

Analysis of PTO April 2000 Exam, By John M. White for the PLI Patent Bar Review

General Commentary:

The Exam was formatted to be two 27 page 50 question sections divided into AM and PM. The length was not excessive as compared with some years past, but it seemed, as I went through the exam, that it was long. I would suggest simply that more than one question be asked off of the same fact patterns where possible more often than is presently the case.

The distribution of subject matter was historically the same. I had received comments that there were a number of reissue, reexam, and interference questions. I didn't see them, or at least I didn't identify them with those labels. No more than two each on my count. There did seem to be a number of ethics questions, more than in the past anyway.

The few questions which I find truly appealable are AM # 16, and PM # 27. Another potentially appealable question is AM #20. There are other questions which have ambiguity, but I am not a prophet of false hope on the Appeal front. If you can develop other arguments from my suggestions and comments, good for you and I hope you are successful. It is true that the rate of Appeal success for the October 99 exam was high, but that doesn't necessarily translate for this exam. My usual recommendation is that you have a solid chance to bring up a 67, 68, or 69 to the passing mark of 70. Beyond that threshold, it is tougher and tougher to succeed on Appeal, and my advice is to focus the effort on the next round of the exam.

Be wary of other analyses of this exam which identify wholesale lots of questions as faulty. They aren't. One analyses has 18 question identified as appealable. If that's true, which it isn't, then along with the two questions the PTO itself tossed out, 20% of the exam is composed of bad questions! I have every exam back to 1974. The rate of bad questions is about 4-5 for each exam. The PTO tosses 2-3 themselves, and a careful analysis gives 1, 2, or 3 more. That's it. The bad question rate is then, historically, about 5%. So, for this test, if you count the two questions the PTO tossed out, you should reasonably find another 2-3, which is my count. But if you find other analyses useful and can work those suggestions into solid appeal arguments, good. My mission, as always, is to assist you in passing. But don't get worked into a frenzy with false hope! Good luck.

The following question by question analysis is intended to be reviewed in conjunction with a copy of the exam (obviously!) and a copy of the Patent Office model answers in hand.

Morning Session:

1. This question is directed to an understanding of “anticipation” under 35 USC 102. If a prior art reference discloses every feature or limitation of the invention, either explicitly or implicitly, then the reference is an anticipation. There was no “trick” to the question except that it had to be read carefully so as to be certain a full anticipation had been disclosed. It had. So the answer A) was pretty straightforward.
2. A certificate of correction is for typos and minor errors on your part or on the part of the PTO that occur during the prosecution of a patent. B) is obviously wrong under this standard, the others are more tricky. A) talks about including a forgotten reference to a prior co-pending application, that was already referenced in the file. Probably okay, no harm done. C) is more obviously okay since somehow the error in identifying seems to have crept into the file. D) is the one which you just have to remember from the course materials. When all is said and done in correcting inventorship in an issued patent, the document which ultimately notifies the public of this fact is a Cert. of Correction prepared and filed at the same time as the rest of the papers for correcting inventorship under 37 CFR 1.324. So E) is correct since it sweeps in A), C), and D).
3. Straight from the statute (112) and rules (1.75). Easy. E) is correct since it pulls in B) and D).
4. The old, old, standard question to catch you out on the issue of “on sale bar” under 102(b). An assignment or sale of the “rights” to an invention is not the same as the sale of “thing” that is the subject matter of the claims. C) is the obvious answer. B) and D) are each directed to a non-existent exception that somehow a “private” sale might not count as being “on sale” under the 102 bar. E) is flat out bizarre.
5. These are the questions that can drive you over the edge. You’ve got to carefully and thoroughly compare each answer with the respective clause in the claim and then determine if any rule has been broken. Tedious. A) improperly expands the range of the first clause of the claim. B) is okay because the “first gas” is introduced with the phrase “comprising” which can have more stuff added later. C) is no good because the “second gas” is introduced with “consisting” (which I told you to always be suspicious of) and therefore cannot have anything else added. D) uses exemplary language (such as, for example, etc.). E) is not a Markush group. It is, however, limited by the term “consisting” which introduces the “second gas”.
6. Product by process. They rarely show up in real life, but are routinely asked about on the exam. This is a “Sherlock” question. Eliminate the obviously wrong answers and whatever is left is correct. A) and B) are obviously wrong. C) seems strange, but not clearly wrong. D) is the classic incorrect use of a product-by-

