easy for him to file a patent application on behalf of XYZ.
- (E) You must ask XYZ for any prior art which they have available and give it to your partner in order to satisfy the duty of disclosure rules with respect to the case which your partner is handling for ANY.

8. It is widely understood in the relevant art that a knife is but one of many types of "cutting means," and that a knife can have a blade that is "serrated" or "honed." During reexamination of a patent, the patent owner seeks to amend Claim 1 as follows:

(amended) A [knife] cutting means having a handle portion and a serrated blade.

All changes in the claim are fully supported by the original disclosure in the patent. Which of the following correctly explains why the claim, as amended, should or should not be rejected?

- (A) The claim should be rejected because the amendment broadens the scope of the patent claim by changing replacing "knife" with "cutting means," a broader recitation.
- (B) The claim should be rejected because the claim has not been amended in accordance with PTO rules for amending patent claims.
- (C) The claim should not be rejected because the claim is fully supported by the original patent disclosure.
- (D) The claim should not be rejected because the amendment does not add new matter into the claim.
- (E) The claim should not be rejected because the amendment narrows the scope of the patent by modifying "blade" to being a "serrated blade."

9. 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 within 2 months of the Final Rejection mail date, and the examiner responds with an Advisory Action having a mail date after 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 date your reply is received by the PTO.
- (B) the mail date of the Final Rejection.
- (C) the mail date of the Advisory Action.
- (D) the date the Advisory Action is received by you.
- (E) the date the shortened statutory period expires.

10. On December 1, 1998, Sam, attorney for the firm of Thrill and Chill, files a request for reexamination of a patent owned by his client, Hurley Corp., along with a recently discovered Russian patent which issued more than one year before the filing date of the patent. Hurley's patent contains one independent claim and nine dependent claims. The request for reexamination is granted on February 1, 1999. On June 1, 1999, an Office action issues in which the Examiner properly rejects independent claim 1 under 35 U.S.C. §§ 102 and 103 using the Russian reference and objects to the remaining claims as being dependent upon a rejected claim. Sam receives the Office action, agrees with the Examiner that claim 1 is unpatentable over the Russian patent and forwards it to his client, Hurley Corp. Hurley Corp. is undergoing financial problems and files for bankruptcy protection with the Federal District Court. They advise Sam that they have no funds available to further prosecute the reexamination proceeding. In accordance with proper PTO practice and procedure what should Sam do?

- (A) Advise the Examiner on the telephone that the patentee has filed for bankruptcy protection, and that nothing should be done in the reexamination proceeding until the bankruptcy is settled.
- (B) Do nothing and a reexamination certificate will issue indicating that claim 1 is canceled and that the patentability of claims 2 - 10 is confirmed.
- (C) File a fallacious reply arguing the patentability of claim 1 in order to allow the reexamination proceeding to continue.
- (D) File a divisional reexamination proceeding whereby claims 2 through 10 will be transferred into the divisional and allowed to issue. Claim 1, still in the original reexamination proceeding, can then be appealed to the Board of Patent Appeals and Interferences at a later point in time after the bankruptcy is resolved.
- (E) Send a letter to his client Hurley Corp. advising them that unless he is paid in advance, he will take no further action in the proceeding and file no papers with the PTO.

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

- (A) The differences between a continuation application and a continuation-in-part (C-I-P) application include: (1) new matter can be added when a C-I-P is filed and (2) the inventive entity in an original application and continuation application must be the same, whereas only one common inventor is necessary between an original application and a CIP application.
- (B) A reissue applicant's failure to timely file a divisional application is error and proper grounds for filing a reissue application.
- (C) A patent claiming a process is shown to be inoperative by showing no more than that it is possible to operate within the disclosure of the patent without obtaining the alleged product.
- (D) Where appeal to the Board of Patent Appeals and Interferences is dismissed for failure to argue a ground of rejection involving all the appealed claims, but allowed claimed remain in the application, the application becomes abandoned.
- (E) None of the above.

12. Clem and Tine, while dating, invent a wedding ring programmed to chime on each wedding anniversary. Unfortunately, the romance did not last. Clem comes to you, a registered practitioner, and says that he now wants to file a patent application. Clem admits that it was partly Tine's idea. Clem further advises you that before the couple ended their relationship, Tine deceptively filed a patent application for the same wedding ring in her name alone, application No. 09/123456. Which of the following is the proper advice to give Clem in accordance with proper PTO practice and procedure?

