

Test Number 123
Test Series 199

NAME _____

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

APRIL 21, 1999

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

1. P, a registered patent practitioner, filed a reply to a first Office action which rejected all claims under 35 U.S.C. § 102(a) based on an earlier patent granted to Z. The Office Action was dated September 15, 1998 and set a three month shortened statutory period for reply. P's unsigned reply, filed February 3, 1999, did not include a petition for an extension of time and contained only the following paragraph:

Applicant respectfully spits on the ludicrous position taken by the Examiner in rejecting all claims under 35 U.S.C. § 102(a) based on an invalid patent granted to Z. Applicant may be willing to overlook the Examiner's stupidity in making this rejection since it is possible that the Examiner was unaware that Z is a bum and a thief who stole Applicant's invention. Applicant has renumbered the claims and has attached a copy of Z's patent with notations made thereon. Applicant respectfully requests that the Examiner "WAKE UP" and take another look at Applicant's claims in light of these remarks. Please charge my deposit account number 99-1234 to cover the cost of any required fees.

P should not be surprised when the amendment is not entered because:

- (A) The reply was not signed.
- (B) An amendatory paper determined to contain objectionable remarks will be returned to the sender.
- (C) P did not file a petition for an extension of time.
- (D) (A) and (B) are correct.
- (E) (A),(B), and (C) are correct.

2. On August 20, 1998, you filed in the PTO a patent application which claims a new pharmaceutical compound and a method of using the pharmaceutical compound to treat obesity. On January 29, 1999, you received a restriction requirement from the examiner requiring election between the following groups of claims: group (I), directed to the product; and group (II), directed to the method of use. Which of the following statements, if any, is not a proper reply to the restriction requirement?

- (A) You file a written reply provisionally electing the claims of group I, with traverse, and set forth the reasons why you believe the restriction requirement is improper.
- (B) You file a written reply electing the claims of group I for prosecution on the merits, and an amendment canceling the method claims of group II.
- (C) You file a written reply traversing the restriction requirement, and setting forth specific reasons why you believe the restriction requirement is improper.

- (D) You file a written reply electing the claims of group I for prosecution on the merits, without traverse of the restriction requirement.
- (E) None of the above.

3. Which of the following statements regarding design patents are **not** true?

- (A) A design patent and a trademark may be obtained on the same subject matter.
- (B) A design patent claim for type fonts will be rejected for failure to comply with the "article of manufacture" requirement.
- (C) A computer-generated icon must be embodied in a computer screen, monitor, or other display panel to satisfy 35 U.S.C. § 171.
- (D) The claimed design is shown by solid lines in the drawing. It is not permissible to show any portion of the claimed design in broken lines.
- (E) Novelty and unobviousness of a design claim must generally be determined by a search in the pertinent design classes. It is mandatory that the search be extended to the mechanical classes encompassing inventions of the same general type.

4. During a reexamination proceeding, the patent owner seeks to amend Claim 1 as follows:

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

All changes in the claim are fully supported by the original patent disclosure. Should the claim, as amended, be rejected?

- (A) Yes, because the amendment broadens the scope of the claim of the patent.
- (B) No, because the claim is fully supported by the original patent disclosure.
- (C) No, because the amendment does not add new matter into the claim.
- (D) No, because the amendment narrows the scope of the patent.
- (E) Yes, because the claim has not been amended in accordance with PTO rules for amending patent claims.

5. On February 13, 1998, practitioner Wally filed a complete nonprovisional application for patent, filing fee, and an executed oath under 37 CFR § 1.63 in the PTO identifying inventors A and B by their full names, and providing their residence, post office addresses, and citizenship. A and B have assigned their application to XYZ Corporation who Wally represents. Two weeks after the filing of the patent application, XYZ sends Wally a letter informing him that due to an oversight, a third inventor, C, should be added to the joint inventorship. Which of the following is the most proper procedure for correcting the inventorship of the patent application?

- (A) File a new oath signed by C, and file an amendment adding C as an inventor along with a statement of facts by C noting that the omission of him as an inventor was without deceptive intent and establishing when the error was discovered and how it occurred.
- (B) File a new oath signed by A, B, and C, and file an amendment adding C as an inventor along with a verified statement of facts by C noting that the omission of him as an inventor was without deceptive intent and establishing when the error was discovered and how it occurred.
- (C) File a new oath signed by A and B, and file an amendment adding C as an inventor along with the written consent of the assignee and a statement of facts verified by A and B noting that the omission of C as an inventor was without deceptive intent and establishing when the error was discovered and how it occurred along with payment of the petition fee.
- (D) File a new oath signed by A and B, and file an amendment adding C as an inventor along with the written consent of the assignee and a petition with the appropriate fee giving a verified statement of facts by A and B noting that the omission of C as an inventor was without deceptive intent and establishing when the error was discovered and whether they had reviewed and understood the contents of the specification including the claims as amended by any amendment specifically referred to in the oath or declaration and whether they had reviewed the oath or declaration prior to its execution and if so, how the error had occurred in view of such reviews.
- (E) File a new oath signed by A, B, and C, and file an amendment adding C as an inventor along with the written consent of the assignee, a petition, the appropriate fee, and a statement from C that the inventorship error occurred without deceptive intention.

6. On January 7, 1998, your client published an article containing a complete and enabling disclosure of a new pharmaceutical compound she developed. On February 6, 1998, you prepared and filed in the PTO a provisional application for the client containing an enabling disclosure of the pharmaceutical compound disclosed in the publication. The provisional patent application was filed by depositing it directly with the United States Postal Service via "Express Mail Post Office to Addressee." On Saturday, February 6, 1999, you deposit a complete, nonprovisional U.S. patent application directly with the U.S. Postal Service via "Express Mail Post Office to Addressee." The nonprovisional application claims the new pharmaceutical compound and claims priority to the filing date of the provisional application under 35 U.S.C. § 119(e). The nonprovisional application is received in the PTO mailroom on Tuesday, February 9, 1999. The claims to the pharmaceutical compound are:

- (A) Patentable over your client's article. The effective filing date of the complete nonprovisional application is February 6, 1998.
- (B) Unpatentable. The effective filing date of the complete nonprovisional application is February 9, 1999, and thus the claims to the compound are barred by the publication of your client's article more than one year before the complete nonprovisional application's effective filing date.
- (C) Unpatentable over your client's article because the article is prior art under 35 U.S.C. § 102(a).
- (D) Patentable over your client's article. The effective filing date of the complete nonprovisional application is Monday, February 8, 1999. However, because the article was written by the inventor, the inventor can swear behind the article's publication date.
- (E) Unpatentable. The effective filing date of the complete nonprovisional application is February 9, 1999, and thus the claims to the compound are barred by the publication of your client's article more than one year before the complete application's effective filing date.

7. A patent application claims a chemical composition and discloses in the application that the composition has a cleansing property in addition to being able to remove ink stains. The examiner rejected the claims in the application under 35 U.S.C. § 103 as being obvious over Parker in view of Cross. Each reference discloses chemical compositions which can be used to remove ink stains. The proposed combination of references includes all the limitations of the composition claimed in the application. However, neither reference shows nor suggests the cleansing property newly discovered by applicant. Does the combination of Parker and Cross support a *prima facie* case of obviousness?

- (A) Yes, even though neither reference shows or suggests the newly discovered property of the claimed composition.
- (B) Yes, because after reading applicant's specification, it would be obvious that both references can be combined to achieve the cleansing property claimed by applicant.
- (C) No, unless in addition to structural similarity between the claimed and prior art compositions, the references contain a suggestion that the compositions will have the newly discovered cleansing property.
- (D) No, because the discovery of a new property of a previously known composition imparts patentability to the known composition.
- (E) No, because the burden of proof cannot be shifted to the applicant to show that the prior art compositions lacked the newly discovered property asserted for claimed composition unless one of the references discloses the property.

8. An original application was prosecuted through final rejection. All of the claims in the original application were properly rejected by the examiner as being obvious over two patent references. The applicant allows the application to go abandoned without replying to the final rejection. Two years after the abandonment, the applicant files a substitute application in which all of the claims are identical to those in the original application. The examiner _____ make a final rejection in the substitute application in the first Office action on the merits _____.

- (A) can ... provided any assignment in the original application has been applied to the substitute application
- (B) can ... because the claims would have been properly finally rejected in the next Office action on the grounds of rejection and the same art of record in the original patent application
- (C) can ... because the substitute application is entitled to the filing date of the original application

- (D) cannot ... because applicant is entitled to a new search and further consideration of the claims presented in the substitute application
- (E) cannot ... because the substitute application does not identify and make reference to the original application

9. In a first Office action dated March 18, 1999, the examiner rejected Claim 1 under 35 U.S.C. § 103 and objected to Claim 2 as being dependent upon a rejected claim. The examiner stated that Claim 2 would be allowable if the subject matter of Claim 2 was rewritten in independent form to include all the limitations of Claim 1. On April 6, 1999, after consulting with your client, you filed an amendment canceling Claim 2 and incorporating the subject matter of Claim 2 into Claim 1. Two weeks later, your client has changed his mind and now desires to traverse the rejection of Claim 1 without incorporating the subject matter of Claim 2 into Claim 1. Which of the following would be the most appropriate procedure to take under the circumstances?

- (A) Advise your client that there is nothing you can do until a reply is due for the next Office action.
- (B) Immediately file a supplemental amendment traversing the rejection of Claim 1 and requesting that Claim 2 be reinstated.
- (C) Immediately file a supplemental amendment adding a claim identical to canceled Claim 2. The new claim should be underlined in its entirety with the parenthetical expression (amended) following the original claim number 2.
- (D) Immediately file a supplemental amendment adding a new Claim 3 which is identical to original Claim 2, amend Claim 1 to delete the subject matter added by the April 6, 1999, amendment, and traverse the rejection of Claim 1.
- (E) Immediately file a supplemental amendment adding a new Claim 3 which is identical to original Claim 2, adding a new Claim 4 which is identical to original Claim 1, cancel amended Claim 1, and traverse the rejection of Claim 1.

10. Your client informs you that he has filed an international application in the United States Receiving Office and timely elected and designated the United States. Your client now wishes you to file the necessary documents to enter the U.S. national stage prior to April 27, 1999, the 30 month deadline for entering the national stage. Which of the following actions should you take to obtain the benefit of the international filing date prior to April 27, 1999?

- (A) File only the oath or declaration since that is all that is required for entry into the U.S. national stage.
- (B) File a copy of the international application in the PTO if a copy has not been provided by the International Bureau, and a cover letter instructing that the U.S. national filing fee be deducted from your deposit account.
- (C) File a request to enter the national stage with the PTO identifying the international application.
- (D) File a paper with the PTO identifying the international application, and asking that the PTO send you a bill for the U.S. national filing fee.
- (E) File a request that the International Bureau send all the necessary papers and the fee to the PTO, and send a new oath or declaration signed by your client.

11. Newly registered patent practitioner, Andy, is working at a large patent law firm. Supervising patent attorney, Pat, asks Andy to prepare a short memo which addresses the manner in which an issued patent may be corrected and/or amended. To fully respond to Pat's request, which of the subjects set forth below should Andy include in the following sentence: "An issued patent may be corrected by _____"

- (I) filing for reissue
- (II) filing a disclaimer
- (III) filing a Continued Prosecution Application
- (IV) filing a request for reexamination
- (V) filing a certificate of correction

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

12. Inventor X, a citizen of Germany, invented a new stapler in Germany on July 25, 1997. On January 22, 1998, X filed a patent application for the stapler in the German Patent Office. On January 22, 1999, you filed a complete U.S. patent application in the PTO claiming a stapler on behalf of X. The U.S. application was filed with a declaration under 37 CFR § 1.63 signed by X claiming foreign priority of the German patent application. In an Office action dated April 16, 1999, and setting a three month shortened statutory period for reply, the primary patent examiner properly rejected all the claims in the U.S. patent application as being anticipated under 35 U.S.C. § 102(a) by the disclosure in magazine articles describing how to make and use an identical stapler. The articles were published in the United States in February 1998, and in Great Britain in March 1998. Which of the following actions are in accord with proper PTO practice and procedure, and represent the most appropriate actions for overcoming the rejection?

- (A) File a petition to have the Commissioner exercise his supervisory authority and withdraw the rejection stating that the references cannot be properly used inasmuch as the declaration under 37 CFR § 1.63 makes clear that the application inventor X filed in the German Patent Office antedates the articles.
- (B) File a reply on or before July 16, 1999, which argues that the references cannot be used because the application inventor X filed in the German Patent Office antedates the articles.
- (C) On or before July 16, 1999, file a certified copy of the German application, an English translation of the German application, and point out that the references are no longer available as prior art.
- (D) File an affidavit under 37 CFR § 1.132 signed by you stating that the references cannot be used because the application which inventor X filed in the German Patent Office antedates the articles.
- (E) On or before July 16, 1999, file a certified copy of the German application, and an English translation of the German application.

13. All of the following portions of an application can be used for interpreting the scope of the claims 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.

The answer to each of Questions 14 and 15 is based upon the facts set forth in the paragraphs below. Answer each question independently of the other.

Smith discovered that a tungsten carbide insert for a metal cutting tool may be bonded (with a far superior bond strength over other known methods of attachment) to a steel tool holder. Smith filed a patent application on his invention which contained the following two claims:

- (1) A method of bonding a carbide insert to a steel tool holder comprising the steps of providing a layer of polystick at the interface of the holder and insert, heating the holder, insert, and polystick to a temperature of 250°F. and thereafter cooling the holder, insert, and polystick at a rate of between 12 and 13°F. per hour until a temperature of 120°F. is reached.
- (2) A carbide insert bonded to a steel holder by the method of Claim 1.

The examiner rejected Claim 1 under 35 U.S.C. § 103 as being unpatentable over a U.S. patent to Y in view of a British patent to Z. The examiner rejected Claim 2 under 35 U.S.C. § 102(b) as being anticipated by the patent to Y. The patent to Y teaches that a tungsten carbide insert is bonded to a steel tool holder by utilizing a layer of polystick at the interface of the insert and holder, but makes no mention of any particular temperatures. The patent to Z teaches that in a grinding tool, diamond chips may be "securely fastened" to a ceramic holder by applying a layer of polystick at the interface of the diamonds and holder, heating the holder, chips, and polystick to a temperature of 150°F. and thereafter "slowly" cooling the holder.

14. Which of the following, if any, if submitted with the reply to the Office action, would most likely overcome the examiner's rejection of Claim 1?

- (A) Evidence that a gear cutting machine which includes a carbide insert bonded to a steel tool holder by the method set forth in Claim 1 is outselling all other such machines by a two-to-one margin.
- (B) An affidavit by Smith that, in his opinion, the patent to Y is inoperative.
- (C) Evidence that heavy advertising resulted in increased sales of Smith's invention.
- (D) An affidavit by Smith showing that the claimed method of bonding a carbide insert to a steel tool holder results in a bond which is 50 times greater than that of the invention disclosed in the patent to Y.
- (E) None of the above.

15. Which of the following, if any, if submitted with a reply to the Office action, would be most persuasive and most likely overcome the examiner's rejection of Claim 2?

- (A) Evidence that a gear cutting machine which includes a carbide insert bonded to a steel tool holder as set forth in Claim 1 is outselling all other such machines by a two-to-one margin.
- (B) An affidavit by Smith that, in his opinion, the patent to Z is inoperative.
- (C) Evidence that heavy advertising resulted in increased sales of Smith's invention.
- (D) An affidavit by Smith showing that there is a long felt need in the industry for Smith's carbide insert to a steel tool holder.
- (E) None of the above.

16. Pete the patent practitioner is preparing a patent application for his client, Perry. The invention is disclosed in the specification as a pickle machine comprising 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 A, B, means C, and D, or to form A, B, means C and E. The specification further discloses that component G may be used with only means C', and then only if components D and E are not present.

The first three claims in the application are as follows:

1. A pickle machine comprising A, B and means C for performing a function.
2. A pickle machine as claimed in Claim 1, wherein means C is C'.
3. A pickle 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 pickle machine consisting essentially of A, B, means C' for performing a function, D, and G.
- (B) A pickle machine as claimed in Claim 2, further comprising E.
- (C) A pickle machine as claimed in Claim 1, further comprising D.
- (D) A pickle machine as claimed in Claim 2 or 3, wherein means C is C", and further comprising G.
- (E) A pickle machine as claimed in Claims 1, 2 or 3, further comprising G.

17. You are a sole patent practitioner. You have just finished reading the opinion of the Court of Appeals for the Federal Circuit in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, wherein the Federal Circuit held that patent claims directed to “a data processing system for managing a financial services configuration of a portfolio . . .” were directed to statutory subject matter under 35 U.S.C. § 101. Convinced that your background as a computer programmer and electrical engineer will now be more in demand as a result of the *State Street Bank* decision, you decide to place an advertisement in *PC Magazine*. Your advertisement reads as follows:

INVENTOR NEWSFLASH!!! The highest patent court in the land has just ruled that computer programs can be patented. Don't miss this opportunity to make millions on your invention. To obtain a patent at a reasonable cost, call 1-888-DO IT NOW! Free initial consultation.

Would your advertisement violate the PTO Code of Professional Responsibility?

- (A) Yes. Free consultations are not permitted.
- (B) No. You have not given anything of value to *PC Magazine* for recommending your services.
- (C) No. The PTO Code of Professional Responsibility permits advertising in magazines.
- (D) Yes. The advertisement does not indicate that you are a registered patent agent.
- (E) Yes. The advertisement does not include your name.

18. Inventors Beavis and Barbara mailed their complete provisional patent application to the PTO via first class mail on Tuesday, January 13, 1998, with a certificate of mailing. The application was received in the PTO on Friday, January 16, 1998. In late December 1998, Beavis and Barbara acquired financing for their invention. Encouraged by their good fortune, Beavis and Barbara hire a patent attorney to file a patent application for them. It is Monday, January 4, 1999, and you are the patent attorney hired by Beavis and Barbara. What is the latest date that a nonprovisional patent application can be filed claiming the benefit of Beavis and Barbara's earlier filed provisional patent application?

- (A) Saturday, January 16, 1999, via “Express Mail” date stamped as such in accordance with 37 CFR § 1.10.
- (B) Tuesday, January 13, 1999, via “Express Mail” date stamped as such in accordance with 37 CFR § 1.10.
- (C) Tuesday, January 13, 1999, via hand delivery to the PTO.
- (D) Friday, January 15, 1999, via facsimile transmission.
- (E) Friday, January 15, 1999, with a certificate of mailing.

19. Which of the following statements, if any, are *true* regarding representations to the Patent and Trademark Office under 37 CFR § 10.18 and 37 CFR § 1.4(d)(2)?

- (I) Practitioners are required to advise clients regarding the sanctions which apply for knowingly and willfully concealing a material fact in papers submitted to the PTO.
 - (II) Every paper filed by a practitioner must be personally signed by the practitioner, except those required to be signed by the applicant or party.
 - (III) Applicant has a duty to conduct a prior art search as a prerequisite to filing an application for patent.
- (A) I and II.
 - (B) I only.
 - (C) II only.
 - (D) I, II, and III.
 - (E) III only.

20. 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 on July 22, 1998. Application E was filed on July 22, 1998 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, 1998

21. Mike, an avid cyclist, has developed an invention relating to a bicycle having a “shaped handlebar” which provides improved aerodynamic properties for the bicycle. The invention is described in Mike’s pending U.S. patent application. The “shaped handlebar” is disclosed as being “Y” shaped. The application as filed, however, contained only a single claim (Claim 1) to the bicycle having a “shaped handlebar”. Claim 1 was properly rejected under 35 U.S.C. § 102(b) as anticipated by a U.S. patent to Lois which discloses a “V” shaped handlebar on a bicycle. Claim 1 was amended to add a bicycle wheel structure not disclosed or suggested by the Lois patent. Dependent Claims 2 and 3 were added to add further limitations to the invention. Claim 2 is dependent from Claim 1 and further defined the handlebar as being “Y” shaped. Claim 3 is also dependent from Claim 1 and further defined the handlebar as being “U” shaped. Which of the following statements is true?

- (A) Claim 3 would be unpatentable under the second paragraph of 35 U.S.C. § 112 as being indefinite.
- (B) Claim 2 would be unpatentable under the fourth paragraph of 35 U.S.C. § 112 because it does not further limit the subject matter of independent Claim 1.
- (C) Claim 3 would be unpatentable under the first paragraph of 35 U.S.C. § 112 since the description requirement is not satisfied.
- (D) Claim 2 would be unpatentable under 35 U.S.C. § 132 as being drawn to new matter.
- (E) Claims 2 and 3 would be unpatentable under 35 U.S.C. § 102(b) as being anticipated by the Lois patent.

22. Which of the following does **not** have to be included as part of a request for reexamination of a patent filed by the patent owner?

- (A) The entire specification, claims, and drawings of the patent for which reexamination is requested in cut-up form.
- (B) Proposed amendments to the patent claims for which reexamination is requested.
- (C) A copy of every patent or printed publication relied upon as raising a substantial new question of patentability.
- (D) A statement pointing out each substantial new question of patentability based on prior patents and printed publications.
- (E) An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested.

23. Grish, Dersh, and you are registered practitioners and partners in a law firm. You prepared and filed in the PTO a patent application for Inahurry, your client. Inahurry has successfully marketed the claimed invention. Financial success of the invention is a real possibility. The application was filed with a combined Declaration and Power of Attorney signed by Inahurry appointing you, Grish, and Dersh as Inahurry's attorneys to prosecute the application. All of the claims in the application were rejected in the first Office action. After you filed a timely reply to the first Office action, the examiner issued a second Office action dated January 13, 1999, in which he made a final rejection of the claims, and set a three month shortened statutory period for reply. Promptly after receipt of the second Office action, you notified Inahurry of the action and possible replies. Inahurry, who is not well versed in patent practice and procedure, but who is dissatisfied with the course of prosecution with the application, sends you a letter dated April 5, 1999, discharging you, Grish, and Dersh. What are your ethical obligations as a result of Inahurry's letter?

- (A) You must file with the Commissioner by July 13, 1999, a request to withdraw signed by you on behalf of yourself, Grish, and Dersh; and take reasonable steps to avoid foreseeable prejudice to Inahurry's rights, including giving due notice to Inahurry of the request, the period for reply, the availability of extensions of time to reply and fees for the same, and delivery to Inahurry of all papers and property to which Inahurry is entitled, and refund any unearned fees.
- (B) You must obtain from the Commissioner approval to withdraw at least thirty days before the expiration of the statutory period for reply, give due notice to Inahurry of the request, and deliver to Inahurry all papers and property to which Inahurry is entitled, and refund any unearned fees.
- (C) You must continue to prosecute the application until Inahurry files a revocation of the power of attorney in the PTO and it is approved by the Commissioner.
- (D) You have an ethical obligation to talk to Inahurry and find out why he is dissatisfied with your firm and to persuade him to let your firm continue to represent him before the PTO.
- (E) You have an ethical obligation to continue to prosecute the application because Inahurry is not well versed in patent practice and procedure, and Inahurry's financial success will depend on securing a patent.

24. The first three claims in a pending patent application read as follows:

1. A widget comprising A, B, and C.
2. A widget as claimed in Claim 1, further comprising D.
3. A widget as claimed in Claims 1 or 2, further comprising E.

The application further discloses element G which can be combined with any combination of elements A, B, C, D, and E to form the widget. Which of the following claims would be a correct form for Claim 4?