- process claim whereby what you really want to patent is the “process” but make a mistake and write a product-by-process claim. E) is wrong because it is too restrictive. It is usually the case that you end up using product-by-process because that is all you’re left with. But it is not true to say that that is the only time it is available to you. It is by definition a claim by inference (ie, product defined by a process) so it is unwieldy, but you can use it if you want. This analysis leaves C) as correct, and points out yet another reason why product-by-process claims should be avoided if possible.
7. Another tedious claim crunching question. A clause by clause comparison is the only way through. This is an “antecedent” question more than anything else. In the second line of clause (iv) of claim 1, “said mid-point” appears. Checking backwards through the proposed answers, D) falls for that reason. Answers A) and E) fall because they don’t supply “a connector”, for later Claim 3. This leaves a choice between B) and C), and you’ve got to choose the “broad one”. The “broad” claim is the one having the fewest limitations, hence B) wins because it lacks the “reservoir” of C).
 8. The two month rule in action! How exciting, plus a mailing date in February, on the leap day! Wow, they’ve rolled it all into one! Count 3 months from your mailing date and you have May 29. Since that is a holiday, the next day is okay too. You also filed your Notice of Appeal, which gets you two months, or the end of the initial response period, whichever is later. So May 30 is still the winner at this point. The two month rule yields the mailing date of the Advisory Action as another possible response date, which is the winner, May 31, 2000. So D) wins the day. Any date later than that requires some form of extension, which is disallowed by the question.
 9. The restriction question. You absolutely must make an election. Repeat that ten times. I and III are no good because of that simple rule. II is no good because you didn’t point out any reasons why the restriction was no good. IV is all you’re left with, which corresponds to answer D). This answer both points out the reasons why the traverse is being made and elects.
 10. Remember, an inventor cannot defeat himself within the one year time period, so the article is no good on that basis regardless of where it published or how enabling it was or wasn’t. Mario simply has to establish that the article was his work.
 11. There is now no difference between NAFTA and WTO countries, the dates in the facts are too late to identify any distinctions between the countries. So Mario can rely on all of it, so E) is the answer.
 12. This question would only trip you up if you’ve been practicing for awhile already. Verification statements used to be a part of daily practice, now they are not.

13. This is the “predictable” vs “unpredictable” issue developed in MPEP 2100. If the art is unpredictable, more specific disclosure is necessary to support the claims. Here A) is the answer because it properly says the rejection is appropriate and gives the relevant reasons. B) simply doesn’t give the right reason, and creates facts not in the question. C) – E) are wrong because they indicate the rejection is inappropriate.
14. Laurel & Hardy and Abbot + Costello couldn’t find the patent office let alone make an invention! However, if we wade through the PTO humor, we find that all of the inventors contributed to the subject matter of claim 2 and thusly all of them must sign the affidavit. Claim 2 is claim 1 plus another limitation because it depends from claim 1. Hence, all of the inventors are necessary, the owner, Burns, is not. Answer B) is the choice.
15. A gift. The answer would’ve been A) if it hadn’t been messed up with the Affidavit stuff. Sal wasn’t in the country so he couldn’t swear to anything prior to April 10. In fact, we don’t know where Sal was between the time he left Vietnam and when he returned stateside. Sal may not know either!
16. What a mess! This should’ve been a gift as well! Let’s work through it. Your specification doesn’t support claim 9. Claim 10 depends from an unsupported claim, and claim 11 expands claim 10, from which it depends. All of these claims are pure junk! I would contest the PTO assertion that “claim 9, though broad, is supported”. It flatly isn’t. It says so right in the question, ie, “there is no disclosure of a minimum amount of RAM”. Well, if that is true, then you can’t have a limitation to that effect in a claim. Period. End of story. 112, first paragraph says so. And, I don’t care what they say in their answers, both 112, and CFR 1.75, state quite clearly and absolutely that a dependent claim includes all the limitations of the claim from which it depends. That is, “the sins of parent are visited upon the child”. That is, a dependent claim cannot be any better, ever, than the claim from which it depends, so claim 10 is no good either. Answer C) is correct.
17. This question ought to be up for grabs too. It is a repeat from a few years ago. I don’t like it any better this time. Negative limitations are almost never a good idea. Claim something by what it is, not by what it is not. B) is really the only correct answer. C) is a bad idea. But since they accepted the negative limitation last time they asked this question, they’ll accept it this time as well.
18. Unusual question for the PTO. Fortunately the answer was obvious. D) jumps out as the answer clearly against any kind of policy in favor of the public. Also, strictly speaking, D) makes no sense. How can you extend an effective term if you start the process late and the term only begins when you actually obtain the patent? You’d have no idea of how you effected the term. See, it still makes no sense.