- (A) File a patent application listing Clem as the sole inventor, and the appropriate fees. Since Tine has already filed an application for the same device as sole inventor, she cannot be listed as a co-inventor in another application for the same device. An interference must be declared to determine proper inventorship.
- (B) File a patent application listing both Clem and Tine as coinventors, and the appropriate fees. If Tine refuses to sign the declaration, Clem has to file (i) a declaration signed by him naming himself and Tine as joint inventors, (ii) a petition, and (iii) the appropriate fees.
- (C) File a protest in the PTO (prior to the mailing of a notice of allowance in Tine's application) indicating the application serial number 09/123456 and informing the PTO that Clem is a coinventor.
- (D) Advise Clem that he could save money by allowing Tine to continue to prosecute her application and then, after the patent issues, he can sue her for half of the royalties.
- (E) (B) and (C).

13. Upon filing in the PTO, an original, nonprovisional patent application contains the following claims: Claim 1 is independent. Claim 2 depends from Claim 1. Claim 3 depends from Claim 2. Claim 4 depends from Claim 2 or 3. Claim 5 depends from Claim 3. Claim 6 depends from Claim 2, 3, or 5. The application contains only the foregoing claims. How many dependent claims are there for fee calculation purposes?

- (A) 4
- (B) 5
- (C) 7
- (D) 8
- (E) 9

14. A practitioner submitted a new patent application to the PTO using the Express Mail service of the U.S. Postal Service. The PTO never receives the new patent application. Which of the following is not necessary to comply with the requirements for receiving the date of deposit with the U.S. Postal Service as the filing date?

- (A) A petition showing that the number of the Express Mail mailing label was placed on the application before the application was sent.
- (B) A true copy of the new application showing certificate of mailing thereon signed by the practitioner's secretary stating when the correspondence was deposited with the U.S. Postal Service as first class mail with sufficient postage in an envelope addressed to the Commissioner of Patents and Trademarks, Washington, DC 20231.
- (C) A true copy of the of the Express Mail mailing label showing the "date-in" or other official notation entered by the U.S. Postal Service.
- (D) A true copy of the new application showing the number of the Express Mail mailing label thereon.
- (E) A true copy of any returned postcard receipt.

15. 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 3 or 4, also comprising...
- (E) The claim form in (A), (B), (C) and (D) is acceptable.

Please answer questions 16 and 17 based on the following facts. On February 15, 1999, Debbie conceived a unique system for humanely caging hunting dogs and automatically feeding them at appropriate times. Debbie told her husband, Ted, about her idea that night, and the two spent the next four months working regularly on the concept. Ted built a cage that implemented the concept on June 17, 1999, and tested it on his own dogs for a week. It worked perfectly for its intended purpose. The next day, Ted visited a family friend, Ginny, who happened to be a registered practitioner, and asked her to prepare a patent application on Debbie's behalf. Ginny declined representation, explaining that she was in the middle of trial preparation and would not be able to work on the application for at least four months. Ginny gave Ted the names of a number of qualified patent practitioners, suggesting he consider retaining one of them to promptly prepare the patent application, and explained that a delay in filing the patent application could prejudice Debbie's patent rights. Ted, however, felt uncomfortable going to a practitioner he did not know personally, and did not contact any of the individuals recommended by Ginny. After Ginny had completed her trial and was back in the office, Ted visited her on December 1, 1999. At that time Ginny agreed to represent Debbie. An application was filed in the PTO within 10 days.

On May 15, 1999, Billie conceived an idea substantively identical to Debbie's. Billie immediately prepared a detailed technical description including drawings and visited a registered practitioner. Billie filed a patent application on June 14, 1999. Later, on July 9, 1999, Billie built a cage that implemented the concept and had fully tested it by August 11, 1999.

16. Assuming Debbie's patent application is substantively identical to Billie's patent application, which of the following statements is most correct?

- (A) Nearly simultaneous invention by Debbie and Billie is proof that the invention is obvious and precludes patentability.
- (B) Nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention.
- (C) Nearly simultaneous invention by Debbie and Billie may be evidence of a long-felt need for the invention.
- (D) Nearly simultaneous invention by Debbie and Billie may be evidence of commercial success of the invention.
- (E) Statements (A), (B), (C) and (D) are each incorrect.

17. With regard to a priority contest between Debbie and Billie, which of the following statements is most correct?

- (A) To encourage prompt disclosure of inventions to the public, the PTO always awards priority to the first to file an application, in this case Billie.
- (B) Debbie will be awarded priority only if she can establish diligence for the entire time between May 14, 1999 and her actual reduction to practice in June 1999, and can establish that she did not suppress, abandon or conceal the invention.
- (C) Debbie will be awarded priority only if she can establish diligence for the entire time between her conception in February 1999 and actual reduction to practice in June 1999, and can establish that she did not suppress, abandon or conceal the invention.
- (D) Debbie will be awarded priority if she can establish diligence for the entire time between May 14, 1999 and her patent filing in December 1999, and can establish that she did not suppress, abandon or conceal the invention.
- (E) Billie must be awarded priority because his patent application established a constructive reduction to practice prior to Debbie's actual reduction to practice, even if Debbie was diligent in reducing her invention to practice.