- (A) A widget as claimed in Claims 1, 2, and 3, further comprising G.
- (B) A widget as claimed in Claim 2, further comprising D.
- (C) A widget as claimed in Claim 3, further comprising D.
- (D) A widget as claimed in Claims 1 or 2, further comprising G.
- (E) A widget as claimed in Claims 1, 2, or 3, further comprising G.

25. Bert and Ernie are joint inventors of a widget that automatically adjusts television volume levels during commercial breaks. A nonprovisional patent application was filed on October 15, 1998, and a first Office action on the merits was mailed on January 11, 1999. A reply was filed on January 28, 1999, and a Notice of Allowance was mailed on February 26, 1999. The Issue Fee has not been paid. What is the **last day** that Bert and Ernie can file a properly drafted Information Disclosure Statement (IDS) **without** having to pay a fee and to ensure that the information submitted in the IDS would be considered by the examiner?

- (A) Friday, January 15, 1999, via facsimile with a Certificate of Transmission
- (B) Sunday, January 10, 1999, via facsimile with a Certificate of Transmission
- (C) Thursday, January 28, 1999, via first class mail with no Certificate of Transmission
- (D) Friday, January 15, 1999, via "Express Mail Post Office to Post Office" with a Certificate of Express Mailing
- (E) Thursday, February 25, 1999, via facsimile with a Certificate of Transmission but without a statement that each item cited in the IDS was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to submission of the IDS

26. A double patenting issue can be raised _____

- I. between two or more pending applications.
- II. in a reexamination proceeding.
- III. between a pending international application which has not yet entered the national stage in the United States and a patent.
- IV. between three pending applications and a patent.

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

27. On April 3, 1997, Priscilla discovered a process for making a new composition by heating an aqueous mixture of a resin and a metal salt. Priscilla filed a patent application on July 28, 1997, which issued as a patent on January 19, 1999. The patent claims were directed only to the process for making the composition. Priscilla's patent discloses, but does not claim, the composition. On September 19, 1998, Bruce discovered that Priscilla's composition could be made by a different process comprising the steps of reacting a resin, a metal oxide, and an acid in a nitrogen atmosphere. On January 11, 1999, Bruce filed an application in the PTO which claims the composition and his method of making the composition. All work by Priscilla and Bruce was done in this country. Bruce's work is independent of and not derived from Priscilla. Bruce and Priscilla have never been employed by the same employer. The examiner rejected Bruce's composition claims over Priscilla's patent under 35 U.S.C. § 102. The rejection is:

- (A) improper because Priscilla discloses a process which is different from the process used by Bruce to make the composition.
- (B) proper because Priscilla's composition was known by others in this country before the invention thereof by Bruce.
- (C) improper because Bruce filed his application before Priscilla's patent issued.
- (D) proper because Priscilla discloses, but does not claim the composition, and has an earlier filing date than Bruce.
- (E) (B) and (D).

28. Inventor Dan invented Y in the United States on February 5, 1998, and hired practitioner P to prepare and file a provisional application. On March 6, 1998, P filed a provisional patent application in the PTO. P received a Notice to File Missing Parts dated June 5, 1998, because the appropriate filing fee was not filed. The Notice set a period for reply which was two months from the date of the Notice. The filing fee and required surcharge were not filed in the PTO. The provisional patent application became abandoned. A Notice of Abandonment, dated August 10, 1998, was duly received by P's secretary in P's office, and P's secretary placed the notice in Dan's file. On March 3, 1999, Dan furnished P with a copy of a publication by Smith dated March 1, 1998, fully describing Y, and its method of manufacture. On March 4, 1999, P reviewed Dan's file and found the two notices. To properly protect Dan's patent rights, the most appropriate course of action for P to take is to _____

- (A) file in the PTO on Friday, March 5, 1999, a nonprovisional application claiming Y, and file a copy of the Smith publication, and an explanation of the relevance of the Smith publication.
- (B) deposit with the U.S. Postal Service as "Express Mail" in accordance with 37 CFR § 1.10, on Saturday, March 6, 1999, a nonprovisional application which claims Y, a copy of the Smith publication, and an explanation of the relevance of the Smith publication.
- (C) file in the PTO on Friday, March 5, 1999, another provisional application claiming the benefit of the filing date of the March 6, 1998, provisional application. For the March 6, 1998, provisional application, file the filing fee and surcharge, the appropriate petition and fee to revive the provisional application, a statement by P that the abandonment of the provisional application was unintentional, a copy of the Smith publication, and an explanation of the relevance of the Smith publication.
- (D) deposit in the U.S. Postal Service as "Express Mail" in accordance with 37 CFR § 1.10 on Saturday, March 6, 1999, a nonprovisional application claiming Y, and claiming the benefit of the filing date of the provisional application under 35 U.S.C § 119(e) along with a copy of the Smith publication, and an explanation of the relevance of the Smith publication. Also, in the provisional application, file the filing fee and surcharge for the provisional application along with the appropriate petition and fee to revive the provisional application as unintentionally abandoned, and a statement by P that the abandonment of the provisional application was unintentional.

- (E) file in the PTO on Monday, March 8, 1999, a nonprovisional application claiming Y and claiming benefit of the filing date of the provisional application under 35 U.S.C § 119(e), and also file the filing fee and surcharge for the provisional application along with the appropriate petition and fee to revive the provisional application as unintentionally abandoned, a statement by P that the abandonment of the provisional application was unintentional, a copy of the Smith publication, and an explanation of the relevance of the Smith publication.

29. On April 1, 1999, Inventor Dave filed a patent application claiming a pancake flipper. To fully describe the pancake flipper, Dave refers to a February 1999 issue of a cooking magazine. The examiner objected to the specification on the ground that it improperly incorporated the material of the publication by reference. Which of the following actions would accord with proper PTO practice and procedure in overcoming the objection?

- (A) Amend the specification to include the material incorporated by reference.
- (B) File a declaration executed by Dave containing the essential material and stating that the material consists of the same material incorporated by reference.
- (C) Abandon the application and file a new application incorporating by reference Dave's prior application.
- (D) File an amendment which amends the specification to include the material incorporated by reference and file a petition to the Commissioner stating that the incorporation by reference was inadvertent with the proper fee.
- (E) File an amendment to the specification to include the material incorporated by reference, and accompany it with an affidavit executed by Dave stating that the amendatory material consists of the same material incorporated by reference.

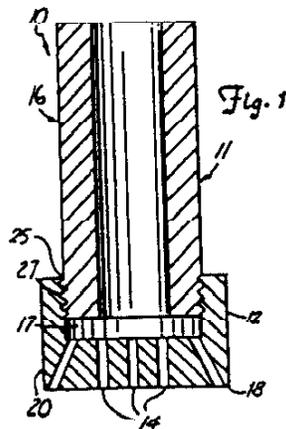
Answer Questions 30 and 31 independently of each other and based upon the following information. You have drafted and filed a patent application for JoJo Industries directed to a device for mechanically flushing food storage containers with gases which includes the following disclosure and drawings:

The gas flushing device of the present invention, illustrated generally at 10 in FIG. 1, includes a main body 11 having a piston portion 12 with holes 14 that is securely attached to a piston rod 16. The piston rod 16 is in communication with a source of a flushing gas such as carbon dioxide. The piston rod 16 conveys flushing gas to a chamber 17 in which the flushing gas under pressure exits through holes 14.

In one preferred embodiment, the piston portion 12 of the gas flushing device 10 includes a bottom surface 18 that is substantially circular. The bottom surface 18 of the piston portion 12 is preferably made of a non-stick material such as nylon or teflon. The piston portion 12 also includes a cylindrical side surface 20 that meets the bottom surface 18 at the circumference of the bottom surface 18. For a flat bottom surface 18, the cylindrical surface 20 is substantially perpendicular to the bottom surface 18.

The piston portion 12 also includes at least one hole 14. In one embodiment, the hole 14 is positioned in the bottom surface 18 of the piston portion 12. In another embodiment, the piston portion 12 includes a plurality of holes that are located on the bottom surface 18. In another embodiment, the piston portion 12 includes a plurality of holes that are located on each of the bottom surface 18 and the cylindrical surface 20. The piston portion 12 is securely attached to the hollow rod portion 16 by a threaded section 25 on the piston rod portion 16 that engages a threaded section 27 on the piston portion 12. The piston rod portion 16 may be detached from the piston portion 12 by disengaging the threaded sections, thereby facilitating cleaning of the flushing device 10.

The piston rod portion 16 of the main body 11 shown in FIG. 1 is a hollow rod. The piston rod portion 16 is threadably attachable to and detachable to a source of flushing gas. In one embodiment, the piston rod portion 16 and piston portion 12 are parts of a single substantially hollow main body 11.



The following independent claim is included in the application:

1. A gas flushing device for flushing a container enclosing food comprising a main body (11) that includes a piston portion (12) with at least one hole (14) providing direct contact between the gas and the food, a piston rod portion (16) which is threadably attachable to and detachable to a source of flushing gas and which is securely attached to the piston portion (12), the piston portion (12) having a nonstick surface (18).

30. Which of the following claims, if any, comply with 35 U.S.C. § 112 based upon JoJo's disclosure and independent claim?

- (A) 2. The gas flushing device of Claim 1 wherein said piston portion (16) is attached to said piston rod portion (12) by a threaded section (25) on said piston rod portion (12) that engages a threaded section (27) on said piston rod portion (12).
- (B) 2. The gas flushing device according to Claim 1 wherein said piston portion is made of nylon.
- (C) 2. The gas flushing device of Claim 1 wherein the piston portion includes a bottom surface and a cylindrical side surface bounding the bottom surface.
- (D) 2. The gas flushing device of Claim 1 wherein said hole is positioned in said bottom surface of said piston portion.
- (E) None of the above.

31. Which of the following dependent claims, if any, cover the embodiment described in lines 15-16 of the disclosure?

- (A) 2. A gas flushing device as set forth in Claim 1 wherein the piston portion includes a plurality of holes located on each of said bottom surface and said cylindrical surface.
- (B) 3. A gas flushing device of Claim 2 wherein the piston portion includes a plurality of holes located on each of said bottom surface and said cylindrical surface.
- (C) 2. The gas flushing device of Claim 1 wherein the piston portion includes a cylindrical surface perpendicular to a bottom surface and said piston portion includes a plurality of holes located on each of said bottom surface and said cylindrical surface.
- (D) (A), (B), and (C).
- (E) (A) and (C).

32. XYZ Corporation has hired you to draft and file a patent application relating to a steel alloy. You diligently prepare the application and file it in the PTO on June 23, 1998, naming Baker as the inventor. On February 5, 1999, you receive a first Office action rejecting all the claims under 35 U.S.C. § 102(g)/103 over a patent assigned to XYZ Corporation. Able is the inventor named in the patent. The Able patent was granted on an application filed on June 25, 1996, and issued on January 13, 1998. You can overcome this rejection by _____

- (A) filing an affidavit signed by an officer of the XYZ Corporation averring that both Able and Baker were subject to an obligation of assignment on the date the later invention was made, and stating facts which explain the officer's belief of ownership.
- (B) filing an affidavit by Baker averring common ownership on the date of filing the Able patent application with the necessary fee.
- (C) filing a terminal disclaimer so as not to extend the term of the Baker application beyond that of the Able patent if the Baker application matures into a patent.
- (D) filing a request to suspend the prosecution of the Baker patent application, and petition the Commissioner for a corrected filing receipt dated January 13, 1998, because of common ownership.
- (E) filing a request for reexamination of the Able patent based on prior art references not disclosed by Baker.

33. Inventor Cal files a provisional application in the PTO on June 5, 1997. On June 2, 1998, Cal asks you to prepare and file a nonprovisional utility patent application. On June 3, 1998, you file the nonprovisional utility application with a specific reference to Cal's June 5, 1997, provisional application. A Notice of Allowance is sent on February 3, 1999, and the Issue fee is timely paid on April 1, 1999. The patent will issue on June 1, 1999. When will Cal's patent term begin and end?

- (A) The term will begin on June 1, 1999, and end on June 5, 2017.
- (B) The term will begin on February 3, 1999, and will end on June 5, 2017.
- (C) The term will begin on April 1, 1999, and will end May 1, 2018.
- (D) The term will begin on June 1, 1999, and will end on June 3, 2018.
- (E) The term will begin on February 3, 1999, and will end on June 3, 2018.

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

A steam cooking device comprising:

- a steam generating chamber having a steam generator;
- a cooking chamber adjacent to said steam generating chamber for receiving steam from said steam; and
- 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.

Which of the following 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 7, after "inner" insert --panel--.
- (C) In Claim 1, line 6, delete [one], insert --two--, and amend "zone" to read --zones--.
- (D) In Claim 1, lines 3-4, 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--.

35. A Notice of Allowance is dated and mailed on September 25, 1998, to the applicant. In which of the following situations would the issue fee **not** be considered as timely paid?

- (A) The issue fee is filed in the PTO on Monday, December 28, 1998.
- (B) The issue fee is filed in the PTO on Wednesday, November 25, 1998.
- (C) The issue fee is filed in the PTO on Thursday, March 25, 1999, 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 December 29, 1998, and is accompanied with a certificate of mailing dated Monday, December 28, 1998.
- (E) (A) and (D).

36. Whenever a claim of a patent is held invalid:

- (A) the claim must be disclaimed by the patent owner to avoid invalidity of the remaining claims in the patent.
- (B) a portion of the claim can be disclaimed provided the remaining portion of the claim adequately defines the invention.
- (C) any disclaimer of the claim shall be in writing, but need not be recorded in the PTO.
- (D) and the invalid claim is to a composition of matter, the claims to a biotechnological process which result in that composition of matter will also be held invalid.
- (E) None of the above.

37. Which of the following statements, if any, regarding amendments to claims in a reexamination proceeding are true?

- (A) If copies of the printed patent are used to amend the claims, additions to the claims are indicated by carets.
- (B) Brackets may not be used in amending claims if more than 5 words are being inserted into the claim.
- (C) Additions to amended claims are indicated by underlining, and new claims may be added, if and only if, an equal number of existing claims are canceled.
- (D) A patent claim should be canceled by a statement canceling the patent claim and renumbering any new claim to have the number of the canceled claim.
- (E) A previously proposed new claim should be canceled by a statement canceling the proposed new claim without presentation of the text of the previously proposed new claim.

38. You are a registered patent agent representing a corporate client. An appeal is taken from the examiner's final rejection of Claims 1-8 of your client's nonprovisional patent application. Independent Claim 1 and its dependent Claims 2-4 stand rejected under 35 U.S.C. § 102(b) based on a U.S. patent to X. Independent Claim 5, independent Claim 6 and its dependent Claims 7-8 stand rejected under 35 U.S.C. § 103 based on a U.S. patent to Y in view of a U.S. patent to Z. None of the dependent claims are multiple dependent claims. The subject matter of Claims 1, 2, 3, 5, 6, and 8 is very important to

your client and you consider each of these claims to be separately patentable over the art applied by the examiner in rejecting these claims. In your Appeal Brief, which of the following courses of action, if any, would be the most appropriate to follow on behalf of your client?

- (A) Specify that dependent Claims 2-4 and 7-8 stand or fall together with their respective independent Claims 1 and 6, and present reasons as to why independent Claims 1, 5, and 6 are considered separately patentable.
- (B) Point out the errors in the examiner's rejection of Claims 1-3 and how the specific limitations of Claims 1-3 are not shown in X's patent. Point out the errors in the examiner's rejection of Claims 5, 6, and 8 and how Y and Z, taken as a whole, do not suggest the claimed subject matter of Claims 5, 6, and 8.
- (C) Point out that dependent Claims 4 and 7 stand or fall with their respective independent Claims 1 and 6, and present arguments as to the separate patentability of each of Claims 1, 2, 3, 5, 6, and 8.
- (D) Argue the importance of each claim to your client, emphasizing the differences in what independent Claims 1, 5, and 6 cover, and state how the examiner erred in relying on X, Y, and Z's patents.
- (F) All of the above.

39. You are prosecuting a patent application in which there are two named inventors. You received a notice of allowance in the patent application. However, before the Issue fee became due, one of the named inventors died. Which of the following statements is *true* with respect to the application as a consequence of the death of the inventor?

- (A) A new power of attorney must be submitted so that you can continue to represent the remaining inventor.
- (B) The application is automatically abandoned upon the death of the inventor.
- (C) A new application must be filed naming the heirs of the deceased inventor and the remaining inventor.
- (D) The executor or administrator of the deceased inventor must intervene to prevent the application from being withdrawn from issue.
- (E) The application matures to a patent after timely payment of the required fees.

40. You are a registered practitioner and you have filed a patent application in the PTO on behalf of your client, Wannaberich, on January 7, 1998. In the first Office action, the examiner made a restriction requirement. Although your client disagrees with the restriction, you have made a provisional election with traverse and vehemently argue the restriction requirement. In the next Office action, the restriction is made final and an action on the merits follows. The application is eventually allowed. The client now wants to pursue the non-elected invention. You file a divisional application directed to the non-elected invention before the parent application issues as a patent. In the first Office action in the divisional application, the examiner rejects the claims on the grounds of obviousness-type double patenting over the patent which issued from the parent application. What should be the most appropriate reply to the rejection?

- (A) File a terminal disclaimer to obviate the double patenting rejection.
- (B) Amend the claims in the pending application to overcome the rejection.
- (C) File a 37 CFR § 1.132 antedating affidavit.
- (D) Request reconsideration and point out that it is improper to use the parent patent in an obviousness-type double patenting rejection when a restriction requirement has been made by the examiner in the parent application.
- (E) File a petition under 37 CFR § 1.183 to the Commissioner.

41. Petitions under 37 CFR § 1.48 are generally decided by the primary examiner except:

- (A) When the application is involved in an interference.
- (B) When the application is a national stage application filed under 35 U.S.C. § 371.
- (C) When accompanied by a petition under 37 CFR § 1.183 requesting waiver of a requirement under 37 CFR § 1.48(a) or (c), e.g., waiver of the statement of lack of deceptive intent by an inventor to be added or deleted, or waiver of the reexecution of the declaration by all of the inventors.
- (D) When a second conversion under 37 CFR § 1.48(a) is attempted.
- (E) All of the above.

42. The examiner determined that amended Claim 1 contains new matter and rejected amended Claim 1. The claim was added by an amendment which was filed after the filing date of the application. Which of the following identifies the proper basis for the rejection of amended Claim 1 and the action which should be taken by the applicant to overcome the rejection?

- (I) Claim 1 is rejected under 35 U.S.C. § 112, first paragraph. Applicant should amend the specification to include the new matter therein so as to provide antecedent support for the claim.
- (II) Claim 1 is rejected under 35 U.S.C. § 132. Applicant should cancel the claim.
- (III) Claim 1 is rejected under 35 U.S.C. § 112, first paragraph. Applicant should cancel the claim.
- (IV) Claim 1 is rejected under 35 U.S.C. § 132. Applicant should file a declaration in accordance with 37 CFR § 1.63.

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

43. Which of the following phrases, when appearing in a claim, would render the claim indefinite?

- (A) A claim to a bicycle that recited "said front and rear wheels so spaced as to give a wheelbase that is between 58 percent and 75 percent of the height of the rider that the bicycle was designed for."
- (B) A claim limitation specifying that a certain part of a pediatric wheelchair be "so dimensional as to be insertable through the space between the doorframe of an automobile and one of the seats."
- (C) A claim limitation defining the stretch rate of a plastic as "exceeding about 10% per second."
- (D) (A) and (B).
- (E) (A), (B), and (C).

Both questions 44 and 45 are based on the following fact pattern:

B filed a patent application on March 31, 1997, for an ice cream machine. Discovering an added feature that improved productivity, B filed a CIP application on May 14, 1997. Thereafter, B abandoned the application filed on March 31, 1997. On June 30, 1998, a patent was granted to B for his invention in the CIP application. On March 1, 1999, B realizes that he is claiming less than he is entitled to in view of the added feature in the CIP application. B is worried that this will hurt his upcoming negotiations to assign his patent rights to Mega Corporation. B comes to you, a registered patent practitioner, on March 2, 1999, for advice regarding how to file an application for reissue.

44. What is the latest date that B can file an application for reissue and be entitled to seek enlargement of the scope of the claims of the original patent?

- (A) June 29, 2000
- (B) May 14, 1999
- (C) March 31, 1999
- (D) June 30, 2000
- (E) None of the above

45. What documents must be filed as part of B's application for reissue in order to be granted a filing date?

- (I) Reissue Oath or Declaration
- (II) An offer to surrender
- (III) Filing fee
- (IV) Written Consent of Mega Corp.
- (V) A specification, claims and any required drawings.

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

46. The claims in an application filed on behalf of McTeal were rejected as being unpatentable under 35 U.S.C. § 103 over Gage in view of Nell. McTeal gave you, a registered practitioner, power of attorney to prosecute her application. Which one of the following items of information available to you would be relevant to overcoming the rejection of the claims without modifying or amending the claims?

- (A) Gage and Nell do not teach or suggest feature A of McTeal's invention which is set forth in each of the drawings and in the working examples in McTeal's application, but which is not recited in any of the rejected claims.
- (B) In the opinion of Billy, a noted expert in the field, McTeal's invention is patentable because it has revitalized the industry and Billy has nominated McTeal to receive the prestigious Phrog Foundation Award for Excellence.
- (C) McTeal's invention can be shown to possess unexpected superior properties over the prior art.
- (D) Gage was published 50 years before Nell and therefore contains no specific reference to Nell suggesting that his invention can be modified in the manner suggested by the Examiner.
- (E) The teachings of Gage and Nell, taken singularly or combined, would not be followed by one of ordinary skill in the art because it would be cost prohibitive to do so.

47. Which of the following must be filed to obtain a filing date for a Continued Prosecution Application?

- (I) A copy of the originally filed specification, claims and drawings.
 - (II) A newly executed oath or declaration signed by all the originally named inventors.
 - (III) The filing fee.
 - (IV) A request, on a separate paper, for an application under 37 CFR § 1.53(d) in compliance with that paragraph.
- (A) (I), (II), and (III)
 - (B) (I)
 - (C) (I), (II), (III), and (IV)
 - (D) (IV)
 - (E) (I) and (IV)

48. Patent practitioner Luke filed a patent application in the PTO on behalf of his client Vader which contained three original claims directed to Vader's invention and which were fully supported by the specification. The three original claims read as follows:

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 BB.

The examiner issued a rejection of Claim 3 under 35 U.S.C. § 112, second paragraph, citing the improper dependency of the claim. In the absence of issues of supporting disclosure, which of the following proposed amendments will overcome the rejection?

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

49. You are a registered practitioner and Henry has come to you to determine whether he has a patentable invention. He discloses to you that he has developed a composition that can be used as bait for a conventional mousetrap. He explains to you that his composition is so effective that one need only wait minutes to lure mice to the trap. You explain to Henry that you cannot give a patentability opinion until after a preliminary search has been made of the prior art. You have a search made and find that Henry's composition is a well known pork barrel lubricant that has been in public use for over 20 years. What should be your advice to Henry?

- (A) File a U.S. patent application claiming the composition as mouse bait.
- (B) File a U.S. patent application with claims directed to a method of using the composition as bait.
- (C) Explain that it would be impossible for any claims to the process of using the composition as mouse bait to be allowed under the current guidelines of the PTO.

- (D) File a provisional patent application directed only to the composition in order to gain a competitive advantage for one year. Within one year of filing the provisional application, recommend that Henry file a nonprovisional application claiming the composition.
- (E) None of the above.