19. Answer B) is the best of the lot. You've received an "objection" not a "rejection" so you're not going to appeal anything. That gets rid of A) and C). D) is filed after the six month period, so it is no good. That leaves you B), which is correct.
20. Garden variety extension question. No tricks, except that the PTO is acting with lightening like speed! Subsequent actions are calculated from the expiration of the three month period. However, the expiration of that period is calculated from the original mailing date. For example, a 3 month response period set by a mailing date of April 4. Response due July 4, but we know that will roll to the next day of business at the PTO. All of the things transpire that the PTO says, ie, quick reply etc., and you reply August 5 with your next response. How much do you pay for? Answer: Two months. It is calculated based on the original mailing date and its imaginary expiration date, July 4, not the actual date you could've replied which was some date after July 4. So even with the direct quote from the MPEP in the PTO answers, there is, as always, plenty of room for ambiguity. I would say D) is as good as E) in view of the forgoing example.
21. Straight from my 2100 practice exam! The abstract may not be used to determine "the broadest reasonable interpretation" of a claim. Answer B).
22. Classic application of a 1.131 affidavit. 102a) and 102e) are the targets, so I and IV qualify, which makes E) the answer.
23. Typical restriction follow up factual scenario. Two inventors with separate contributions, and only one is left after restriction. Rule 48 comes into play. Leaving the one inventor off in the original cover sheet is harmless if followed up by the filing of a proper oath (48(f)). Rule 48 and the ACE rule bring you to the right answer, which is C).
24. All of the statements are obviously wrong so E) is your answer. Remember that the restriction requirement eliminates the possibility of a double patenting rejection.
25. Act quickly, otherwise the statutory bar (102b) will overtake any remaining opportunity! E) is all you've got left.
26. This is a toughie with lots of little ambiguities. A) seems to imply that the filing of a patent application, ie, a "constructive reduction to practice", may not be enough to establish an "actual reduction to practice". Well that's true. But you can still have a winning date of reduction to practice without the "actual reduction" having occurred. If "Constructive reduction" is sufficient to secure a filing date, why would you need to try and prove the other? Hmmmmm? B) is clearly wrong. C) is true, but there is more to the answer. The corollary, ie, to have an actual reduction, it has to be successfully performed, is not true. So confusion might pop up on that point. I wouldn't have chosen D) or E) because

no one, not even the PTO or the CAFC, can tell you what diligence is absent a whole bunch of facts.

27. Not a very good answer, but acceptable. A), B), and D) rely on the well established wrong headed principle that intended use makes any difference at all. It doesn't, unless of course it is a method claim. Which this isn't. E) has no facts to support it. You're left with C).
28. Both i) and ii) are true (ii being a repeat issue from 1997 and 1998). Iii) is false because the "issue" date (and whether it will even occur) is unknown during the examination process. Right? Come on, you knew that, and you didn't mistake issue date for filing date? Right? So B) is correct.
29. You're doomed. Don't file express abandonments unless you really have to. Let things die in the ordinary course of events. It gives people time to truly consider their positions.
30. Tricky, tricky, tricky. Hair splitting at its best. I didn't pick up on the issue of two separate "effective amount" definitions until the third reading of the facts. Given that is the case, the claim isn't clear until you clearly define which definition you're after. So III is the only possibility.
31. Answer D) simply states the standard under 35 USC 103 for combining references. Know the rule, know the answer.
32. B) is truly an odd way of expressing common sense. It is, none-the-less, correct. That is, if the combination teaches away from what you've got, it is not a good 103 rejection.
33. This application is eligible for the longer of 17 years from issue or 20 years from its earliest effective filing date. The time from filing to issue is less than three years (even with an appeal included, which defies belief). So the applicant will go for the 20 years from filing, which is June 8, 1994 plus 20 years, which is June 8, 2014, regardless of what day of the week that may occur on. Answer B).
34. Again, tricky. Sherlock leads you to this answer. A) is incorrect since it seems that the rejection is supported and no doubt has been cast upon it. B) seems right, but remember it was printed and available to someone, even if that someone included only those with a "classified" clearance. C) doesn't seem right, but D) is wrong because 102b doesn't come into play, and we don't have any facts to assess E). So C) must be it even if it doesn't seem right. Sherlock prevails here, but only just. This may have also been a save and look up.
35. A) is not right all the time. B) is unappealing, but correct. C) is stupid because everything the PTO offers in a rejection is hearsay (strictly speaking)! D) doesn't