18. Which of the following statements regarding a registered practitioner is most correct?

- (A) An unsubstantiated argument by a practitioner that applicant discovered the problem is insufficient to show that applicant discovered the source of the problem.
- (B) An unsubstantiated argument by a practitioner that the invention provides a solution of a long-felt need is insufficient to show that the invention fills a long-felt need.
- (C) Where an examiner has advanced a reasonable basis for questioning the adequacy of disclosure, an argument by a practitioner that the application meets the requirements of 35 U.S.C. § 112, first paragraph, is entitled to little, if any weight, in the absence of facts supporting a basis for deciding that the specification complies with 35 U.S.C. § 112, first paragraph.
- (D) An argument by a practitioner that the prior art reference is inoperative is insufficient to show the claimed subject matter is unobvious in the absence of objective evidence demonstrating inoperability of the prior art reference.
- (E) Each of (A), (B), (C), and (D) is correct.

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

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

20. Which of the following is (are) appropriate for restarting the period for replying to an Office action, dated September 25, 2000?

- I. The examiner set a shortened statutory period of three months for replying to the Office action, and three months from September 25, 2000 falls on Christmas Day, December 25, 2000, a federal holiday, and the registered practitioner calls this to the attention of the examiner within one month of the mail date of the Office action.
 - II. The examiner's interpretation of the prior art in rejecting certain claims, as set forth in the Office action, is believed by a registered practitioner to be contrary to the interpretation given by one of ordinary skill in the art, and the practitioner calls this alone to the examiner's attention within one month of the mail date of the office action.
 - III. The examiner incorrectly cited one of the references, and the registered practitioner calls this to the attention of the examiner within one month of the mail date of the Office action.
- (A) I.
 - (B) II.
 - (C) III.
 - (D) II and III.
 - (E) None of the above.

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

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

22. You, a registered practitioner, are responsible for filing a patent application on Thursday, February 3, 2000. The application has a foreign priority date of February 3, 1999. You prepare the application and place on the transmittal page (a) the Express Mail Label number and (b) a certificate of mailing pursuant to 37 C.F.R. § 1.8. At 5:10 p.m. on February 3, 2000, you place the Express Mail envelope with the application inside in an Express Mail Deposit box. The "Express Mail" drop box has a clear sign stating that the box will be cleared for the last time at 5:00 p.m. The box was cleared for the last time at 5:00 p.m. by a U.S. Postal Service employee. On February 4, 2000, the U.S. Postal Service picks up the envelope and clearly stamps the "date in" as 2/4/2000. What is the filing date that will be assigned to the application upon its receipt in the PTO?

- (A) February 3, 1999, since the envelope was mailed by Express Mail and was in the custody of the United States Postal Service on February 3, 2000.
- (B) February 4, 2000 since the operative date is the date stamped by the U.S. Postal Service.
- (C) February 3, 1999 since a certificate of mailing under 37 C.F.R. § 1.8 allows the applicant the benefit of the date on which the envelope was mailed.
- (D) February 3, 2000, since in order to be entitled to foreign priority the application had to have been deposited before 5:00 p.m., which is the time that the U.S. Patent & Trademark Office closed for business that day.
- (E) (A) and (C).

23. In 1998, Chris invents an automobile or truck windshield wiper device that uses a transparent grid to automatically sense water drops on the windshield and wipe the window whenever a drop appears. The grid detects current variations when moisture impregnates the grid, and then activates the windshield wiper. In April 1998, Chris submitted an article for publication in Popular Scientist magazine disclosing the invention. The magazine edited the article to the extent that the article, published August 1, 1998, fails to enable one of ordinary skill in the art to make the invention. On August 31, 1998, Chris offers the automobile windshield wiper device for sale to the Ajax Motor Company, leaving a sample device for use in automobiles at the Ajax plant. Chris knew his device can be used with trucks only if the sensors are modified to accommodate the larger windshields, however no such modification has been made. Without Chris' knowledge, Ajax intends to use the device on its trucks. Ajax modifies and successfully tests the device using larger sensors for trucks on a public highway on September 1, 1998. Chris files a patent application with the PTO for the basic concept for automotive windshields on August 2, 1999. On August 30, 1999, Chris realizes that Ajax modified his invention to work with trucks on September 1, 1998, and that his claims do not cover the truck embodiment. There is no basis in the application supporting a claim directed to the embodiment for trucks, but the modification would have been obvious to one of ordinary skill in the art. Chris' application has not yet issued. He comes to you, a registered practitioner, for advise on the morning of August 30, 1999 as to whether he should file a new application for his windshield wiper directed to trucks and buses. What should you advice Chris to do in accordance with proper PTO practice and procedure?