50. Your client has invented a widget consisting essentially of an amplifier having a voltage of 100 to 300 amps, preferably 250 amps, and a woofer having a wattage of 400 to 450 watts, preferably 425 watts. You draft a patent application directed to your client's invention and satisfying the requirements of 35 U.S.C. § 112. You draft the following independent claim:

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

Which of the following 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 amplifier has a voltage of up to 300 amps.
- (B) 2. The widget of Claim 1 wherein the woofer has a wattage of 425 to 450 watts.
- (C) 2. The widget of Claim 1 wherein the amplifier has a voltage of 300 amps and the woofer has a wattage between 430 and 450 watts.
- (D) 2. A widget of Claim 1 further comprising an amplifier having a voltage of at least 250 amps and a woofer having a wattage of at least 425 amps.
- (E) (A) and (D).

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

APRIL 21, 1999

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 I 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 I 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

Answer questions 1 and 2 based on the following facts:

Registered patent attorneys, Will, Able and Fleet, are partners in their own California law firm specializing in patent law. As luck would have it, a PTO filing deadline falls due for each partner on Friday, February 12, 1999. Having to forego their weekly Friday afternoon discussion of the MPEP, all three partners are scrambling to finish their papers. Will is drafting a Continued Prosecution Application (CPA) under 37 CFR § 1.53(d) which must be filed by Friday, February 12, 1999. Having just received the client's instructions that morning, Able is replying to a Final Office action dated August 12, 1998, which set a three month shortened statutory period for reply. Fleet, working hard to satisfy a forgetful, new client, is putting the finishing touches on a nonprovisional patent application based on a provisional application his new client had filed on February 12, 1998. Finishing their work at 8:30 p.m. Pacific time, all three partners head to the mailroom. There is only one facsimile machine. With their deadline fast approaching, Will and Able begin to argue about who should use the facsimile machine first to send their papers to the PTO. A complete transmission of Able's amendment would take fifteen minutes. A complete transmission of Will's CPA would take ten minutes. Thankful that they had been studying their MPEP, Will and Able come to an agreement. At exactly 8:40 p.m. Pacific time, a first facsimile transmission is sent to the PTO from Will and Able's firm.

1. Which one of the following choices outlines the best course of action taken by Will and Able so that both Will and Able's documents received a Friday, February 12, 1999, filing date?

- (A) Will files his CPA via facsimile at 8:40 p.m. Pacific time with all the necessary papers including a Certificate of Transmission. The CPA is received in the PTO exactly ten minutes later. Able files his amendment via facsimile at 8:50 p.m. Pacific time with all the necessary papers including a Certificate of Transmission which states the date of transmission. Able's amendment is received in the PTO exactly fifteen minutes after he sent it.
- (B) Able files his amendment via facsimile at 8:40 p.m. Pacific time with all the necessary papers including a Certificate of Transmission. The amendment is received in the PTO exactly fifteen minutes later. Will files his CPA via facsimile at 8:55 p.m. Pacific time with all the necessary papers including a Certificate of Transmission which states the date of transmission. Will's CPA is received in the PTO exactly ten minutes after he sent it.

- (C) Will files his CPA via facsimile at 8:40 p.m. Pacific time with all the necessary papers including a Certificate of Transmission. The CPA is received in the PTO exactly ten minutes later. After a quick conference call with his client about the amendment, Able files the amendment via facsimile at 9:10 p.m. Pacific time with all the necessary papers but fails to include a Certificate of Transmission. Able's CPA is received in the PTO exactly fifteen minutes after he sent it.
- (D) (A) and (B).
- (E) None of the above.

2. At 8:45 p.m. Pacific time that same day, Fleet rushes to the nearest United States Post Office (USPS) down the street to send his nonprovisional patent application with all the necessary papers to the PTO. What is the best action for Fleet to take to receive a Friday, February 12, 1999, filing date?

- (A) Send the application with a Certificate of Mailing via first class mail no later than 11:59 p.m. Pacific time on Friday.
- (B) Deposit the application directly with an employee of the U.S. Postal Service by "Express Mail Post Office to Post Office" at 8:59 p.m. Pacific time.
- (C) Deposit the application directly with an employee of the U.S. Postal Service by "Express Mail Post Office to Addressee" no later than 11:59 p.m. Pacific time.
- (D) Send the application via "Federal Express" before 11:59 p.m. Pacific time.
- (E) (B) and (C).

3. In addition to complying with 37 CFR § 1.4(d)(2), which of the following documents, if any, must also contain a separate verification statement?

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

4. In early 1997, Goforgold, a company based in Australia, developed a widget with increased reflective properties. Goforgold filed a patent application in the Australian Patent Office on January 8, 1997, and filed a corresponding application in the USPTO on January 5, 1998. All research activities for the inventions disclosed and claimed in the U.S. and Australian applications took place in Australia. The U.S. patent application contains five claims:

1. A widget comprising elements A and B.
2. A widget according to Claim 1 wherein the widget further includes element D.
3. A widget comprising elements A and C.
4. A widget according to Claim 3 wherein the widget further includes element E.
5. A widget comprising elements A, B, and C.

The Australian application only supports claims 1, 2, and 5 of the U.S. application. During the course of prosecution of the U.S. application, the examiner properly rejected all of the claims under 35 U.S.C. § 102(e) as being anticipated by a U.S. patent assigned to Gotthesilver. The Gotthesilver patent was granted on October 6, 1998, on a U.S. application filed on June 15, 1997. The Gotthesilver patent specifically describes, but does not claim, the widget in claims 1-5 of the U.S. application filed by Goforgold. The subject matter of the Gotthesilver patent was reduced to practice in Flushing, New York as of February 12, 1997. Which of the following proposed arguments or actions would properly overcome the examiner's § 102(e) rejection with respect to all the claims?

- (A) File an affidavit under 37 CFR § 1.132 swearing behind the claims of the Gotthesilver patent by relying on the 1997 research activities of Goforgold in Australia.
- (B) File a claim for a right of priority based on the application filed in Australia along with a certified copy of the Australian patent application and canceling Claims 3 and 4.
- (C) File a claim for a right of priority based on the application filed in Australia along with a certified copy of the Australian patent application.
- (D) File an affidavit under 37 CFR § 1.132 swearing behind the February 12, 1997, reduction to practice date of the Gotthesilver patent.
- (E) File a terminal disclaimer.

5. In which of the following situations would a petition to make special **not** be granted?

- (A) The applicant files a petition with the petition fee requesting special status and stating that small entity status has been established; that the subject of the biotechnology patent application is a major asset of the small entity; and that the development of the technology will be significantly impaired if examination of the application is delayed, including an explanation of the basis for making the statement.
- (B) Applicant's invention materially enhances the quality of the environment. Applicant files a petition that the application be accorded special status and includes a statement explaining how the invention contributes to the restoration of a basic life-sustaining element. No fee is included.
- (C) Applicants have filed a request that their application which is directed to an invention for a superconductive material be accorded special status. Applicants' request is accompanied by a statement that the invention involves superconductivity. No fee is included.
- (D) Applicant's invention is directed to a system for detecting explosives. Applicant files a petition for special status which is accompanied by a statement explaining how the invention contributes to countering terrorism. No fee is included.
- (E) None of the above.

6. Which of the following fees are reduced for small entities?

- I. Patent application filing fees
- II. Petition for an extension of time fees
- III. Petition to suspend the rules fees
- IV. Patent Issue fees
- V. Certificate of Correction fees

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

The answer to each of questions 7-11 is based upon the facts set forth in the paragraph below. Answer each question independently of the others.

You are a registered patent agent with an office in Buffalo, New York. On January 13, 1998, Murphy, a resident of Canada, came to your office for purpose of obtaining a U.S. patent on her invention. She tells you that she first conceived her invention at her home in Ontario on December 18, 1996, and that she reduced it to practice on January 10, 1997, at her home. On January 13, 1998, Murphy provided you with a detailed written description fully disclosing her invention. You diligently proceeded to prepare the application. You filed the application in the PTO on February 12, 1998. Consider each of the situations presented in the questions below in light of the facts presented above and determine which paragraph of 35 U.S.C. § 102, if any, would prevent Murphy from obtaining a U.S. patent.

7. Murphy's invention is described and claimed in a U.S. patent to O'Malley granted on February 9, 1999, on a national stage application filed in the United States on February 17, 1998, based on a PCT international application filed in France on November 13, 1997. O'Malley satisfied the requirements of 35 U.S.C. § 371(c)(1), (2), and (4) on February 17, 1998.

- (A) 35 U.S.C. § 102(b).
- (B) 35 U.S.C. § 102(c).
- (C) 35 U.S.C. § 102(e).
- (D) 35 U.S.C. § 102(f).
- (E) None of the above.

8. Murphy patented her invention in Canada on December 30, 1997 on a Canadian patent application filed on February 10, 1997.

- (A) 35 U.S.C. § 102(a).
- (B) 35 U.S.C. § 102(b).
- (C) 35 U.S.C. § 102(d).
- (D) 35 U.S.C. § 102(e).
- (E) None of the above.

9. In January of 1997, Murphy sold prototypes of her invention in Canada.

- (A) 35 U.S.C. § 102(a).
- (B) 35 U.S.C. § 102(b).
- (C) 35 U.S.C. § 102(f).
- (D) 35 U.S.C. § 102(g).
- (E) None of the above.

10. After the application was filed in the U.S., Murphy admitted that in order to make the claimed invention operative, the mechanic who built the prototype of Murphy's invention added a novel feature without consulting Murphy which is included in all the claims of the application.

- (A) 35 U.S.C. § 102(a).
- (B) 35 U.S.C. § 102(b).
- (C) 35 U.S.C. § 102(f).
- (D) 35 U.S.C. § 102(g).
- (E) None of the above.

11. Murphy's invention is described and claimed in a German Gebrauchsmuster petty patent granted on February 11, 1998, based on an application filed by Murphy on February 2, 1997. The German Gebrauchsmuster patent was published on February 14, 1998.

- (A) 35 U.S.C. § 102(b).
- (B) 35 U.S.C. § 102(c).
- (C) 35 U.S.C. § 102(d).
- (D) 35 U.S.C. § 102(e).
- (E) None of the above.

12. Which of the following statements, if any, regarding Secrecy Orders are **false**?

- (A) A Secrecy Order remains in effect for a period of one year from its date of issuance.
- (B) If the Secrecy Order is applied to an international application, the application will not be forwarded to the International Bureau as long as the Secrecy Order remains in effect.
- (C) If, prior to or after the issuance of the Secrecy Order, any significant part of the subject matter or material information relevant to the application has been or is revealed to any person in a foreign country, the principals must promptly inform such person of the Secrecy Order and the penalties for improper disclosure.
- (D) Use of facsimile transmissions to file correspondence in a Secrecy Order case is permitted so long as it is transmitted to the Office in a manner that would preclude disclosure to unauthorized individuals and is properly addressed.
- (E) (C) and (D).

13. On January 19, 1999, inventor B filed a patent application in the PTO claiming invention X. Inventor B did not claim priority based on a foreign application filed by inventor B on April 3, 1998, in the Patent Office in Japan. In the foreign application, inventor B disclosed and claimed invention X, which inventor B had conceived on August 11, 1997, and reduced to practice on November 5, 1997, all in Japan. The U.S. patent examiner issued an Office action where all the claims in the patent application were properly rejected under 35 U.S.C. § 102(a) and (e) as being anticipated by a U.S. patent granted to inventor Z on September 1, 1998, on a patent application filed in the PTO on December 5, 1997. There is no common assignee between Z and B, and they are not obligated to assign their invention to a common assignee. Moreover, inventors Z and B, independently of each other, invented invention X, and did not derive anything from the other. The U.S. patent to Z discloses, but does not claim, invention X. Which of the following is/are appropriate reply(ies) which could overcome the rejections under §§ 102(a) and (e) when timely filed?

- (A) File an antedating affidavit or declaration under 37 CFR § 1.131 showing conception on August 11, 1997, and actual reduction to practice on November 5, 1997, all in Japan.
- (B) File a claim for the right and benefit of foreign priority wherein the Japanese application is correctly identified, file a certified copy of the original Japanese patent application, and argue that as a result of the benefit of foreign priority, the U.S. patent is no longer available as a prior art reference against the claims.
- (C) Amend the claims to require particular limitations disclosed in inventor B's application, but not disclosed or suggested in inventor Z's patent, and argue that the limitations patentably distinguish the claimed invention over the prior art.
- (D) (A) and (C).
- (E) (B) and (C).

14. A Certificate of Correction cannot be used to correct:

- (A) the failure to make reference to a prior copending application.
- (B) an incorrect reference to a prior copending application.
- (C) the omission of an inventor's name from an issued patent through error and without deceptive intent.
- (D) the omission of a preferred embodiment in the original disclosure overlooked by the inventor which would materially affect the scope of the patent.
- (E) (A), (B), and (D).

15. In responding to a final rejection of Claims 1 to 5 as being obvious, applicant's patent agent argued that the references applied in the rejection neither taught nor suggested the claimed invention. The examiner issued a Notice of Allowance which included a statement of reasons for allowance. In the statement, the examiner explained her reasons for allowance of the claims. Upon receipt of the statement from the examiner, which of the following, if any, describes the most appropriate course of action the agent may take in reply to the examiner's reasons for allowance?

- (A) The agent may file a reply commenting on the examiner's statement, even though the failure to do so will not give rise to any implication that applicant agrees with or acquiesces in the examiner's reasoning.
- (B) The agent should object to the examiner's statement to avoid any implication that applicant agrees with or acquiesces in the examiner's reasoning.
- (C) Applicant may file comments on the reasons for allowance after payment of the issue fee upon submission of a petition for an extension of time.
- (D) Under current Office policy and procedure, the agent cannot reply to the examiner's statement.
- (E) The agent must file a timely reply to the examiner's statement to enable the examiner to reply to the comments submitted by applicant and to minimize processing delays.

16. Which of the following statements regarding plant patent applications is (are) true?

- (A) Only one claim is necessary and only one claim is permitted.
- (B) The oath or declaration required of the applicant, in addition to the averments required by 37 CFR § 1.63, must state that he or she has asexually reproduced the plant.
- (C) A method claim in a plant patent application is improper.
- (D) Specimens of the plant variety, its flower or fruit, should not be submitted unless specifically called for by the examiner.
- (E) All of the above.

17. The last day of a three month shortened statutory period to reply to a non-final rejection occurs today, April 21, 1999. Your client is overseas and sends you a facsimile asking you to cancel all of the current claims in the application. There is no deposit account. She further advises you that a new set of claims to replace the current claims will be sent to you no later than April 29, 1999. Which of the following would be the most appropriate course of action to take with regard to the outstanding Office action?

- (A) File a request for a one month extension of time today and pay the fee when you file the amendment.
- (B) File an amendment today canceling all claims in accordance with your client's instructions.
- (C) Await receipt of the new claims and then file the amendment and request for reconsideration with the appropriate fee for an extension of time, no more than 6 months from the date of the non-final rejection.
- (D) File a request for reconsideration today and state that a supplemental amendment will be forthcoming.
- (E) File a request for reconsideration today, stating that the rejection is in error because the claims define a patentable invention.

18. Which of the following statements is true respecting product-by-process claims?

- (A) 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 a product is claimed in the conventional fashion.
- (B) It is proper to use product-by-process claims only when the process is patentable.
- (C) It is proper to use product-by-process claims only when the product is incapable of description in the conventional fashion.
- (D) Product-by-process claims cannot vary in scope from each other.
- (E) Product-by-process claims may only be used in chemical cases.

19. Patent applicant Smith claims “a rotary vane pump having impellers coated with ceramic X for the purpose of preventing cavitation of the impellers.” The examiner rejected the claim under 35 U.S.C. § 103 as being unpatentable over a patent to John in view of a patent to Alex. John teaches a rotary vane pump having impellers coated with epoxy resin for the purpose of preventing corrosion of the impellers. Alex teaches a mixing device having agitator blades coated with ceramic X for the purpose of preventing corrosion of the blades. Alex also suggests that the ceramic X coating material “is useful on various types of pumps for the purpose of preventing corrosion.” The examiner determined that (i) it would have been obvious to one having ordinary skill in the art to substitute the ceramic X coating material taught by Alex for the epoxy resin coating material in John and (ii) the resultant rotary vane pump would have coated impeller blades which would inherently prevent cavitation. The combination of John and Alex:

- (A) cannot support a *prima facie* case for obviousness unless the Alex reference contains a suggestion that ceramic X will cause cavitation.
- (B) cannot support a *prima facie* case for obviousness inasmuch as the discovery that ceramic X prevents cavitation imparts patentability to a known composition.
- (C) may support a *prima facie* case for obviousness even though the Alex reference does not disclose that ceramic X will prevent cavitation or can be used on the impellers of a rotary vane pump.
- (D) cannot shift the burden of proof to the applicant to show that the prior invention lacked the newly discovered property asserted for the claimed invention unless one of the references discloses the property.
- (E) can support a *prima facie* case for obviousness only if both references show or suggest that ceramic X can be used in a rotary vane pump.

20. Claim 1 is independent. Claim 2 depends from Claim 1. Claim 3 depends from Claim 2. Claim 4 depends from Claims 2 or 3. Claim 5 depends from Claim 3. Claim 6 depends from Claims 2, 3 or 5. The application contains one independent claim. How many dependent claims are there for fee calculation purposes?

- (A) 5
- (B) 7
- (C) 8
- (D) 9
- (E) 11

Answer questions 21 and 22 based on the following facts:

Registered patent practitioner P prepares and files a patent application for his Japanese client, XYZ Corp., on October 5, 1998. The application claims a banana peeler device. A Notice to File Missing Parts dated December 7, 1998, is received by P on December 10, 1998. P submits an executed oath, along with the surcharge, in order to fully reply to the Notice to File Missing Parts which is received by the PTO on December 23, 1998. In the first Office action dated January 6, 1999, the examiner rejects all of claims 1-5 as being anticipated by the disclosure of a U.S. patent to Apple. The Apple patent discloses, but does not claim, a banana peeler. The Apple patent issued October 7, 1997, and is based on an application filed on June 26, 1996. On January 20, 1999, P faxes a copy of the Office action and the Apple patent to his client in Japan. There is no common ownership between the prior art patent and XYZ's patent application. On March 20, 1999, XYZ faxed instructions to P which distinguish the claims from the Apple patent and includes a reference to a U.S. patent to Zucchini. XYZ discovered the Zucchini patent in February 1999. The Zucchini patent issued on January 12, 1993, and contradicts the teachings of the Apple patent.

21. On March 20, 1999, XYZ instructs P to file an Information Disclosure Statement (IDS) which includes the Zucchini patent, ten Japanese patents, and a November 13, 1998, magazine article. The magazine article and the ten patents were received from the Japanese Patent Office in XYZ's counterpart foreign application on February 1, 1999. Which of the following actions, if any, taken by P would best comply with PTO practice and procedure?

- (A) File a properly drafted IDS via "Express Mail" in accord with 37 CFR § 1.10 on March 30, 1999, with the fee set forth in 37 CFR § 1.17(p).
- (B) File a properly drafted IDS via first class mail with a Certificate of Mailing dated March 30, 1999, with the required fee and a statement that each item of information was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the IDS.
- (C) File a properly drafted IDS via facsimile with a Certificate of Transmission on March 23, 1999, along with a legible copy of each reference.
- (D) (B) and (C).
- (E) None of the above.

22. Which of the following most correctly sets forth the sections of Title 35 U.S.C. under which XYZ **would not be entitled** to a U.S. patent based on the Apple patent?

- (A) 102(a)
- (B) 102(c)
- (C) 102(d)
- (D) 102(f)
- (E) 102(g)

23. In a first action on the merits dated February 12, 1997, the examiner (1) rejected all of the claims under 35 U.S.C. § 112, second paragraph; (2) objected to new matter added to the specification by a preliminary amendment; and (3) required a substitute specification that includes a revised summary of invention, abstract, and an additional drawing showing the prior art. You, as a patent practitioner prosecuting the application, disagree with the propriety of the rejection, objection and requirement. Which of the following would be the most appropriate course of action to take to reply to the examiner's action?

- (A) File a petition with the Group Director requesting withdrawal of the examiner's objection to the specification, and suspension of further action on the claims until three months after the petition has been decided.
- (B) File a request for reconsideration and present arguments distinctly and specifically pointing out the supposed errors in the examiner's requirement, rejection, and objection, and otherwise fully reply to the rejection and objection.
- (C) Appeal the objection and requirement of the examiner to the Board of Patent Appeals and Interferences, and request that the final rejection of the claims be suspended until the appeal is decided.
- (D) Amend the claims to overcome the examiner's rejection under 35 U.S.C § 112, and file a motion to the Board of Patent Appeals and Interferences appealing the examiner's objection to the specification.
- (E) Change the summary of invention to conform to the broadest claim, request reconsideration of the requirement for a substitute specification, request that the requirement for submission of the additional drawings be held in abeyance until after allowance of the application, and generally allege that the claims define a patentable invention.

24. Which of the following statements correctly sets forth the manner in which Inventor Ann, a U.S. citizen, may file documents regarding her international patent application with the United States Receiving Office?

- ✦ (A) Where the document is the PCT international application and Ann needs to receive an April 1, 1999, filing date, Ann should file her PCT international application via first class mail with the United States Post Office and include a Certificate of Mailing dated April 1, 1999.
- (B) Where the document is a Demand for international preliminary examination, two weeks before the deadline, Ann should file her Demand by facsimile transmission with a dated Certificate of Transmission.
- (C) Where the document is the PCT international application and Ann needs to receive an April 12, 1999, filing date, Ann should file a copy of her international application via facsimile transmission with a Certificate of Transmission dated April 12, 1999.
- (D) Where the documents are substituted drawing sheets due on April 15, 1999, Ann should file her substitute drawing sheets via facsimile on April 15, 1999.
- (E) All of the above.

25. A multiple dependent claim _____

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

26. A design patent application was filed on July 5, 1995, which issued as a design patent on December 3, 1996. On December 16, 1996, a proper reissue design application was filed. The reissue patent was granted on September 2, 1997. When will the first maintenance fee be due?

- (A) December 2, 2000
- (B) December 16, 1999
- (C) December 3, 1999
- (D) March 3, 2000
- (E) None of the above

27. After one of your client's claims has been allowed, another claim in the same application stands objected to as being a substantial duplicate of the allowed claim, i.e. they both cover the same thing. You and your client agree that the claim is a substantial duplicate. Which of the following could **NOT** overcome the objection?

- (A) Amending the claim objected to in a manner consistent with the specification to have a different scope.
- (B) Amending the allowed claim consistent with the specification to have a different scope.
- (C) Canceling the allowed claim to obviate the objection.
- (D) Filing a divisional application that includes the objected claim.
- (E) Canceling the claim objected to so as to permit issuance of the allowed claim.

28. Which of the following statements regarding reissue applications is **false**?

- (A) If the file record is silent as to the existence of an assignee, it will be presumed that an assignee does exist.
- (B) An examination on the merits of a reissue application will not be made without an offer to surrender the original patent, the actual surrender, or an affidavit or declaration to the effect that the original is lost or inaccessible.
- (C) A broadened claim can be presented after two years from the grant in a broadening reissue which was filed within two years from the grant.
- (D) The filing of a continued prosecution application (CPA) under 37 CFR § 1.53(d) of a reissue application will not be announced in the *Official Gazette*.
- (E) When making amendments to the claims, patent claims must not be renumbered and the numbering of any claims added to the patent must follow the number of the highest numbered patent claim.