- have sufficient factual support in the question, and E) is bizarre since you'd be proving up facts to defeat yourself.
36. Ah, the predictable age, environment, illness, or energy "make special for free" question. The qualifying age is 65, so B) is the answer. (65 isn't old, the law should really be changed! Right?)
 37. I love the rigorous technical stuff on this test, to wit, "the doodad"! According to the facts A) can work. B) is inoperative because D is present with G. C) is no good because it is the same as a claim already present. D) is an improper multiple dependent claim. E) is a bizarre attempt to depend a claim from claims which will follow it.
 38. This is a common sense question. The only answers to consider are A) and B). The rest of the answers don't make much sense. B) is no good because it just seems reasonable that if you insistently rely on a limitation in a claim by argument, you'll be stuck with it, regardless of whether you added it to avoid a reference or not. It is the same result. You argued that the limitation, present originally, or by amendment, had to be in the claim. I'd say you're stuck, and so does the answer. So A) is correct.
 39. C) is the best answer, although B) will likely also get you into trouble.
 40. E) is correct, but the statement seems to infer that you can broaden in a reexam. You cannot. But that confusing inference is my only objection.
 41. Kind of confusing and entertaining. You have deceased and unavailable inventors. Rule 47 takes care of both. An inventor can only sign for someone missing, not dead. So Seya can sign for Mae, not Bea, so D) is wrong. B) is wrong since an assignment doesn't eliminate the need for signatures. A) seems to indicate that the administrator shall sign for everyone, but that is not the case if you read the facts carefully. C) seems almost complete, but lacks obtaining a signature for Bea. So combine all these facts and you end up with A) and C), which is E).
 42. Under 102a an inventor cannot undermine themselves. Hence, E) is your choice. A) is an admission. B) becomes a publication as of the date the patent issues. C) does likewise. D) is okay since you can, contrary to most views, have a two or three reference 102 rejection, but only where the secondary references are used to define or explain terms in a single primary reference.
 43. You're doomed. Having a good docketing system and other practitioners working with you are your only defense.
 44. Don't lie, cheat, or steal, and don't do anything unarguably stupid so as to prejudice your client's position or your capacity to represent them. That's the

- PTO code of conduct. A) is cheating. B) is perhaps not a good thing, but that is arguable. C) is lying. D) prejudices your capacity to represent. E) is a combination of stealing and stupidity.
45. Our friend Markush. Soooooo easy! B) is obviously correct if you paid attention to what I told you in class. A) uses “or” instead of “and”. C) uses comprising. D) uses comprising. E) couples the “is” version incorrectly with “and”. In that version, it should be “or”. Sooooooooo eeeeeeezy! A gift really.
 46. A) is the answer because Reissue now does not permit the five word rule for handwritten entries. It is all by re-write now. Same as for reexam.
 47. The rule is “any person at any time”, so even while litigating is okay. Of course, you may make the Judge want to treat you badly in a major way, but they may do that anyway!
 48. C) you and your client have the duty. Is it usually the case, however, that the practitioner discharges the duty by making the actual written disclosure in the form of an IDS.
 49. A) is clearly false. You don’t have to engage in unlawful conduct at the request of your client.
 50. You’re doomed. 102b finishes you off. You have no evidence to support the experimental use exception and you filed on Tuesday the 8th, not Monday the 7th when you should’ve filed. You’re doomed. E) is your answer. Depart the country at the earliest opportunity! (Just kidding).

