

Test Number 100
Test Series 123

Name _____

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

APRIL 12, 2000

Morning Session (50 Points)

Time: 3 Hours

DIRECTIONS

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

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

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

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

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO

This examination does not address or test any changes to the Patent Statute brought about by the enactment of the American Inventors Protection Act of 1999, Pub. L. No. 106-113 (“Act”). Accordingly, do not read the questions or answers as involving or being affected by the Act.

1. The claimed invention in a patent application is directed to an explosive composition “comprising 60-90% solid ammonium nitrate, and 10-40% water-in-oil in which sufficient aeration is entrapped to enhance sensitivity to a substantial degree.” The application discloses that the explosive requires both fuel (the ammonium nitrate), and oxygen to “sensitize the composition.” A prior art reference, published more than two years before the effective filing date of the application, discloses explosive compositions containing water-in-oil emulsions having identical ingredients to those claimed, in ranges overlapping with the claimed composition. The only element of the claim not recited in the reference is “sufficient aeration entrapped to enhance sensitivity to a substantial degree.” The reference does not recognize that sufficient aeration sensitizes the fuel to a substantial degree. However, in fact, “sufficient aeration” is necessarily an inherent element in the prior art blasting composition within the overlapping ranges inasmuch as the blasting composition explodes. The prior art reference:

- (A) anticipates the claim because it discloses every limitation of the claim either explicitly or inherently.
- (B) does not anticipate the claim because the prior art reference does not recognize an inherent property.
- (C) does not anticipate the claim because the prior art reference does not recognize an inherent function of oxygen.
- (D) does not anticipate the claim because the prior art reference does not recognize an inherent ingredient, oxygen.
- (E) (B), (C) and (D).

2. A Certificate of Correction effectuates correction of an issued patent where:

- (A) Through error and without deceptive intent, there is a failure to make reference to a prior copending application according to 37 C.F.R. § 1.78, and the failure does not otherwise affect what is claimed, but the prior copending application is referenced in the record of the application, and a petition under 37 C.F.R. § 1.324 and appropriate fees were filed.
- (B) Through error and without deceptive intent, a preferred embodiment that materially affects the scope of the patent was omitted in the original disclosure in the filed application, and a petition under 37 C.F.R. § 1.324 and appropriate fees were filed.
- (C) Through error and without deceptive intent, a prior copending application is incorrectly referenced in the application, the incorrect reference does not otherwise affect the claimed subject matter, and the prior copending application is correctly identified elsewhere in the application file, and a petition under 37 C.F.R. § 1.324 and appropriate fees were filed.
- (D) Through error and without deceptive intent, an inventor’s name is omitted from an issued patent, a petition under 37 C.F.R. § 1.324 and appropriate fees were filed, and the petition was granted.
- (E) (A), (C) and (D).

3. A multiple dependent claim:

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

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

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

5. A patent application includes the following Claim 1:

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

- (i) heating a base made of carbon to a first temperature in the range of 1875°C to 1925°C;
- (ii) passing a first gas over said heated base, said first gas comprising a mixture of hydrogen, 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 1800°C to 2000°C.
- (B) Claim 3. The method of claim 1, wherein said first gas further comprises an inert gas.
- (C) Claim 4. The method of claim 1, wherein said second gas further comprises Argon.
- (D) Claim 5. The method of claim 1, wherein said first gas is an inert gas such as Argon.
- (E) Claim 6. The method of claim 1, wherein said second gas consists of a mixture of hydrogen, SiCl₄ and AlCl₃ only.

6. Which of the following statements is **true** regarding a product-by-process claim?

- (A) Product-by-process claims cannot vary in scope from each other.
- (B) Product-by-process claims may only be used in chemical cases.
- (C) A lesser burden of proof may be required to make out a case of prima facie obviousness for product-by-process claims than is required to make out a prima facie case of obviousness when the product is claimed in the conventional fashion.
- (D) It is proper to use product-by-process claims only when the process is patentable.
- (E) It is proper to use product-by-process claims only when the product is incapable of description in the conventional fashion.

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

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

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

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

8. Applicant received a Final Rejection with a mail date of Tuesday, February 29, 2000. The Final Rejection set a 3 month shortened statutory period for reply. Applicant files an Amendment and a Notice of Appeal on Monday, March 27, 2000. The examiner indicates in an Advisory Action that the Amendment will be entered for appeal purposes, and how the individual rejection(s) set forth in the final Office action will be used to reject any added or amended claim(s). The mail date of the examiner's Advisory Action is Wednesday, May 31, 2000. Which of the following dates is the last date for filing a Brief on Appeal without an extension of time?

- (A) Saturday, May 27, 2000.
- (B) Monday, May 29, 2000 (a Federal holiday, Memorial Day).
- (C) Tuesday, May 30, 2000.
- (D) Wednesday, May 31, 2000.
- (E) Tuesday, August 29, 2000.

9. A non-final Office action contains, among other things, a restriction requirement between two groups of claims, (Group 1 and Group 2). Which of the following, if included in a timely reply under 37 C.F.R. § 1.111, preserves applicant's right to petition the Commissioner to review the restriction requirement?

- I. Applicant's entire reply to the restriction requirement is: "The examiner erred in distinguishing between Group 1 and Group 2, and therefore the restriction requirement is respectfully traversed and no election is being made, in order that applicant's right to petition the Commissioner to review the restriction requirement is preserved."
 - II. Applicant's entire reply to the restriction requirement is: "Applicant elects Group 1 and respectfully traverses the restriction requirement, because the examiner erred in requiring a restriction between Group 1 and Group 2."
 - III. Applicant's reply distinctly points out detailed reasons why applicant believes the examiner erred in requiring a restriction between Group 1 and Group 2, and additionally sets forth, "Applicant therefore respectfully traverses the restriction requirement and no election is being made, in order that applicant's right to petition the Commissioner to review the restriction requirement is preserved."
 - IV. Applicant's reply distinctly points out detailed reasons why applicant believes the examiner erred in requiring a restriction between Group 1 and Group 2, and additionally sets forth, "Applicant therefore respectfully traverses the restriction requirement and elects Group 2."
- (A) I.
 - (B) II.
 - (C) III.
 - (D) IV.
 - (E) None of the above.

Please answer questions 10 and 11 based on the following facts. Mario Lepieux was a member of a Canadian national hockey team touring Europe. While travelling through Germany (a WTO member country) in December 1998, Mario conceived of an aerodynamic design for a hockey helmet that offered players improved protection while reducing air resistance during skating. Upon Mario's return to Canada (a NAFTA country), he enlisted his brothers Luigi and Pepe Lepieux to help him market the product under the tradename "Wing Cap." On February 1, 1999, without Mario's knowledge or permission, Luigi anonymously published a promotional article written by Mario and fully disclosing how the Wing Cap was made and used. The promotional article was published in Moose Jaw Monthly, a regional Canadian magazine that is not distributed in the United States. The Wing Cap was first reduced to practice on March 17, 1999. A United States patent application properly naming Mario as the sole inventor was filed September 17, 1999. That application has now been rejected as being anticipated by the Moose Jaw Monthly article.

10. Which of the following statements is most correct?

- (A) The promotional article cannot be used as prior art because the Wing Cap had not been reduced to practice at the time the article appeared in the regional Canadian magazine.
- (B) The regional Canadian magazine article is not *prima facie* prior art because it was published without Mario's knowledge or permission.
- (C) The regional Canadian magazine article is not *prima facie* prior art because it appeared in a regional Canadian publication and does not evidence knowledge or use in the United States.
- (D) The promotional article in the regional Canadian magazine constituted an offer to sell that operates as an absolute bar against Mario's patent application.
- (E) Mario, as the inventor, can overcome the rejection by filing an affidavit under 37 C.F.R. § 1.132 establishing that he is the inventor, and the article describes his work.

11. Which of the following statements is most correct?

- (A) In a priority contest against another inventor, Mario can rely on his activities in Canada in establishing a date of invention.
- (B) In a priority contest against another inventor, Mario can rely on his activities in Germany in establishing a date of invention.
- (C) Mario can rely on his activities in Canada in establishing a date of invention prior to publication of the regional Canadian magazine article.
- (D) (A) and (C).
- (E) (A), (B), and (C).

12. Which of the following documents, if any, must also contain a separate verification statement?

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

13. The specification of a patent application contains limited disclosure of using antisense technology in regulating three particular genes in *E. coli* cells. The specification contains three examples, each applying antisense technology to regulating one of the three particular genes in *E. coli* cells. Despite the limited disclosure, the specification states that the “the practices of this invention are generally applicable with respect to any organism containing genetic material capable of being expressed such as bacteria, yeast, and other cellular organisms.” All of the original claims in the application are broadly directed to the application of antisense technology to any cell. No claim is directed to applying antisense technology to regulating any of the three particular genes in *E. coli* cells. The examiner rejects the claims under 35 U.S.C. § 112, first paragraph, for lack of enablement citing a publication that correctly notes antisense technology is highly unpredictable, requiring experimentation to ascertain whether the technology works in each type of cell. The publication cites the inventor’s own articles (published after the application was filed) that include examples of the inventor’s own failures to control the expressions of other genes in *E. coli* and other types of cells. The rejection is:

- (A) appropriate. The claims are not commensurate in scope with the breadth of enablement inasmuch as the working examples in the application are narrow compared to the wide breadth of the claims, the unpredictability of the technology, the high quantity of experimentation needed to practice the technology in cells other than *E. coli*.
- (B) appropriate. The claims are not commensurate in scope with the breadth of the enablement inasmuch no information is provided proving the technology is safe when applied to animal consumption.
- (C) inappropriate. The claims are commensurate in scope with the breadth of enablement inasmuch as the specification discloses that the “the practices of this invention are generally applicable with respect to any organism containing genetic material capable of being expressed.”
- (D) inappropriate. The claims are commensurate in scope with the breadth of enablement inasmuch as the claims are original, and therefore are self-supporting.
- (E) inappropriate. The claims are commensurate in scope with the breadth of the enablement inasmuch as the inventor is not required to theorize or explain why the failures reported in the article occurred.

14. On August 7, 1997, practitioner Costello filed a patent application identifying Laurel, Abbot, and Hardy as inventors. Each named inventor assigned his patent rights to Burns just prior to the application being filed. Laurel and Abbot, alone, jointly invented the subject matter of independent claim 1 in the application. Hardy contributed to inventing the subject matter of claim 2. Claim 2 properly depends upon claim 1. The examiner rejected claim 1 and claim 2 under 35 U.S.C. § 102(a) as anticipated by a journal article by Allen, dated July 9, 1997. Laurel, Abbot, and Hardy are readily available to provide evidence in support of and sign an antedating affidavit under 37 C.F.R. § 1.131 showing reduction to practice of the subject matter of claims 1 and 2 prior to July 9, 1997. Which of the following may properly make an affidavit under 37 C.F.R. § 1.131 to overcome the rejection of claims 1 and 2.?

- (A) Laurel and Abbot.
- (B) Laurel, Abbot, and Hardy.
- (C) Laurel, Hardy and Burns.
- (D) Burns only.
- (E) None of the above.

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

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

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

- 9. A personal computer comprising a microprocessor and a random access memory including at least 1 gigabyte of storage.
- 10. The personal computer of Claim 9, wherein the microprocessor has a clock speed of 100-200 megahertz.
- 11. The personal computer of Claim 10, wherein the random access memory is greater than ½ gigabyte of storage.

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

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

17. Smith invented a laminate. In a patent application, Smith most broadly disclosed the laminate as comprising a transparent protective layer in continuous, direct contact with a light-sensitive layer without any intermediate layer between the transparent protective layer and the light-sensitive layer. The prior art published two years before the effective filing date of Smith's application included a laminate containing a transparent protective layer and a light-sensitive layer held together by an intermediate adhesive layer. Which of the following is a proper claim that would overcome a 35 U.S.C. § 102 rejection based on the prior art?

- (A) 1. A laminate comprising a transparent protective layer and a light-sensitive layer.
- (B) 1. A laminate comprising a transparent protective layer and a light-sensitive layer which is in continuous and direct contact with the transparent protective layer.
- (C) 1. A laminate comprising a transparent protective layer and a light-sensitive layer, but not including an adhesive layer.
- (D) (A) and (B).
- (E) (B) and (C).

18. Which of the following is NOT a policy underlying the public use bar of 35 U.S.C. § 102(b)?

- (A) Discouraging the removal, from the public domain, of inventions that the public reasonably has come to believe are freely available.
- (B) Favoring the prompt and widespread disclosure of inventions.
- (C) Allowing the inventor(s) a reasonable amount of time following sales activity to determine the potential economic value of a patent.
- (D) Increasing the economic value of a patent by extending the effective term of the patent up to one year.
- (E) Prohibiting the inventor(s) from commercially exploiting the invention for a period greater than the statutorily prescribed time.

19. On February 1, 1999, you filed an application on behalf of Williams directed to a system for detecting expired parking meters. The specification fully supports original Claim 1, the sole claim. The application includes several drawings. One of the drawings shows a block diagram of the system, illustrating the electronics control unit as a box, labeled “electronics control unit.” Claim 1 of the Williams application is as follows:

Claim 1. A system for detecting expired parking meters, comprising: a timer mechanism; an infrared sensor for detecting the presence of a parked vehicle; and an electronics control unit coupled to the infrared sensor and the timer mechanism.

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

- (A) On April 1, 2000, file a Notice of Appeal, appropriate fees, and a brief pointing out that a patent should issue since the subject matter of the electronics control unit was adequately described in the original specification.
- (B) On April 1, 2000, file in the PTO a drawing illustrating only the portion of the electronics control unit that was described in the original specification.
- (C) On April 1, 2000, file a Notice of Appeal, appropriate fees, and a brief pointing out that the addition of a drawing showing the electronics control unit would not constitute addition of new matter since the electronics control unit was adequately described in the original specification.
- (D) On September 1, 2000, file a petition urging that no further drawing should be required because the subject matter of the electronics control unit, for purposes of the application, was adequately disclosed in the block diagram drawing.
- (E) None of the above.