29. Employees Larry and Curly work for Taylor, Inc., each with knowledge of the other's work, and with obligations to assign to Taylor inventions conceived while employed by Taylor. Larry invented a novel coating apparatus which utilized a spring released mechanism that worked well at temperatures of at least 32° F. Larry discussed his invention with Curly during work at Taylor. After their discussion, Curly conceived of an improvement and developed a piston activated mechanism for use in Larry's novel coating apparatus. Curly's piston activated mechanism worked extremely well at temperatures between 45 to 60° F. On April 8, 1997, Curly filed a patent application in the PTO disclosing the fact that Larry invented a novel coating apparatus and claiming an improved coating apparatus with a piston activated mechanism. Curly's specification disclosed the excellent results obtained when the piston activated mechanism was used at temperatures between 45 to 60° F. On August 14, 1997, Larry's application claiming the coating apparatus with the spring released mechanism for use at temperatures of at least 32° F. was filed in the PTO. On December 29, 1998, a patent was granted to Larry. In an Office action dated March 18, 1999, the examiner rejected the claims in Curly's application under 35 U.S.C. §§ 102(g)/103 over Larry's patent in view of a patent granted to Moe on August 25, 1992. Larry's patent claims the coating apparatus with the spring released mechanism for operation at temperatures of at least 32° F. The patent to Moe discloses a piston activated mechanism (substantially similar to Curly's piston activated mechanism) in combination with a different coating apparatus. The Moe patent also discloses that the piston activated mechanism would only operate at temperatures below 32° F. The examiner properly found that substitution of the piston activated mechanism of Moe for the spring released mechanism in Larry's coating apparatus would have been obvious. As a registered practitioner hired by Taylor to prosecute both the Larry and Curly applications, which of the following best describes the course of action you should take to provide Taylor with all the patent protection it is entitled to receive?

- (A) Traverse the rejection by arguing that the rejection is improper, and in support thereof, submit an affidavit under 37 CFR § 1.132 signed by an officer of Taylor, Inc. attesting to the fact that at the time the inventions were made, Larry and Curly were obligated to assign their inventions to Taylor, Inc.
- (B) Traverse the rejection by arguing that the rejection is improper and provide an affidavit signed by Larry stating that Curly derived his work from Larry and that both Curly and Larry were under an obligation to assign their inventions to Taylor.
- (C) Traverse the rejection and submit an affidavit signed by Curly under 37 CFR § 1.131 stating that he made his invention in the United States before Larry filed his patent application and that both Larry and Curly were obligated to assign their inventions to Taylor, Inc. at the time the inventions were made.

- (D) Amend the Curly application to claim only a piston activated mechanism which operates at temperatures between 45 - 60° F., and delete the coating apparatus from the claims.
- (E) File a terminal disclaimer to have any patent granted on Curly's application expire on the same date the Larry patent expires.

Questions 30 and 31 are based on the following facts. Each question should be answered independently of the other.

Horatio invented a new widget for vacuum cleaners. You prepared and filed a patent application containing claims 1 through 10 directed to the widget. In a second Office action dated September 10, 1998, the examiner rejected claims 1 through 10 for the second time and on the same grounds and set a three month shortened statutory period for reply. You filed a reply to the second Office action on December 9, 1998. On January 8, 1999, the examiner sent another Office action containing a final rejection of claims 1 through 10 and set a three month shortened statutory period for reply.

30. Horatio asked you to file a Notice of Appeal. In which of the following situations, would the Notice of Appeal be considered **acceptable**?

- (A) A Notice of Appeal signed by you, and the appropriate appeal fee are filed on April 8, 1999. The Notice does not identify the rejected claims appealed.
- (B) A unsigned Notice of Appeal and the appropriate appeal fee is filed on April 8, 1999, and the Notice identifies the rejected claims appealed.
- (C) A Notice of Appeal, signed by you, with the necessary fee for appeal and extension of time, are filed on July 8, 1999, without identifying the rejected claims appealed.
- (D) (A) and (B).
- (E) (A), (B), and (C).

31. An acceptable Notice of Appeal is timely filed in the PTO on March 23, 1999. Absent extraordinary circumstances, which of the following is the **last day** that an appeal brief can be filed if a proper petition and the necessary fees for the brief and extension of time are filed with the brief?

- (A) April 8, 1999
- (B) Monday, October 25, 1999
- (C) August 23, 1999
- (D) Monday, May 24, 1999
- (E) September 23, 1999

32. On a sunny January day in Minnesota, neighbors X and Y working together stumble across a novel means for melting snow with a device that X and Y have jointly invented. Being low on funds to market their invention, X and Y decide to save money and file their own patent application. X and Y decide to file a provisional patent application in order to have more time to market their invention. X and Y carefully prepare all the necessary papers for the filing of their provisional patent application and come up with the money to cover the filing fee. On Saturday, January 9, 1999, X and Y meet at their favorite coffee shop to take a final look at the specification and drawings they had prepared and to prepare a cover letter to accompany their application. In their eagerness to get to the Post Office after drinking two double mocha cappuccinos, the handwritten cover letter prepared by X and Y fails to identify X as an inventor. The cover letter only identifies the application as a provisional patent application; inventor Y's full name, residence and correspondence address; and the title of the invention. Unaware that X has not been identified as an inventor, X and Y make a copy of their application papers and mail the cover letter with the specification, drawings and the proper fee to the Patent and Trademark Office via first class mail that same morning. A huge winter storm is expected to hit Minnesota by dusk and X and Y hurry home to conduct further experiments with their snow melting invention. The papers are received in the Patent and Trademark Office on Monday, January 11, 1999.

Three weeks later, X and Y return to their favorite coffee shop to celebrate the outstanding success of their experiments with their snow melting device during the huge winter storm which hit Minnesota and to discuss the minor adjustment they made to their invention. In reviewing their application papers for the first time since they were mailed, X notices that the handwritten cover letter does not identify him as an inventor, and fails to include his residence and correspondence address. Which of the following is the best action to be taken by X and Y to correct these omissions from their handwritten cover letter in accordance with proper PTO practice and procedure?

- (A) X and Y should timely file an amendment to the provisional patent application to add X as an inventor, accompanied by a petition stating that the error occurred without deceptive intent on the part of X and the appropriate fee.
- (B) X and Y should file an amendment to their provisional patent application which describes the minor adjustment made to the snow melting device and sign the amendment naming X and Y as joint inventors.
- (C) X and Y should file a request for a certificate of correction and with an explanation of how the error occurred without deceptive intent.
- (D) X and Y should file a continuation application with a new declaration signed by X and Y.
- (E) X and Y should timely file a new cover sheet during the pendency of their provisional application which identifies both X and Y as inventors, and provides the title of the

invention, as well as the residences of X and Y and the correspondence address.

33. The claim, "An alloy consisting of 70.5 to 77.5% iron, 15.0 to 17.0% cobalt, 0.5 to 1.0% carbon, up to 2.5% chromium, and at least 7.0% tungsten" is anticipated by a reference disclosing an alloy having:

- (A) 76.0% iron, up to 15.0% cobalt, 0.5% carbon, and 8.5% tungsten.
- (B) 71% iron, 15% cobalt, 1.0% carbon, 1% chromium, 8% tungsten, and 4% nickel.
- (C) 71.3% iron, 15.2% cobalt, 0.9% carbon, 2.6% chromium, and 10% tungsten.
- (D) 76% iron, 15% cobalt, 1.0% carbon, at least 2.0% chromium, and 6% tungsten.
- (E) 72.0% iron, 16.5% cobalt, at least 2.0% carbon, 2.5% chromium, and up to 7.0% tungsten.

34. On January 6, 1999, Doe asked patent agent Bronson to prepare and file a patent application on an automobile jack which Doe had invented. Doe gave Bronson several sketches and a written description of the jack which described and showed the jack as utilizing only a scissors-type lifting mechanism. Bronson prepared a patent application disclosing the scissors-type lifting mechanism based on information provided by Doe. The claims of the patent application recited the lifting mechanism generically as "lifting means" since the specific type of lifting mechanism was not thought by Doe to be critical to the inventive feature of his jack. After Doe reviewed and signed the application, Bronson filed it in the PTO on February 3, 1999. On March 19, 1999, Doe discovered that his jack worked much better with a screw-type lifting mechanism as opposed to the scissors-type mechanism. The screw-type lifting mechanism is not disclosed in the application. Doe immediately informed Bronson of this fact. In reply to the first Office action, Bronson canceled all of the original claims and presented a new claim to the jack which included the provision of the screw-type lifting mechanism. Is the new claim proper at this stage of the prosecution?

- (A) Yes, because the claim particularly points out and distinctly claims the subject matter which Doe regards as his invention or discovery.
- (B) No, because the claim could be properly rejected under 35 U.S.C. § 112, first paragraph.
- (C) Yes, because the claim sets forth the best mode contemplated by Doe for carrying out his invention.
- (D) No, because the claim could be properly rejected under 35 U.S.C. § 132.
- (E) No, because the claim could be properly rejected under 35 U.S.C. § 112, sixth paragraph.

35. On January 7, 1998, you filed a U.S. patent application containing Claims 1 through 8 on behalf of your client, Grumpy. In a first Office action, the examiner rejected Claims 1-8 under 35 U.S.C § 103 over a U.S. patent to Happy in view of a U.S. patent to Sleepy. The Happy patent issued on January 6, 1998, based on an application filed on June 11, 1996. The Sleepy patent issued in 1950. Which of the following responses would be the most persuasive in having the rejections withdrawn?

- (A) Argue that the claimed invention is patentably distinguishable over the combination of the Happy and Sleepy patents, pointing out the specific language in the claims that is not shown by the combination of the references.
- (B) Argue that the Sleepy patent is outdated and that its teachings are so obsolete that it would no longer be read by one of ordinary skill in the art.
- (C) Argue that the claimed invention is patentably distinguishable from Sleepy, and point out the specific language in the claims that is not shown by Sleepy.
- (D) Argue that the devices disclosed by Sleepy and Happy are not physically combinable.
- (E) Argue that the Happy patent is not prior art because it was not granted more than one year before Grumpy filed his patent application.

36. The specification shall conclude with one or more claims and must set forth:

- (A) the manner of making the invention, the theory of why the invention works, and at least one working example showing how the invention works.
- (B) the manner and process of making and using the invention, a written description of the invention, and the best mode of carrying out the invention.
- (C) a description of the invention, how the invention is distinguishable over the most relevant prior art, and the best mode of carrying out the invention.
- (D) only a full, clear, and concise description of the invention.
- (E) a complete description of the invention, and how to use the invention so that a person having ordinary skill in the art to which the invention pertains would be able to practice the invention.

37. Which of the following statements, if any, is true?

- (A) A claim for a "soap composition comprising a maximum of 0.2 parts by weight of X per part by weight of Y" is anticipated by a soap composition disclosed in a publication as having 5 parts by weight of X per part weight of Y.
- (B) A claim for "a laminate circuit material comprising a sheet of adhesive film, and a sheet of conductive material disposed on said sheet of adhesive film" is **not** anticipated by an article of manufacture consisting of an adhesive film disposed on one surface of a sheet of conductive material and a glass reinforced adhesive film disposed on the opposite surface of said sheet of conductive material."
- (C) An independent Claim 1 for an "article comprising a widget having a coating from 0.05 to 1 mm thickness," and a dependent Claim 2 for "an article according to Claim 1 wherein the coating is 0.3 mm thick," both are anticipated by "a widget having a coating of 0.5 mm thickness" described in a printed publication.
- (D) A claim for a "nickel alloy comprising nickel, chromium, iron and at least one member selected from the group consisting of copper, silver and tin" is anticipated by a printed publication which discloses "an alloy consisting of nickel, silver, chromium, iron, copper, and cobalt."
- (E) None of the above.

38. On Monday, April 5, 1999, an Office action was mailed to practitioner P. The Office action contained a rejection of all claims in the application and set a three month shortened statutory period for reply. The very last day for filing a reply without requesting an extension of time would be _____.

- (A) July 2, 1999
- (B) July 3, 1999
- (C) July 5, 1999
- (D) July 6, 1999
- (E) August 3, 1999

39. Jones invented a widget. She disclosed to her patent agent that the widget can be any combination of colors, the most preferred embodiment being a widget having a blue, orange, yellow or purple color. The agent prepared a patent application which disclosed a widget having a blue, orange or purple color and which included the following claim: "1. A widget having a blue, orange or purple color." On January 8, 1999, Jones reviewed the application and signed the oath. Just after Jones left the agent's office, the agent remembered that Jones had also disclosed to him a yellow widget. The attorney immediately prepared a preliminary amendment which included instructions to amend the specification to also include a yellow widget and to rewrite Claim 1 as follows: "A widget having a blue, orange, yellow or purple color." The specification, oath, and the amendment were mailed to the PTO in the same envelope and were received in the PTO on January 12, 1999. Given these facts, which one of the following statements is true?

- (A) Claim 1 cannot be properly rejected under 35 U.S.C. § 102(a) as being anticipated by a patent to Smith which was filed on March 2, 1997, and issued on August 13, 1998, and which discloses but does not claim, a widget having an orange color.
- (B) Claim 1 can be considered to contain new matter even though the preliminary amendment was filed concurrently with the filing of the specification.
- (C) Claim 1 can be properly rejected under 35 U.S.C. § 112, second paragraph, because the use of the word "or" renders the metes and bounds of the claim indeterminate.
- (D) Claim 1 can be properly rejected on the ground of disclaimer.
- (E) None of the above statements is true.

40. In order to calculate when an appeal brief must be filed, which of the following documents should be used to establish the date that a Notice of Appeal was filed?

- (A) A separate letter sent from the Patent and Trademark Office which acknowledges receipt of your Notice of Appeal.
- (B) A self-addressed postcard included with the filing of your Notice of Appeal which was date stamped and returned to you.
- (C) A copy of the Certificate of Mailing you signed which states the date you deposited the Notice of Appeal via first class mail.
- (D) (A), (B), and (C).
- (E) (B) and (C).

41. Which of the following choices would be considered as independent grounds for filing a reissue application?

- (I) The claims are too narrow or too broad.
- (II) The disclosure contains inaccuracies.
- (III) Applicant failed to or incorrectly claimed foreign priority.
- (IV) The specification contains a plurality of obvious spelling and grammatical errors.
- (V) Applicant failed to make reference to or incorrectly made reference to prior copending applications.

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

42. On April 19, 1999, Inventor Mary hires you for advice on a patent application. Mary informs you that she previously filed a provisional application for her invention on May 1, 1998. However, Mary has since made some improvements that were not described in her provisional application. To fully protect Mary's patent rights, what is the best course of action to recommend to Mary?

- (A) File an amendment in the provisional application on or before May 1, 1999, which describes the improvements made by Mary.
- (B) Immediately file a continued prosecution application based on the provisional application filed on May 1, 1998, and include a preliminary amendment which adds a description of the improvements made.
- (C) File a second provisional patent application which claims the benefit of the May 1, 1998, filing date of the first provisional patent application.
- (D) File a continuation-in-part application as soon as possible which adds a disclosure of the improvements made.
- (E) None of the above.

43. A U.S. patent application to AuGratin, a French national, was filed in the U.S. Patent and Trademark Office on August 10, 1997. The application disclosed and claimed an apparatus having a combination of elements A, B, and C. AuGratin filed a claim for priority in his U.S. application based upon an application which he filed in the French Patent Office on September 16, 1996. AuGratin's U.S. patent application as filed is an exact English translation of his French application. AuGratin's French application was issued and published as French Patent No. 1,234,567 on March 20, 1998. On April 12, 1999, AuGratin filed a continuation-in-part application (CIP) containing disclosure of new element D in the apparatus. The CIP application included new claims to an apparatus comprising a new combination of elements A, B, C, and D. The examiner properly rejected the new claims in the CIP application as being obvious over AuGratin's French Patent No. 1,234,567 in view of a U.S. patent to Baker which clearly suggests modifying AuGratin's apparatus by adding element D to the combination of elements A, B, and C. The rejection is a *prima facie* case of obviousness. Can AuGratin's French patent be removed as a reference?

- (A) Yes, because AuGratin can swear behind French Patent No. 1,234,567 since the publication date of AuGratin's French patent is less than one year prior to AuGratin's August 10, 1997, U.S. filing date.
- (B) Yes, because the claims in the parent application are supported in the CIP application.
- (C) No, because the new claims in the CIP are not entitled to the benefit of the filing date of the parent application since the combination of elements A, B, C, and D is not supported in the parent application.
- (D) Yes, because AuGratin's French patent cannot be used as prior art in view of the claim for priority in the parent application.
- (E) No, because the new claims are not supported in the CIP application.

44. A Customer Number in the USPTO may be used to do which of the following?

- (A) Designate the fee address of a patent.
- (B) Designate the correspondence address of a patent application.
- (C) Serve as the Deposit Account Number to pay an extension of time fee.
- (D) Submit a list of practitioners so that an applicant may in a Power of Attorney appoint those practitioners associated with the Customer Number.
- (E) (A), (B), and (D).

45. Where a flat board and parallel legs are separate elements which are intended to be included in a claim to the combination of the flat board and legs, the combination is properly set forth in which of the following claims?

- (A) A table having a flat board and parallel legs secured to the flat board.
- (B) A table having a flat board capable of being connected to parallel legs.
- (C) A table having a flat board and means for securing parallel legs to the flat board.
- (D) A table having a flat board with means whereby parallel legs can be secured to the flat board.
- (E) A table having a flat board for receiving parallel legs.

46. Which of the following statements regarding design patent applications is (are) false?

- (A) The use of trademarks in design patent application specifications is permitted under limited circumstances.
- (B) It is improper to use a trademark alone or coupled with the word "type" in the title of a design patent.
- (C) A design patent and a trademark may be obtained on the same subject matter.
- (D) It is the policy of the Patent and Trademark Office to prohibit the inclusion of a copyright notice in a design patent application.
- (E) (A) and (B).

47. Which of the following statements concerning the confidentiality of patent applications before the Patent and Trademark Office is true?

- (A) All documents filed as part of the Disclosure Document Program are open to the public two years after filing.
- (B) All reissue applications are open to the public.
- (C) Copies of any document contained in the application file for which the United States acted as the International Preliminary Examining Authority will be furnished in accordance with Patent Cooperation Treaty (PCT) Rule 94.2 or 94.3 upon payment of the appropriate fee.
- (D) (B) and (C).
- (E) (A) and (B).

48. Apple's claims have been properly rejected under 35 U.S.C. § 102(e) as being anticipated by Carrot. The rejection is based upon the disclosed, but unclaimed, subject matter in the Carrot patent. The Carrot patent issued six months after the filing date of Apple's application. The unclaimed subject matter in the Carrot patent was not invented by Carrot, but rather was disclosed to Carrot by Apple. Carrot's claimed invention is patentably distinct from Apple's claimed invention. The proper reply to obviate this rejection would be to:

- (A) Copy the claims in the Carrot patent to provoke an interference.
- (B) File an affidavit by Carrot establishing that Carrot derived his knowledge of the relevant subject matter from Apple.
- (C) Argue that the Carrot patent is not prior art because the patent did not issue before Apple filed his application.
- (D) File a terminal disclaimer signed by Apple.
- (E) File a terminal disclaimer signed by Carrot.

49. In which of the following situations does the prohibition against double patenting rejections under 35 U.S.C. § 121 **not** apply?

- (A) The applicant voluntarily files two or more cases without a restriction requirement by the examiner.
- (B) The requirement for restriction was only made in an international application by the International Searching Authority or the International Preliminary Examining Authority.
- (C) The requirement for restriction was withdrawn by the examiner before the patent issues.
- (D) The claims of the second application are drawn to the "same invention" as the first application or patent.
- (E) All of the above.

50. A patent application is filed with 10 claims. Claims 1, 2, and 3 are independent claims directed to a product. Claim 4 is an independent claim directed to a process for making the product. Which of the following would be acceptable form for a dependent Claim 5?

- (A) A product as in claims 1-3, wherein ...
- (B) A product as claimed in claims 1, 2, and 3, wherein ...
- (C) A product as in claim 1, made by the process of claim 4.
- (D) A product as claimed in any one of claims 1, 2, or 3 wherein ...
- (E) A product as claimed in claim 6 or claim 7, wherein ...

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

NOVEMBER 3, 1999

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

1. Abigail has invented a novel watering mechanism for a flower pot. The flower pot also possesses a unique ornamental design. Abigail consults with patent practitioner P for advice on the differences between a design patent and a utility patent. Which of the following general statements regarding design and utility patents, if made by P, would be accurate?

- (A) A “utility patent” protects the way an article is used and works, while a “design patent” protects the way an article looks.
- (B) Unlike utility patent applications, a design patent application may not make a claim for priority of a provisional patent application.
- (C) Maintenance fees are required for utility patents, while no maintenance fees are required for design patents.
- (D) Both design and utility patents may be obtained on an article if the invention resides both in its utility and ornamental appearance.
- (E) All of the above.

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

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

3. What would **not** be permitted to be incorporated by reference in your client’s U.S. utility patent application?

- (A) Essential material from a U.S. patent.
- (B) Essential material from a foreign application.
- (C) Non-essential material from a prior filed, commonly owned U.S. application.
- (D) Essential material from a magazine article.
- (E) (B) and (D).

4. Beverly is a research chemist. While cleaning a clogged shower drain she recovers several ounces of goop from the drain. She analyzes the ingredients and properties, and finds that the goop makes a highly effective industrial lubricant. She comes to you for help in preparing and filing an application. She informs you that the goop is formed from equal parts of chemicals W, X, Y and Z. She knows that chemical W comes from the soap she uses and that chemicals Y and Z are components of the conditioner she uses on her hair. Her soap uses the tradename “Acme SmellNice”, and her shampoo and conditioner both use the tradename “A-1 Silky.” Chemicals W, Y and Z are all readily available on the commercial market. Chemical X is also a common, readily available chemical, but she cannot determine how it got in the shower drain. She suspects it is the result of a reaction between A-1 Silky shampoo and Acme SmellNice soap that occurs when the two are mixed in the presence of hot water. You prepare an application describing a prophetic example setting forth one way to make the goop from commercially available chemicals and a working example describing (as well as the inventor can) how the goop is formed in the bathroom drain. The working example describes mixing of A-1 Silky shampoo and Acme SmellNice soap in the presence of water having a temperature of at least 100°F to form chemical X. Because you know that the ingredients for at least Acme SmellNice soap have recently changed, but the nature of the change is unknown, you list every ingredient of A-1 Silky shampoo, and Acme SmellNice soap in positive language so there will be no confusion as to what is meant. The application includes the following claims:

- Claim 1. An industrial lubricant consisting essentially of equal parts of chemical W, chemical X, chemical Y and chemical Z.
- Claim 2. The industrial lubricant of Claim 1, wherein said chemical X is formed by mixing A-1 Silky shampoo and Acme SmellNice soap in the presence of water having a temperature of at least 100°F.

Which of the following statements is/are correct?

- (A) Claim 1 cannot be supported by an enabling specification because Beverly does not fully understand the processes that occurred in the drain, and a prophetic example alone is never sufficient to enable a claim.
- (B) Claim 2 is not patentable because it sets forth an incorrect theory of formation of chemical X.
- (C) Claim 1 is not patentable because Beverly merely found the goop in her drain and did not formulate it herself.
- (D) Claim 2 is not patentable because it is indefinite.
- (E) (B) and (D).