AFTERNOON SESSION

1. D) is the answer. The success may have been due to the brand and not the invention. After all, we all know that we’d buy anything SONY, right?
2. Tough to work through each alternative and its implications. If you do, however, E) pops out as the only truly “true” statement.
3. Odd start to the question. 100, what? D) is obviously true, so I picked that one. B) seems to be on the edge of truth because of the ambiguity of actual filing date as compared to “effective filing date”.
4. A tedious antecedent test. Go over it line by line, compare carefully, and mark all the “saids” which you have to deal with and you’re done. In this case, that leads to D).

5. Beverly's thesis is prior art as of the date it's indexed according to subject, which is, January 29, 1999. For it to be 102(b) art it cannot be used until one year has passed. That date would be January 30, 2000. Both B) and C) are after that magic date so E) is correct.
6. Clearly, the question writer hasn't practiced very long before the PTO. This answer has a "snowball's chance" of succeeding in the real world. Happily, this exam is not the real world, and answer C) wins the day.
7. Answer A) is obviously correct. The rest of the answers rise to the "ARE YOU CRAZY" level of choice. Conflicts are conflicts, at the Patent Office as in any law practice.
8. This question has appeared on every exam since 1997. If you don't get this right it means you haven't looked at any of the last four exams. You cannot broaden in a reexam. Repeat, you cannot broaden in a reexam.
9. The two-month rule is in play. If you can recite the rule then this question is automatically answered. The answer is that all subsequent extensions beyond the initial expiration of the three-month period are calculated from the mailing date of the advisory action, if the advisory action is mailed after the end of the three-month period. Hence, answer C) is correct.
10. Once the reexamination process starts, nothing can stop it. If you stop participating, a reexam certificate reflecting the state of the claims when you stopped participating will duly issue. In this case, the client can do nothing further and likewise the attorney does nothing further and a certificate issues. Answer B) follows this explanation.
11. A) is funny. B) is the classic error that cannot be fixed by a reissue. C) is funny. D) is bizarre. And they are all wrong. Hence, the answer is E).
12. Patent Office humor at its finest - Clem and Tine and a love story gone bad. Clem can file his own application identifying both he and Tine as inventors, and he can sign for Tine if she won't cooperate (and she won't in these facts). Additionally, Clem should do something about Tine and her lying ways. Hence, the protest. This makes E) your answer.
13. Ah, the claim counting question. Use the circles and the boxes and you come up with answer D).
14. What matters in an Express Mail scenario is what the Post Office stamped with the "date in" and that the Express Mail label was attached to what was stamped. Everything else is surplusage. Hence, B) doesn't matter because what the secretary did with a first class mail envelope flatly doesn't matter.

15. This question is straight out of the MPEP multiple dependent claim preamble examples. They are all acceptable because they are all expressed with the implication of a singular alternative format.
16. This is a tricky topic. My view is that B) is the most correct answer, but C) is a very close second. A) and D) make no sense.
17. In order to prevail in terms of priority, Debbie must show that she was diligent from a time before the date of invention by the other (May 15, 1999 and Billie) until her actual reduction to practice (June 1999). The only answer to follow these requirements is B).
18. The lesson of this question is that arguments of the practitioner are given no weight, unless bolstered by probative evidence. Hence, E) is the answer.
19. It may not be fair, but the views of a District Court are only binding when they conclude that a patent is invalid. If they find a patent to be valid, the Patent Office can determine the opposite later on, even on the same evidence. The reason for this is that there are different standards of review in place for the District Court as opposed to the Patent Office during a reexamination. The answer is B).
20. This is so predictable. A response date of Christmas Day. I told you, you had to know that July 4th and Christmas Day were holidays, that's it on the holiday front. This is a real world scenario; the Patent Office will only reset the period if they have made a mistake in a citation, not in their technical opinion. Hence, C) is the only correct answer.
21. A rare application of 102(f). Roberts is not an inventor, he is a copier.
22. You're doomed. Get this Express Mail procedure, and get it right! Your malpractice rates will depend on it. The "date in" is the date stamped, not the actual date on which it was improperly dropped off. Hence, you are a day late (and presumably, a dollar short).
23. Windshield wipers and patents go together like peas and carrots. Chris shouldn't have done what he did when he simply left his device at Ajax. He has to act quickly before Ajax's testing of their own version of his invention blocks him from obtaining a patent. 102(b) gives him one year from the date of their public use in September 1998 to file his application. C) follows this rationale.
24. Adam must proceed to the CAFC. This option is not among the alternatives so none of them are any good.