- (A) The Popular Scientist publication is a bar under 35 U.S.C. § 102(b) since it was filed over a year before the application was filed.
- (B) Chris can still file a claim in the pending application directed to windshield wipers for trucks because the modification of the sensors would have been obvious to the artisan.
- (C) Chris must file a new application on or before September 1, 1999, to avoid the testing by Ajax from becoming a statutory bar to him obtaining a second patent directed to the windshield wiper for trucks embodiment.
- (D) Chris may file a continuation-in-part application anytime before the first patent application issues in which he can disclose and claim the windshield wiper device for use on trucks and buses since a continuation-in-part is entitled to the parent filing date for everything disclosed in the continuation-in-part application.
- (E) Since the Ajax use of the device on trucks was not discovered until August 31, 1999, Chris has one year from August 31, 1999, to file a new patent application directed to use of his invention on trucks.

24. Adam is a foreign national legally residing in Baltimore, Maryland. Before moving to the United States, Adam filed a United States patent application. The claims in the application were finally rejected by the examiner. The rejection was affirmed on appeal to the Board of Patent Appeals and Interferences. Adam remains convinced that the rejection is incorrect and wishes to pursue further review. Which of the following will properly consider a request by Adam for official review of the decision by the Board of Patent Appeals and Interferences?

- (A) The Commissioner of Patents and Trademarks.
- (B) The Chairman of the Board of Patent Appeals and Interferences.
- (C) The Director of Patent Quality Review.
- (D) The United States Secretary of Commerce.
- (E) None of the above.

25. You filed a patent application on behalf of Smith, an employee of Fix Corporation. The application contains a power of attorney authorizing you to transact all business before the Office on behalf of Smith. After the application is filed, Smith assigns all rights in the application to Fix Corp. In which of the following situations will the power of attorney granted to you be properly revoked?

- I. Joe, in-house corporate counsel at Fix Corp., but not an officer of Fix, signs a submission, pursuant to 37 C.F.R. 3.73(b), establishing ownership of the entire interest in the application by Fix Corp., and forwards the submission along with a revocation of the power of attorney granted to you, to the PTO. Joe is not a registered practitioner, and he has not been authorized to bind Fix Corp.
 - II. Smith refuses to revoke the power of attorney given to you, but Snix, president of Fix Corp., signs a submission, pursuant to 37 C.F.R. 3.73(b), establishing ownership of the entire interest in the application by Fix Corp., and forwards the submission along with a Snix-signed revocation of the power of attorney granted to you, to the PTO.
 - III. Joe, in-house corporate counsel at Fix Corp., advises Snix, president of Fix Corp., that the assignment by Smith to Fix Corp, automatically operates as a revocation of the power of attorney granted to you, and Snix relies upon Joe's advice in good faith and takes no further action toward revoking the power of attorney. Joe is not a registered practitioner, and he has not been authorized to bind Fix Corp.
- (A) I.
 - (B) II.
 - (C) III.
 - (D) I and II.
 - (E) None of the above.

26. The following three original claims in inventor Smith's regular utility patent application are fully supported by the disclosure in the specification:

1. A widget comprising A, B, and C.
2. A widget as claimed in Claim 1 wherein C further comprises D.
3. A widget as claimed in Claim 1 and 2 wherein B is B'B'.

The examiner properly rejected Claim 3 under 35 U.S.C. § 112, second paragraph, citing the claim's improper dependency. In the absence of issues of supporting disclosure, which of the following proposed amendments is presented in proper claim format?

- (A) 3. (Amended) A widget as claimed in Claim 1 [and 2] wherein B is B'B'.
- (B) 3. (Amended) A widget as claimed in any one of Claims 1 and 2 wherein B is B'B'.
- (C) 3. A widget as claimed in Claims 1 and 2 wherein B is B'B'.
- (D) Cancel Claim 3 and substitute the following Claim: 4. A widget as claimed in Claims 1 or 2 wherein B is B'B'B'.
- (E) Cancel Claim 3 and substitute the following claim: 3. (Amended) A widget as claimed in Claim 1 or 2 wherein B is B'B'.

27. A patent application is filed with the following original Claim 1:

A steam cooker comprising:

- (i) a steam generating chamber having a steam generator;
- (ii) a cooking chamber adjacent to said steam generating chamber for receiving steam from said steam; and
- (iii) a heat exchanger secured within said steam generator, said heat exchanger including at least one heating zone comprised of an inner having raised surface projections thereon, an outer panel having raised surface projections thereon, and a path between said raised surface projections whereby flue gases may pass for heating the walls of the heat exchanger.