5. Jack, a registered patent agent, received a final rejection of all of the claims in an application directed to an article of manufacture. Jack is about to file a timely Notice of Appeal to the Board of Patent Appeals and Interferences. Before filing his notice of appeal, Jack would like to tie up some loose ends by amendment. Which of the following reply(replyes) may he file without triggering the requirements of 37 CFR § 1.116(b)?

- (A) A reply that presents his argument in a more defensible light and adds additional claims.
- (B) A reply amending the claims into process claims.
- (C) A reply amending all of the independent claims, accompanied by a declaration from the inventor.
- (D) A reply complying with a requirement of form expressly set forth in the previous Office action.
- (E) (A) and (D).

6. You are preparing a patent application for filing in the PTO. The application contains the following partial claim:

A walking device comprising:

- (i) a vertical member having opposing top and bottom portions;
- (ii) a handle connected to the top portion of the vertical member forming a 45E angle with the top portion of the vertical member;
- (iii)
- (iv) a set of non-skid covers for the set of legs, said set of legs being aluminum.

Following proper PTO practices and procedures, which of the following claim limitations best completes the claim by providing the missing limitation (iii)?

- (A) a horizontal member, substantially round in shape, having opposing sides connected along one of the opposing sides to the bottom side of the vertical member and along the other of the opposing sides to a set of legs; and
- (B) a horizontal member, substantially round in shape, having first and second opposing sides connected along the first opposing side to the bottom side of the vertical member and along the second opposing side to a set of legs; and
- (C) a horizontal member, substantially round in shape, connected to the bottom portion of the vertical member; and
- (D) a horizontal member, substantially round in shape, having opposing top and bottom portions; the top portion of the horizontal member is connected to the bottom portion of the vertical member, and the bottom portion long the bottom portion of the vertical member is connected to a set of legs; and
- (E) a horizontal member, substantially round in shape, having a top side connected to the bottom side of the vertical member and a bottom side connected to the set of legs; and

7. Which of the following statements, regarding amendments filed after final rejection in a timely manner, is correct?

- (A) Amendments touching upon the merits of the application presented after final rejection shall be entered upon payment of the proper fee and a showing of good and sufficient reasons why they are necessary and were not earlier presented.
- (B) An amendment filed after final rejection is entitled to entry if it amends only the claims that were finally rejected.
- (C) Amendments after final rejection may be made canceling claims or complying with any requirement of form expressly set forth in the final Office action.
- (D) An amendment after final rejections is entitled to entry if it cancels claims and adds new claims that clearly set forth a previously unclaimed embodiment of the invention.
- (E) Applicant cannot make any further amendments after final rejection, but may submit remarks and a notice of appeal.

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

- (A) An amendment to the specification changing the definition of “holder” from “is a hook” to “is a hook, clasp, crimp, or tong” and no amendment is made of the claim, which uses the term “holder.” The amendment is filed one month after the application was filed. There was no previous supporting disclosure in the specification of the holder being a clasp, crimp, or tong.
- (B) An amendment to the specification and claims changing the definition of “holder” from “is a hook” to “is a hook, clasp, crimp, or tong.” The amendment is filed one month after the application was filed. There was no previous supporting disclosure in the specification of the holder being a clasp, crimp, or tong.
- (C) Original claim 1 in the application refers to “a holder,” and original claim 2 depends from and refers to claim 1 stating, “said holder is a hook, clasp, crimp, or tong.” There is no disclosure in the specification preceding the claims in the application as filed for the holder to be a clasp, crimp, or tong.
- (D) An amendment is filed presenting a claim to an electrical insulating device, copied from a patent for the purpose of provoking an interference. The claim refers to “nonconductive plastic holder.” The application as filed contains a broad generic disclosure describing electrical insulating devices. The holder is described in the specification of the application as “conducting electricity.” There is no disclosure in the specification of the holder being “nonconductive.”
- (E) All of the above.

9. An application as originally filed contains the following Claim 1:

Claim 1. A doughnut making machine comprising:

- (i) an input conveyor that receives dough to be used in making said doughnuts;
- (ii) portioning means for portioning dough from said input conveyor into a plurality of dough balls, each of said plurality of balls containing dough sufficient to create a single doughnut;
- (iii) forming means for forming each of said dough balls into a ring of dough;
- (iv) a deep fat fryer which receives rings of dough from said forming means and cooks said rings of dough;
- (v) applying means for selectively applying a flavored coating on cooked rings of dough to produce doughnuts; and
- (vi) placing means for placing a plurality of said doughnuts on a flat sheet.

The specification adequately describes the claimed subject matter. Two different “means for selectively applying” are described in the specification: a sprayer and a brush. Which of the following original claims is an improper dependent claim?

- (A) 2. The doughnut making machine of Claim 1, wherein said placing means is a conveyor that extends from said applying means to said flat sheet.
- (B) 3. The doughnut making machine of Claim 1, wherein said forming means includes a cutter that removes a center portion of each of said dough balls to form a ring of dough.
- (C) 4. The doughnut making machine of Claim 1, wherein said applying means is omitted for making plain doughnuts.
- (D) 5. The doughnut making machine of Claim 1, wherein said applying means includes a sprayer which receives a sugar based flavored coating, wherein said sugar based flavored coating is sprayed on said cooked rings of dough.
- (E) 6. The doughnut making machine of Claim 1, wherein said applying means is a sprayer.

10. Which of the following dependent claims, each occurring in different patent applications, is in a proper claim format?

- (A) Claim 4. The process of claim 5, further characterized by...
- (B) Claim 2. The process of claim 1 or claim 5, further comprising...
- (C) Claim 6. The widget as in claims 1, 2 or 3, further including...
- (D) Claim 3. The widget as in the preceding claims, further containing...
- (E) Claim 5. The process as in claims 1-2 or 3, further comprising...

11. In August 1999, a recently registered patent agent, who is not an attorney, asked a registered patent attorney to help the agent establish a practice. Considering the additional facts in the following choices separately, which choice best comports with the professional responsibilities of both the agent and the attorney?

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

12. On February 12, 1999, you filed a patent application containing two independent claims, Claims 1 and 2, directed to methods of forming an integrated circuit device. The applicant conceived the methods in Jacksonville, Florida on June 10, 1997. Commencing on June 10, 1997, the applicant exercised due diligence until she reduced the methods to practice on February 27, 1998. In an Office action dated August 18, 1999, the examiner rejected Claim 1 as being anticipated by Doppler under 35 U.S.C. § 102(b). Doppler is a French patent that was filed on July 18, 1996, and issued on January 13, 1998. The Doppler patent claims the method of the applicant's Claim 1 for forming integrated circuit devices. Claim 2 was rejected as being anticipated by Spot under 35 U.S.C. § 102(e). Spot is a U.S. patent that was filed on January 7, 1998, and discloses, but does not claim, the method of applicant's Claim 2 for forming an integrated circuit device. The Spot patent issued on May 5, 1999. Which of the following would be the most proper course of action to take to respond to the rejections?

- (A) File an antedating affidavit to overcome the rejection of Claim 1 and cancel Claim 2.
- (B) File an antedating affidavit to overcome both the rejections and request that an interference be declared with the Doppler patent.
- (C) File an antedating affidavit to overcome the rejection of Claim 2 and cancel Claim 1.
- (D) File a reply arguing that the rejections are improper because the Spot patent issued after the filing date of your client's application.
- (E) File an antedating affidavit to overcome both rejections.

13. Able files a patent application in 1999 disclosing a barstool having a rectangular molded plastic seat portion supported by four adjacent vertical tubular steel legs connected to the underside of the seat portion. A set of four horizontal tubular steel support members connects adjacent tubular steel legs to brace the legs. The barstool further includes a plastic back member connected to the topside of the plastic seat portion. The application states that wood could be used in place of tubular steel for the legs and horizontal support members. No alternative to plastic is mentioned in the application for use in the seat portion, but it is well known in the art that plastic and wood are interchangeable. As originally filed, Baker's application included the following Claim 1:

- Claim 1. A barstool comprising:
- (i) a rectangular seat portion having four vertical edges, an underside and a topside;
 - (ii) means for supporting said seat portion such that said underside is substantially horizontal; and
 - (ii) a back member connected to one of the vertical edges of said seat portion, said back member being substantially perpendicular to the topside of said seat portion.

The Examiner rejects the claim under 35 U.S.C. § 102 as being anticipated by a 1997 publication by Baker showing a three-legged wooden barstool with a rectangular seat, a back and arms. The Examiner cites, but does not apply against Claim 1, a 1996 patent to Charlie that discloses a four-legged wooden barstool with a round wooden seat. The Charlie patent states that in barstools the use of plastic and/or tubular steel is equivalent to the use of wood. Able responds to the rejection by amending his claim to require that the seat portion be formed of plastic, and by arguing that Baker does not disclose the recited "supporting means" because Baker utilizes only three legs, which is less stable than four legs. The examiner finds a 1980 Wilson patent that structurally equates three legged barstools to four-legged barstools. Which of the following is in accordance with proper PTO practices and procedures?

- (A) The anticipation rejection is withdrawn only because Baker does not disclose a plastic seat portion. An obviousness rejection is then made based on Baker in view of Charlie since Charlie suggests replacing a wood seat with a plastic seat. Able's argument concerning the recited "supporting means" of Claim 1 does not provide a basis for overcoming the anticipation rejection.
- (B) The anticipation rejection should be withdrawn because Baker does not disclose a plastic seat portion and because Baker does not disclose a four legged supporting means. An obviousness rejection is then made based on Baker in view of Charlie because Charlie suggests modifying Baker to utilize a plastic seat and four legs.
- (C) The anticipation rejection is maintained because one of ordinary skill in the art would understand that a plastic seat could readily replace a wood seat. Furthermore, Able's argument that the "supporting means" of Claim 1 is not disclosed because Baker utilizes only three legs is unsupported by any limitation in the Claim.
- (D) The anticipation rejection is withdrawn because Baker does not disclose a plastic seat. However, a rejection is made under 35 USC §112, paragraph 1 as being

based upon an inadequate disclosure because the specification does not specify that the use of a plastic seat is critical to the invention.

- (E) (B) and (D).

14. A patent application filed in the PTO contains the following original claim:

Claim 1. A talbecloth for protecting the finish of a table comprising:
a layer of cotton;
a layer of vinyl affixed to the layer of cotton; and
a backing of felt.

Which of the following amendment(s) is/are not in accord with proper PTO amendment practices and procedures?

- (A) In claim 1, line 3, add -with an epoxy resin-.
(B) In claim 1, line 2, after "cotton" add -woven to have 250 threads per inch-.
(C) In claim 1, line 3, before "layer" add -thin-.
(D) In claim 1, line 1, correct the spelling of "talbecloth" please.
(E) All of the above.

15. You draft a patent application disclosing and describing an electrical chronometer containing a resistor having a resistance of 20-90 ohms, preferably 40 ohms. You draft the following independent claim:

1. An electrical chronometer comprising a resistor with a resistance of 20-90 ohms.

Which of the following 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 electrical chronometer of Claim 1 wherein the resistor has a resistance of 40 ohms.
(B) 2. An electrical chronometer as in Claim 1 wherein the resistor has a resistance of 40-90 ohms.
(C) 2. An electrical chronometer as in Claim 1 wherein the resistor has a resistance of about 20 - 90 ohms.
(D) 2. The electrical chronometer of Claim 1 wherein the resistor has a resistance of between 50 and 90 ohms.
(E) (C) and (D).

16. When does jurisdiction over an application normally transfer from the examining group to the Board of Patent Appeals and Interferences?

- (A) After the examiner has notified the appellant by written communication that the reply brief has been entered and considered, and that the application will be forwarded to the Board.
- (B) After a supplemental examiner's answer, pursuant to a remand from the Board, has been mailed.
- (C) After 2 months from the examiner's answer, plus mail room time, if no reply brief has been timely filed.
- (D) (A), (B), or (C).
- (E) (A) or (C).

17. A request for reexamination of U.S. Patent X,XXX,XXX (the 'XXX patent) was filed by ABC Technology, Inc. (ABC) on the ground that a substantial new question of patentability exists. In the first Office Action during reexamination, all the claims, i.e., claims 1 through 4, were rejected as unpatentable under 35 U.S.C. § 103 over U.S. Patent Z,ZZZ,ZZZ (the 'ZZZ patent). Claims 1 through 4 are all independent and original claims, and are the only claims that were presented during prosecution of the application that matured into 'XXX patent. All the claims are directed to a hydrocyclone separator apparatus. The apparatus is used for separating material, including fibers suspended in a liquid suspension, into a light fraction containing the fibers, and a heavy fraction containing rejects. Assuming no issues under 35 U.S.C. §§ 102, 103, or 112 are raised, which of the following claims, if any, would be properly subject to rejection under 35 U.S.C. § 305?

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

18. A patent application filed in the PTO contains the following dependent claim:
2. The method of Claim 1, further consisting of the step of cooling the mixture to a temperature of 32° F.

Following proper PTO practices and procedures, from which of the following claims does the dependent claim not properly depend?

- (A) 1. A method of making liquid compound A consisting of the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
 - (B) 1. A method of making liquid compound A comprising the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
 - (C) 1. A method of making liquid compound A including the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
 - (D) 1. A method of making liquid compound A characterized by the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
 - (E) (C) and (D).
19. If a claim has been properly rejected under 35 U.S.C. § 103 as being rendered obvious over a combination of prior art references, then in accordance with proper PTO practice and procedure:

- (A) it is not necessary that the prior art suggests the combination to achieve the same advantage or result discovered by the applicant, if the combination provides motivation to make the claimed invention.
- (B) the rationale to modify or combine the prior art must be found expressly set forth in the prior art.
- (C) in considering the disclosure of prior art it is proper to take into account the specific teachings of the reference. It is not proper to take into account the inferences that one skilled in the art could reasonably draw from the specific teachings.
- (D) it is improper for a patent examiner to take official notice of facts outside the record which are capable of instant and unquestionable demonstration as being “well known.”
- (E) it is proper to rely on equivalence in support of the rejection, the equivalence may be recognized in the prior art or in the applicant’s disclosure.

20. An application is directed to novel and unobvious scissors for cutting hair having a pair of cutter blades and a pointer loop. The application includes the following partial independent Claim 1 and dependent Claims 2-5.

- Claim 1. An apparatus for cutting hair, said apparatus comprising:
- (i) a first cutting member having a first cutting edge at one end and the other end of said first cutting member terminating in a thumb loop;
 - (ii) a second cutting member having a second cutting edge at one end and the other end terminating in a finger loop having an arcuate finger brace extending therefrom;
 - (iii) _____
 - (iv) said second cutting member additionally including a pointer loop between said finger loop and said mid-point, said finger loop having a finger loop center such that a plane through said finger loop center and said pointer loop center is generally parallel to said second cutting edge in order for the apparatus for cutting hair to be generally balanced when held by a user.
- Claim 2. The apparatus of claim 1, wherein said first cutting member includes a threaded aperture extending entirely therethrough 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.

Without regard to prior art, and in view of partial Claim 1, which of the following best completes missing paragraph (iii) of Claim 1 while maintaining the broadest scope of protection and complying with proper PTO practice and procedure?

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

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

22. Patentee P wishes to amend Claim 1 in the patent granted to P, and obtain the following amended Claim 1 either through reexamination or reissue:

- 1. A ball valve comprising:
 - i) a housing;
 - ii) a valve [member] ball rotatably joined in the housing;
 - iii) a [flanged] seal engagable with surfaces of the [member] ball; and
 - iv) a linear spring [means] interposed between the housing and the seal and biasing the seal into engagement with the [member] ball.

The amended claim is supported by the original disclosure in the application, which matured into P's patent. In the absence of questions of recapture, novelty, obviousness, and utility which of the following statements is/are true?

- (A) A claim so amended is properly presented in a reissue application filed on October 14, 1999, and a reissue patent is grantable where reissuance is sought of a patent granted on September 9, 1997.
- (B) A claim so amended is properly presented in a reissue application filed on September 9, 1999, and a reissue patent is grantable where reissuance is sought of a patent granted on October 7, 1997.
- (C) A claim so amended is properly presented in a request for reexamination filed on October 14, 1999, and a certificate of reexamination is grantable where reexamination is sought of a patent granted on September 9, 1997.
- (D) A claim so amended is properly presented in a request for reexamination filed on September 9, 1999, and a certificate of reexamination is grantable where reexamination is sought of a patent granted on October 7, 1997.
- (E) (B) and (D).

23 and 24. Answer Questions 23 and 24 based on the following facts.

Your client, Homer, invented a new system for laying underground pipes for in-ground sprinkler systems utilizing a tunneling tool he calls “the Mole.” The Mole is placed in a small hole is dug in the ground at a starting location. A target is placed in the ground at the desired ending location. The Mole automatically tunnels through the ground to the target. The Mole has a clamp to pull flexible pipe behind it as it tunnels. A high-pressure air source is connected to the Mole to remove dirt as the Mole progresses toward the target. Homer informs you that he has continuously used this original system for three years in his commercial landscaping business, displayed the system to his numerous customers, and handsomely profited from his original system. In the original system, the Mole sensed and moved toward the target emitting electromagnetic signals. Recently, the Mole sometimes gets confused due to interference from ferromagnetic underground pipes and overhead power lines. Two months ago Homer modified the system to utilize ultrasonic signals emitted from the target. The ultrasonic signals are encoded with location information derived by the target from a Global Positioning System (GPS) satellite. The modified system decodes the location information and tunnels toward the specified location. The use of ultrasonic signals in the modified system is new and unobvious. Homer has reduced the modified system to actual practice, and kept it confidential. Homer prepared a draft patent application fully describing both the original system and the modified system. He wants you to review the draft application, make sure it meets all requirements, and revise it as necessary prior to filing. The draft application prepared by Homer includes the following draft claims:

- Claim 1. A system for laying underground flexible pipe in the ground, said system comprising:
 - (i) a target placed in the ground at a target location and including a transmitter which emits target signals;
 - (ii) a tunneling device including a clamp operable to connect one end of said flexible pipe to said tunneling device, said tunneling device further including a sensor which detects said target signals and steers said tunneling device to move toward said target; and
 - (iii) a source of high pressure air connected with said tunneling device for removing dirt as said tunneling device moves toward said target.
- Claim 2. The system of claim 1, wherein said transmitter emits electromagnetic signals.
- Claim 3. The system of claim 1, wherein said transmitter emits ultrasonic signals.
- Claim 4. The system of claim 3, wherein said ultrasonic signals include encoded position information that is decoded by the decoder portion of said tunneling device sensor.
- Claim 5. The system of claim 1, wherein said transmitter emits signals having encoded position information.

23. Which of the following would not be reasonable advice to Homer?
- (A) Claim 5 is not indefinite even though it is not limited to ultrasonic target signals and the only disclosed embodiment that utilizes encoded position information utilizes ultrasonic target signals.
 - (B) Claim 1, as presently written, is statutorily barred, and the claimed invention should be limited to the modified system.
 - (C) Because the original system had a drawback in that it sometimes got confused by ferromagnetic underground pipes or power lines, and because Homer continued to develop the system to overcome these drawbacks, the original system was experimental and does not constitute prior art against the modified system.
 - (D) Claim 4 is indefinite.
 - (E) The language in Claim 1 reciting the “target” should be reworded to clarify that the ground is not part of the claimed combination, *e.g.*, by adding the words “adapted to be” before “placed”.
24. Claims 1 and 2 are unpatentable under which of the following statutory provisions?
- (A) 35 U.S.C. § 102(b).
 - (B) 35 U.S.C. § 102(c).
 - (C) 35 U.S.C. § 102(d).
 - (D) 35 U.S.C. § 102(e).
 - (E) None of the above.
25. Which of the following is not a PTO recommendation or requirement?
- (A) Claims should be arranged in order of scope so that the first claim presented is the least restrictive.
 - (B) Product and process claims should be separately grouped.
 - (C) Every application should contain no more than three dependent claims.
 - (D) A claim which depends from a dependent claim should not be separated from that dependent claim by any claim which does not also depend from the dependent claim.
 - (E) Each claim should start with a capital letter and end with a period.

26. A patent was granted to inventor Munch on August 3, 1999, on a patent application filed in the PTO on March 5, 1997. In which of the following circumstances in a reexamination proceeding of the Munch patent, considered independently of each other, will the cited prior art reference(s) properly support a determination that there is substantial new question of patentability?

- (A) In a reexamination proceeding, claims 7-15 in the Munch patent are rejected as being anticipated under 35 U.S.C. § 102(a) by the disclosure in the Leal patent. The Leal patent was granted on January 21, 1997. It is the only rejection in the reexamination proceeding. During the original prosecution of the Munch application, the Leal patent was used by the examiner as prior art to reject original claims 1-5 as being anticipated under 35 U.S.C. § 102(a).
- (B) In a reexamination proceeding, newly added claims 16-20 in the Munch patent are rejected as being anticipated under 35 U.S.C. § 102(b) by the disclosure in the Zellot patent. The Zellot patent was granted in 1987. It is the only rejection in the reexamination proceeding. During the original prosecution of the Munch application the examiner cited the Zellot patent against claims 1-7 in the patent application Munch filed on March 5, 1997.
- (C) In a reexamination proceeding, claims 1-15 in the Munch patent are rejected as being obvious under 35 U.S.C. § 103 over the Wills patent in view of the Note patent. The Wills patent was granted on December 3, 1996, and the Note patent was granted in 1994. It is the only rejection in the reexamination proceeding. During the original prosecution of the Munch application the examiner used the Wills patent as prior art to reject original claims 1 and 2 in the Munch application. The Note patent was never before the examiner during the original prosecution of the Munch application, is not cumulative with the prior art cited during the original prosecution, and is material to the question of obviousness.
- (D) In a reexamination proceeding, claims 1-15 in the Munch patent are rejected as being anticipated under 35 U.S.C. § 102(a) by the disclosure in the Richards patent. The Richards patent was granted on January 14, 1997. It is the only rejection in the reexamination proceeding. During the original prosecution of the Munch application, the examiner used the Richards patent in combination with a patent to Smith, granted in 1923, to reject original claims 1-5 in the application as being obvious under 35 U.S.C. § 103.
- (E) All of the above.

27. Which of the following statements explains why Claim 1 below does recite subject matter eligible for protection under the Patent Statute?

Claim 1. A top soil for retaining water comprising:
about 10% of material X;
about 60% of material Y; and
balance of material Z.

- (A) The subject matter is eligible if the top soil occurs in nature, and M was the first to find the topsoil on a remote tropical island.
- (B) The subject matter is eligible if M developed the top soil through extensive research and experimentation with various materials, including materials X, Y, and Z.
- (C) The subject matter is eligible because all inanimate objects are subject matter eligible for protection under the patent statute.
- (D) The subject matter is eligible because the claim is sufficiently broadly written as not to exclude the inclusion of a living organism.
- (E) (A) and (B).

28. A patent application filed in the PTO contains the following three claims, including product by process Claim 3:

Claim 1. A method for making an Ethernet cable comprising the steps of A, B and C.
Claim 2. The method of claim 1, further characterized by the step of D.
Claim 3. The Ethernet cable as in any one of the preceding claims.

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

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

29. Which of the following statements is in accordance with proper PTO practice and procedure?

- (A) Unlike questions of public use, there is no requirement that “on sale” activity be “public.”
- (B) Sales to toy stores throughout the United States of a claimed rocking horse by an independent third party more than one year before the filing date of applicant’s patent application without the applicant’s consent will not bar applicant from obtaining a patent for the rocking horse.
- (C) An offer for sale of a claimed invention, where the offer originates in the United States and is communicated to a potential buyer in Europe, more than one year before the filing date of applicant’s patent application, cannot be sufficient activity to bar applicant from obtaining a patent for the invention.
- (D) Delay alone in filing a patent application is sufficient to infer any required intent by the inventor to abandon the invention.
- (E) “Patented” in 35 U.S.C. § 102(e) includes the publication of German applications as printed documents called Offenlegungsschrift.