25. The answer here is that an officer of the assignee can revoke your authority, and no one else. The only alternative that works is B).
26. Ah, a claim amendment question. Answer A) is astoundingly simple to identify and choose as correct. B) does not fix the improper dependency. C) does not fix the dependency either and lacks the phrase (Amended). D) is improper amendment format and adds subject matter not previously mentioned in the spec. E) replaces claim 3 with claim 3, an automatic mistake.
27. This is appealable if you chose A) and got it wrong. On the test, “steam” only appears once on line 4 of claim 1. As a result, A) and B) are equally good. C) is really not too bad because the standard is “sufficient specificity” not perfection. D) violates the five word rule. E) makes no sense. I think A) and B) are equally good, and C) is very close and should also be considered a correct answer.
28. A), C), and D) are all clearly wrong, I would have to look up B). But E) is so clearly correct, that I wouldn’t bother looking up B) anyway.
29. This is tricky, but A) is the best answer. The trick is to know that 102(d) requires that the rights have been granted, not that anything in particular has necessarily been published.
30. B) obviously is the only correct answer. It is laughable to think you could fax a reexam or a new national application to the Patent Office. Also, these were listed among the “no fax” exceptions in the three ring binder.
31. This question almost mimics an example question that I wrote for the 2100 practice exam. E) is the answer because it expands a range of a claim from which it depends.
32. A new use of an old composition is always patentable. In this case, the new use is a method of fishing using a known material as the lure. C) is the answer that corresponds to these requirements.
33. You cannot have alternative language in a claim. Such language makes the claim indefinite. A) is the only answer according to this limitation.
34. This is soooooo eeeeeezzzzzzy. Not only is this a repeat (a word for word repeat), but it also tests the July 4th is a holiday set of facts. C) is the obvious answer.
35. B) is the laughable and correct answer, because it is obviously false. It suggests that subject matter of a design application does not have to be shown in the drawings.

36. Awful but true, the Patent Office can throw you off the Register at any time if you don't tell them where you are by responding to the letters they send you. The true statement is B).
37. Do nothing. Isn't that a great course of action? In this case, it is the correct thing to do because you do not have instructions from your client to do anything substantive, and the request for extension of time is retroactive and can be done later when you do have instructions.
38. A different inventive entity simply means that the same identical people are not present in each application. If even one name is different, or left off, it is a different inventive entity. So B) is correct.
39. You must have on file your intent to broaden claims in a reissue within two years of the issue date of the original patent. If you do, the argument of "how broad" can proceed in the full course of prosecution, no matter how long it takes after the two year period has passed.
40. To further demonstrate that this exam is not reality, we have a question about when the Commissioner will refund money. The short answer – almost never! The accurate answer is when a mistake has been made and you've paid or been charged too much.
41. It is unclear to me why A) is the answer. I suppose it is because Monday, May 3rd, is the soonest you can file the application after the expiration of the one year bar period on Sunday, May 2nd.
42. Follow the formula for identifying a method claim. The formula is: preamble identifies a destination, followed by active "ing" words which take you to that destination. Both A) and B) qualify, so the answer is E).
43. Do not lie, cheat, or steal. A) is not allowed. B) is lying. C) is cheating. D) is OK. E) is lying and cheating. Hence, D) is the answer.
44. Sherlock leads you to this answer. Even if I don't understand what A) says, it must be right because Sherlock eliminates answers B), C), D) and E). A careful reading of A) reveals it as common sense.
45. You can never add new matter. Ever. Not even in a reissue. You're stuck with the mistake and there is no cure.
46. An independent inventor is an independent inventor. Period. Only A) qualifies.
47. A) is the obviously correct answer.

48. I am surprised by this question because 103 is a fairly subjective and pliant area of interpretation. It seems to me that B) and C) are at least partly correct and D) is just slightly better, but given that you choose the most correct answer, D) qualifies.
49. This is a repeat question. No overlap for copendency exists between application E and any of the others. Sadly, the earliest date that application E receives is its own filing date of July 22, 1999, which is answer E).
50. A gift. C) and D) are quite obviously false. A), B), and E) are at least partly true. So you get credit for all of them.