Assuming all of the following amendments are supported by the original disclosure in the specification, which amendment is in accord with proper PTO amendment practice and procedure?

- (A) In Claim 1, line 4, after "steam" insert, --generator--.
- (B) In Claim 1, line 6, after "inner" insert --panel--.
- (C) In Claim 1, line 6, delete [one], insert --two--, and amend "zone" to read --zones--.
- (D) In Claim 1, line 3, after "chamber" (second occurrence) delete [for receiving] and insert --to produce sufficient quantities of gas and--.
- (E) In Claim 1, line 4, delete "secured within" and insert --attached to--.

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

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

29. Which of the following is not a requirement of 35 U.S.C. § 102(d) to bar the granting of a patent in this country?

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

30. Which of the following actions, if taken by a registered practitioner, comports with proper PTO rules and procedure?

- (A) Faxing a request for reexamination to the PTO on a weekday, during the period of enforceability of a patent, within two years of the patent's issue date.
- (B) Faxing an amendment under 37 C.F.R. § 1.111 to the PTO on the last day of the period for reply set by the examiner with a proper Certificate of Transmission.
- (C) Faxing a request for reexamination to the PTO on a weekday, during the period of enforceability of a patent, but more than two years after the patent's issue date.
- (D) Filing, by facsimile, a national patent application under 37 C.F.R. § 1.53(b) with a specification and drawings for the purpose of obtaining an application filing date.
- (E) None of the above.

31. You are drafting a patent application for your client's widget invention. The application discloses a widget consisting essentially of, in series, an amplifier having a power output of 100 to 300 amps, preferably 250 amps, and a woofer having a wattage of 400 to 450 watts, preferably 425 watts. The application satisfies the requirements of 35 U.S.C. § 112, and does not disclose the widget having any power output or wattage outside the foregoing limits set forth in the specification. The following independent claim will be Claim 1 in the application:

1. A widget consisting essentially of an amplifier having a power output of 100 to 300 amps, and woofer having a wattage of 400 to 450 watts.

Which of the following claims would not be a proper dependent claim if presented as an original claim in the application when the application is filed in the PTO?

- (A) 2. The widget of Claim 1 wherein the woofer has a wattage of 425 to 450 watts.
- (B) 2. The widget of Claim 1 wherein the amplifier has a power output of 300 amps and the woofer has a wattage between 430 and 450 watts.
- (C) 2. The widget of Claim 1 wherein the amplifier has a power output of 250 amps.
- (D) 2. The widget of Claim 1 wherein the woofer has a wattage of 425 watts.
- (E) 2. The widget of Claim 1 wherein the amplifier has a power output of up to 300 amps.

32. Your client has asked you to determine whether his invention is patentable. The client developed a fishing lure made of a composition that is so effective that a fisherman need wait only a few minutes to lure fish to a hook or net. Your client purchased the material and cut it with a knife into a fishing lure. Your client does not know how to make the composition. Upon conducting a prior art search, you find that the client's composition is a well known gel used in shoes that has been in public use for 5 years. The prior art does not disclose the use of the composition as a fishing lure. Which of the following is the most appropriate advice to give the client?

- (A) Explain that it would be impossible for any claims to the process of using the composition as a fish lure to be allowed under the current PTO guidelines.
- (B) File a U.S. patent application (and required fees) claiming the composition.
- (C) File a U.S. patent application (and required fees) claiming a method of using the composition as a fishing lure.
- (D) File a provisional patent application (and required fees) directed only to the composition to gain a competitive advantage for one year. Within one year of filing the provisional application, file a nonprovisional application claiming the composition.
- (E) File a Disclosure Document (and required fee) to obtain a document from the PTO showing that the invention is registered with and protected by the PTO.

33. A claim limitation reads “having 10 to 20 grams of iron, preferably 13-18 grams of iron.” The specification preceding the claim supports not only the limitation, but also the broader amounts of iron. Which of the following statements is correct?

- (A) The limitation may be indefinite.
- (B) Since the limitation properly sets forth outer limits, it is definite.
- (C) As long as the limitation is supported in the written description, it is proper.
- (D) The limitation is definite since the limitation sets forth a preferred range.
- (E) The applicant, having set forth a limitation in the claim, i.e., a range of 10 to 20 grams, is precluded by the doctrine of equivalents from expanding the claim coverage beyond the 10 to 20 grams of iron.

34. A Notice of Allowance, setting a three month statutory period for reply, is dated and mailed on April 4, 2000, to the applicant. In which of the following situations would the issue fee be considered to be paid late?