30. On September 14, 1999, you filed a patent application in the PTO on behalf of a large corporation together with an authorization to charge the filing fee to your deposit account. However, due to unforeseen circumstances, measures were not taken to cover the \$760.00 filing fee against the amount in your deposit account, which has a \$10.00 balance. Consequently, you received a notice from the PTO dated September 28, 1999, that your deposit account has insufficient funds. Which of the following steps avoids abandonment of the recently filed application?

- (A) On September 29, 1999, replenish the deposit account with \$800.00 in cash to encompass the filing fee, and the \$10 fee required by 37 CFR § 1.21(b)(1).
- (B) On September 29, 1999, open a new deposit account with \$800.00 in cash, and file in the PTO correspondence authorizing the fee for filing the application be charged against your new deposit account.
- (C) On September 29, 1999, file in the PTO a check for \$760.00 for the filing fee, and file in the PTO correspondence authorizing the balance of the filing fee be paid from your deposit account.
- (D) On September 29, 1999, replenish the deposit account with \$890.00 in cash to cover the filing fee, and a surcharge fee for late payment of the filing fee, and file in the PTO correspondence authorizing the fees for the application be charged to your deposit account.
- (E) (B) or (C).

31. The following claims are included in a newly filed patent application:

Claim No.

1. Independent
2. Dependent on claim 1
3. Dependent on claim 1
4. Dependent on claims 2 and 3
5. Independent
6. Dependent on claim 1, 2 or 5
7. Dependent on claim 6
8. Independent

Which of the following represents the proper number of total claims for fee calculation purposes?

- (A) 10
- (B) 13
- (C) 11
- (D) 12
- (E) 8

32. On August 23, 1999, you file a patent application in the PTO. Along with the application, you file an unexecuted declaration that refers to the application and a preliminary amendment that describes the best mode of carrying out the claimed invention. Subsequently, you file a signed declaration in reply to a Notice to File Missing Parts. The best mode is described only in the preliminary amendment. In the first Office action, the examiner objects to the preliminary amendment as adding new matter to the specification and requires cancellation of the new matter. Considering the following responses and the additional facts separately, the best way to respond to and overcome the objection, and obtain a patent is to:

- (A) file a reply pointing out that the objection is improper because the declaration filed in reply to the Notice to File Missing Parts is a properly executed declaration that refers only to the amendment.
- (B) file a reply pointing out that the objection is improper because the declaration filed in reply to the Notice to File Missing Parts is a properly executed declaration that refers only to the application and amendment.
- (C) file a reply pointing out that the objection is improper because the declaration filed in reply to the Notice to File Missing Parts is a properly executed supplemental declaration that refers only to the amendment.
- (D) file an appeal to the Board of Patent Appeals and Interference requesting review of the examiner's objection to the amendment as adding new matter.
- (E) file a reply to the Office action canceling the new matter.

33. During a reexamination proceeding, you submit the following amendment less than two years from the date that a patent was granted with the claim:

1. (once amended) An application specific integrated circuit for calculating a correlation coefficient, comprising: a multiplication unit [having a plurality of sixty-four bit shift registers]; an integration unit coupled to said multiplication unit; and a digital filter unit coupled to said integration unit and to said multiplication unit.

The original disclosure in the patent application stated that a plurality of thirty-two bit shift registers could be used to form the multiplication unit. In accordance with PTO rules and procedure, which, if any, of the following statements, including any reasons given in support thereof, concerning the amendment is true?

- (A) The form of the amendment is improper, since underlining and brackets are not proper in proceedings where only issues concerning substantial new questions of patentability may be raised.
- (B) The claim as amended should be allowed if it overcomes the art of record in the application since the amendment was made less than two years from the date that a patent was granted.
- (C) The claim as amended should be allowed if it overcomes the art of record in the application since the amendment, although broader in some respects than the claim of the patent, is narrower in other respects.
- (D) The claim as amended should not be allowed since it broadens the scope of the claim of the patent.
- (E) None of the above.

34. If a claim has been properly rejected under 35 U.S.C. § 103 as being rendered *prima facie* obvious over a combination of prior art references, then the rejection can be rebutted in accordance with proper PTO practice and procedure by:

- (A) showing the criticality of the claimed range where the range in the claim overlaps the range disclosed in one or both prior art references.
- (B) arguing that the client has recognized latent properties in the prior art which were not recognized by the prior art references.
- (C) arguing that a combination would not be made by a businessman for economic reasons.
- (D) contending that each of the prior art references, taken individually, does not teach or render obvious the claimed invention.
- (E) (A), (B), and (C).

35. Morris, a registered practitioner with a solo practice he operates out of his house, obtained a plant patent for a client on a commercial catnip hybrid. One morning, over four years later, as he was sorting through his cat's toys, he came across a letter from his client indicating the client's belief that a maintenance fee was due four years after issuance. By the time Morris found the letter, it was eight months after the four year anniversary of the plant patent's issuance. Morris should immediately:

- (A) Tender the maintenance fee and submit a petition (with the required fee) for acceptance of payment where the delay was unintentional.
- (B) Pay the maintenance fee plus the surcharge for filing a maintenance fee during the grace period.
- (C) Write the client that no maintenance fee is in fact owed, and apologize for the delay in responding to the client.
- (D) Do nothing because the patent is irrevocably lost due to failure to pay the maintenance fee within the grace period.
- (E) Tender the maintenance fee and submit a petition (with an affidavit blaming the cat and with the required fee) for acceptance of payment where the delay was unavoidable.

36. Following proper PTO practices and procedures, which of the following reference(s) anticipates Claim 1:

- 1. A composition consisting of:
 - 60-80% cellulose;
 - 16-18% nylon;
 - up to 0.5% fiber; and
 - at least 6% cotton;said composition being capable of absorbing water in the amount of not more than 45% by weight of the composition.
- (A) A reference disclosing a sponge having 69% cellulose, 16% nylon, 0.4% fiber, 7% cotton, and 7.6% silk.
- (B) A reference disclosing a sponge having 78% cellulose, 17% nylon, 0.2% fiber, 4.8% cotton, and a water content of 30% by weight.
- (C) A reference disclosing a sponge having 76% cellulose, 16% nylon, 8% cotton and containing no water.
- (D) A reference disclosing a sponge having 61% cellulose, 18% nylon, 0.6% fiber, 20.4% cotton, and a water content of 45% by weight.
- (E) (B) and (D).

37. A patent application includes the following partial Claim 1:

- Claim 1. A shaving implement comprising
- (i) _____
 - (ii) a shaving head 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 chamber, said tube including a neck having a dispensing opening;
 - (iv) a tube squeezing slide positioned within said channel and said chamber, said slide including opposed slots thereon, said slots being in sliding engagement with said longitudinal sides of said channel; and
 - (v) a tube closure connected to said neck of said collapsible tube.

Which of the following, if included as paragraph (i) of Claim 1, best completes the claim while giving the client the broadest protection?

- (A) a substantially rigid handle including a chamber and a channel formed in said handle, said channel being defined by longitudinal sides within said handle;
- (B) a substantially rigid 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;
- (C) a substantially rigid handle having a first end, said handle including a chamber and an elongated channel formed in said handle;
- (D) a substantially rigid handle having a first end, said handle including a chamber and a channel formed in said handle;
- (E) a substantially rigid handle having a first end, said handle including a channel formed in said handle, said channel being defined by longitudinal sides within said handle;

38. Which of the following must be included in a petition for a retroactive license to file a patent application in a foreign country?

- (A) A verified statement containing an averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order.
- (B) A verified explanation of why the material was filed abroad through error and without deceptive intent without the required license first having been obtained.
- (C) A listing of each of the foreign countries in which the unlicensed patent application was filed.
- (D) (A) and (B).
- (E) (A), (B) and (C).

39. Applicant filed a patent application claiming a polyol. The application discloses that the claimed polyol is used to form rigid polyurethane foam having a structural formula. The examiner properly rejected the claimed polyol as unpatentable over prior art disclosing the claimed polyol and its use to form rigid polyurethane foam having the same structural formula. Given the fact that applicant's specification discloses that the polyol may be produced by a process comprising steps A, B, C, and D, and the process is novel and unobvious, which of the following claims, if introduced by amendment, would overcome the rejection?

- (A) A polyol having the property of forming rigid polyurethane foam having structural formula Z, the polyol being produced by the process comprising the steps A, B, C, and D.
- (B) A polyol produced by the process comprising the steps A, B, C, and D, said polyol having the property of forming rigid polyurethane foam having structural formula Z.
- (C) A polyol produced by the process comprising the steps A, B, C, and D.
- (D) A polyol comprising the resultant product of steps A, B, C, and D.
- (E) A polyol-producing process comprising steps A, B, C, and D, said process resulting in a polyol capable of forming rigid polyurethane foam having structural formula Z.

40. In the course of prosecuting a patent application before the PTO, you receive a non-final Office action allowing Claim 1, and rejecting Claims 2 through 6, the remaining claims in the case. Claim 1 reads as follows:

- 1. A ship propeller exhibiting excellent corrosion resistance, said ship propeller consisting essentially of a copper base alloy consisting of 2 to 10 percent tin, 0.1 to 0.9 percent zinc, and copper.

The specification of the application teaches that the copper base alloy made with the addition of 2 to 10 percent aluminum increases the alloy's wear resistance without detracting from its corrosion resistance. However, adding aluminum to the surface of the propeller does not increase wear resistance. Which of the following claims, if any, if added by amendment would accord with proper PTO practice and procedure?

- (A) 7. A copper base alloy according to Claim 1 wherein said alloy includes 2 to 10 percent aluminum.
- (B) 7. A ship propeller according to Claim 1 including the step of adding 2 to 10 percent aluminum to the copper base alloy.
- (C) 7. A ship propeller according to Claim 1 including 2 to 10 percent aluminum.
- (D) 7. A ship propeller according to Claim 1 wherein said alloy includes 2 to 10 percent aluminum.
- (E) None of the above.

41. A claim limitation reads “a pH range between 7 and 12, preferably between 9 and 10.” Which of the following is correct?

- (A) Since the limitation properly sets forth outer limits, it is definite.
- (B) As long as the limitation is supported in the written description, it is proper.
- (C) The limitation is indefinite.
- (D) Since the limitation sets forth a preferred range, it is definite.
- (E) An applicant is precluded from expanding the claim coverage beyond a pH range of 7-12 under the doctrine of equivalents.

42. Patent practitioner Wally is hired to prepare a patent application directed to a method of making a particular composition. After consulting with his client, Wally believes that schematic drawings would be helpful, and that color drawings would be most helpful in disclosing the method. Wally diligently contacts a draftsman to prepare the color drawings and proceeds to complete his draft patent application. The application contains only method claims. Upon completing the application, Wally forwards the draft application to his client for review. The application contains method claims, and does not include any reference to drawing figures. Before the color drawings are complete, Wally receives an urgent call from his client directing Wally to file the application by the close of business that day due to an unforeseen statutory bar date. Drawings are not required to understand the claimed method. A patent would be barred if the application is filed the following day. Which of the following combination of acts presents the **minimum** course of action to be taken by Wally in order to obtain a filing date that avoids the statutory bar?

- (A) File the application, oath and filing fee by the close of business without the drawings.
- (B) File the application by the close of business without the oath, filing fee or drawings.
- (C) File the application and filing fee without the drawings and later file a petition for accepting the color drawings along with the petition fee; three (3) sets of color drawings; and a proposed amendment to insert the following in the specification: “The file of this patent contains at least one drawing executed in color. Copies of this patent with color drawing(s) will be provided by the Patent and Trademark Office upon request and payment of the necessary fee.”
- (D) File the application without the drawings by the close of business; file a preliminary amendment the next day that amends the specification to refer to drawing figures and which includes a set of black and white drawings.
- (E) None of the above.

43. You received an Office action dated March 17, 1999, rejecting the claims of a pending patent application filed April 22, 1998. You prepared a timely reply that would overcome the examiner's rejections and place the application in condition for allowance. You put the reply in a correctly addressed envelope, with a metered mail stamp having a date of June 4, 1999. Your procedure is to give all outgoing mail to your staff assistant who keeps it locked in his desk drawer until he can mail it at the end of his work day. The reply fell inside the desk, behind the drawer, and was never mailed. Today, November 3, 1999, you receive a Notice of Abandonment of the patent application for which the reply was prepared. You searched and found the unopened and unmailed envelope. You know that the applicant, your mother, sold five items covered by all the claims of the now abandoned application over a year ago (but not before the original application was filed) and that her commercial survival depends on obtaining the claims in the abandoned application. A valid patent, including the claims in the abandoned application, can be obtained for your mother, if:

- (A) you submit a new reply to the patent examiner arguing the commercial success of the item as shown by the sales of the five items sold over a year ago with affidavits under 37 CFR § 1.132 traversing the holding of abandonment.
- (B) you mail the reply today in its original, sealed envelope which takes precedence over the Notice of Abandonment since the date stamped on the envelope is both before the due date for reply and before the Notice of Abandonment.
- (C) the applicant files a petition to revive an unintentionally abandoned application stating that the entire delay in filing the required reply was unintentional, files the reply that was prepared by you in June 1999, and submits the appropriate petition fee.
- (D) you provide the unopened envelope as evidence of the staff assistant's negligence and petition the Group Director to reopen prosecution of the application on the merits.
- (E) you file a petition to revive an unavoidably abandoned application stating that the entire delay in filing the reply was unavoidable, submitting the required reply prepared by you in June 1999, the proper petition fee, and a terminal disclaimer and fee dedicating to the public a terminal part of the term of any patent granted equivalent to the period of abandonment of the application.

44. A practitioner should consider whether information presented during prosecution of an application may be used by the examiner as evidence against the applicant. What evidence may an examiner not use to demonstrate that a claim fails to correspond in scope with that which an applicant regards as his or her invention?

- (A) Arguments, containing admissions, advanced in a reply filed by the practitioner representing the applicant.
- (B) Admissions contained in a brief.
- (C) The lack of agreement between the claims and the specification.
- (D) Affidavits, containing admissions, filed under 37 CFR § 1.132.
- (E) All of the above.

45. Which of the following statements regarding a reissue patent application is *true*?

- (A) Only one reissue patent application is permitted to be issued for distinct and separate parts of the thing patented.
- (B) New matter may be properly added in a reissue application to correct an error made during the prosecution of the original patent application.
- (C) A reissue will not be granted to “recapture” claimed subject matter deliberately canceled in an application to obtain a patent.
- (D) To retain the benefit of priority under 35 U.S.C. § 119, it is not necessary to make a new claim for priority in the reissue patent application if a claim for priority was perfected in the application on which the original patent was made.
- (E) (C) and (D).

46. You filed a patent application for Sam, who invented an apparatus for labeling and identifying baseballs. In the application, the apparatus is described as including means for marking baseballs; an ultraviolet light source; and a computer coupled to both the means for marking baseballs and the ultraviolet light source. The only means for marking baseballs set forth in the application was a commercially available invisible ink stamper, also known as a marker. The specification described the invention as being useful for identifying home run baseballs. The application was filed with one claim, which stated:

Claim 1. An apparatus, comprising: an invisible ink stamper; an ultraviolet light source; and a computer coupled to said invisible ink stamper and to said ultraviolet light source.

Claim 1 was properly rejected under 35 U.S.C. §102(b) as being anticipated by a patent issued to McGoo, which disclosed an apparatus having only an invisible ink stamper, an ultraviolet light source, and a computer coupled to the invisible ink stamper and to the ultraviolet light source. The McGoo patent did not mention identifying baseballs, but described the invention as useful for labeling and identifying baseball bats. Which of the following amendments, if any, avoids anticipation of Claim 1 by the McGoo patent?

- (A) 1. (amended once) An apparatus intended to be used to identify home run baseballs, comprising: an invisible ink stamper; an ultraviolet light source; and a computer coupled to said invisible ink stamper and to said ultraviolet light source.
- (B) 1. (amended once) An apparatus, [comprising] consisting of: an invisible ink stamper, an ultraviolet light source, and a computer coupled to said invisible ink stamper and to said ultraviolet light source.
- (C) 1. (amended once) An apparatus, comprising: [an invisible ink stamper] a marker; an ultraviolet light source, and a computer coupled to said means for marking baseballs and to said ultraviolet light source.
- (D) (B) and (C).
- (E) None of the above.

47. 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 1800°C to 2000°C;
 - (ii) passing a first gas over said heated base, said first gas comprising a mixture of hydrogen, SiCl₄, 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, SiCl₄, AlCl₃, 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 1875°C to 1925°C, and preferably between 1895°C and 1905°C.
- (B) Claim 3. The electrical device of claim 1, wherein said first gas further comprises an inert gas such as Argon.
- (C) Claim 4. The method of claim 1, wherein said second gas further consists of Argon.
- (D) Claim 5. The method of claim 1, wherein said first gas further comprises an inert gas such as Argon.
- (E) Claim 6. The electrical device of claim 1, wherein said heated base has a first layer comprising silicon, phosphorus, and carbon.

48. An original claim in a patent application to a mechanical arts invention recites the limitation of “a clip,” which is shown in an original application drawing as being one of several elements of the invention. The “clip” is well known in the mechanical arts. However, “a clip” does not appear in the original written description part of the application. Which of the following is correct?

- (A) The written description may not be properly amended to include “a clip”
- (B) The claim is indefinite with respect to “a clip.”
- (C) The application lacks an enabling disclosure as to “a clip.”
- (D) The claim is definite with respect to “a clip.”
- (E) The application fails to set forth the best mode for “a clip.”

49. A nonprovisional patent application has been filed for inventor Alton disclosing and claiming an alumino-silicate catalyst for oxidizing organic compounds. Which of the following statements, considered separately, about the best mode contemplated by Alton for the alumino-silicate catalyst is not true?

- (A) The best mode must be designated as the best mode in the application if the application contains several embodiments, one of which is the best mode.
- (B) The presence of one specific example in the specification is evidence that the best mode has been disclosed.
- (C) The best mode need not be updated if, between the time of filing the non-provisional patent application and a continuation application, Alton discovered a better catalyst than the best mode disclosed in the non-provisional application.
- (D) A failure to disclose the best mode in the application as filed cannot be cured by first introducing into the application by amendment a specific mode of practicing the invention.
- (E) There is no statutory requirement for the best mode being disclosed in the specification as a specific example.

50. You are drafting a patent application disclosing and describing a door assembly wherein a door, a door frame, and a pair of hinges are separate elements which must be included in a claim to the assembled combination of a door secured to a door frame by a pair of hinges. The application discloses that it is essential to the invention that the door is secured to the doorframe in the described manner to permit the door to be readily opened and closed. The application further discloses that it is also essential to the invention for the assembly, in a closed relationship, to keep out exterior elements, while providing privacy and permitting quick egress in an emergency. Which of the following claims properly sets forth the combination?

- (A) An assembly having a door capable of being hingedly connected to a doorframe.
- (B) An assembly having a door and means for securing the door.
- (C) An assembly having a door and a pair of hinges for securing the door.
- (D) An assembly having a door, and a doorframe, said door being secured to said doorframe with a pair of hinges.
- (E) An assembly having a door adapted to be secured to a doorframe with a pair of hinges.

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

NOVEMBER 3, 1999

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

1. Your client, Smith, invents a composition for adhering metal to glass. You prepare a patent application including a specification and several claims of varying scope. Your specification includes a detailed description of Smith's invention, which sets forth the following: the composition is made from, among other things, a combination of A, B, and C; the composition is at least 20% A but can be up to 30% A; the composition works best if it is 24% to 26% A; and the composition contains substantially equal portions of B and C. Your specification also includes guidelines for determining what would constitute substantially equal portions of B and C in the composition. Furthermore, your specification includes a detailed explanation of why it is preferable to use 24% to 26% A. Among the following claims drawn to Smith's invention, which is the broadest claim that is unlikely to be properly rejected under 35 U.S.C. 112, second paragraph?

- (A) A composition comprising 20 to 30% A, and substantially equal portions of B and C.
- (B) A composition comprising 20 to 30% A, preferably 24% to 26% A.
- (C) A composition comprising 20 to 30% A, 30% B, and 30% C.
- (D) A composition comprising 24% A, and substantially equal portions of B and C.
- (E) A composition comprising 20 to 30% A, and equal portions of B and C.

2. On August 17, 1999, you filed a reissue application to enlarge the scope of the claims directed to an electrical device in a patent granted to your client on January 20, 1998. In the patent, as well as the patent application on which the patent was granted, the broadest disclosure (including the specification and the original claim) regarding the resistance of the device is that "the device's resistance is .02 to 1.5 ohms." The examiner issued a non-final first Office action containing a rejection of several claims in the reissue application. Your reply to the first Office action includes presentation of an amendment to the specification adding the following disclosure: "The device can have a resistance of 3.0 to 4.5 ohms." No petition and fee requesting entry of the amendment was filed. In accordance with PTO practice and procedure,

-
- (A) the amendment will be entered, and if the examiner objects to the amendment to the specification as being new matter, you should traverse the objection on the grounds that the patent owner is entitled to enlarge the scope of the content of the patent.
 - (B) the amendment will not be entered because the amendment to the specification does not enlarge the scope of the claim.
 - (C) the amendment will not be entered because a petition and necessary fee requesting entry of the amendment was not filed.
 - (D) the amendment will be entered, and if the examiner objects to the amendment to the specification as being new matter, you should file another amendment canceling "The device can have a resistance of 3.0 to 4.5 ohms."
 - (E) the amendment will be entered because it does not introduce new matter.

3. Smith received a second Office action in his pending application finally rejecting pending claims 1-20 on prior art grounds. Claims 1 and 11 are presented in independent form, claims 2-10 depend from claim 1, and claims 12-20 depend from claim 11. To continue prosecution, Smith submitted an Amendment After Final Rejection narrowing the scope of independent claims 1 and 11. Smith believed the Amendment placed the application in condition for allowance and, accordingly, requested entry of the Amendment and allowance of the application. However, the Examiner denied entry on the ground that the Amendment presented new issues requiring further consideration or search. Rather than appeal the rejection, Smith filed a request for a Continuing Prosecution Application (CPA), and asked that the Amendment After Final be entered as a Preliminary Amendment. The Examiner issued a first Office action in the CPA allowing claims 1-10 and finally rejecting claims 11-20 on substantially the same grounds that these claims had been rejected in the parent application. Which of the following statements regarding the first Office action in the CPA is correct?

- (A) The Examiner cannot properly allow claims 1-10 because a determination was made in the parent application that the Amendment After Final Rejection presented new issues requiring further consideration or search.
- (B) The Examiner is precluded from rejecting claims 11-20 on substantially the same grounds that these claims had been rejected in the parent application because a determination was made in the parent case that the Amendment After Final Rejection presented new issues requiring further consideration or search.
- (C) The Amendment After Final Rejection cannot be entered as a Preliminary Amendment in the CPA application.
- (D) The finality of the rejection of claims 11-20 is improper.
- (E) (B) and (D).