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

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

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

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

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

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

Please answer questions 23 and 24 based on the following facts. Jo invented a new and unobvious technique for inexpensively manufacturing a chemical that has been used in paper mills for years to bleach paper. Tommie developed a new and unobvious technique to clean-up toxic waste spills. Jo and Tommie collaborated to invent a method to clean-up toxic waste spills using the chemical made according to the unobvious technique invented by Jo. The inventions have been assigned to your client, Dowel Chemical Company. You prepared a single patent application fully disclosing and claiming each invention. Claims 1-9 were directed to the method of manufacturing; claims 10-19 were directed to the method of cleaning up toxic waste spills; and claim 20 was directed to a method of cleaning up toxic waste spills using the chemical manufactured in accordance with claim 1. Both inventors approve the application, but Tommie is unavailable to sign an oath before an upcoming statutory bar date. Accordingly, you are instructed to immediately file the application without an executed oath. On June 1, 1999, you file the application along with an information sheet to identify the application. However, you do not notice that Tommie was inadvertently left off the list of inventors on the information sheet, which listed Jo as a sole inventor. After receiving a Notice to File Missing Parts, you submit an oath executed by both Jo and Tommie. No paper was filed to change the named inventive entity. You later receive an Office action requiring restriction between Jo's invention and Tommie's invention. In reply to the restriction requirement, you elect Jo's invention, cancel claims 10-20, and immediately file a divisional application directed to the invention of claims 10-19. Claim 20 was omitted from the divisional application. The divisional application includes a specific reference to the original application and is filed with an inventor's oath executed by Tommie only. The divisional application incorporated the original application by reference.

23. Which of the following statements is correct?

- (A) Because the original application as filed named only Jo as an inventor, Tommie's divisional application is not entitled to the filing date of the original application because there is no common inventor between the original application and the divisional application.
- (B) The incorrect inventorship listed on the information sheet of the original application was never properly corrected and, therefore, any patent issuing on that application will be invalid under 35 U.S.C. § 116 unless the inventorship is later corrected.
- (C) After canceling claims 10-20, it is necessary to change the named inventive entity in the original application by filing a petition including a statement identifying Tommie as being deleted and acknowledging that Tommie's invention is no longer being claimed in the application and an appropriate fee.
- (D) Written consent of Dowel Chemical Company is required before Tommie can be deleted as an inventor in the original application.
- (E) It is necessary in the divisional application to file a petition including a statement identifying Jo as being deleted as an inventor and acknowledging that Jo's invention is not being claimed in the divisional application.

24. Which of the following statements is most correct?

- (A) Since claim 20 was omitted from the divisional application as filed, it cannot be added to the divisional application by a subsequent Amendment because such an Amendment would constitute new matter.
- (B) It was improper to include Tommie and Jo as joint inventors in the parent application.
- (C) The examiner may properly make a provisional obviousness-type double patenting rejection in the divisional application based on the parent application, but that rejection may be readily overcome with the filing of a terminal disclaimer.
- (D) Because the inventive entity of the amended parent application is different than the inventive entity of the divisional application, the examiner may reject the claims of the divisional application under the provisions of 35 U.S.C. § 102(e).
- (E) Statements (A), (B), (C) and (D) are each incorrect.

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

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

26. Which of the following statements is most correct?

- (A) The same evidence sufficient to establish a constructive reduction to practice is necessarily also sufficient to establish actual reduction to practice.
- (B) Proof of constructive reduction to practice does not require sufficient disclosure to satisfy the “how to use” and “how to make” requirements of 35 U.S.C. §112, first paragraph.
- (C) A process is reduced to actual practice when it is successfully performed.
- (D) The diligence of 35 U.S.C. § 102(g) requires an inventor to drop all other work and concentrate on the particular invention.
- (E) The diligence of 35 U.S.C. § 102(g) does not impose on a registered practitioner any need for diligence in preparing and filing a patent application inasmuch as such the practitioner’s acts do not inure to the benefit of the inventor.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

32. Nonobviousness of a claimed invention may be demonstrated by:

- (A) producing evidence that all the beneficial results are expected based on the teachings of the prior art references.
- (B) producing evidence of the absence of a property the claimed invention would be expected to possess based on the teachings of the prior art.
- (C) producing evidence showing that unexpected results occur over less than the entire claimed range.
- (D) producing evidence showing that the unexpected properties of a claimed invention have a significance less than equal to the expected properties.
- (E) (A), (B), (C) and (D).

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

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

34. You have just received an Office action rejecting all of your claims in your patent application as anticipated under 35 U.S.C. § 102(a) using published declassified material as the reference. The examiner explains that the declassified material is being used as *prima facie* evidence of prior knowledge as of the printing date. The published declassified material contains information showing that it was printed six months before the filing date of the application, and that it was published two months after the application's filing date. You correctly note that although the printing date precedes your application filing date by six months, you note that the publication was classified as of its printing date (thus, available only for limited distribution even when the application was filed), and was not declassified until its publication date (when it became available to the general public). Each element of the claimed invention is described in the publication of the declassified material. Which of the following statements is **true**?

- (A) The rejection is not supported by the reference.
- (B) The publication is not available as a reference because it did not become available to the general public until after the filing date of your patent application.
- (C) The publication is *prima facie* evidence of prior knowledge even though it was available only for limited distribution as of its printing date.
- (D) The publication constitutes an absolute statutory bar.
- (E) It is not possible to use a Rule 131 affidavit or declaration to antedate the printing date of the publication.

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

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

36. A petition to make a patent application special may be filed without fee in which of the following cases?

- (A) The petition is supported by applicant's birth certificate showing applicant's age is 62.
- (B) The petition is supported by applicant's unverified statement that applicant's age is 65.
- (C) The petition is supported by applicant's statement that there is an infringing device actually on the market, that a rigid comparison of the alleged infringing device with the claims of the application has been made, and that applicant has made a careful and thorough search of the prior art.
- (D) The petition is accompanied by a statement under 37 C.F.R. § 1.102 by applicant explaining the relationship of the invention to safety of research in the field of recombinant DNA research.
- (E) The petition is accompanied by applicant's statement explaining how the invention contributes to the diagnosis, treatment or prevention of HIV/AIDS or cancer.

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

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

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

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

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

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

39. Impermissible recapture in an application exists _____

- (A) if the limitation now being added in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.
- (B) if the limitation now being omitted or broadened in the present continuation was originally presented/argued/stated in a parent application to make the claims allowable over a rejection or objection made in the parent application.
- (C) if the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.
- (D) if the limitation now being omitted or broadened in the present reissue was being broadened for the first time more than two years after the issuance of the original patent.
- (E) None of the above.

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

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

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

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

42. Which of the following can never properly be available as prior art for purposes of a rejection under 35 U.S.C. § 102(a)?

- (A) A drawing, labeled “Prior Art,” submitted by the applicant.
- (B) Canceled matter in an application that matured into a U.S. patent where the matter is not published in the patent.
- (C) An abandoned patent application referenced in a publication available to the public.
- (D) The combination of two references, where one of the references is used merely to explain the meaning of a term used in the primary reference.
- (E) A reference authored only by applicant, and published less than one year prior to the effective filing date of applicant’s patent application.

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

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

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

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

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

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

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

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

47. Which of the following, if any, is **true**?

- (A) The loser in an interference in the PTO is estopped from later claiming he or she was the first to invent in a Federal District Court since the loser must win in the PTO or he/she will lose the right to contest priority.
- (B) A person being sued for infringement may file a request for reexamination without first obtaining the permission of the Court in which the litigation is taking place.
- (C) A practitioner may not represent spouses, family members or relatives before the PTO since such representation inherently creates a conflict of interest and a practitioner is likely to engage in favoritism over his/her other clients.
- (D) Employees of the PTO may not apply for a patent during the period of their employment and for two years thereafter.
- (E) None of the above.

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

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

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

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

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

Test Number 100
Test Series 456

Name _____

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

APRIL 12, 2000

Afternoon Session (50 Points)

Time: 3 Hours

DIRECTIONS

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

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

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

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

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO

This examination does not address or test any changes to the Patent Statute brought about by the enactment of the American Inventors Protection Act of 1999, Pub. L. No. 106-113 (“Act”). Accordingly, do not read the questions or answers as involving or being affected by the Act.

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

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

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

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

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

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

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

Claim 1. A shaving implement comprising

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

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

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

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

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

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

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

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

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

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

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

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

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

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

- (A) the date your reply is received by the PTO.
- (B) the mail date of the Final Rejection.
- (C) the mail date of the Advisory Action.
- (D) the date the Advisory Action is received by you.
- (E) the date the shortened statutory period expires.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

A steam cooker comprising:

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

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

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

28. Which of the following is **true**?
- (A) On appeal of a rejection of ten claims to the Board of Patent Appeals and Interferences, each appealed claim stands or falls separately as a result of appellant pointing out differences in what the claims cover.
 - (B) The 2-month period for filing a petition mentioned in 37 CFR 1.181(f) is extendable under 37 CFR 1.136(a).
 - (C) An examiner may enter a new ground of rejection in the examiner's answer to an applicant's appeal brief.
 - (D) After filing a notice of appeal, an applicant is estopped from further prosecuting the same claims in a continuation application.
 - (E) When desiring to claim foreign priority, the oath or declaration in a reissue application must claim foreign priority even though the priority claim was made in the original patent.
29. Which of the following is not a requirement of 35 U.S.C. § 102(d) to bar the granting of a patent in this country?
- (A) The foreign patent or inventor's certificate must have been published prior to the date of the application for patent in the United States.
 - (B) The foreign application must have been filed more than 12 months before the effective filing of the application in the United States.
 - (C) The foreign application must have been filed by the same applicant as in the United States or by his or her legal representatives or assigns.
 - (D) The foreign patent or inventor's certificate must be actually granted before the U.S. filing date.
 - (E) The same invention must be involved.
30. Which of the following actions, if taken by a registered practitioner, comports with proper PTO rules and procedure?
- (A) Faxing a request for reexamination to the PTO on a weekday, during the period of enforceability of a patent, within two years of the patent's issue date.
 - (B) Faxing an amendment under 37 C.F.R. § 1.111 to the PTO on the last day of the period for reply set by the examiner with a proper Certificate of Transmission.
 - (C) Faxing a request for reexamination to the PTO on a weekday, during the period of enforceability of a patent, but more than two years after the patent's issue date.
 - (D) Filing, by facsimile, a national patent application under 37 C.F.R. § 1.53(b) with a specification and drawings for the purpose of obtaining an application filing date.
 - (E) None of the above.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

40. In which of the following situations is the Commissioner authorized to refund a fee?
- (A) After receiving a final rejection, a notice of appeal and appeal fee are filed. After the notice of appeal and correct appeal fee are filed, the examiner thereafter withdraws the final rejection.
 - (B) Upon a showing of an extraordinary situation, when justice requires refund of a fee paid to the PTO where a practitioner paid the correct fee for an extension of time to provide the client with time to given instructions, and the client thereafter informs the practitioner that the client would not pay the fee and authorizes the practitioner to permit the application to become abandoned.
 - (C) Upon a showing that the application, which had been filed in the PTO and for which the correct filing fee had been paid, has been withdrawn from examination and expressly abandoned.
 - (D) Upon a petition to the Commissioner to exercise his supervision to refund a fee, though paid in the correct amount, when the practitioner no longer desired copies of patents ordered.
 - (E) Upon a showing that the fee was paid by mistake or in excess of the amount required by law.

41. Which of the following may not be properly used as prior art for purposes of rejecting a claim under 35 U.S.C. § 102(b) in an application having an effective filing date of Monday, May 3, 1999?

- (A) A journal article, published Saturday, May 2, 1998, disclosing all the claimed elements and fully teaching how to make and use the invention as claimed.
- (B) A foreign patent, published March 3, 1998, which applicant referenced in the application when claiming foreign priority based on the foreign application date, and applicant submitted a certified copy of the original foreign application.
- (C) Applicant's statement in a declaration under 37 C.F.R. § 1.132 that although the invention as claimed had been offered for sale in department stores in New York during 1997, this was done only to analyze consumer acceptance of the packaging in which the invention is marketed.
- (D) A journal article, published May 1, 1997, disclosing all the elements of the claim and teaching how to make and use the claimed invention. The examiner used the article in combination with another journal article in a previous non-final Office action to reject the same claim under 35 U.S.C. § 103.
- (E) All of the above.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

Test Number 123
Test Series 200

Name _____

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

OCTOBER 18, 2000

Morning Session (50 Points)

Time: 3 Hours

DIRECTIONS

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

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

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

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

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO

This examination does not address or test any changes to the Patent Statute or regulations brought about by the enactment of the American Inventors Protection Act of 1999, Pub. L. No. 106-113 (“Act”). This is necessary inasmuch as final rules implementing the Act have not been adopted. Accordingly, do not read the questions or answers as involving or being affected by the Act. The questions will apply the statute and rules in place as of November 28, 1999, regardless of any date(s) appearing in the questions.

1. Regarding the specification of a nonprovisional patent application, which of the following practices is in accordance with proper USPTO practice and procedure?

- (A) The specification may include graphical illustrations or flowcharts.
- (B) The specification may include tables and chemical formulas.
- (C) The specification may include hyperlinks or other forms of browser-executable code embedded in the text.
- (D) The specification must begin with one or more claims.
- (E) The specification may include a reservation for a future application of subject matter disclosed but not claimed in the application.

2. On December 31, 1998, Sam Practitioner files a notice of appeal in a patent application assigned to ABC Corp. after the examiner has rejected all of the claims on prior art. Within two months he sends in his appeal brief and three months after the examiner's answer is filed the case is sent to the Board of Patent Appeals and Interferences (Board). Subsequently, while reading the Official Gazette Sam notices that a patent issued to XYZ Corp. on October 26, 1999, contains claims which read on an unclaimed embodiment in the ABC application, which is an invention that is not within the scope of the invention claimed in the ABC application. The ABC application was filed one month after the issuance of the XYZ patent. Upon learning of the XYZ patent, ABC Corp. wants to provoke an interference by adding additional claims to its application relating to the previously unclaimed embodiment. It is October 18, 2000 and Sam comes to you for advice. Which of the following is the best and correct course of action?