- (A) The issue fee is filed in the PTO on Monday, July 3, 2000.
- (B) The issue fee is filed in the PTO on Wednesday, July 5, 2000, inasmuch as the PTO was closed for a Federal holiday on Tuesday, July 4, 2000.
- (C) The issue fee is filed in the PTO on Wednesday, October 4, 2000, and is accompanied by a petition to the Commissioner for a three month extension of time, as well as the late payment fee.
- (D) The issue fee is received in the PTO on Thursday, July 6, 2000, accompanied by a certificate of mailing complying with 37 C.F.R. § 1.8 and dated Monday, July 3, 2000.
- (E) (B), (C), and (D).

35. Which of the following statements regarding design patent applications is not correct?

- (A) The specification may contain a brief description denoting the nature and environmental use of the claimed design.
- (B) Different embodiments or modifications may be set forth in the specification, but do not need to be shown in the drawings.
- (C) The drawings may be color drawings or color photographs if accompanied by a grantable petition.
- (D) The design application may have only a single claim.
- (E) The inventive novelty or nonobviousness of a design resides in the shape or configuration, and/or surface ornamentation embodied in or applied to an article of manufacture.

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

- (A) As a registered practitioner, it is not necessary to notify the Director of Enrollment and Discipline of your address changes as long as you file a change of address in each individual application for which you are responsible.
- (B) At any time the Director of Enrollment and Discipline may send out letters to registered practitioners for the purpose of ascertaining whether they wish to remain on the register and if no reply is received, without further warning, the name may be removed from the register.
- (C) A practitioner may not refuse to aid or participate in conduct that the practitioner believes to be unlawful, even though the client presents some support for an argument that the conduct is legal.
- (D) Any person who passes this examination and is registered as a patent agent or patent attorney is entitled to file and prosecute patent applications and trademark registration applications before the PTO for the same client.
- (E) It is permissible to give examiners gifts valued at between \$25 and \$250 so long as the gift is made after issuance of all patent applications that the practitioner or the practitioner's firm has before the Examiner.

37. Today, April 12, 2000, is the last day of a three month shortened statutory period for reply to a non-final rejection over references under 35 U.S.C. § 103. Today, your client, located overseas, requests in a facsimile that you cancel all of the current claims in the application, and advises that a new set of claims to replace the current claims will be sent to you no later than April 29, 2000. There is no deposit account. The client pays all fees in a timely manner. In accordance with proper PTO practice and procedure, which of the following is the most appropriate course of action to take regarding the non-final rejection?

- (A) Await receipt of the new claims and necessary fees, and then file the amendment, request for reconsideration, and appropriate fee for an extension of time, no more than six months from the date of the non-final rejection.
- (B) File a request for a one month extension of time today and pay the fee when you file the amendment.
- (C) File an amendment today canceling all claims in accordance with your client's instructions.
- (D) File a request for reconsideration today, stating only that "[t]he rejection is in error because the claims define a patentable invention."
- (E) File a request for reconsideration today, and state that a supplemental amendment will be forthcoming.

38. Which of the following statements correctly describes current PTO practice and procedure?

- (A) A joint application by inventors Sam and Will, and a joint application by Will and Sam are different inventive entities.
- (B) A joint application by inventors Sam and Will, and a sole application by Sam are different inventive entities.
- (C) Where a patent is granted to Will, and later Will and Sam file a joint application, the presence of Will, a common inventor in the patent, prevents a determination that the patent entity is to “another” within the meaning of 35 U.S.C. § 102(e).
- (D) The fact that an application has named a different inventive entity (Sam and Will) than a patent reference (Will) makes the patent prior art, even where one of the inventors is common to both.
- (E) (A) and (C).

39. A U.S. patent issued to Smith on January 6, 1998. Realizing that the claims of the issued patent were too narrow, Smith properly filed a broadening reissue application on September 30, 1999. On March 15, 2000, while preparing a reply to an Office action in the reissue application, Smith recognized that additional claims should be added to provide the desired range of patent protection. On March 17, 2000, Smith submitted an Amendment that, *inter alia*, added new claims 20-33 to the reissue application. Each of claims 20-22 was broader than the claims originally submitted on September 30, 1999, with the application for a broadened reissue. Each of claims 23-28 was narrower than the claims originally submitted on September 30, 1999, but broader than the original patent claims. Each of claims 29-33 was narrower than the original patent claims. The reissue oath originally filed with the reissue application is adequate to support the newly submitted claims. Which of the following best describes a proper action by the examiner in reply to the Amendment?