4. After filing a proper appeal brief for an application you are prosecuting, you begin to have doubts as to how convincing your arguments would be to the Board of Patent Appeals and Interferences (“Board”). After further consideration, you agree to the examiner’s suggestions. You file an amendment incorporating all of the examiner’s suggestions after you filed the appeal brief and before an examiner’s answer is mailed in this patent application. In accordance with PTO practice and procedure, the amendment _____

- (A) may be entered if the amendment obviously places the application in condition for allowance and there is a showing of good and sufficient reasons why it was not earlier presented.
- (B) will not be entered as it was not sent prior to or with the appeal brief.
- (C) will not be entered because it was not in the form of a petition.
- (D) will be entered and appended to the appeal brief for the Board’s consideration.
- (E) will not be entered because a petition should have accompanied it since it was filed after the appeal brief.

5. On March 1, 1995, applicant filed a nonprovisional patent application for a stool. The original disclosure set forth that a base member of the stool was generally elliptical and, in particular, could be circular (a special kind of ellipse). It also stated that all leg members must be parallel to each other. The only claim included in the application stated as follows:

1. A stool for sitting on, comprising a circular shaped base member having a top surface and a bottom surface; said bottom surface having a center portion and three circular holes equally spaced about said center portion; and three leg members connected to said bottom surface, each hole having a leg member protruding therefrom.

In a first Office action rejection, the examiner rejected claim 1 under 35 U.S.C. § 102(e) as unpatentable over a U.S. Patent to Pigeon. The Pigeon patent specified that each of the leg members formed a thirty degree angle with each of the other leg members. Applicant filed a timely response to the Office action, amending the specification to state that the leg members could be substantially parallel and including guidelines for determining what would be considered “substantially parallel.” Applicant also amended claim 1 as follows:

1. (once amended) A stool for sitting on, comprising a circular shaped base member having a top surface and a bottom surface; said bottom surface having a center portion and three circular holes equally spaced about said center portion; and three leg members connected to said bottom surface, each hole having a leg member protruding therefrom, wherein the leg members are parallel to each other.

The examiner allowed Claim 1 as amended and a patent was granted to applicant on January 5, 1997. On January 5, 1999, applicant filed a reissue application, including a proper declaration pursuant to 37 CFR § 1.175. Assume that there is no other relevant prior art. In accordance with PTO rules and procedure, which of the following statements concerning the reissue application is true?

- (A) Any amendment to claim 1 so as to broaden its scope will likely be considered untimely.
- (B) If applicant amends claim 1 to replace “a circular shaped member” with “an elliptical shaped member,” then the amendment should be considered untimely since the amendment would broaden the scope of the claim.
- (C) If applicant amends claim 1 to delete “wherein the leg members are parallel to each other,” then the amended claim should be allowed.
- (D) If applicant amends claim 1 to replace “parallel” with “substantially parallel,” then the amended claim will likely be allowed.
- (E) None of the above.

6. If 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 in which the claim appears, which claim properly presents a process claim?

- (A) A process of utilizing a filter comprising electrical components, placing a plurality of electrodes on the human body, receiving electrical signals from the electrodes, and passing the signals through the filter which comprises electrical components.
- (B) A process of polymerizing an organic compound by combining in a reaction vessel a catalyst and reactants dissolved in a solvent, heating the mixture in the vessel to a high temperature to start the reaction, separating an upper 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) and (B).
- (E) (A), (B), and (C).

7. You were drafting a patent application claiming a widget invented by your client Able. While drafting the application, you looked through a recent *Official Gazette* and noticed a patent, No. 888,888,888, directed to a widget that appears to be the same as the widget you are claiming. You obtained a copy of the patent and discovered that the patent was granted on May 4, 1999, to your client's strongest competitor, QED Incorporated. Claim 5 in the QED patent is the same widget Able invented. Claim 6 in the QED patent is an improvement to Able's widget. The QED patent was granted on a patent application filed on December 22, 1997. You have evidence that Able invented his widget before December 22, 1997. You copied, as claim 9 in Able's application, QED claim 5. Today, November 3, 1999, you are about to file, in the PTO, Able's nonprovisional patent application containing claim 9, and an information disclosure statement (IDS) listing several patents, including the QED patent, and publications. Which of the following would be the most proper course of action to take to comply with your duties to your client and the PTO?

- (A) In the IDS, state and explain why the identified patents may be relevant, and state that the burden has shifted to the examiner to find and disclose other pertinent or relevant prior art.
- (B) Identify the QED patent in bold in the list in the IDS, and include the following explanation about the QED patent: "QED discloses a relevant type of widget."
- (C) In the IDS, state, "The QED patent discloses a relevant type of widget," and provide a copy of the patent.
- (D) In the IDS, state, "Claim 9 in this application has been copied from claim 5 in the QED patent," and provide a copy of the patent.
- (E) In the IDS, state, "Claim 9 in this application has been copied from a claim in a QED patent," and argue that "Claim 6 in the QED patent is an obvious improvement to the instant invention," and provide a copy of a QED patent.

8. Jones' patent application was filed in the PTO in January 1999, claiming an invention Jones conceived and reduced to practice in the United States. Claim 1 in the application was rejected under 35 U.S.C. § 102 as being unpatentable over a U.S. patent to Smith. Smith did not derive anything from Jones, or visa versa. Smith and Jones were never obligated to assign their inventions to the same employer. In which of the following situations should a declaration by Jones under 37 CFR § 1.131 overcome the rejection in accordance with proper PTO practice and procedure?

- (A) The rejected claim is drawn to a genus. The Smith patent issued in March 1998, on an application filed in June 1994. The patent discloses, but does not claim, a single species of the genus claimed by Jones. The declaration shows completion in April 1994, of the same species disclosed by Smith.
- (B) The rejected claim is drawn to a species. The Smith patent issued in March 1998 on an application filed in June 1994. The patent discloses, but does not claim, the species claimed by Jones. The declaration shows completion in April 1994, of a different species.
- (C) The rejected claim is drawn to a genus. The Smith patent issued in March 1998, on an application filed in June 1994. The patent discloses, but does not claim, several species within the genus claimed by Jones. The declaration shows completion in April 1994, of a species different from the reference's species and the species within the scope of the claimed genus.
- (D) The rejected claim is drawn to a genus. The Smith patent issued in March 1997, on an application filed in June 1994. The patent discloses, but does not claim, several species within the genus claimed by Jones. The declaration shows completion in April 1994, of one or more of the species disclosed in the patent.
- (E) The rejected claim is drawn to a genus. The Smith patent issued in November 1998, on an application filed in June 1994, and the patent discloses and claims several species within the genus claimed by Jones. The declaration shows completion in April 1994, of each species claimed in the Smith patent.

9. A personal interview with an examiner to discuss the merits of the claims **may not** be properly conducted by:

- (A) the inventor, even though the attorney of record is present at the interview.
- (B) a registered practitioner who does not have power of attorney in the application, but who is known to the examiner to be the local representative of the attorney of record in the case.
- (C) an unregistered attorney who is the applicant in the application.
- (D) an unregistered attorney who has been given the associate power of attorney in the particular application.
- (E) a registered practitioner who is not an attorney of record in the application, but who brings a copy of the application file to the interview.

10. Which of the following claim phrases may be used 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.

11. A final rejection, with a mailing date of Thursday, February 4, 1999, was received Saturday, February 6, 1999. The examiner set a three month shortened statutory period for reply. Which of the following will be considered as being timely filed?

- (A) A reply, mailed using the U.S. Postal Service, first class mail, on Friday, August 6, 1999, and received by the PTO on Monday, August 9, 1999 accompanied by a petition and appropriate fee for a three-month extension of time, and a certificate of mailing stating, "I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on August 6, 1999." The certificate of mailing was signed by and contained the printed name of one who reasonably expected the response to be mailed in the normal course of business by another no later than August 6, 1999.
- (B) A reply, mailed using the U.S. Postal Service, on Tuesday, May 4, 1999 and received by the PTO on Thursday, May 6, 1999 accompanied by a copy of a U.S. Postal Service certificate of mailing, which states "One piece of ordinary mail addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231." The certificate of mailing contained an official U.S. Postal Service date stamp of May 4, 1999, and the printed name of one who reasonably expected the response to be mailed in the normal course of business no later than May 4, 1999.
- (C) A reply, mailed using the U.S. Postal Service, first class mail, on Wednesday, August 4, 1999, and received by the PTO on Monday, August 9, 1999, accompanied by a petition and the appropriate fee for a three-month extension of time, and a certificate of mailing stating, "I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on August 6, 1999." The certificate of mailing was signed by and contained the printed name of one who reasonably expected the response to be mailed in the normal course of business by another no later than August 4, 1999.
- (D) (A) and (C).
- (E) None of the above.

12. Which of the following statements is true concerning terms of degree (relative terms, e.g., such as, “hotter”) used in claim language?

- (A) Definiteness of claim language using terms of degree should not be analyzed using a claim interpretation that would be given by one possessing the ordinary level of skill in the art, and only the specification should be used to interpret the claim.
- (B) A claim may be rendered indefinite even if the specification uses the same term of degree as the claim language, if the term of degree is not understandable by one of ordinary skill in the art when the term of degree is read in light of the specification.
- (C) If the specification includes guidelines which would enable one of ordinary skill in the art to determine the scope of a claim having a term of degree, then the language of the guidelines must be included in the claim in order to render the claim definite.
- (D) If the original disclosure does not include guidelines which would enable one of ordinary skill in the art to determine the scope of a claim having a term of degree, then as long as the term of degree in the claim was part of the original disclosure, the claim will be properly rendered definite by amending the specification to provide guidelines concerning the term of degree which would enable one of ordinary skill in the art to determine the scope of the claim.
- (E) None of the above.

13. You are a registered patent agent prosecuting a patent application filed on behalf of Harry. You received an Office action having a mailing date of August 13, 1999, in which the examiner set a three month shortened statutory period for reply and rejected all of the claims in the application under 35 U.S.C § 112 for failing to particularly point out and distinctly claim the invention. After receiving the Office action, you discovered a recently issued U.S. patent that you believe discloses and claims your client’s invention. On September 28, 1999, you filed an amendment copying some of the claims from the patent for the purpose of provoking an interference and notify the examiner that you have copied specific claims from the patent. In a second Office action dated October 13, 1999, the examiner rejected the copied claims under 35 U.S.C. § 112 as being based on a non-enabling disclosure and set a three month shortened statutory period for reply. If no requests for an extension of time are filed, the last day(s) for filing replies to the first and second Office actions, is(are):

- (A) Monday, November 15, 1999.
- (B) Monday, November 15, 1999, and Thursday, January 13, 2000, respectively.
- (C) Monday, November 29, 1999, and Wednesday, January 12, 2000 respectively.
- (D) Tuesday, December 28, 1999.
- (E) Thursday, January 13, 2000.

14. Claim 1 in a patent application states the following:

1. A modular telephone plug crimping tool comprising:
 - (i) a pair of body parts comprising first and second body parts, each having a fixed length;
 - (ii) a flexible member connecting an end of the first body part to an end of the second body part;
 - (iii) a hand lever;
 - (iv) a pivot pin connecting the hand lever to the first body part;
 - (v) an interchangeable crimping punch removably seated in the first body part and guided relative to an interchangeable crimping anvil removably seated in the second body part;
 - (vi) a roller mounted on the pivot pin for engaging the crimping punch; and
 - (vii) a guide pin being fixed in said second body part and extending in aligned bores in said pair of body parts.

Which, if any, of the following claims, if presented in the application, is a proper dependent claim in accordance with PTO rules and procedure.

- (A) 2. The modular telephone according to claim 1, wherein said crimping punch comprises integral contact and strain relief punch portions.
- (B) 2. The modular telephone plug crimping tool according to claim 1, wherein said second body part has an adjustable length.
- (C) 2. A process for using the modular telephone plug crimping tool of claim 1 to connect a telephone to a telephone line.
- (D) 2. The modular telephone plug crimping tool according to claim 1, further comprising: a free end on each of said first and second body parts; first and second stripping blades adjustably and detachably provided at said free ends of said first and second body parts, respectively; and at least one severing blade held in cooperating relationship with a severing anvil, said severing blade and severing anvil being provided on said first and second body parts, respectively.
- (E) None of the above.

15. You are prosecuting an application for inventor Smith that receives a rejection under 35 U.S.C. § 102(b) based on a U.S. patent to Jones that discloses and claims the same invention. Which of the following, if any, will overcome the rejection?

- (A) An affidavit or declaration showing that Jones is not the true inventor.
- (B) An affidavit or declaration showing commercial success of the Smith invention.
- (C) An affidavit or declaration containing an argument that the invention claimed in the Smith application provides synergistic results.
- (D) An affidavit or declaration swearing back of the Jones patent.
- (E) None of the above.

Questions 16 and 17 are based on the following facts. Answer each question independently of the other.

A patent application contains a single independent claim:

1. A process for manufacturing water soluble crayons which comprises (i) preparing one or more water soluble alkoxylation products by contacting an organic compound selected from the group consisting of alcohols and carboxylic acids, with an alkylene oxide in the presence of an effective amount of a catalyst under alkoxylation conditions; (ii) preparing a water soluble crayon composition by adding a coloring agent to the one or more water soluble alkoxylation products; (iii) pouring said water soluble crayon composition into a mold; and (iv) solidifying said water soluble crayon composition by cooling.

The coloring agents disclosed in the specification include pigments selected from the group consisting of titanium dioxide, red iron oxide and carbon black. These pigments are used in an amount of about 1 to 30 weight percent or greater, preferably about 4 to about 25 weight percent, of the total weight of the crayon composition. As disclosed in the specification, preferred organic compounds useful in the process of this invention also include alcohols, carboxylic acids, and amines. The specification also discloses that the water soluble crayon compositions harden readily upon cooling, i.e. when exposed to a temperature of from about 10°C. to 15°C.

16. Which of the following choices would be a proper dependent claim which could be added to the application by amendment and be supported by the specification?

- (A) 2. A process according to Claim 1 wherein said water soluble crayon composition is exposed to a temperature of at least 10°C.
- (B) 2. A process as set forth in Claim 1 wherein said coloring agent is titanium dioxide.
- (C) 2. A process for manufacturing water soluble crayons as set forth in Claim 1 wherein said coloring agent is 1 to 30 weight percent of the total weight of the crayon composition.
- (D) 2. A process as set forth in Claim 1 wherein said organic compound further comprises amines.
- (E) (B) and (C).

17. Which of the following amendments to Claim 1 are in accordance with PTO policy and procedure and are supported by specification?

- (A) In Claim 1, line 3, before “alcohols” delete “monohydric”.
- (B) In Claim 1, line 4, after “alcohols” insert “amines”.
- (C) In Claim 1, line 6, delete “a coloring agent” and insert “titanium dioxide”.
- (D) In Claim 1, line 7, after “cooling” insert “to a temperature of 13°C.”
- (E) (B) and (C).

18. Bill wishes to amend the sole, original Claim 1 of the patent granted to him and obtain the following amended Claim 1. The amended Claim 1 set forth below is fully supported by the original disclosure in the application:

- 1. A computer processor comprising:
 - a. a plurality of registers divided into a global port subset and a local pool subset;
 - b. means for distinguishing a successful [unconditional] interruptable jump operation;
 - c. means for receiving interrupts or exceptions; and
 - d. an interrupt or exception handler for handling the interrupts or exceptions in response to distinguishing the [unconditional] interruptable jump operation [from the local pool subset].

In the absence of questions of recapture, novelty, obviousness, and utility, which of the following statements, if any, is true?

- (A) A claim so amended is properly presented during a reexamination proceeding where a request for reexamination was filed on September 9, 1999, and a certificate of reexamination may be issued where reexamination is sought of a patent granted on July 15, 1997.
- (B) A claim so amended is properly presented in a reissue application filed on September 9, 1999, and a reissue patent is grantable where reissuance is sought of a patent granted on July 15, 1997.
- (C) A claim so amended is properly presented in a reissue application filed on September 9, 1999, and a reissue patent is grantable where reissuance is sought of a patent granted on November 18, 1997.
- (D) A claim so amended is properly presented in a request for reexamination filed on September 9, 1999, and a certificate of reexamination may be issued where reexamination is sought of a patent granted on November 18, 1997.
- (E) A claim so amended is properly presented in a reissue application filed any time before expiration of the term of the patent inasmuch as the scope of Claim 1 in the original patent is narrowed by replacing the word “unconditional” with the word “interruptable.”

19. Which of the following requirements of 35 U.S.C. § 112 does not apply to design patent claims?

- (A) The written description requirement of the first paragraph.
- (B) The best mode requirement of the first paragraph.
- (C) The requirement in the second paragraph to distinctly claim the subject matter which the applicant regards as his invention.
- (D) The requirement in the third paragraph for an independent claim.
- (E) None of the above.

20. Inventors Moe and Jeff originally gave attorney Curly a power of attorney to prosecute their application before the PTO. At this time, inventor Jeff has decided that he no longer wants attorney Curly to represent him. Instead, inventor Jeff wants you to represent him. Thus, Jeff wants the power of attorney to Curly revoked. Moe does not agree and wants Curly to continue. How, if at all, should the revocation and appointment of a new power of attorney be properly handled?

- (A) Papers revoking Curly's power of attorney with regard to Jeff, and giving you a new power of attorney need to be signed by Jeff and must include a statement from Moe indicating that Moe wishes to retain Curly.
- (B) Papers revoking Curly's power of attorney with regard to Jeff, and giving you a new power of attorney cannot be accepted without concurrence by Curly.
- (C) Papers revoking Curly's power of attorney with regard to Jeff, and giving you a new power of attorney signed only by you should be accompanied by a petition giving good and sufficient reasons as to why such papers should be accepted upon being filed together with an appropriate fee.
- (D) Papers revoking Curly's power of attorney with regard to Jeff, and giving you a new power of attorney signed only by Jeff should be accompanied by a petition giving good and sufficient reasons for acceptance should be filed together with an appropriate fee.
- (E) Papers revoking Curly's power of attorney with regard to Jeff, and giving you a new power of attorney cannot be accepted without concurrence of Moe and Curly.

21. Which of the following files is ordinarily not open to the public?

- (A) A substitute application.
- (B) An interference proceeding file involving a U.S. patent.
- (C) A reissue application.
- (D) A reexamination proceeding file.
- (E) All of the above.

22. You are preparing a patent application for filing in the PTO. The application describes a microcomputer having several components. You have drafted the following independent claim:

1. A micro-computer comprising:
 - (i) a central processing unit for processing information;
 - (ii) a memory unit for storing information;
 - (iii) an input device for entering information characterized by a keyboard;
 - (iv) an output device for viewing information consisting of a video monitor; and
 - (v) a bus for interconnecting the central processing unit to the memory unit, the input device and the output device.

In the absence of issues of supporting disclosure, and following proper PTO practices and procedures, which of the following dependent claim(s) is (are) an improper dependent claim?

- Claim 2. The micro-computer of Claim 1, wherein the memory unit contains random access memory.
- Claim 3. The micro-computer of Claim 1 or 2, wherein the input device includes a light pen.
- Claim 4. The micro-computer in any one of the preceding claims, wherein the output device is a printer or a video monitor.
- Claim 5. The micro-computer of Claim 4, wherein the memory unit contains read-only memory.
- (A) Claim 2.
- (B) Claim 2 and Claim 3.
- (C) Claim 3.
- (D) Claim 5.
- (E) Claim 4 and Claim 5.

23. To avoid a proper rejection of a claim for being indefinite, which of the following expressions in the claims must be supported by a specification disclosing a standard for ascertaining what the inventor means to cover?

- (A) “relatively shallow.”
- (B) “of the order of.”
- (C) “similar” in the following claim preamble: “A nozzle for high-pressure cleaning units or similar apparatus.”
- (D) “essentially” in the following phrase following the claim preamble: “a silicon dioxide source that is essentially free of alkali metal.”
- (E) All of the above.

24. Claims 1 through 5 in a patent application read as follows:

1. A computer comprising:
 - (i) a microprocessor having a maximum clock rate of 350 megahertz;
 - (ii) a random access memory chip coupled to said microprocessor;
 - (iii) a read only memory chip coupled to said microprocessor; and
 - (iv) a case enclosing said microprocessor, said random access memory chip, and said read only memory chip.
2. The computer of claim 1, wherein said case has an outer surface comprised of plastic.
3. The computer of claims 1 or 2, further comprising a peripheral controller chip coupled to said microprocessor.
4. The computer of claim 1, wherein said memory chip has eight million storage locations.
5. The computer of claim 2, wherein said microprocessor has a maximum clock rate of 400 megahertz.

Which of the following is/are proper dependent claims(s) in accordance with 37 CFR §1.75?

- (A) Claims 2 and 3.
- (B) Claim 4 only.
- (C) Claims 2 and 5.
- (D) Claim 2 only.
- (E) None of the above.

25. Gonnagetrich Corporation asked you to represent, before the PTO, some of its employees who have invented an apparatus. On Tuesday, August 17, 1999, you deposited a nonprovisional patent application containing a specification with ten claims drawn to the apparatus via hand delivery to the PTO. At that time, you neither supplied the names of any of the actual inventors with the application, nor did you file with the application drawings necessary to understand the invention. The specification refers to the drawings. You sent the drawings by first class mail to the PTO on Wednesday, September 13, 1999, and the PTO received them on Wednesday, September 15, 1999. On Wednesday, September 29, 1999, using the "Express Mail Post Office to Addressee" service of the U.S. Postal Service, and so certifying in compliance with 37 CFR § 1.10, you deposited with the U.S. Postal Service a declaration pursuant to 37 CFR § 1.63 signed by all the actual inventors. On Friday, October 1, 1999, the PTO received the signed declaration. What will be the earliest filing date given to the application by the PTO?

- (A) August 17, 1999.
- (B) September 13, 1999.
- (C) September 15, 1999.
- (D) September 29, 1999.
- (E) October 1, 1999.

26. X invented a laminate which is most broadly disclosed in a patent application as containing a transparent protective layer and a light-sensitive layer, without an intermediate layer. The prior art included a laminate containing a transparent protective layer and a light-sensitive layer held together by an intermediate adhesive layer. Which of the following claims would overcome a 35 USC § 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).

27. On April 21, 1998, a patent was issued to Belinda on a novel switching circuit. Shortly after receiving the patent grant, Belinda assigned 50% of her right, title and interest in her patent to Ace and 25% of the right, title and interest to Duce. After the assignments were recorded in the PTO, Belinda discovered that her claim coverage is too narrow because her patent attorney did not appreciate the full scope of her invention. Today, November 3, 1999, Belinda consults you about filing a reissue application. The reissue oath must be signed and sworn to by:

- (A) Belinda, Ace and Duce.
- (B) Belinda only.
- (C) Belinda and either Ace or Duce.
- (D) Ace and Duce only.
- (E) the attorney or agent of record.

28. A patent specification can be altered by interlineation before it is filed in the PTO. Such alterations are permitted if each interlineation is initialed and dated by the:

- (A) registered practitioner who prepared the specification, even if the applicant is available to sign the oath or declaration.
- (B) applicant, before the oath or declaration is signed by the registered practitioner.
- (C) applicant, at any time after the oath or declaration is signed.
- (D) applicant, before the oath or declaration is signed by the applicant.
- (E) registered practitioner who prepared the specification before the oath or declaration is signed by the applicant.