- (A) Since the ABC application is at the Board of Patent Appeals and Interferences already, Sam need only request that the case be transferred to the Interference part of the Board where an interference can be declared between the ABC application and the XYZ patent.
- (B) Sam should file an amendment adding the claims copied from the XYZ patent and the Board is required to enter the amendment.
- (C) Sam should promptly file an amendment containing the claims copied from the XYZ patent and request entry. If the Board declines to enter the amendment, Sam should file a separate, continuation application no later than October 26, 2000, containing the claims copied from the XYZ patent as well as claims previously appealed, and then, to avoid the rendering of a decision of the Board, he should promptly inform the clerk of the Board in writing that they have decided to refile and abandon the application containing an appeal waiting a decision.
- (D) Sam should file an amendment containing the claims copied from the XYZ patent and ask that the interference between the ABC application and the XYZ patent be considered while the case is at the Board.
- (E) Sam should wait until the appeal is decided before filing an amendment to incorporate claims copied from the XYZ patent and to provoke an interference. There is no benefit to filing new claims since only allowable claims will be considered during an interference.

3. You are a registered practitioner and filed a new application on behalf of John. All claims were drawn to a single invention. With the application, you submitted an offer to elect without traverse if the Office deems the application to be drawn to more than one invention, a search made by a foreign patent office, one copy each of the references deemed most closely related to the claimed subject matter, and a detailed discussion of the references pointing out with the particularity required by 37 C.F.R. § 1.111(b) and (c), how the claimed subject matter is patentable over the references. You also submitted a petition to make John's application special. John was 75 years of age at the time of filing, and in such poor health that his doctor had issued a certificate stating that John is unable to assist in the prosecution of his application. Which of the following, singularly or in combination, submitted with the petition, is not sufficient to result in the petition being granted?

- I. The fee set forth in 37 C.F.R. § 1.17(i).
 - II. John's birth certificate showing his date of birth.
 - III. The doctor's certificate stating that John's health is such that he is unable to assist in the prosecution of his application.
- (A) I
 - (B) II
 - (C) III
 - (D) II and III
 - (E) None of the above.

4. Regarding amendments to the specification of an application or the claims in an application, which of the following is not true?

- (A) If an amendment signed by the applicant is received in an application in which there is a duly appointed registered patent attorney or agent, the amendment should be entered and acted upon.
- (B) Where, by amendment under 37 C.F.R. § 1.121(a), a dependent claim is rewritten to be in independent form, the subject matter from the prior independent claim is considered to be "added" matter and should be underlined.
- (C) Any amendment using parentheses to indicate canceled matter in a claim rewritten under 37 C.F.R. 1.121(a) may be held nonresponsive.
- (D) Amendments to the original patent drawings in a reissue application are not permitted. Any change to the patent drawings must be by way of a new sheet of drawings with the amended figures identified as "amended" and with added figures identified as "new" for each sheet changed.
- (E) Amendment to the claims in a nonprovisional application, other than a reissue application may be made by specifying only the exact matter to be added or deleted, and the precise point where the deletion or insertion is to be made, where the change is limited to deletions and/or additions of no more than ten words in any one claim.

5. You filed a U.S. patent application for Pete, obtaining an effective filing date of January 5, 1999, for a legal slot machine, fully disclosing and claiming only one claim as follows. Claim 1. A slot machine comprising: a cylindrical drum mechanically coupled to a motor; an electronic random data generator electrically coupled to the motor; and a push button coupled to the random data generator. You received a non-final Office action dated September 20, 1999. The examiner rejected claim 1 under 35 U.S.C. 102(e) as anticipated by a U.S. patent dated May 4, 1999 to Bud. The examiner stated and pointed out that the Bud patent, filed January 7, 1998, disclosed a slot machine with a cylindrical drum mechanically coupled to a motor; a mechanically spinning random data generator electrically coupled to the motor; and a push button coupled to the random data generator. The examiner further stated, "The examiner takes official notice that it was well known by those of ordinary skill in the art of slot machines, prior to applicant's invention, to use interchangeably either a mechanically spinning, or an electronic random data generator." The examiner did not provide any references to support the official notice. Which of the following timely filed replies to the Office action (compared to each other) is best?

- (A) Traverse the rejection arguing that the examiner's use of official notice was improper because the examiner did not provide any references to support the official notice.
- (B) Traverse the rejection arguing that Bud's invention was patented after Pete's effective filing date.
- (C) Amend Pete's claim to further include a flat screen video monitor display and point out that the newly added feature distinguishes Pete's invention over Bud.
- (D) Traverse the rejection arguing that the examiner did not create a prima facie case of obviousness because the examiner did not show why one of ordinary skill in the art of slot machines would be motivated to modify the patent to Bud.
- (E) Traverse the rejection arguing that the examiner's rejection under 35 U.S.C. § 102(e) was improper because Pete's claim is not anticipated by the patent to Bud.

6. Evidence that a claim may not comply with the second paragraph of 35 U.S.C. § 112 occurs in accordance with proper USPTO practice and procedure where:

- (A) Remarks filed by applicant in a reply or brief regarding the scope of the invention differ and do not correspond in scope with the claim.
- (B) There is a lack of agreement between the language in the claims and the language set forth in the specification.
- (C) The scope of the claimed subject matter is narrowed during pendency of the application by deleting the originally much broader claims, and presenting claims to only the preferred embodiment within the originally much broader claims.
- (D) Claims in a continuation application are directed to originally disclosed subject matter (in the parent and continuation applications) which applicants did not regard as part of their invention when the parent application was filed.
- (E) All of the above.

7. You, a registered patent practitioner, have agreed to represent an independent inventor in connection with a patent application that was filed in the United States Patent and Trademark Office by the inventor on a *pro se* basis. As filed, the application lacks an abstract of the disclosure, but included a detailed written description that contained numerous errors. However, when viewed together with four accompanying color photographs, the application disclosure was adequate to enable one of ordinary skill in the pertinent art to make and use the invention. The application also included three independent patent claims, an inventor's declaration in compliance with 37 C.F.R. § 1.63, a small entity statement (independent inventor) under 37 C.F.R. § 1.27, and all necessary small entity filing fees. The inventor has been granted a filing date and has received an official filing receipt. MEGACORP, a very large multi-national corporation, licensed rights in the invention shortly after the application was filed and, therefore, the inventor wants to ensure that the application is properly handled.

The inventor has asked you to suggest steps to help expedite prosecution and to remove any formal objections that can be expected from the examiner, without incurring unnecessary government fees. You determine that the first color photograph is the only practical medium by which to disclose certain aspects of the claimed invention, but that the substance of the remaining photographs could readily be illustrated through ordinary ink drawings. Which of the following represents the most reasonable advice to the independent inventor?

- (A) Prepare a preliminary amendment to correct errors in the detailed description, add an abstract of the disclosure, revise the existing claims and present additional dependent claims to more fully protect the invention; submit a request for approval of drawing changes wherein the first photograph is labeled "Figure 1" and the remaining photographs are cancelled in favor of corresponding ink drawings labeled Figures 2 through 4; and immediately withdraw the claim for small entity status because of the license to MEGACORP.
- (B) Prepare a preliminary amendment to correct errors in the detailed description, add an abstract of the disclosure, revise the existing claims and present additional dependent claims to more fully protect the invention; submit a request for approval of drawing changes wherein the first photograph is labeled "Figure 1" and the remaining photographs are cancelled in favor of corresponding ink drawings labeled Figures 2 through 4; and submit a petition for acceptance of Figure 1 in the form of a color photograph along with a proposed amendment to insert language concerning the color photograph as the first paragraph of the specification and the required petition fee.
- (C) Prepare a preliminary amendment to correct errors in the detailed description and to present additional dependent claims to more fully protect the invention; and submit a request for approval of drawing changes wherein the first photograph is labeled "Figure 1" and the remaining photographs are cancelled in favor of corresponding ink drawings labeled Figures 2 through 4.
- (D) Prepare a preliminary amendment to correct errors in the detailed description and to present additional claims that more fully protect the invention; and immediately withdraw the claim for small entity status because of the license to MEGACORP and submit to the USPTO the difference between the small entity filing fee and the large entity filing fee.

- (E) Completely rewrite the written description and claims as part of a new application and file it as a continuation application, including a color photograph as Figure 1, ink drawings as Figures 2-4, a new inventor's declaration and a small entity filing fee.

8. Which of the following is true?

- (A) If after the filing of a reissue application no errors in the original patent are found, a reissue patent will be granted on the reissue application noting no change, and the original patent will be returned to the applicant.
- (B) In order to add matter not previously found in the patent, a continuation-in-part reissue application must be filed.
- (C) In a reissue application, additions and deletions to the original patent should be made by underlining and bracketing, respectively, except for changes made in prior Certificates of Correction and disclaimer(s) of claims under 37 C.F.R. §1.321(a).
- (D) A dependent claim may be broadened in a reissue application only in the first two years of the enforceable life of the patent.
- (E) (A), (B), and (C).

9. Which of the following statements, in accordance with proper USPTO practice and procedure, is true?

- (A) Inasmuch as the Defensive Publication Program was removed from the rules in view of the applicant's ability to obtain a Statutory Invention Registration, a defensive publication is not available as prior art.
- (B) An application from which a defensive publication has been prepared may be used as a reference under 35 U.S.C. § 102(a) effective only from the date of publication of the defensive application.
- (C) A defensive publication may be cited as prior art only if used alone, but not in combination with other prior art in rejecting claims under 35 U.S.C. § 102 and 35 U.S.C. § 103.
- (D) Abbreviations contain specific portions of the disclosures of abandoned applications and were discontinued in 1965. They may be cited as prior art only if used in combination with other prior art in rejecting claims under 35 U.S.C. § 102 and 35 U.S.C. § 103.
- (E) Abstracts include a summary of the disclosure of an abandoned application. Publication of such abstracts was discontinued in 1953. These publications may be cited as prior art alone or in combination with other prior art in rejecting claims under 35 U.S.C. § 102 and 35 U.S.C. § 103.

10. Independent claim 1, fully supported by the specification in a patent application states:

Claim 1. An apparatus comprising: a plastic valve; a copper pipe connected to the plastic valve; and an aluminum pipe connected to the plastic valve.

Which of the following claims, presented in the application, provide the basis for a proper rejection under 35 U.S.C. § 112, second paragraph?

Claim 2. The apparatus of claim 1, wherein said pipe is statically charged.

Claim 3. The apparatus of claim 1, wherein the outer surface of said copper pipe is statically charged.

Claim 4. The apparatus of claim 1, further comprising a thermostat connected to said plastic valve.

- (A) Claim 2.
- (B) Claim 3.
- (C) Claim 4.
- (D) Claims 2 and 3.
- (E) Claims 3 and 4.

11. An Office action issued with a three month shortened statutory period for reply. Four and one-half months after the mailing date of the Office action, the applicant submitted a fully responsive amendment along with a petition and fee for a one-month extension of time. The petition for extension of time included an authorization to charge fees under 37 C.F.R. § 1.17 to applicant's deposit account. The applicant knew at the time the amendment was filed that a two-month extension of time was required. Unfortunately, however, a clerical error was made that resulted in only a one-month extension of time being requested. Applicant overlooked this error when the amendment was filed. Assuming no further papers by applicant, which of the following statements is true?

- (A) The amendment is treated as untimely and the application becomes abandoned. However, applicant may petition to revive the abandoned application on the basis that the abandonment was unavoidable.
- (B) The amendment is treated as untimely and the application becomes abandoned. However, applicant may petition to revive the abandoned application on the basis that the abandonment was unintentional.
- (C) The petition for a one-month extension of time will be construed as a petition requesting the appropriate period of extension, and the appropriate fee will be charged to the deposit account.
- (D) Applicant will be notified that the petition for extension of time was insufficient and will be given 30 days from the mailing date of the notification to request an extension of time for a second month.
- (E) None of the above.

12. Regarding a power of attorney or authorization of agent in a patent application, which of the following is in accordance with proper USPTO practice and procedure?

- (A) All notices and official letters for the patent owner or owners in a reexamination proceeding will be directed to the attorney or agent of record in the patent file at the address listed on the register of patent attorneys and agents.
- (B) Powers of attorney to firms submitted in applications filed in the year 2000 are recognized by the United States Patent and Trademark Office
- (C) The associate attorney may appoint another attorney.
- (D) The filing and recording of an assignment will operate as a revocation of a power or authorization previously given.
- (E) Revocation of the power of the principal attorney or agent does not revoke powers granted by him or her to other attorneys or agents.

13. A United States patent issued to inventor Smith on January 6, 1998. The Smith patent had a total of nine claims, with claim 1 being the only independent claim. Smith subsequently became aware of prior art that was not before the examiner that likely invalidated claim 1 of the patent. Accordingly, Smith properly filed a narrowing reissue application on September 30, 1999 along with a reissue oath stating that he believed the original patent to be wholly or partly invalid by reason of the patentee claiming more than he had the right to claim in the patent. As filed, the reissue application sought to narrow the first limitation of claim 1 to distinguish over the new prior art. Claims 2 through 9 were rewritten in independent form. On March 15, 2000, while preparing a reply to an Office action in the reissue application, Smith determined that he would like to add further claims to provide a desired range of patent protection. Thus, on March 17, 2000, Smith submitted an amendment that, *inter alia*, added new claims 10-19 to the reissue application, with claims 10 and 16 being presented in independent form. Each of claims 10-15 was narrower than original claim 1 in certain aspects, but broader than original claim 1 in other aspects. Each of claims 16-19 was narrower than claim 1 in all aspects, and was fully supported by the original reissue oath. Smith also submitted on March 17 a supplemental reissue oath stating that he believed the original patent to be wholly or partly inoperative by reason of the patentee claiming less than he had the right to claim in the patent. Which of the following best describes a likely action by the examiner in response to the amendment?

- (A) Each of claims 10-19 is rejected as being improper since the claims were added after the two-year anniversary of the original patent issuance.
- (B) Each of claims 10-19 is examined on the merits.
- (C) Claims 10-15 are rejected as being improper because they improperly seek to broaden the invention claimed in the original patent, and need not be further examined on their merits, but claims 16-19 are examined on the merits.
- (D) Claims 16-19 are examined on the merits, and claims 10-15 are examined on the merits if there is no prosecution history estoppel during the original prosecution relating to the broadened aspects of the claims.
- (E) None of the above.

14. 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 (replies) may he file without triggering the requirements of 37 C.F.R. § 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).