- (A) Each of claims 20-33 is rejected as being improper since the claims were added after the two-year anniversary of the original patent issuance.
- (B) Each of claims 20-33 is examined on the merits, but are not rejected for improperly broadening the reissue application after the two-year anniversary of the original patent issue.
- (C) Claims 20-28 are rejected as being improper because they were added after the two-year anniversary of the original patent issue, but claims 29-33 are examined on the merits.
- (D) Claims 20-22 are rejected as being improper because they were added after the two-year anniversary of the original patent issue, but claims 23-33 are examined on the merits.
- (E) Claims 20-28 are examined on the merits, but claims 29-33 are rejected as improper because this is a broadening reissue application and these claims are narrower than the original patent claims.

40. In which of the following situations is the Commissioner authorized to refund a fee?
- (A) After receiving a final rejection, a notice of appeal and appeal fee are filed. After the notice of appeal and correct appeal fee are filed, the examiner thereafter withdraws the final rejection.
 - (B) Upon a showing of an extraordinary situation, when justice requires refund of a fee paid to the PTO where a practitioner paid the correct fee for an extension of time to provide the client with time to given instructions, and the client thereafter informs the practitioner that the client would not pay the fee and authorizes the practitioner to permit the application to become abandoned.
 - (C) Upon a showing that the application, which had been filed in the PTO and for which the correct filing fee had been paid, has been withdrawn from examination and expressly abandoned.
 - (D) Upon a petition to the Commissioner to exercise his supervision to refund a fee, though paid in the correct amount, when the practitioner no longer desired copies of patents ordered.
 - (E) Upon a showing that the fee was paid by mistake or in excess of the amount required by law.
41. Which of the following may not be properly used as prior art for purposes of rejecting a claim under 35 U.S.C. § 102(b) in an application having an effective filing date of Monday, May 3, 1999?
- (A) A journal article, published Saturday, May 2, 1998, disclosing all the claimed elements and fully teaching how to make and use the invention as claimed.
 - (B) A foreign patent, published March 3, 1998, which applicant referenced in the application when claiming foreign priority based on the foreign application date, and applicant submitted a certified copy of the original foreign application.
 - (C) Applicant's statement in a declaration under 37 C.F.R. § 1.132 that although the invention as claimed had been offered for sale in department stores in New York during 1997, this was done only to analyze consumer acceptance of the packaging in which the invention is marketed.
 - (D) A journal article, published May 1, 1997, disclosing all the elements of the claim and teaching how to make and use the claimed invention. The examiner used the article in combination with another journal article in a previous non-final Office action to reject the same claim under 35 U.S.C. § 103.
 - (E) All of the above.

42. Assuming that each of the following claims is in a different utility patent application, and each claim is fully supported by the disclosure in preceding claims or in the application wherein the claim appears, which of the claims properly presents a process claim?

- (A) A process of utilizing a filter having electrical components, said process comprising placing a plurality of electrodes on the human body, receiving electrical signals from the electrodes and passing the signals through said filter.
- (B) A process of polymerizing an organic compound comprising combining a catalyst, organic compound reactants, and solvent in a reaction vessel, heating the combination in the vessel to a high temperature to start the reaction, separating the organic layer from the remaining materials, and evaporating the solvent.
- (C) The use of a water repellant paint as a sealant for wooden patio furniture.
- (D) (A), (B) and (C).
- (E) (A) and (B).

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

- (A) The practitioner entering into a business partnership with an individual who is neither an attorney nor a registered practitioner, where the activities of the partnership consist of the practice of patent law before the Office by the practitioner, and the individual will market the practitioner's services and the client's inventions.
- (B) Filing an amendment wherein claims are presented that have been copied from an issued patent of another, and knowingly withholding from the Office information identifying the patent from which the claims have been copied.
- (C) Telling a client that the client's application will go abandoned if the client's bill is not paid and refusing to file any papers in the PTO unless and until the fee is paid.
- (D) Upon being discharged by a client, filing a request to withdraw wherein the client's intent to discharge is set forth as the reason for the request.
- (E) When the client refuses to pay, without the client's consent after full disclosure, accepting compensation from a client's friend for the practitioner's legal services on behalf of the client.

44. Which of the following statements best correctly describes current PTO practice and procedure?

- (A) Where a patent discloses subject matter being claimed in an application undergoing examination, if the patent's designation of inventorship differs from that of the application, then the patent's designation of inventorship does not raise a presumption of inventorship regarding the subject matter disclosed but not claimed in the patent so as to justify a rejection under 35 U.S.C. § 102(f).
- (B) The fact that a claim recites various components, all of which can be argumentatively assumed to be old, provides a proper basis for a rejection under 35 U.S.C. § 102(f).
- (C) A person can be an inventor without having contributed to the conception of the invention.
- (D) In arriving at conception, an inventor may not consider and adopt ideas and materials derived from other sources such as an employee or hired consultant.
- (E) It is essential for the inventor to be personally involved in reducing the invention to actual practice.