29. On January 2, 1999, Billie files a U.S. patent application that discloses forming a naturally occurring composition X by a chemical reaction of compounds A, B and C under specified ranges of temperature and pressure. The application includes a statement “The most common meaning of the term ‘fluid’ includes both gases and liquids. However, it has been determined that the present invention properly operates when B is in a gaseous, fluid, or solid state, so long as temperature of the solid B is above 2°C. Below that temperature, it is believed the chemical reaction will not occur. Thus, in the context of the present invention, the term ‘fluid’ means ‘gaseous’, ‘liquid’, and/or certain solid states.” However, research conducted in 1998 by Greene in England shows that the desired chemical reaction would occur with solid compound B at a temperature of 1°C. Greene also showed the reaction with compound B in a liquid and gaseous states. Greene submitted his research results to a British technical journal in November 1998, and they were published on January 5, 1999. Originally filed Claim 1 of Billie’s application is directed to “[a] method for forming composition X comprising mixing compound A with fluid compound B at a temperature between 0°C and 10°C”. Examiner Redd locates the published Greene research results that disclose the identical method set forth in Billie’s Claim 1. Which rejection of Claim 1 is in accordance with proper PTO practices and procedures?

- (A) Claim 1 is rejected under 35 U.S.C. § 112, paragraph 2 as being indefinite because the meaning of the term “fluid” is unclear. Billie is encouraged to clarify the claim by deleting “fluid” and inserting --liquid-- in its place.
- (B) Claim 1 is rejected under 35 U.S.C. § 102(a) as being anticipated by Greene because, although the research results were published after Billie’s filing date, the research results were submitted to the British technical journal before the filing date and were therefore known in the art.
- (C) Claim 1 is rejected under 35 U.S.C. § 112, paragraph 1 as being based on an insufficient specification because the claim does not specify a pressure at which A and B are mixed and, depending on that pressure, compound B could be either a gas or a liquid at the recited temperature range.
- (D) Claim 1 is rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter because composition X occurs naturally.
- (E) Claim 1 is rejected under 35 U.S.C. § 112, paragraph 2 as being based on an incorrect theory of operation because the theory of operation disclosed in the specification is inconsistent with the claim.

30. Which of the following may not properly apply for a patent on an invention?

- (A) A child.
- (B) A convicted felon.
- (C) A British subject.
- (D) A current employee of the PTO.
- (E) A scientist who has assigned to his employer all rights to the invention.

31. An international application under the Patent Cooperation Treaty (PCT), which designated the United States, was filed on November 1, 1996. The application claimed priority of a prior French national application filed on December 6, 1995. A copy of the international application was communicated to the United States as a designated office on June 20, 1997. A demand for international preliminary examination, in which the United States was elected, was filed on June 5, 1997. Accordingly, the thirty month period of PCT Article 39(1)(a) expired at midnight on June 6, 1998. The applicant submitted the basic national fee to enter the United States national stage on June 2, 1998. On August 3, 1998, the applicant timely submitted a translation of the international application and a declaration of the inventors in compliance with PCT regulations in reply to a Notice of Missing Requirements. Also, on August 10, 1998, the applicant timely submitted a translation of amendments under Article 19 of the PCT in reply to the Notice of Missing Requirements. On August 29, 1998, a Notice of Acceptance was mailed to the applicant. The national stage application issued as a U.S. patent on October 13, 1999. What is the effective date of the U.S. patent as a reference under 35 U.S.C. § 102(e)?

- (A) November 1, 1996.
- (B) June 2, 1998.
- (C) August 3, 1998.
- (D) August 10, 1998.
- (E) October 13, 1999.

32. A client comes to you and tells you that he has been informed by his competitor that he is infringing the competitor's patent. Your client tells you that the competitor's invention was well known in the field at the time the application for the patent was filed. Your client shows you several published articles, two United States patents, and two written statements by experts in the field which clearly support his conclusion. Upon further investigation, you find that the published articles and patents were not considered by the examiner during the prosecution of the patent application. Your client informs you that he would like to avoid litigation, and have the PTO take action to invalidate the patent. Which of the following choices would be an appropriate course of action to take on behalf of your client?

- (A) Petition the Commissioner of Patents and Trademarks to revoke the patent.
- (B) File a request and fee for reexamination of the claims in the patent relying on the published articles and the U.S. patents as the basis for reexamination, and include all statements, information, and documents required by PTO rules for initiating reexamination proceedings.
- (C) File a protest in the PTO with copies of the published articles, patents and the written statements from the experts, along with an explanation of their pertinence to the claims of the patent.
- (D) File in the PTO copies of all of the documents provided to you by your client and request that they be made of record in the patented file.
- (E) (B) and (C).

33. Ann invented an electrical signal filter for obtaining increased signal-to-noise ratios in certain electrical systems. Ann filed a first non-provisional patent application on May 1, 1997, fully disclosing and claiming one embodiment of her invention, a capacitor. The sole claim stated: “a capacitor for filtering electrical signals, comprising: a first terminal connected to a first plate; a second terminal connected to a second plate; and an electrical insulator between said first plate and said second plate.” The first application also disclosed that even better results could be obtained if the capacitor were coupled to a resistor. Ann wanted to file a second application in the future specifically claiming the combination of the capacitor and resistor. On February 1, 1999, while Ann’s first application was still pending, Ann filed a continuation application under 37 CFR § 1.53(b). The continuation application contains the following single claim: “a capacitor for filtering electrical signals, comprising: a first terminal connected to a first plate; a second terminal connected to a second plate; an electrical insulator between said first plate and said second plate; and a resistor, connected to said first terminal.” Ann received a non-final Office action wherein the claim in the continuation application was provisionally rejected under the judicially created doctrine of double patenting over the claim drawn to a capacitor in Ann’s copending first application. The rejection correctly stated that the subject matter claimed in Ann’s continuation application was fully disclosed in her copending first application and would be covered by a patent granted containing the claim in the first application. Neither application was ever assigned to anyone. The rejection may be properly overcome by a timely reply:

- (A) traversing the rejection and arguing that since the first application had not yet matured into a patent, a double patenting rejection was unfounded.
- (B) arguing that rejections of this type are no longer warranted for continuation applications, since any utility application filed on or after June 8, 1995, will expire 20 years from its filing date, and therefore Ann’s continuation application, which gets the benefit of the filing date of the first application, would expire at the same time as the first application, anyway.
- (C) arguing that the claim in the continuation application is patentably distinct and unobvious from the claim in the first application.
- (D) including a terminal disclaimer, signed by Ann, disclaiming any portion of the term of any patent granted on the continuation application beyond twenty years from May 1, 1997, and including a provision in the terminal disclaimer that any patent granted on the continuation application shall be enforceable only for and during such period that said patent is commonly owned with the first application.
- (E) including the filing of a terminal disclaimer, signed by Ann, disclaiming any portion of the term of any patent granted on the continuation application beyond twenty years from May 1, 1997.

34. Your client, Vada, disclosed the following information to you. While vacationing on a desert island, she discovered a salt lake where the water was a solution saturated with NaCl. Vada experimented with the solution and determined that it could be used to cure skin rashes if applied directly to the skin. By further experimentation, Vada determined that the best results could be obtained if the solution were first heated to an ideal temperature (T_i) equal to skin temperature (T_s) plus the square of the difference between room temperature (T_r) and skin temperature (T_s). Vada documented her findings in the form of the following equation: $T_i = T_s + (T_r - T_s)^2$. Vada further experimented and found that she could obtain the exact same solution that she discovered while vacationing, by mixing NaCl with water followed by heating the mixture to 212°F and cooling it to 80°F. You draft a patent application with a specification including all the information disclosed to you by Vada. Which, if any, of the following claims, included in the application, would provide the proper basis for a rejection pursuant to 35 U.S.C. § 101?

- (A) A composition comprising: water saturated with NaCl
- (B) A composition for restoring youth.
- (C) A composition and method for treating skin rashes, comprising: a solution of water saturated with NaCl; heating said solution to a temperature defined by skin temperature plus the square of the difference between room temperature and skin temperature; and applying said solution to skin rashes.
- (D) An expression comprising: $T_i = T_s + (T_r - T_s)^2$.
- (E) All of the above.

35. Which, if any, of the following statements is true according to PTO rules and procedure?

- (A) If a claim is cancelled by an amendment and a new claim is added in the amendment, then the new claim should be numbered using the number previously assigned to the canceled claim.
- (B) A claim which recites the best mode of carrying out the invention can only properly incorporate by reference the limitations having the essential material into the claim, for purposes of satisfying the requirements of 35 U.S.C. § 112, second paragraph, if the reference is made to a U.S. patent or U.S. patent application.
- (C) For fee calculation purposes, a multiple dependent claim which refers directly to independent claims and dependent claims will always be considered to be the number of independent claims to which direct reference is made therein.
- (D) The subject matter disclosed in a first claim which is part of the original disclosure in a nonprovisional patent application may be relied upon for purposes of enabling a second claim in the application in order to satisfy the requirements of 35 U.S.C. § 112, first paragraph, even if the detailed description and drawings, taken alone, are inadequate to satisfy the requirements of 35 U.S.C. § 112, first paragraph, with respect to the second claim.
- (E) None of the above.

36. A patent application includes a specification describing a mechanical fastener that attaches a rubber heel to the bottom of a shoe. The particular structure of the fastener allows the heel to maintain a secure attachment to the shoe while providing a cushioning effect when the shoe is worn. The specification includes a drawing clearly illustrating the fastener. The written portion of the specification accurately explains the structure of the fastener, the manner in which the fastener attaches the heel to the shoe, and how the cushioning effect is obtained. Additionally, the last paragraph of the specification states “It should be understood that the present invention is not limited to the preferred embodiment described above, and that changes may be made without departing from the spirit or scope of the invention. For example, an adhesive may be used in conjunction with the mechanical fastener to more securely attach the heel to the shoe.” No specific formulation of adhesive is given in the specification, but such adhesives are well known in the art. Claim 1 of the application reads:

1. A system for securely attaching a rubber heel to the bottom of a shoe and providing a cushioning effect when worn, said system comprising cushioning means for mechanically fastening said heel to said shoe.

Which of the following statements is correct?

- (A) Claim 1 is a “means plus function” claim subject to the provisions of 35 U.S.C. § 112, paragraph 6 and is therefore construed to cover the corresponding structure disclosed in the specification for performing the recited function and equivalent structures. Thus, claim 1 is properly construed to cover only the specific mechanical structure of the fastener described in the specification and equivalents of that mechanical structure.
- (B) Claim 1 is a “means plus function” claim subject to the provisions of 35 U.S.C. § 112, paragraph 6 and is therefore construed to cover the corresponding structure disclosed in the specification for performing the recited function and equivalent structures. Thus, claim 1 is properly construed to cover both (a) the specific mechanical structure of the fastener described in the specification and equivalents of that mechanical structure; and (b) the specific mechanical structure of the fastener described in the specification together with an adhesive and equivalents of that mechanical structure together with an adhesive.
- (C) Claim 1 is indefinite because it covers every conceivable means for achieving the stated result.
- (D) Claim 1 is not supported by an enabling specification because the claim covers every conceivable means for achieving the stated result.
- (E) Because claim 1 is drafted in means plus function language, proper claim interpretation under 35 U.S.C. § 112, paragraph 6 requires that there be a specific description in the specification of an acceptable adhesive formulation.

37. Fred files a patent application disclosing and claiming an electrical circuit. The disclosed circuit has, in series, (i) a DC current source capable of producing a variable current of 10-30 amperes, preferably 18-22 amperes; (ii) a resistor having a value in the range of 10-20 ohms, preferably 14-16 ohms; and (iii) a fixed capacitor in the range of 3-8 microfarads (mf), preferably 5-6 mf. The application includes the following four original claims:

- Claim 1. An electrical circuit comprising, in series, a DC current source, a resistor and a capacitor, wherein said DC current source is capable of producing current of 18-22 amperes, said resistor has a value in the range 10-20 ohms, and said capacitor has a value in the range of 5-6 mf.
- Claim 2. The electrical circuit of claim 1, wherein said resistor has a value in the range of 14-16 ohms.
- Claim 3. The electrical circuit of claim 1, wherein said capacitor has a value in the range of 3-8 mf.
- Claim 4. The electrical circuit of claim 1, wherein the DC current source produces variable current in the range of 18-22 amperes.

Barry's Canadian patent, published thirteen months before the effective filing date of Fred's application, discloses an electrical circuit having, in series, a DC current source which produces 20 ampere current, a 12 ohm resistor, and a 6 mf capacitor. Which of the following statements regarding the claims is correct?

- (A) Each of Claims 1- 4 is patentable over Barry's Canadian patent.
- (B) Claim 1 is unsupported by a sufficient written description because the specification does not set forth the claimed combination of component values in a single disclosed embodiment.
- (C) Claim 2 is an improper dependent claim.
- (D) Claim 3 is an improper dependent claim.
- (E) Claim 4 is an improper dependent claim.

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

- (A) A process for using monoclonal antibodies to isolate and purify interferon.
- (B) A process of using paint to cover a surface comprising applying paint to a surface and removing any excess paint.
- (C) A use of a metallic fibrous compound having a proportion of metallic granules as a motor compression part subject to stress by sliding friction.
- (D) The use of a sustained release therapeutic agent in a human body wherein said sustained release therapeutic agent comprises a painkiller absorbed on a polymeric surface.
- (E) All of the above.

39. You prepared a patent application on behalf of inventors Jo and Tommie. Jo invented a new and unobvious technique for inexpensively manufacturing a known chemical compound. Tommie invented a new and unobvious technique that uses the chemical to clean-up toxic waste spills. Both inventions have been assigned to Ace Chemical Company. The patent application fully discloses and claims both inventions. Both inventors approve the application, but Tommie is unavailable to sign an inventors' oath before an upcoming statutory bar date. In accordance with instructions, you to immediately file the application under 37 CFR §1.53(b) without an executed oath, but with an information sheet to identify the application. 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 restricting the application between Jo's invention, and Tommie's invention. In response, you elect Jo's invention, cancel the claims directed to Tommie's non-elected invention, and immediately file a divisional application directed to Tommie's invention together with an inventor's oath executed by Tommie only. The divisional application includes a specific reference to the original application. 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 the claims to Tommie's non-elected invention, 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 Ace Chemical Company is required before any change of inventorship can be made.
- (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, and the appropriate fee.

40. Which of the following factors would **not** be indicative of an experimental purpose for testing a utility invention?

- (A) Testing is conducted over a substantial period of time to determine the operativeness of the invention.
- (B) Testing is conducted under the supervision and control of the inventor.
- (C) Testing to determine product acceptance or market testing.
- (D) The nature of the invention was such that any testing had to be, to some extent, public.
- (E) The inventor regularly inspected the invention during the period of experimentation.

41. Your client has invented a miniature vacuum tube comprising a capacitor having a capacitance of 0.003 to 0.012 μf , preferably 0.006 μf . You draft a patent application directed to your client's invention and satisfying the requirements of 35 U.S.C. § 112. You draft the following independent claim:

1. A miniature vacuum tube comprising a capacitor having a capacitance of 0.003 to 0.012 μf .

Which of the following 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 miniature vacuum tube of Claim 1 wherein the capacitor has a capacitance of 0.006 μf .
- (B) 2. A miniature vacuum tube as in Claim 1 wherein the capacitor has a capacitance of 0.006 to 0.012 μf .
- (C) 2. A miniature vacuum tube as in Claim 1 wherein the capacitor has a capacitance of about 0.003 to 0.011 μf .
- (D) 2. The miniature vacuum tube of Claim 1 wherein the capacitor has a capacitance of between 0.005 and 0.012 μf .
- (E) (C) and (D).

42. A multiple dependent claim may not properly depend upon _____.

- (A) an independent claim.
- (B) another dependent claim.
- (C) any other multiple dependent claim.
- (D) a claim containing Markush language.
- (E) a claim which is in Jepson-type format.

43. In which of the following situations, considered independently of each other, does the event described below not constitute a statutory bar to the granting of a patent on an application filed August 30, 1999, claiming a bottle cap?

- (A) The inventor reduced the invention to practice in June, 1998, and sold the claimed bottle caps to a bottling company on July 30, 1998. The sale was conditioned on the bottling company's satisfaction. The inventor and the company are located in New York.
- (B) The inventor reduced the invention to practice in June, 1998, sold the claimed bottle caps to bottling companies beginning on July 30, 1998. Although the inventor sold the bottlecaps to commercially exploit his invention, the inventor's manufacturing and overhead costs exceeded his income from the sales and the inventor did not profit from the sales. The inventor and the companies are located in New York.
- (C) The inventor reduced the invention to practice in June, 1998, and on July 30, 1998, assigned to Company X his patent rights to the claimed bottle cap invention for good and valuable consideration. The inventor and Company X are located in New York.
- (D) The inventor reduced the invention to practice in June, 1998, and on July 30, 1998, the inventor offered to sell his inventory of the claimed bottle cap to a bottling company. The sale was not consummated until September 3, 1999. The inventor and the company are located in New York.
- (E) The inventor reduced the invention to practice in June, 1998, and the inventor's offer, on July 30, 1998, to sell the claimed bottle caps to a bottling company was delayed in the mail and not received by the company until September 10, 1998. The inventor and the company are located in New York.

44. G is the sole inventor in a patent application filed in the PTO describing and claiming a surgical instrument. H is the sole inventor in a patent application filed in the PTO describing G's surgical instrument, as well as describing and claiming a modified embodiment of G's surgical instrument. Following proper PTO practices and procedures, under which circumstance is it most likely that you will need to overcome a provisional 35 U.S.C. § 102(e)/103 rejection in G's application?

- (A) G's application is filed in the PTO before H's application, and they do not have a common assignee.
- (B) H's application is filed in the PTO before G's application, and they do not have a common assignee.
- (C) G's application is filed in the PTO on the same date as H's application, and they have a common assignee.
- (D) G's application is filed in the PTO after H's application, and they have a common assignee.
- (E) G's application is filed in the PTO before H's application, and they have a common assignee.

45. You have been asked to draft a patent application based on Figures 1 and 2 provided below. The inventor has provided you with a written disclosure which states that the invention is directed to a toy building element which may be mounted as a dump body on a toy vehicle. According to the inventor's description, the toy building element comprises an open container part and a bottom, said container part and bottom being hingedly interconnected, said bottom being moreover provided with coupling means for coupling with other toy elements. Referring to Figure 1, the inventor's description states that the toy building element (1), which is just called a dump body, consists of two parts which are interconnected via a hinge (2) viz a container part (3) and a bottom (4). The written description further provides that the container part (3) is formed by an upwardly open, box-like unit having a substantially square bottom and four side walls, one of which is considerably lower than the others. In the embodiment shown, the bottom of the container is provided with coupling studs (5) on which toy building elements may be coupled. As described by the inventor, the bottom (4), which is square in its base face, has a plane surface on which the container part (3) rests along its entire circumference when it is tilted down. The surface of the bottom (4) may be provided with well-known means for detachably retaining (not shown) the container part (3) so that "it just takes a small force to tilt the container part." Referring to Figure 2, the inventor's description states "Figure 2 shows the dump body (1) mounted to tilt rearwardly on a toy truck (6), which comprises a bottom (7), wheels (8), and a driver's cab (9)." It is further provided that "on the chassis at the rear end of the truck (6), the truck bottom (7) is equipped with a square, plane face provided with well-known coupling means (not shown) which meet with the well-known coupling means (not shown) positioned on the underside of the bottom (4) of the dump body (1).

Based on the drawings and description provided above, which of the following claims, if any, are in accordance with proper PTO practice and procedure?

- (A) A toy building element for use as a dump body (1) for a toy vehicle, said toy building element comprising an open container part (3) and a bottom (4).
- (B) A toy building element for use as a dump body (1) for a toy vehicle, said toy building element comprising an open container part (3) and a bottom (4), said container part (3) and bottom (4) being hingedly interconnected by a hinge (2).
- (C) A toy building element comprising an open container part and a bottom, said open container part and bottom being hingedly interconnected, said bottom being provided with coupling means for coupling with other toy building elements.
- (D) (A), and (B).
- (E) (A), (B), and (C).

46. On June 22, 1999, you receive a final Office action, dated June 17, 1999, rejecting numerous claims in a patent application that you filed in the PTO. The Office action did not set a shortened statutory period for reply. Following proper PTO practices and procedures, under which circumstances is it most likely your submission of new evidence under 37 CFR § 1.129(a) in support of patentability, along with the appropriate fee, will result in the automatic withdrawal of the finality of the final rejection?

- (A) The application is filed on June 8, 1995, it has an effective filing date of June 8, 1993, and you file the submission on October 14, 1999, one month after you file a Notice of Appeal to the Board of Patent Appeals and Interferences.
- (B) The application is filed on June 7, 1995, it has an effective filing date of June 8, 1993, and you file the submission on October 14, 1999, one month after you file an appeal brief to the Board of Patent Appeals and Interferences.
- (C) The application is filed on June 8, 1995, it has an effective filing date of June 7, 1993, and you file the submission on December 20, 1999.
- (D) The application is filed on June 7, 1995, it has an effective filing date of June 7, 1993, and you file the submission on the same day you file an appeal brief to the Board of Patent Appeals and Interferences.
- (E) (A) and (C).

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

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

48. Which of the following statements is in accordance with proper PTO practice and procedure?

- (A) A claim to a computer which recites that various components, such as motherboard and RAM, which are old in the art, as well as a novel disc drive, is unpatentable under 35 U.S.C. § 102(f) inasmuch as the inventor derived one or more components, and did not himself invent each of the components of the claimed computer.
- (B) Where a patent granted to Able discloses subject matter being claimed in an application filed by Baker undergoing examination, the designation of Able as the sole inventor in Able's patent raises a presumption of inventorship with respect to the subject matter disclosed but not claimed in the patent.
- (C) A terminal disclaimer overcomes a rejection under 35 U.S.C. § 102(e).
- (D) When Able's patent application, filed on June 2, 1999, is rejected based on unclaimed subject matter of a patent granted to Smith on July 6, 1999, on Smith's application filed on February 18, 1997, and the unclaimed subject matter is Able's own invention, Able may overcome a prima facie case by showing that the patent discloses Able's own previous work.
- (E) All of the above.

49. In preparing an application claiming only apparatus to be filed in the PTO, you inadvertently forgot to include a figure in the drawings. While, you did include a brief description of the figure in the written description of the invention in the specification nevertheless the invention of Claim 10 cannot be understood without the omitted figure in the drawings. Only after the application had been filed in the PTO did you realize that the figure was omitted. The application as filed included a proper declaration under 37 CFR § 1.63 signed by the inventor. What document(s), if any, must be filed in the PTO to obtain the original filing date in accordance with proper PTO practice and procedure?

- (A) An amendment deleting the description of the figure and Claim 10, and a petition with the proper fee to have the application accepted without the omitted figure.
- (B) An amendment filed before the first Office action deleting all references to the omitted figure and Claim 10 to have the application accepted without the omitted figure.
- (C) A petition and an amendment to add the figure to the application as soon as possible, and a supplemental declaration stating the omitted figure accurately illustrates and is part of the applicant's invention.
- (D) The omitted figure along with a supplemental oath or declaration stating that the omitted figure accurately illustrates and is part of the applicant's invention.
- (E) An amendment adding the figure to the application.

50. Prior art references have been combined to show obviousness of the claimed invention under 35 U.S.C. § 103. Which of the following most correctly completes the statement: “In establishing obviousness, _____

- (A) a suggestion to modify the art must be expressly stated in one of the references used to show obviousness.”
- (B) a suggestion to modify the art must be expressly stated in all the references used to show obviousness.”
- (C) a suggestion to modify the art may be inherently or implicitly taught in one of the references used to show obviousness.”
- (D) a suggestion to modify the art is unnecessary unless the patent applicant presents evidence or argument tending to show unobviousness.”
- (E) a suggestion to modify the art can come from recent nonanalogous prior art references.”

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