15. Which of the following 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).

16. Which of the following statements regarding a proper prior art reference is true?

- (A) Canceled matter in the application file of a U.S. patent is a prior art reference as of the filing date under 35 U.S.C. 102(e).
- (B) Where a patent refers to and relies on the disclosure of a copending subsequently abandoned application, such disclosure is not available as a reference.
- (C) Where the reference patent claims the benefit of an earlier filed, copending but subsequently abandoned application which discloses subject matter in common with the patent, and the abandoned application has an enabling disclosure for the common subject matter and the claimed matter in the reference patent, the effective date of the reference patent as to the common subject matter is the filing date of the reference patent.
- (D) Matter canceled from the application file wrapper of a U.S. patent may be used as prior art as of the patent date.
- (E) All foreign patents are available as prior art as of the date they are translated into English.

17. In June 1997, Rene invents a circuit board device which automatically logs a computer onto the Internet without the need for entering passwords. During the prosecution of the patent for the circuit board device, Rene's patent practitioner files the following claims 1 and 2:

1. An electronic device for automatically logging onto the Internet comprising: communication means for communicating on the Internet, said communication means further comprising circuit means for automatically entering a password, and storage means for automatically storing a password for logging onto the Internet.
2. The device of claim 1 wherein the communication means is a desktop computer.

During the patent prosecution, the examiner cites as prior art a telephone with a memory, which automatically dials a telephone number. The examiner reasons that because the telephone can store the number in its memory, it would have been obvious to store a password in the memory as well. The examiner objects to claim 2 as being dependent upon a rejected claim. Being very eager to get patent protection and low on financial resources, Rene instructs the practitioner to combine claims one and two and allow the application to issue. One year and one day after issuance, Rene comes to you, a patent attorney, inquiring if her patent reads on a widely distributed, hand-held, pocket sized, portable device that is not a telephone and does not use a desktop computer to access the Internet automatically without a password, and if not, what corrective action is available. Which of the following choices is the best advice for Rene?

- (A) Since the two-year period for broadening has not expired, Rene may file a reissue with a declaration stating that the failure to claim more was due to error without deceptive intent. Rene may broaden her claims to the extent permitted by the prior art, since at no time did she narrow her claims to avoid the prior art.
- (B) Since the prior art device was a telephone, Rene is entitled to seek patent protection on all that which is not in the prior art. Rene should be able to obtain broadened patent protection by reissue of the patent.
- (C) Since Rene's original claim 1 was broadly written and since Rene narrowed her scope of patent protection by incorporating the limitations of the original claim 2 during the original prosecution, she is barred by the doctrine of recapture from enlarging her claims to the scope of the original claim 1.
- (D) Although Rene narrowed her claims during the original prosecution, she can file a declaration stating that the narrowing of her claims was not because she believed the prior art precluded her from claiming more but due to financial concerns. Therefore, the narrowing of the claim was error without deceptive intent and Rene may file a reissue seeking broader claims.
- (E) Rene should file a request for reexamination seeking to enlarge the scope of her patent protection.

Please answer questions 18 and 19 based on the following facts.

You are a registered patent practitioner handling prosecution of a patent application assigned to your client, Manufacturing Company, Inc. (“ManCo”). In discussing a reply to a first, non-final Office action with the sole named inventor (I. M. Putin) on August 11, 2000, you uncover evidence that suggests an individual employed by your client may have intentionally concealed the identity of a possible joint inventor (Phil Leftout). Leftout quit ManCo after a dispute with the company president, and is currently involved in litigation against ManCo over his severance package. You learn that Leftout would be entitled to additional severance payments if he were indeed a joint inventor. You decide it is necessary to further investigate the identity of the proper inventive entity and, if the inventive entity was misidentified on the application, determine the circumstances behind this misidentification. Particularly in light of the schedules of individuals with relevant information, such an investigation would take at least three months and perhaps longer to complete. The outstanding Office action issued 5½ months ago with a 3-month shortened statutory period for reply. The examiner has raised only minor matters of form in the Office action, and you are confident the application would be in condition for allowance after you submit a reply. After discussing the matter with you, ManCo informs you they want the matter straightened out before any patent issues on the application.

18. How do you best advise ManCo?

- (A) Recommend promptly filing a Request for Stay of Prosecution until you can complete your investigation, and upon completion of the investigation filing an appropriate reply to the outstanding Office action along with a petition and associated fees for a three month extension of time.
- (B) Recommend promptly filing a petition and associated fees for a three month extension of time along with a Request for Stay of Prosecution until you can complete your investigation, and upon completion of the investigation filing an appropriate reply to the outstanding Office action.
- (C) Recommend proceeding with prosecution by promptly filing an appropriate reply to the outstanding Office action along with a petition and associated fees for a three month extension of time; and allowing the patent to issue in Putin’s name alone with the understanding that, if the investigation shows the possible joint inventor should have been named, correcting the inventorship after issuance of the patent in accordance with 37 C.F.R. § 1.48.
- (D) Recommend promptly filing an appropriate reply to the outstanding Office action along with a petition and fees for a three-month extension of time and concurrently submitting a petition and associated fees for suspension of action for a reasonable time until you can complete your investigation.
- (E) Recommend promptly filing a petition and associated fees for suspension of action for a reasonable time until you can complete your investigation.

19. Further assume that the application is awaiting action by the Office at the time you complete your investigation. The investigation revealed that Leftout should indeed have been named as a joint inventor and that the error in naming the inventive entity resulted from Putin's assistant purposely omitting Leftout from an invention disclosure form to avoid increasing the value of Leftout's severance package. Although the application was originally filed with an inventor's Declaration and an Assignment to ManCo signed by Putin as a sole inventor, Putin did not realize at the time that he was not the sole inventor of the claimed subject matter. Leftout was unaware that the application had even been prepared and filed. Thus, neither Putin nor Leftout were aware that an error had been made in the named inventive entity. There was never any deceptive intent by either Putin or Leftout concerning the error. How do you correct the named inventive entity?

- (A) Promptly file a replacement declaration executed jointly by Putin and Leftout along with a cover letter explaining that Leftout was inadvertently omitted as an inventor.
- (B) Because Putin's assistant purposely omitted Leftout's name, the mistake in the named inventive entity was not an error without deceptive intention and the mistake cannot be corrected.
- (C) Simply file a continuation application naming Leftout and Putin as inventors and submit any necessary filing fee.
- (D) Amend the application to name Leftout and Putin as joint inventors and, along with the amendment, submit a petition including a statement from Leftout that the error in inventorship occurred without deceptive intention on his part, a declaration executed by both Putin and Leftout, and all necessary fees.
- (E) (C) and (D) are each an appropriate way to correct the named inventive entity.

20. Assume a "claim" for the benefit of an earlier filing date in a foreign country under 35 U.S.C. § 119(a)-(d) was made and a certified copy of the foreign application was filed in a corresponding U.S. application on which the original U.S. patent was granted, and the benefit of priority is desired in a reissue patent application. Which of the following statements accords with proper USPTO practice and procedure?

- (A) It is unnecessary to make such claim in the reissue application.
- (B) It is unnecessary to make such claim in the reissue application provided a certified copy of the foreign application is provided in the reissue application.
- (C) It is unnecessary to make such claim in a reissue application provided the oath or declaration identifies the foreign application and its filing date.
- (D) It is necessary to make such claim in the reissue application, and in addition, the oath or declaration must identify the foreign application on which priority is claimed, and any foreign applications having a filing date before that of the application on which priority is claimed.
- (E) It is necessary to make such claim in the reissue application, and in addition, a certified copy of the foreign application must be provided in the reissue application.

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

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

22. Which of the following is true?

- (A) When the subject matter of an appeal is particularly difficult to understand, a patentability report is prepared by an examiner in order to present the technical background of the case to the Board of Appeals and Patent Interferences.
- (B) In those appeals in which an oral hearing has been confirmed and either the Board of Appeals and Patent Interferences or the primary examiner has indicated a desire for the examiner to participate in the oral argument, oral argument may be presented by the examiner whether or not the appellant appears.
- (C) If a patent applicant files a notice of appeal which is unsigned, it will be returned for signature, but the applicant will still receive the filing date of the unsigned notice of appeal.
- (D) Statements made in information disclosure statements are not binding on an applicant once the patent has issued since the sole purpose of the statement is to satisfy the duty of disclosure before the Office.
- (E) None of the above.

23. Mitch and Mac are named inventors on an international application that is filed in the USPTO Receiving Office, and designates the United States of America. Mac now indicates that he will not sign the Request for the international application. Mitch wishes to proceed with the Request and seeks the advice of their patent agent. Which of the following answers accords with the provisions of the Patent Cooperation Treaty?

- (A) Mitch's agent should sign the Request and accompany it with a statement indicating why it is believed that Mac refuses to proceed with the Request.
- (B) Mitch should sign the request for himself and also sign on behalf of Mac.
- (C) Mitch should sign the request and seek a court order to obtain Mac's signature.
- (D) Mitch should sign the Request and accompany it with a statement providing a satisfactory explanation for the lack of Mac's signature.
- (E) Mitch should sign the Request and Mitch's agent should sign on behalf of Mac, since he continues to represent Mac.

24. Which of the following actions accords with proper USPTO practice and procedure?

- (A) Filing a petition to make special on the ground of applicant's health accompanied by a doctor's certificate showing that the state of health of the applicant is such that he might not be available to assist in the prosecution of the application if it were to run its normal course, unaccompanied by a petition fee.
- (B) Filing a petition to make special on the ground of prospective manufacture by applicant's business competitor accompanied by the required petition fee and a statement by applicant alleging the possession by the competitor of sufficient available capital (stating an approximate amount) and facilities (stating the nature) to manufacture the invention in quantity, that the business competitor is manufacturing the invention in the United States, and that the competitor has a good knowledge of the pertinent prior art, on information and belief.
- (C) Filing a petition to make special on the ground of prospective infringement accompanied by the required fee and a statement by the applicant alleging that an infringing device is about to be put on the market, that a rigid comparison of the alleged infringing device with the claims of the application has been made, and that in applicant's opinion, some of the claims are unquestionably infringed, and that applicant has made a careful and thorough search of the prior art.
- (D) Filing a petition to make special on the ground of environmental quality accompanied by a statement from a Professor of Environmental Engineering at a leading university explaining how the invention contributes to the restoration of lakes and streams, but unaccompanied by a petition fee.
- (E) Filing a petition to make special on the ground of inventions relating to recombinant DNA accompanied by a statement from a Professor of Genetics at a leading university explaining the relationship of the invention to safety of research in the field of recombinant DNA research, and accompanied by the required fee.

25. In June 1997, Jack and Jill, a married couple, are vacationing in Vietnam (not a WTO country) when they encounter a man selling bamboo knives for cleaning fish. The particular curvature of the bamboo both lends support to the knife to prevent it from bending and breaking and facilitates cleaning inside the fish. Jill takes a picture of Jack with the knife cleaning the fish. Subsequently, in November 1997, when Jack returns to the United States he begins to make and sell a identical knife to the one seen in Vietnam. In July 1998, he files a patent application claiming the nearly identical knife. Jack discloses no prior art during the prosecution of his application and fails to mention the knife he saw in Vietnam. The examiner finds no prior art similar to the claimed knife, and Jack is awarded a patent in December 1999. Meanwhile, Jill divorces Jack, and associates with Sam. Unfortunately, Sam is penniless. To raise cash, Sam and Jill begin selling a knife identical to the one Jack produces, only Sam and Jill make their knife out of plastic. The knives of Sam and Jill sell like hotcakes. Jack sues for infringement. Jill and Sam come to you for advice. Which of the following is not true?

- (A) Jack had a duty under 37 C.F.R. §1.56 to disclose his discovery of the bamboo knife in Vietnam to the examiner during the original patent prosecution.
- (B) Jack is entitled to patent protection since Vietnam is not a WTO country and evidence of the Vietnamese knife cannot be used against him to reject his patent claims.
- (C) Since the use in Vietnam was not in this country, it does not constitute a public use bar under 35 U.S.C. § 102(b).
- (D) If Jill's attorney files a request for reexamination, it will be denied because the picture is not a patent or printed publication.
- (E) Although Jack marketed the invention before obtaining a patent, the patent claims cannot be invalidated under 35 U.S.C. § 102(a) since Jack's making and selling of the knife cannot be used against him under 35 U.S.C. § 102(a).

26. In a reissue patent application, which of the following statements is correct?

- (A) It is unnecessary to claim the benefit of an earlier filing date in a foreign country in order to gain the benefits of 35 U.S.C. § 119(a) - (d) so long as such a claim was made in the application on which the original patent was granted.
- (B) New matter, that is, matter not present in the patent sought to be reissued, may be included in a reissue application in accordance with 35 U.S.C. § 251.
- (C) No additional certified copy of the foreign application is necessary if a claim for the benefit of an earlier filing date in a foreign country under 35 U.S.C. § 119(a) - (d) is made in a reissue application as well as in the application on which the original patent was granted.
- (D) The recapture rule permits a patentee to acquire through reissue claims that are, in all respects, of the same scope as, or are broader than, those claims canceled from the original application to obtain a patent.
- (E) A practitioner's failure to appreciate the full scope of the invention is not an error correctable through reissue.

27. If a *prima facie* case of obviousness is properly established by a primary examiner, how can an applicant effectively rebut the rejection in accordance with proper USPTO practice and procedure?

- (A) Rebuttal may be by way of arguments of counsel used in place of factually supported objective evidence to rebut the *prima facie* case.
- (B) Rebuttal may be by way of an affidavit or declaration under 37 C.F.R. § 1.132 containing objective evidence arising out of a secondary consideration related to the claimed invention.
- (C) No substantive showing is required by applicant. The burden remains on the examiner to maintain a *prima facie* case.
- (D) Rebuttal evidence must be found elsewhere than in the specification.
- (E) Rebuttal may be by way of arguing that the prior art did not recognize latent properties.

28. Which of the following is true?

- (A) There is no practical difference between an objection and rejection of a claim.
- (B) If the form of the claim (as distinguished from its substance) is improper, an objection is made.
- (C) An objection, if maintained by an examiner, is subject to review by the Board of Patent Appeals and Interferences.
- (D) An example of a proper objection is where the claims are refused because they fail to comply with the second paragraph of 35 U.S.C. § 112.
- (E) An example of a proper rejection is a rejection of a dependent claim for being dependent on a claim that has been rejected only over prior art, where the dependent claim is otherwise allowable.