45. You obtained a patent for inventor Jones. The patent, although disclosing a use for her invention, and the best mode contemplated by Jones at the time the application was filed for making and using her invention, through error and without deceptive intent, failed to describe an embodiment of her invention. The embodiment has become a commercial success. Eighteen months after the patent issued, you filed a reissue application adding a claim and new, necessary supporting disclosure directed to the omitted embodiment, together with Jones' declaration explaining the error, and other required papers. In accordance with proper PTO practice and procedure:

- (A) The claim is subject to a new matter rejection under 35 U.S.C. § 132.
- (B) The specification is subject to rejection under 35 U.S.C. § 101 for failure to disclose the best mode for achieving commercial success.
- (C) The claim is subject to a rejection under 35 U.S.C. § 251 and a rejection under 35 U.S.C. § 112, first paragraph.
- (D) The claim is allowable.
- (E) (B) and (D).

46. Assume that a corporation employing more than 500 persons does not qualify as a small business entity. Which of the following qualifies for reduction of certain patent fees by claiming small entity status in an application?

- (A) An independent inventor, who intends to make a profit through producing goods made according to the invention disclosed in the application, who has not assigned, granted, conveyed, or licensed any rights in the invention disclosed in the application, and is under no obligation to assign, grant, convey, or license any rights in the invention disclosed in the application.
- (B) A corporation, assigned all rights in the invention disclosed in the application, having 600 employees, which derives a profit from producing and selling energy-saving devices.
- (C) An eighty-five year-old inventor who has assigned to a corporation, having 600 employees, all rights in the invention disclosed in the application. The corporation derives a profit from producing and selling energy-saving devices.
- (D) A patent examiner who works in a group which examines applications which are funded solely by Federal agencies.
- (E) None of the above.

47. Which of the following actions, if any, when taken as an initial step to dispute the propriety of the finality of an Office action, comports with proper PTO rules and procedure?

- I. Filing a request for reconsideration concerning the finality of the Office action, while the application is still pending before the primary examiner.
 - II. Filing a Notice of Appeal, then a brief, and arguing in the brief the impropriety of the finality of the rejection.
 - III. Filing a petition under 37 C.F.R. 1.181 based on improper finality of the rejection to stay the running of the period for reply set in the final Office action.
- (A) I. only.
 - (B) II. only.
 - (C) III. only.
 - (D) I. and III.
 - (E) None of the above.

48. Which of the following statements regarding 35 U.S.C. § 103 is most correct?
- (A) PTO classification of prior art references used to reject a claim under 35 U.S.C. § 103, and the similarities and differences in structure and function carry equal weight as evidence of whether the references are analogous or non-analogous.
 - (B) The question of obviousness under 35 U.S.C. § 103 is resolved by determining whether the differences between the prior art and the claims would have been obvious.
 - (C) Obviousness of an invention can be properly determined by identifying the “gist” of the invention, even where the “gist” does not take into regard an express limitation in the claims.
 - (D) In delineating the invention, consideration is given not only to the subject matter recited in the claim, but also the properties of the subject matter which are inherent in the subject matter and disclosed in the specification.
 - (E) Obviousness can be predicated on what is not known at the time an invention is made, where the inherency of the feature is later established.

49. A parent application A was filed on September 9, 1988, and became abandoned on October 19, 1993. Application B was filed on October 21, 1993, and referred to application A as well as claimed the benefit of the filing date of application A. Application B issued as a patent on June 17, 1997. Application C was filed on October 29, 1993, and referred to application B as well as claimed the benefit of the filing date of application B. Application D was filed on December 20, 1996. Application D referred to application B and claimed the benefit of the filing date of application B. Both applications C and D were abandoned for failure to file a timely reply to Office actions that were mailed on April 20, 1999. Application E was filed on July 22, 1999 and is drawn to the same invention as claimed in applications C and D. Application E claims the benefit of the filing dates of applications A, B, C, and D, and makes reference to all preceding applications. The earliest effective filing date of application E with respect to any common subject matter in the prior applications is:

- (A) October 21, 1993.
- (B) December 20, 1996.
- (C) October 29, 1993.
- (D) September 9, 1988.
- (E) July 22, 1999.

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

- (A) Reissue applications may be filed to correct errors made without deceptive intent provided that an application is filed within two years from issuance.
- (B) An interference may be declared between three parties who invent their inventions in three different countries and each party may be declared the winner for some of the counts at issue.
- (C) An assignment may not be made conditional on the performance of the payment of money since the public has no way of knowing whether or not payment is made.
- (D) A patent may not be issued to an assignee and if the inventor dies before the patent issues, the rights to the invention are forfeited.
- (E) Anyone may obtain reexamination of a patent upon filing a request for the same as many times as they please provided they pay the required fee each time.