29. Which, if any, of the following statements relating to amendments of claims in reissue applications accords with proper USPTO practice and procedure?

- (A) To distinguish cancellation of an original patent claim from a claim previously added in the reissue, it is necessary to direct cancellation of the latter by the statement: Cancel reissue claim [recite number].
- (B) Each claim not found in the patent that is newly presented in the reissue application should be presented in brackets.
- (C) In amending original patent claims more than once, the second amendment need not include the changes previously presented in the first amendment.
- (D) Since matter not present in the patent sought to be reissued is excluded from a reissue application, changes made to the claims require an explanation in the Remarks.
- (E) None of the above.

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

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

31. Which of the following do not represent prior art?

- (A) The preamble of a Jepson claim.
- (B) A technical journal as of its date of publication which is accessible to the public as of the date of its publication.
- (C) A doctoral thesis indexed, cataloged and shelved in a university library.
- (D) A disclosure publicly posted on the INTERNET, but containing no publication or retrieval date.
- (E) Applicant's labeling of one of the figures in the drawings submitted with his application as prior art.

32. A patent application filed in the USPTO 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 USPTO 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.

33. 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.

34. In which of the following situations would the finality of an Office action rejection be improper?

- I. The final Office action rejection is in a first Office action in a substitute application that contains material which was presented in the earlier application after final rejection but was denied entry because the issue of new matter was raised.
- II. The final Office action rejection is in a first Office action in a continuing application, all claims are drawn to the same invention claimed in the earlier application, and the claims would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.
- III. The final Office action rejection is in a first Office action in a continuation-in-part application where at least one claim includes subject matter not present in the earlier application.

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

35. You, a registered patent practitioner, receive a Notice of Allowance and Issue Fee Due in an application you know is very important to your client, Acme Incorporated. The application has been pending for several years. In accordance with standing instructions from Acme, you immediately pay the issue fee and then report to the client receipt of the Notice of Allowance and payment of the issue fee. One week later, you receive a call from Acme's CEO informing you that three weeks earlier a competitor, Zenith Manufacturing, had forwarded to her copies of several prior art patents. Although she had never seen these prior art patents before, she immediately recognized their materiality to the claims of the pending Acme application. However, she was very busy with other business and therefore did not previously inform you of the patents. Given the importance of the application to Acme, she wants you to ensure that the examiner officially considers the prior art patents during prosecution of the Acme application. Which of the following is likely to be your best course of action to ensure proper consideration of the prior art by the examiner, while minimizing unnecessary costs and delays in issuance of a patent to Acme?

- (A) Promptly file an Information Disclosure Statement ("IDS") signed by you that includes a statement that no item of information contained in the IDS was cited in a communication from a foreign patent office in a counterpart foreign application, and, to your knowledge after a reasonable inquiry, no item of information contained in the IDS was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of the IDS.
- (B) Promptly file an Information Disclosure Statement ("IDS") signed by you that includes a statement that no item of information contained in the IDS was cited in a communication from a foreign patent office in a counterpart foreign application, and, to your knowledge after a reasonable inquiry, no item of information contained in the IDS was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of the IDS; and pay a fee for late submission of the IDS.
- (C) Promptly file an Information Disclosure Statement ("IDS") along with payment of a fee for late submission of the IDS.
- (D) Promptly file an Information Disclosure Statement ("IDS") signed by you that includes a statement that no item of information contained in the IDS was cited in a communication from a foreign patent office in a counterpart foreign application, and, to your knowledge after a reasonable inquiry, no item of information contained in the IDS was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of the IDS; and submit a petition requesting consideration of the IDS and payment.
- (E) Promptly petition to withdraw the application from issue, pay the necessary petition fee, and file continuation application along with an Information Disclosure Statement.

36. In July 1999, Pete Practitioner files a reissue application for Sam's patent on a combination washing machine and dryer, which issued on August 5, 1997. The original 20 claims are filed in the reissue application along with two additional dependent claims. The declaration indicates that there was error without deceptive intent in that applicant failed to claim the subject matter of the two newly added dependent claims. Sam also indicates in the declaration that he has no intention doing anything other than adding the two dependent claims. In September 1999 the examiner allows claims 1-10 of the reissue but rejects claims 11-22. Sam is eager to enforce claims 1-10 against a competitor but does not want to give up prosecuting claims 11-22. Sam also wants to add additional claims 23-30 directed to an entirely different invention, which was disclosed in the patent but not claimed. To claim the new invention, Sam must file new independent claims, which claim subject matter not previously claimed. Pete practitioner has retired and Sam comes to you for advice. Which of the following is true?

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

37. An Office action was mailed in a pending patent application on Wednesday, November 17, 1999. The examiner set a three month shortened statutory period for reply. The applicant petitioned for a one-month extension of time on Thursday, February 17, 2000 and paid the appropriate one-month extension fee. No further papers or fees were submitted and the application became abandoned. What was the date of abandonment?

- (A) Friday, February 18, 2000.
- (B) Friday, March 17, 2000.
- (C) Saturday, March 18, 2000.
- (D) Monday, March 20, 2000.
- (E) Thursday, May 18, 2000.

Please answer questions 38 and 39 based on the following information.

Ace Equipment Corp., approaches you with information concerning a pending original U.S. patent application of its chief competitor. A copy of the patent application, which was filed July 9, 1999, and its entire prosecution history was provided to Ace during negotiations concerning the competitor's trade secret technology. The application stands rejected by the examiner on the basis of a prior art patent. A foreign patent application corresponding to the competitor's U.S. patent application had previously published, and Ace was not required to maintain its knowledge of the U.S. application in confidence. Ace is virtually certain that the competitor had used the claimed invention publicly more than one year before the filing date of the patent application and would like to take whatever steps are available to prevent the application from issuing as a patent. However, Ace does not want the competitor to know they oppose issuance of the patent. The competitor does not know that you represent Ace.

38. Which of the following would be the best advice from you to Ace?
- (A) Recommend initiating a public use proceeding by filing a petition signed by you and serving a copy of the petition on the competitor. The petition would assert that a statutory bar exists that prohibits the patenting of the subject matter of the application, would be supported by appropriate affidavits or declarations, and would describe the subject matter that was in public use sufficiently to enable the examiner to compare the claimed subject matter to the subject matter in public use. The petition would indicate that a copy of the petition was served on the applicant and would specifically identify the application by serial number and filing date, but would not identify Ace. Any required fee would also be submitted with the petition.
 - (B) Recommend filing a copy of the competitor's application as a new patent application naming an Ace employee as the inventor. You then submit a statement that the claims have been copied from the competitor's application, and request that an interference proceeding be declared. During the interference proceeding, you can file a preliminary motion under 37 C.F.R. § 1.633(a) in an effort to obtain a ruling that the subject matter is not patentable to the competitor due to the earlier public use.
 - (C) Inform Ace that because patent applications are maintained in confidence under 35 U.S.C. § 122 and because patent prosecution is conducted *ex parte*, there is nothing that can be done until the patent issues. Once the patent issues, you can file an anonymous request for re-examination based on the competitor's public use of the invention more than one year before the filing date.
 - (D) For strategic reasons, recommend waiting to see if the competitor is able to overcome the examiner's rejection. If the patent issues, you can then file an anonymous request for re-examination on Ace's behalf based on the competitor's public use of the invention more than one year before the filing date.
 - (E) Recommend initiating an *inter partes* protest by submitting a written protest signed by you. The protest would not provide any information other than identifying the application.

39. Based on the foregoing facts, which of the following statements is true?
- (A) Since the corresponding foreign patent application was published, confidentiality of the U.S. application is waived and Ace may inspect the Patent Office file to monitor its progress simply by filing a request for access.
 - (B) Since the competitor provided Ace with a copy of the U.S. patent application and the prosecution history, confidentiality of the U.S. application is waived and Ace may inspect the Patent Office file to monitor its progress simply by filing a request for access.
 - (C) The competitor violated 35 U.S.C. § 122 by providing a copy of the application to Ace.
 - (D) A violation of 35 U.S.C. § 122 would occur if Ace publicly disclosed the competitor's patent application.
 - (E) Statements (A), (B), (C) and (D) are each untrue.

40. You are a partner in a prestigious Virginia intellectual property law firm, and Mr. Laden is a newly hired associate, having recently passed the patent registration examination and been registered as a patent attorney. Shortly after joining your firm, the Supreme Court of Virginia issued an order, dated November 10, 1998, suspending Mr. Laden on ethical grounds from practicing law in Virginia for a period of 3 years from the date of the order. On July 11, 2000, a Fortune 500 company retains your services to continue prosecution of a case in which the joint inventors are obligated to assign to the Fortune 500 company. You immediately mail a paper, signed by the joint inventors, revoking the power of attorney of the present patent counsel giving you a power of attorney as sole attorney of record. On July 17, 2000, you are requested by the Apex Steel Co., one of your most important clients, to immediately file a patent infringement suit against a competitor. Which of the following actions does not accord with proper practice and procedure, and would not permit timely copying of the Fortune 500 case file without detracting from your litigation time?

- (A) File a power to inspect over your signature with the USPTO identifying the Fortune 500 patent application to be inspected, and authorizing Mr. Laden to inspect the application.
- (B) File a power to inspect signed by you with the USPTO identifying the Fortune 500 patent application to be inspected, and your secretary as authorized to have access.
- (C) File a written authority under your signature with the USPTO appointing a registered agent of your firm as an associate in the Fortune 500 patent application to be inspected.
- (D) Record the obligation of assignment to the Fortune 500 company of the patent application to be inspected and instruct the legal representative of the Fortune 500 company to provide proof of identity when requesting access.
- (E) Instruct one of the joint inventors to provide proof of identity when orally requesting access.

41. Which of the following is true?
- (A) The statement, “Whether claims 1 and 2 are unpatentable,” complies with the requirement of 37 C.F.R. § 1.192(c)(6) for a concise statement in the appeal brief of the issues presented for review.
 - (B) A reissue application may be filed in order to broaden claims back to their original form where the claims were mistakenly narrowed during the original prosecution to avoid the prior art provided that the narrowing of the claims was made without deceptive intent on the part of the applicant.
 - (C) If the Board of Patent Appeals and Interferences decides to require an appellant to address a particular matter, and the appellant cannot respond within the time period set, he may obtain an extension of time by paying the requisite fee.
 - (D) Following a new ground of rejection raised by the Board of Patent Appeals and Interferences, the applicant may request a rehearing, or submit an appropriate amendment of the rejected claims or a showing of facts relating to the rejected claims.
 - (E) In an *ex parte* reexamination proceeding, a third party requester who is dissatisfied with a decision of the Board of Patent Appeals and Interferences may seek judicial review by appeal to either the U.S. Court of Appeals for the Federal Circuit or by civil action in the U.S. District Court for the District of Columbia.
42. In which of the following cases is the date of actual receipt by the USPTO not accorded as the application filing date?
- (A) Provisional application filed without claims.
 - (B) Non-provisional application filed containing an error in inventorship.
 - (C) Non-provisional application filed which fails to identify the inventor(s).
 - (D) Non-provisional application with executed oath filed without any claim(s).
 - (E) Non-provisional application filed using a certificate of mailing in accordance with 37 C.F.R. § 1.8.
43. Which of the following definitions does not accord with proper USPTO practice and procedure relating to drawings in patent applications?
- (A) Original drawings are drawings submitted with the application when filed, and may be either formal or informal.
 - (B) Formal drawings are stamped “approved” by the Draftsperson.
 - (C) Drawings may be informal for reasons such as the size of reference elements.
 - (D) A substitute drawing is usually submitted to replace an original formal drawing.
 - (E) A drawing may be declared as informal by the applicant when filed.

44. After filing a Notice of Appeal, an appeal brief is due. In accordance with proper USPTO practice and procedure:

- (A) The brief is due within two months of the date of appeal. The Office date of receipt of the Notice of Appeal is the date from which this two month period is measured.
- (B) The brief is due within two months of the date of appeal, the date indicated on any Certificate of Mailing under 37 C.F.R. § 1.8 attached to the Notice of Appeal is the date from which this two month period is measured.
- (C) Failure to file the appeal brief within the permissible time will result in dismissal of the appeal and abandonment of the application, including any allowed claims.
- (D) Failure to file the appeal brief within the permissible time will result in dismissal of the appeal and abandonment of the application containing no allowed claims, and an appeal brief will be due within two months after the date a petition is granted to revive the application and reinstate the appeal.
- (E) If the appellant is unable to file an appeal brief within the time allotted by the rules, appellant may file a petition, with fee, to the examining group, requesting additional time, and the time extended is added to the last day the appeal brief would have been due when said last day is a Saturday, Sunday, or Federal holiday.

45. 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.

46. Which of the following statements regarding an applicant's duty to submit a drawing in a U.S. patent application is true?

- I. The examiner may only require a drawing where the drawing is necessary for the understanding of the invention.
- II. If a drawing is not necessary for the understanding of the invention, but the case admits of illustration, the examiner may require the drawing, but the lack of a drawing in the application when filed will not affect the filing date of the application.
- III. If a drawing is necessary for the understanding of an invention, but is not submitted on filing, the application cannot be given a filing date until the drawing is received by the USPTO.

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

47. Blackacre is a registered patent agent employed by an intellectual property law firm located in Arlington, Virginia. He is awakened at 5:30 AM one morning by a frantic call from Whiteaker, a senior partner at the law firm. Whiteaker informs Blackacre that she has an examiner interview scheduled for 3:00 PM that day in connection with an important patent application she is handling. However, a family emergency arose during the night and she will not be able to attend the interview. It is also the last day of the statutory six-month period for reply, so the interview cannot be rescheduled. She requests that Blackacre conduct the examiner interview for her and, based on the outcome of the interview, file appropriate papers with the USPTO. She tells him exactly where he can locate the file in her office. Blackacre has not been given a power of attorney in the application, but has been given a power to inspect the USPTO file for the application. Assuming Blackacre has adequate time to prepare for the interview and will competently represent the applicant, which of the following statements is true?

- (A) Blackacre can participate in the interview if he brings along a copy of the application file and states to the examiner that he is authorized to represent the applicant.
- (B) Blackacre cannot participate in the examiner interview because he does not have an express power of attorney and has not previously made an appearance in the application.
- (C) The power to inspect alone is sufficient authority for an examiner to grant an interview involving the merits of an application.
- (D) Blackacre must obtain either a written power of attorney from the applicant or a written associate power of attorney from Whiteaker before he can participate in the examiner interview.
- (E) Statements (B) and (D) are true.

48. A nonprovisional patent application is filed on June 3, 1999, and on September 3, 1999, an Office action is mailed setting a 3 month shortened statutory period for reply. On March 3, 2000, a proper reply is filed together with a petition for a 3 month extension of time accompanied by the appropriate petition fee. A proper petition for conversion of the nonprovisional patent application to a provisional patent application along with the appropriate petition fee is deposited with the U.S. Postal Service as Express Mail pursuant to 37 C.F.R. § 1.10 on Saturday, June 3, 2000. Assuming the petition for conversion is granted shortly thereafter, which of the following statements is true?

- (A) The provisional application is entitled to a filing date of June 3, 1999.
- (B) The provisional application is entitled to a filing date of September 3, 1999.
- (C) The provisional application is entitled to a filing date of March 3, 2000.
- (D) The provisional application is entitled to a filing date of June 3, 2000.
- (E) None of the above.

49. Which of the following is true?

- (A) When an applicant petitions to make his case special, he forfeits the opportunity to request an oral hearing if he should decide to appeal his application to the Board of Patent Appeals and Interferences.
- (B) An oral hearing is a good way to argue a case before the Board of Patent Appeals and Interferences as an appeal decided by an oral hearing is likely to be given closer consideration by the Board of Appeals and Patent Interferences than those without such a hearing.
- (C) During an appeal to the Board of Appeals and Patent Interferences, it is a good idea to schedule the oral hearing before filing a reply brief so that if questions arise at the hearing they may be responded to in the reply brief.
- (D) A rehearing of an appeal involves conducting an oral hearing a second time.
- (E) None of the above.

50. Which of the following is true?

- (A) In order to have a reissue application expedited, the reissue applicant should file a Petition to Make Special.
- (B) Once a reissue issues, the date on which the maintenance fee is due is calculated from the date of issuance of the reissue certificate.
- (C) A dependent claim may not be broadened during a reexamination proceeding.
- (D) If the examiner raises a new ground of rejection in the Examiner's Answer, the applicant has the option of continuing with the appeal or asking that prosecution be reopened.
- (E) None of the above.

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Test Number 456
Test Series 200

Name _____

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

OCTOBER 18, 2000

Afternoon Session (50 Points)

Time: 3 Hours

DIRECTIONS

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

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

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

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

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO

This examination does not address or test any changes to the Patent Statute or regulations brought about by the enactment of the American Inventors Protection Act of 1999, Pub. L. No. 106-113 (“Act”). This is necessary inasmuch as final rules implementing the Act have not been adopted. Accordingly, do not read the questions or answers as involving or being affected by the Act. The questions will apply the statute and rules in place as of November 28, 1999, regardless of any date(s) appearing in the questions.

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

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

2. Which of the following is not a proper incorporation by reference in an application prior to allowance according to USPTO rules and procedures?

- (A) Incorporating material necessary to describe the best mode of the claimed invention by reference to a commonly owned, abandoned U.S. application that is less than 20 years old.
- (B) Incorporating non-essential material by reference to a prior filed, commonly owned pending U.S. application.
- (C) Incorporating material that is necessary to provide an enabling disclosure of the claimed invention by reference to a U.S. patent.
- (D) Incorporating non-essential material by reference to a hyperlink.
- (E) Incorporating material indicating the background of the invention by reference to a U.S. patent which incorporates essential material.

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

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

4. In January 1997, Chris invents an electrical door stop for automatically stopping a door at any position by simply pressing the doorknob downward. The doorknob is such that when carrying a large package, one may rest the package on the doorknob to stop the motion of the door. During a lunch break before completing the writing of the application for the patent on the automatic door stop, Chris' patent agent, Sam, visits a local Shack restaurant and notices a door stop which is actuated by stepping with one's foot on a mechanical lever located at the bottom of the door. Sam makes a mental note to ask a colleague as to whether he needs to disclose the doorstop at the Shack restaurant to the USPTO in conjunction with Chris' application in an information disclosure statement, but ultimately neglects to do so. Sam knows that the restaurant (and doorstop) was in existence at least one year prior to Sam's visit. In the first Office action, the only prior art uncovered by the examiner relates to stopping a door using a lever that engages a channel in the ceiling upon being pressed upward. The examiner rejects the claim asserting it would have been obvious to have either upward or downward actuating motion. In the reply to the first Office action Sam argues that the downward motion is essential because it affords the ability to actuate when one is carrying a package and that the prior art does not disclose a downwardly actuated doorstop. Following Sam's argument, the case issues. Claim 1 reads as follows:

1. A door stop for automatically stopping the pivoting action of a door by pressing downward, said door stop comprising:
 - a) first means attached to a door for receiving a downward movement;
 - b) second means for actuating a mechanism for engaging the floor surface in response to the downward movement of the first means, said first and second means being operatively connected.

Which of the following is true?

- (A) Since Sam knew of the doorstop at the restaurant and not Chris, there is no duty to disclose the Shack restaurant doorstop. An attorney need not disclose that which is within his personal knowledge in an information disclosure statement.
- (B) Since Sam discovered the Shack restaurant device after he had started writing the application, the invention was fully disclosed to Sam. There is no need to disclose that which occurs after an inventor completes his application disclosure.
- (C) Sam needs to disclose only patents or printed publications to the USPTO to satisfy the duty of disclosure. Since Sam was unaware of any patent or printed publication for the Shack restaurant doorstop, Sam does not need to file an information disclosure in this regard.
- (D) Chris should file a request for reexamination seeking to have the Shack restaurant door stop considered.
- (E) None of the above.

5. Which of the following is a proper basis for establishing a substantial new question of patentability to obtain reexamination in accordance with proper USPTO practice and procedure?

- (A) An admission *per se* by the patent owner of record that the claimed invention was on sale, or in public use more than one year before any patent application was filed in the USPTO.
- (B) A prior art patent that is solely used as evidence of an alleged prior public use.
- (C) A prior art patent that is solely used as evidence of an alleged insufficiency of disclosure.
- (D) A printed publication that is solely used as evidence of an alleged prior offer for sale.
- (E) None of the above.

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

- (A) Amending the claim by canceling elements B and C because the reference is concerned only with element A.
- (B) 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."

7. Which of the following is true?

- (A) Once an application is ready to be issued, there is a public policy that the patent will issue in regular course once the issue fee is timely paid. In accordance with the foregoing, issuance of a patent may not be deferred.
- (B) The time period set for the payment of the issue fee is statutory and cannot be extended.
- (C) While anyone may file a request for *ex parte* reexamination, a patent practitioner filing a request for *ex parte* reexamination must disclose the client's name.
- (D) It is necessary to claim priority under 35 U.S.C. § 120 to earlier filed applications for which a corresponding claim of priority has been made in the corresponding foreign filed applications of the same applicant.
- (E) (A), (B), and (C).

8. In early 1998, at the request of MC Motors, Eve demonstrated her reverse automobile heating system at a testing facility in Germany. MC Motors signs a confidentiality agreement and agrees not to disclose the invention to anyone. The test is conducted in a secluded area and the persons involved are sworn to secrecy. Unbeknownst to Eve, MC Motors installs the reverse heating system on its MC cars and begins selling its cars with the reverse heating system in the United States in September 1998. In August 1999, MC files a patent application in the United States for the reverse automobile heating system. In December 1999, Eve files a patent application claiming the automobile heating system. The examiner rejects all the claims in Eve's application based upon an MC Motors brochure advertising its cars in September 1998. Which of the following is true?

- (A) Since the MC Motors misappropriated the invention and since Eve did not authorize the sale, the rejection may be overcome by showing that the sales by MC Motors were not authorized by Eve.
- (B) Eve is not entitled to a patent since 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.
- (C) MC Motors is entitled to a patent since although it misappropriated the idea for the invention from Eve, the misappropriation was beyond the jurisdiction of the USPTO.
- (D) (B) and (C).
- (E) None of the above.

9. 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.

Please answer questions 10 and 11 based on the following information.

A patent issued to Joe Inventor on July 25, 2000 based on an application filed in January 1999. Larry Practitioner was the registered practitioner of record in the application, and all correspondence from the USPTO during prosecution was directed to Larry at his then-current address. At the time he paid the issue fee, Larry designated a “fee address” for payment of maintenance fees. Larry moved his office on September 1, 2000, and notified the Office of Enrollment and Discipline of his new address in accordance with 37 C.F.R. § 10.11. Larry did not, however, file a change of correspondence address in the patent file. An assignment of all rights in the patent from Joe Inventor to Big Corporation was made September 5, 2000 and was recorded in the USPTO on September 14, 2000.

10. Under standard USPTO practice and procedure, where will the USPTO send any Maintenance Fee Reminder?

- (A) Joe Inventor’s address as indicated on the inventor’s declaration, unless a change of address had been filed for Mr. Inventor.
- (B) Larry’s address prior to September 2000.
- (C) Larry’s address subsequent to September 1, 2000.
- (D) The fee address designated by Larry at the time he paid the issue fee.
- (E) The address of the assignee as indicated on the assignment recorded in the USPTO.

11. Under standard USPTO practice and procedure, where will the USPTO send a communication for Big Corporation concerning a request for reexamination involving the patent?

- (A) Joe Inventor’s address as indicated on the inventor’s declaration, unless a change of address had been filed for Mr. Inventor.
- (B) Larry’s address prior to September 2000.
- (C) Larry’s address subsequent to September 1, 2000.
- (D) The fee address designated by Larry at the time he paid the issue fee.
- (E) The address of the assignee as indicated on the assignment recorded in the USPTO.

12. Which of the following is true?

- (A) Claims may be properly rejected on the ground that applicant has disclaimed the subject matter involved if the applicant fails to copy a claim from a patent when suggested by the examiner.
- (B) Res Judicata, as a proper ground for rejection, should be applied when the earlier decision was a final rejection by the same examiner.
- (C) If an article of manufacture capable of illustration is originally claimed and it is not shown in the drawing, the claim should be rejected based on the reason the claimed subject matter is not shown in the drawing, and applicant is required to add it to the drawing.
- (D) A thing occurring in nature, which is substantially unaltered, such as a shrimp with the head and digestive tract removed, is a “manufacture.”
- (E) A scientific principle, divorced from any tangible structure, is a statutory class of patentable subject matter.

13. On February 3, 1999, you filed an application for inventor Sam, fully disclosing and claiming only the following:

Claim 1. A system for preventing unauthorized entry into a garage, comprising: an electric garage opener coupled to a computer and to a video camera.

You received a non-final Office action dated February 4, 2000, wherein the examiner rejected claim 1 under 35 U.S.C. § 102(b) as anticipated by Dan. The examiner attached a copy of Dan’s journal article published on July 4, 1997, fully disclosing an electric garage opener coupled to a computer and to a video camera. Which of the following actions, if taken by you, can overcome the rejection in accordance with proper USPTO practice and procedure?

- (A) Timely filing a reply traversing the rejection, arguing that claim 1 is patentably distinguished from the Dan reference.
- (B) Timely filing a reply traversing the rejection, arguing that since the date of the Dan reference falls on a Federal holiday, the Dan reference is not a statutory bar under 35 U.S.C. § 102(b).
- (C) Timely filing a reply with an affidavit under 37 C.F.R. § 1.131 showing prior invention by Sam.
- (D) Timely filing a reply traversing the rejection, arguing that the examiner did not demonstrate why one of ordinary skill in the art at the time the invention was made would have been motivated to modify the system disclosed by Dan.
- (E) Timely filing a reply including an amendment to the specification perfecting priority under 35 U.S.C. § 120, containing a specific reference in accordance with 37 C.F.R. § 1.78(a), to a U.S. application filed by Sam on July 3, 1997 that fully disclosed but did not claim a garage opener coupled to a computer and a video camera.

14. The right of priority under 35 U.S.C. § 119 (a)-(d) may be obtained where, if all other requirements are met:

- (A) A is the inventor of the U.S. nonprovisional application, and B is the inventor of the foreign application, and the two applications are owned by the same party.
- (B) The United States nonprovisional application, or its earliest parent nonprovisional application under 35 U.S.C. § 120, was filed 18 months from the earliest, and only foreign filing.
- (C) The right is premised upon the second foreign filed application disclosing and claiming the same invention as is claimed in the earliest United States nonprovisional application, the first foreign application having been filed twenty-four months before said United States nonprovisional application.
- (D) The U.S. application contains only process claims, and the foreign application does not enable the disclosed process.
- (E) The claim for foreign priority includes the application number, and filing date of the foreign application, as well as the name of the treaty under which the application was filed, if appropriate, and the name and location of the national or intergovernmental authority which received such application.

15. In December 1987, Molly invents a new potato cutter that cuts the potatoes into shapes having a star cross section. Because of the proximity of the star outer surface to the inter core of the potato, the shape achieves optimal cooking of the potato when fried without resulting in an overly cooked outer surface. Molly, thinking that the invention is important, has two people, Sue and Tom, both sworn to secrecy, witness a drawing of the invention. Molly then locks the drawing in a safe deposit box where it remains for the next twelve years. Neither Molly, Sue, or Tom discloses the invention to anyone for the next twelve years. In December 1999, Troy invents a new potato cutter which produces potatoes having a star cross section, and the potatoes are then fried. The invention becomes an overnight success. Troy files a patent application on February 1, 2000. Molly, after seeing the success of Troy's invention in the marketplace, decides to file an application, also on February 1, 2000. The examiner is unable to find any prior art and no other prior art is cited by either applicant. Which of the following is true?

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

16. In June 1995 Michael buys a television set with a remote control for automatically changing channels on the television set. In June 1997, Michael moves to a new neighborhood and discovers while watching television that the remote control for his television not only changes the channels on his television set but also operates to open his neighbor's garage door. Michael, believing that people no longer need to have separate devices for operating their television and opening their garage doors, goes to a registered practitioner to seek patent protection on his new idea. The practitioner files a patent application in 1997. During the prosecution of the patent for the circuit board device, the practitioner files the following claims 11 and 12:

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

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

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

Which of the following is true?

- (A) Since the television and remote control were sold in June 1995, claims 11 and 12 are barred by 35 U.S.C. § 102(b) since the device was on sale more than one year prior to the invention by Michael.
- (B) Although the device was bought in June 1995, Michael did not use it to open a garage door until 1997. Since claim 11 requires that the signals of the remote control operate to open the garage door, the limitations of claim 11 are not met by the device bought in 1995, and 35 U.S.C. § 102(b) does not apply.
- (C) Since the television remote control device was in public use more than one year prior to the filing date of the application, Michael may obtain the patent coverage for the method claim 12 but not the device of claim 11.
- (D) Since Michael did not make the remote control himself and only inadvertently discovered that his neighbor's garage door opens when changing the channel on his television set, this is merely an inadvertent discovery and not entitled to patent protection.
- (E) Whether or not claim 11 is patentable is solely a question of obviousness. Michael need only produce evidence of commercial success to overcome an obviousness rejection.

17. A patent application filed in the USPTO 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 USPTO 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.

18. Sally, an employee of Ted, conceived of and reduced to practice a spot remover for Ted on May 1, 1997. Sally’s spot remover was made from water, chlorine, and lemon juice. On June 2, 1997, Sally filed a nonprovisional U.S. patent application for the spot remover, and assigned the entire rights in the application to Ted. Sally’s assignment was not recorded in the USPTO, but was referred to in her application. On June 12, 1998, Jane, also an employee of Ted, having no knowledge of Sally’s spot remover, conceived of and reduced to practice a spot remover for Ted. Jane’s spot remover was made from carbonated water, chlorine, and lemon juice. On May 26, 1998, the USPTO granted Sally a patent. On November 6, 1998, Jane filed a nonprovisional U.S. patent application for the spot remover. As noted in Jane’s application, Jane assigned the entire rights in her application to Ted. Jane’s assignment was duly recorded in the USPTO. The examiner mailed a non-final Office action rejection under 35 U.S.C. § 103 to Jane in October 2000, citing the patent to Sally as prior art. Which of the following, if timely filed by Jane, would be effective in disqualifying Sally’s patent?

- I. An affidavit by Jane stating that the application files of Sally and Jane both refer to assignments to Ted.
- II. A copy of Sally’s assignment to Ted, clearly indicating that common ownership of Jane’s and Sally’s inventions existed at the time Jane’s invention was made.
- III. An affidavit by Ted stating sufficient facts to show that there is common ownership of the Sally and Jane inventions and that common ownership existed at the time the Jane invention was made.

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

Please answer questions 19 and 20 based on the following facts:

Your client, Bill, disclosed to you the following. While hiking, he found a natural specimen of tree sap that had bonded rock material to a log, and was impervious to water. Bill realized that the sap would be an excellent roofing material for bonding asphalt shingles to wooden sheathing. Bill performed a chemical analysis of the sap and determined it was 10% A, 30% B, and 60% C. Bill experimented and found that he could synthetically produce the sap by mixing one part A by weight and three parts B by weight at 20 degrees Celsius, heating the mixture of A and B to 100 degrees Celsius, adding six parts C by weight, and cooling the mixture of A, B, and C to 20 degrees Celsius. Bill further experimented and found that if he added an effective amount of D to the mixture of A, B, and C, prior to cooling, the viscosity of the product would decrease, making it easier for roofers to apply it to wooden sheathing. You draft a patent application with a specification having all the information disclosed to you by Bill, including guidelines that explained that an effective amount of D for decreasing the viscosity is between 1% to 2% of the total weight of the mixture of A, B, and C, after cooling. The guidelines also explained that an effective amount of D for brightening the color of the composition is between 3% to 4% of the total weight of the mixture of A, B, and C, after cooling.

19. Which if any of the following claims, included in Bill's application, would not be properly rejected pursuant to 35 U.S.C. § 101?

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

Claim 2. A composition for bonding asphalt shingles to wood sheathing, comprising 10% A, 30% B, and 60% C.

Claim 3. A composition produced by the steps of: mixing one part A by weight with three parts B by weight at 20 degrees Celsius to form a mixture of A and B; heating the mixture of A and B to 100 degrees Celsius; adding six parts C by weight to form a mixture of A, B, and C; cooling the mixture of A, B, and C to 20 degrees Celsius; and adding an effective amount of D to decrease the viscosity of the composition.

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

20. Assuming that A, B, C, and D are known materials, which if any of the following claims, included in Bill's application, would not be properly rejected pursuant to 35 U.S.C. 112, second paragraph?

Claim 1. A composition produced by the steps of: mixing one part A by weight with three parts B by weight at 20 degrees Celsius to form a mixture of A and B; heating the mixture of A and B to 100 degrees Celsius; and adding six parts C by weight to the mixture of A and B.

Claim 2. A composition for bonding asphalt shingles to wood sheathing, comprising 10% A, 30% B, and 60% C.

Claim 3. A composition produced by the steps of: mixing one part A by weight with three parts B by weight at 20 degrees Celsius to form a mixture of A and B; heating the mixture of A and B to 100 degrees Celsius; adding six parts C by weight to form a mixture of A, B, and C; cooling the mixture of A, B, and C to 20 degrees Celsius; and adding an effective amount of D.

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

21. You are prosecuting a patent application wherein an Office action has been issued rejecting the claims as being obvious over the prior art and objecting to the drawings as failing to illustrate an item that is fully described in the specification and included in a dependent claim. The examiner has required an amendment to Figure 1 to illustrate the item. In preparing a reply to the Office action, you identify several errors in Figure 2 that should also be corrected. Assuming that you make a amendment to the claims and develop persuasive arguments to overcome the obviousness rejection and that the examiner will not object to your desired changes to Figure 2, which of the following actions is likely to lead to the most favorable result?

- (A) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. Submit a separate cover letter for replacement Figures 1 and 2 that incorporate the amendments to the drawings.
- (B) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. In the Remarks portion of the reply, explain the proposed drawing changes and attach copies of Figures 1 and 2 with the changes marked in red for the examiner's review and approval.
- (C) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. In a separate paper, explain the proposed drawing changes and attach copies of Figures 1 and 2 with the changes marked in red for the examiner's review and approval.
- (D) Options (A), (B) and (C) are equally likely to lead to the most favorable result.
- (E) Options (B) and (C) are equally likely to lead to the most favorable result.

22. A rejection based on 35 U.S.C. § 102(a) cannot be overcome by:
- (A) Filing an affidavit under 37 C.F.R. § 1.132 showing that the reference invention is not by “another.”
 - (B) Perfecting a claim to priority under 35 U.S.C. § 119(a)-(d).
 - (C) Filing an affidavit under 37 C.F.R. § 1.131 “swearing back” of a U.S. patent which substantially shows or describes, and claims the same patentable invention as the rejected invention.
 - (D) Amending the claims to patentably distinguish over the prior art.
 - (E) Persuasively arguing that the claims are patentably distinguishable from the prior art.
23. Which of the following statements is correct regarding an antedating declaration or affidavit being used in accordance with proper USPTO practice and procedure?
- (A) Where the reference, a U.S. Patent, with a patent issue date less than one year prior to applicant’s effective filing date, shows but does not claim the same patentable invention.
 - (B) Where the reference publication date is more than one year before applicant’s effective filing date.
 - (C) Where the reference is a prior U.S. patent to the same entity, claiming the same invention.
 - (D) Where the subject matter relied on in the reference is prior art under 35 U.S.C. § 102(g).
 - (E) Where the effective filing date of applicant’s parent application or an International Convention-proved filing date is prior to the effective date of the reference.
24. 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.

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

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

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

26. In which of the following situations can the applicant overcome a rejection under 35 U.S.C. § 102(e) over a U.S. patent in accordance with proper USPTO practice and procedure?

- (A) An applicant can antedate the filing date of the patent used to reject claims under 35 U.S.C. § 102(e) by relying upon the filing date of applicant's prior abandoned nonprovisional patent application, which was filed before the effective date of the prior art. The abandoned application was not copending with the applicant's current patent application. The applicant did not file any other patent applications, and is not entitled to benefit of priority of the abandoned application.
- (B) An applicant can antedate the filing date of the patent used to reject claims under 35 U.S.C. § 102(e) if the applicant relies on the applicant's earlier foreign priority application, which conforms to the requirements of the first paragraph of 35 U.S.C. § 112 for all claims in the applicant's U.S. patent application, and all relevant provisions of 35 U.S.C. § 119 have been met. The foreign application has a filing date prior to the filing date of the patent.
- (C) An applicant can antedate the publication of his own invention more than one year before his first patent application was filed by showing that it is a publication of his own work.
- (D) An applicant can antedate the patent to a different inventive entity where the patent discloses but does not claim the applicant's invention, the patent describes the applicant's own work, and the applicant states that the different inventive entity derived the invention from him. The applicant files an affidavit disclosing the foregoing, but lacks evidence showing who invented the claimed subject matter.
- (E) (A), (B), (C) and (D).

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

- I. Applicant's invention was sold in Tokyo and New York more than one year prior to the effective U.S. filing date, but the sales were merely attempts at market penetration.
- II. Applicant's invention was experimented with and tested to further develop the invention more than one year prior to the effective U.S. filing date, but important modifications resulted from the experimentation causing the invention to be reduced to practice after the effective U.S. filing date.
- III. Applicant's invention was sold in Tokyo more than one year prior to the effective U.S. filing date, but the sale was merely market testing of the invention to determine product acceptance.

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

28. You filed an application on behalf of inventor Sam, obtaining an effective filing date of September 7, 1999. You received a non-final Office action dated August 7, 2000. On October 6, 2000, you timely filed a reply under 37 C.F.R. § 1.111. You received a Notice of Allowance dated October 12, 2000. On October 15, 2000, Sam showed you a journal article dated September 5, 1998, which is material to the patentability of Sam's invention as claimed. Which of the following actions, if taken by you, are in accordance with proper USPTO rules and procedure?

- I. Pay the issue fee on October 18, 2000 and do not file an information disclosure statement disclosing the article dated September 5, 1999, since after the issue fee has been paid on an application, it is impractical for the Office to attempt to consider newly submitted information.
- II. Prior to paying the issue fee, file an information disclosure statement disclosing the article dated September 5, 1998, and the fee set forth in 37 C.F.R. § 1.17(p).
- III. Prior to paying the issue fee, file an information disclosure statement disclosing the article dated September 5, 1998, a statement as specified in 37 C.F.R. § 1.97(e), a petition requesting consideration of the information disclosure statement, and the petition fee set forth in 37 C.F.R. § 1.17(i).

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

29. Your Canadian client, UpNorth Incorporated, came to you on August 11, 2000 with a valuable invention for pulping timber. UpNorth informed you it had been successfully using the invention commercially for the past fourteen months deep in the Canadian forests. The invention has not been used anywhere else by UpNorth, and the pulped timber from the UpNorth operations has not left Canada. At least one competitor, another Canadian company, lawfully observed the invention in operation during its first month of use with no restriction as to confidentiality or disclosure. UpNorth filed a Canadian patent application prior to commercial use of the invention, but (in an effort to hold down expenses) chose not file a corresponding application in the United States. The Canadian patent application remains pending. UpNorth just learned that two months ago its competitor began using the invention commercially in the United States. The invention was never disclosed or used in the United States prior to two months ago. UpNorth would like for you seek a United States patent on the invention to block the competitor from continued use of the invention. Which of the following would be reasonable advice from you to UpNorth?

- (A) Since Canada is a NAFTA country, UpNorth is precluded from getting a United States patent because the Canadian application was filed more than twelve months ago and the invention was in public use more than one year prior to any possible United States filing date for an UpNorth patent application.
- (B) UpNorth should promptly file an application in the United States claiming the benefit of the filing date of the Canadian application and should fully disclose the Canadian commercial activities, the observation of the invention in Canada by UpNorth's competitor, and the competitor's commercial activities in the United States.
- (C) UpNorth should promptly file an application in the United States without claiming the benefit of the filing date of the Canadian application and should fully disclose the Canadian commercial activities, the observation of the invention in Canada by UpNorth's competitor, and the competitor's commercial activities in the United States.
- (D) UpNorth should abandon the pending Canadian application to avoid the possibility the Canadian application could be used as prior art against a United States patent application, and then file a patent application in the United States.
- (E) Since UpNorth's activities concerning the invention all took place in Canada, the competitor's commercial use in the United States prior to any possible United States filing date for an UpNorth patent application precludes UpNorth from obtaining a United States patent.

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

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

31. Assume that conception of applicant's complex invention occurred prior to the date of the reference, but reduction to practice occurred after the date of the reference. Which of the following is sufficient to overcome the reference in accordance with proper USPTO practice and procedure?

- (A) In a 37 C.F.R. 1.131 affidavit or declaration, it is sufficient to allege that applicant or patent owner has been diligent.
- (B) In a 37 C.F.R. 1.131 affidavit or declaration, it is sufficient to clearly establish conception of the invention prior to the effective date of the reference. Diligence need not be considered.
- (C) In a 37 C.F.R. 1.131 affidavit or declaration, it is sufficient to clearly establish conception of the invention prior to the effective date of the reference, and diligence from just prior to the effective date of the reference to actual reduction to practice. The presence of a lapse of time between the reduction to practice of an invention and the filing of an application thereon is not relevant.
- (D) In a 37 C.F.R. 1.131 affidavit or declaration, it is sufficient to show conception and reduction to practice in any country.
- (E) In a 37 C.F.R. 1.131 affidavit or declaration, it is always sufficient to prove actual reduction to practice for all mechanical inventions by showing plans for the construction of the claimed apparatus.

32. Which of the following statements is not true?

- (A) The failure to perfect a claim to foreign priority benefit prior to issuance of the patent may be cured by filing a reissue application.
- (B) The failure to both express a desire to obtain the benefits of foreign priority and perfect a claim to foreign priority benefit prior to issuance of a parent patent may be cured by filing a Certificate of Correction request provided the requirements of 35 U.S.C. § 119(a)-(d) are satisfied in a continuation application.
- (C) The failure to perfect a claim to foreign priority benefit prior to issuance of a patent on a continuation application may be cured by filing a Certificate of Correction request provided the requirements of 35 U.S.C. § 119(a)-(d) are satisfied in the parent application prior to issuance, and the requirements of 35 U.S.C. § 120 and 37 C.F.R. § 1.55 are satisfied.
- (D) No renewal of previously made claims for foreign priority under 35 U.S.C. § 119 or continuation status of an application under 35 U.S.C. § 120 is necessary during reexamination.
- (E) A sole or joint applicant may rely on two or more different foreign applications and may be entitled to the filing date of one of them with respect to certain claims and to another with respect to other claims.

33. Mike and Jill are members of the Virginia Bar with a general law practice. Jill is registered to practice before the USPTO and is constantly poking fun at Mike for not being registered. Jake, one of Mike's former clients, owns a small tool shop and while attempting to remove a broken drill bit from a workpiece, invented a tool that easily extracts a broken bit. The tool is simple to make. Jake asked Mike if he could patent his invention, and Mike, desiring to impress Jill with his patent skills, said, "No problem." Using a "how to" book that he obtained from the INTERNET, Mike prepared an application on Jake's invention and filed it in the USPTO together with a power of attorney which Jake executed naming Jack as attorney of record. Shortly thereafter, the Mike and Jill firm hired Jim, a registered patent attorney, and Mike physically filed a document with the USPTO naming Jim as an associate attorney in Jake's application. Upon reviewing Jake's application, Jim discovered that the original claims omitted the recitation of a critical element which was disclosed in the specification. Assuming a preliminary amendment is filed with the USPTO adding the critical element to the claims, and explaining in the REMARKS that the critical element was inadvertently omitted at the time of filing the application, which of the following is the most comprehensive answer in identifying the individual(s), if any, who by signing the amendment will be recognized by the USPTO for representation?

- (A) Jake
- (B) Jim
- (C) Jill
- (D) All of the above
- (E) None of the above

34. You filed a patent application naming your client, Sam, as the sole inventor without an executed declaration under 37 C.F.R. § 1.63. The USPTO mailed you a Notice to File Missing Parts dated January 3, 2000. The Notice to File Missing Parts set a 2-month period for reply. Which of the following statements is in accordance with proper USPTO rules and procedure?

- I. An appropriate reply by you to the Notice to File Missing Parts is, on August 3, 2000 you file a declaration under 37 C.F.R. § 1.63 executed by Sam, with a petition under 37 C.F.R. § 1.136(a) for an extension of five months, and the fee set forth in 37 C.F.R. § 1.17(a).
 - II. In no situation can any extension requested by you carry the date on which reply is due to the Notice to File Missing Parts beyond Monday, July 3, 2000.
 - III. An appropriate reply by you to the Notice to File Missing Parts is, on August 3, 2000 you file a declaration under 37 C.F.R. § 1.63 executed by Sam, with a petition under 37 C.F.R. § 1.136(b).
- (A) I
 - (B) II
 - (C) III
 - (D) I and III
 - (E) None of the above.

35. A patent application filed in the USPTO 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 USPTO practices and procedures, from which of the following claims does Claim 2 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).

36. The following statements relate to “multiple dependent claims.” Which statement is not in accord with proper USPTO practice and procedure?

- (A) A multiple dependent claim contains all the limitations of all the alternative claims to which it refers.
- (B) A multiple dependent claim contains in any one embodiment only those limitations of the particular claim referred to for the embodiment under consideration.
- (C) A multiple dependent claim must be considered in the same manner as a plurality of single dependent claims.
- (D) Restriction may be required between the embodiments of a multiple dependent claim.
- (E) The limitations or elements of each claim incorporated by reference into a multiple dependent claim must be considered separately.

37. You have taken over prosecution of a patent application in January 1998 that had previously been handled by another patent practitioner. The original application had been filed with all required fees, a preliminary amendment, and a signed inventor’s declaration referring to the original application. The original application contained independent claims 1 and 7 and dependent claims 2-6 and 8-14. The preliminary amendment added independent claim 15 and dependent claims 16-19, but made no changes to the specification. A first, nonfinal Office action issued wherein the examiner determined that claim 17 included new matter. The examiner rejected claim 17 on this basis and required cancellation of the claim. All other claims were allowed. You have been asked to respond to the Office action. Which of the following is the most reasonable reply?

- (A) File a Request for Reconsideration explaining that since the Preliminary Amendment was filed concurrently with the original application, the examiner should consider the Preliminary Amendment to be part of the original disclosure and the rejection should be removed.
- (B) File a Petition under 37 C.F.R. § 1.181 for a review of the examiner’s determination that claim 17 includes new matter along with any required fees.
- (C) File a Notice of Appeal along with any required fees.
- (D) Submit a new inventor’s declaration that refers to both the original application and the preliminary amendment along with a Request for Reconsideration explaining that since the Preliminary Amendment was filed concurrently with the original application, the examiner should consider the Preliminary Amendment to be part of the original disclosure and the rejection should be removed.
- (E) Submit a new inventor’s declaration that refers to both the original application and the preliminary amendment, file a Petition under 37 C.F.R. § 1.182 along with the petition fee, requesting that the original oath or declaration be disregarded and that the application be treated as an application filed without an oath or declaration, and pay the surcharge for missing parts.

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

Claim 1. An apparatus for sitting comprising:

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

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

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

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

39. Al files an application for a patent. After the Notice of Allowance is mailed and the issue fee has been paid Al discovers a prior art reference which is material to patentability. What should Al do?

- (A) Al should file a prior art statement under 37 C.F.R. § 1.501 that will be placed in the patent file upon issuance of the application as a patent.
- (B) Since the issue fee has been paid, Al no longer has a duty to disclose to the Office material prior art. He is under no obligation to submit the prior art reference to the Office.
- (C) Since the issue fee has been paid, it is too late to have the examiner consider the reference in this application. Al should file a continuation application to have the reference considered and allow the original patent application to issue as a patent.
- (D) Al should file a petition to have the application withdrawn from issuance, citing the finding of additional material prior art as the reason for withdrawal. A continuation application should also be filed with an information disclosure statement containing the reference in order to have the reference considered.
- (E) Al should file an amendment under 37 C.F.R. 1.312 deleting all of the claims which are unpatentable over the reference since an amendment deleting claims is entitled to entry as a matter of right.

40. Stan, through a registered practitioner, files an application for a patent. During the prosecution of Stan's patent, in an amendment, the practitioner admitted in his discussion as to "all the claims" of Stan's application, that "the most pertinent available prior art known to the Applicants and their representatives is the Acme Patent, cited by the examiner." Within one year after the patent issues, Stan comes to you and wants to file a reissue to broaden his claims, based on the fact that the Acme patent is not prior art. He has ample evidence to show that he conceived and reduced his invention to practice before the filing date of the Acme patent. Which of the following is true?

- (A) Stan should file a reissue application accompanied by a declaration under 37 C.F.R. 1.131 to swear behind the date of the Acme reference. The statement by the registered practitioner, who formerly represented Stan, that the Acme patent was prior art constituted error without deceptive intent and may be corrected by reissue.
- (B) Stan should file a request for reexamination and submit the Acme patent along with evidence in the form of affidavits or declarations showing that the Acme patent is not prior art.
- (C) The explicit admission by registered practitioner, who formerly represented Stan, that the Acme patent constituted prior art is binding on Stan in any later proceeding involving the patent.
- (D) Since Acme patent was cited by the examiner and not by the registered practitioner, who formerly represented Stan, Stan can not be held accountable for the error. Moreover, the statement by was directed to the pertinence of the prior art and not to the issue of whether the date of the Acme patent could be sworn behind. Accordingly, the statement has no binding effect.
- (E) (A) and (D).

41. Where an amendment of a specification or claims is filed after a notice of allowance has been mailed, which of the following is not in accordance with proper USPTO practice and procedure?

- (A) Even though prepared by a practitioner and mailed without a certificate of mailing and not by express mail, all prior to allowance, and the amendment reaches the Office only after the notice of allowance has been mailed, such amendment has the status of one filed after the mailing of the notice of allowance.
- (B) A supplemental oath or declaration is treated as an amendment of the specification or claims.
- (C) The amendment may be refused entry because an additional search is required.
- (D) The amendment may be refused entry because more than a cursory review of the record is necessary.
- (E) The amendment may be refused entry because the amendment would involve materially added work on the part of the examiner; e.g., checking excessive editorial changes in the specification or claims.

42. You are assigned by your firm to prosecute a patent application which had been prepared and prosecuted by a former member of the firm. A Notice of Appeal had been filed and while in the process of preparing the Appeal Brief, you discover that data in the applicant's original notes would materially aid in persuading the Board as to the patentability of the appealed claims. Accordingly, you incorporate the data in an Affidavit and file the Affidavit with the USPTO together with the Appeal Brief. In light of this scenario, which of the following statements is true?

- (A) Since jurisdiction has passed to the Board, the Board will consider the Affidavit concurrently with the Appeal Brief.
- (B) Since jurisdiction has not passed to the Board, the Board will automatically remand the Affidavit for consideration by the examiner and hold consideration of the Appeal Brief in abeyance.
- (C) Since jurisdiction has passed to the Board, the Board may or may not consider the Affidavit as it sees fit.
- (D) Although authority from the Board is not necessary to consider the Affidavit, the examiner may not consider the Affidavit unless it is remanded to the examiner by the Board.
- (E) Since jurisdiction has not passed to the Board, the examiner may admit the Affidavit but require a showing of good and sufficient reasons why the Affidavit was not earlier presented.

43. An article in a popular scientific journal, dated January 13, 1998, fully discloses and teaches how to make a "Smart Shoe" wireless telecommunications device. The article discloses a shoe having a dialer in a rubber sole of the shoe. The article does not teach or suggest using a metallic shoelace as an antenna or for any other purpose. Which of the following claims in an application filed January 20, 1999 is/are anticipated by the journal article, and is/are not likely to be properly rejected under 35 U.S.C. § 112, second paragraph as indefinite?

Claim 1. A telecommunications device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and optionally a metallic shoelace.

Claim 2. A telecommunication device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and a metallic shoelace.

Claim 3. A telecommunication device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and optionally a random access memory for storing telephone numbers.

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

44. Which of the following is true?

- (A) A claim to a process omitting a step in a process, where the step is disclosed in the specification to be essential to the invention, may not be properly rejected under 35 U.S.C. 112, first paragraph, for lack of enablement where the specification provides an enabling disclosure for the process which includes the essential step.
- (B) A claim failing to interrelate essential elements of the invention as defined by the applicant in the specification, where the interrelation is critical to the invention may be properly rejected under 35 U.S.C. 112, second paragraph, for failure to properly point out and distinctly claim the invention.
- (C) The best mode requirement is the same as the enablement requirement of the first paragraph of 35 U.S.C. 112.
- (D) If the best mode contemplated by the inventor at the time of filing the application is not disclosed, a proposed amendment adding a specific mode of practicing the invention would not be new matter.
- (E) Failure to disclose the best mode must rise to the level of active concealment or grossly inequitable conduct in order to support a rejection under 35 U.S.C. 112, first paragraph.

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

- (A) As “Express Mail Post Office to Addressee” without the Express Mail mailing label number being placed on the application and with the “date-in” entered by the USPS on Saturday, June 24, 2000, and the application being received in the USPTO on Tuesday, June 27, 2000.
- (B) As “Express Mail Post Office to Post Office” without the Express Mail mailing label number being placed on the application and with the “date-in” entered by the USPS on Friday, June 23, 2000, and the application being received in the USPTO on Monday, June 26, 2000.
- (C) As “Express Mail Post Office to Addressee” without the Express Mail mailing label number being placed on the application and with the “date-in” entered by the applicant on Thursday, June 29, 2000, and the application being received in the USPTO on Wednesday, July 5, 2000.
- (D) As “Express Mail Post Office to Addressee” with the Express Mail mailing label number being placed on the application and with the “date-in” entered by the applicant on Thursday, June 29, 2000, and the application being received in the USPTO on Monday, July 3, 2000.
- (E) As “Express Mail Post Office to Post Office” with the Express Mail mailing label number being placed on the application and with the “date-in” entered by the USPS on Saturday, July 1, 2000, and the application being received in the USPTO on Monday, July 3, 2000.

46. A non-final Office action was mailed in a pending patent application on Friday, November 12, 1999. The examiner set a three month shortened statutory period for reply. The practitioner petitioned for a one-month extension of time on Monday, February 14, 2000 and paid the appropriate one-month extension fee. An amendment responsive to the Office action was filed Tuesday, March 14, 2000. Each independent claim in the application was revised and two dependent claims were cancelled. No claim was added by the amendment. In the Remarks portion of the amendment, the practitioner express his belief that no fees are required by the amendment, but nevertheless gave authorization to charge any fees to the practitioner's account, nn-nnnn, if any fees are necessary, including fees for any required extension of time. A duplicate copy of the amendment was filed. No fees were submitted with the amendment. Assuming nn-nnnn is a valid deposit account, which of the following statements is true?

- (A) The amendment should be entered with no fees charged to practitioner's deposit account.
- (B) The amendment should be entered, but the fee for a second month extension of time should be charged to the practitioner's deposit account.
- (C) The amendment should not be entered because it is untimely.
- (D) The request to charge any required fees, including fees for any necessary extension of time, is ineffective because it was not made in a separate paper.
- (E) Statements (C) and (D) are true.

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

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

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

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

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

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

48. Regarding claims, which of the following practices is not in accordance with proper USPTO practice and procedure?

- (A) A singular dependent claim 2 could read as follows:
2. The product of claim 1 in which...
- (B) An application may contain a series of singular dependent claims in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.
- (C) A claim which depends from a dependent claim may be separated therefrom by any claim which does not also depend directly or indirectly from said "dependent claim."
- (D) A dependent claim may refer back to any preceding independent claim.
- (E) Each claim begins with a capital letter and ends with a period.

49. A complete continuation application by the same inventors as those named in the prior application may be filed under 35 U.S.C. § 111(a) using the procedures of 37 C.F.R. § 1.53(b) by providing:

- (A) A copy of the prior application, including a copy of the signed declaration in the prior application, as amended.
- (B) A new and proper specification (including one or more claims), any necessary drawings, a copy of the signed declaration as filed in the prior application (the new specification, claim(s), and drawings do not contain any subject matter that would have been new matter in the prior application), and all required fees.
- (C) A new specification and drawings and a newly executed declaration. The new specification and drawings may contain any subject matter that would have been new matter in the prior application.
- (D) A new specification and drawings, and all required fees.
- (E) (A), (B), (C) and (D).

50. Which of the following is not a USPTO 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.

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