

Test Number 123
Test Series 101

Name _____

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

APRIL 18, 2001

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. 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 court decision, a notice in the *Official Gazette*, or a notice in the *Federal Register*. 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 that 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 addresses provisions of the Patent Statute, regulations and MPEP which were not changed as a result of the enactment of the American Inventors Protection Act of 1999, Pub. L. No. 106-113 (“Act”). This examination also does address and test changes to the Patent Statute or regulations brought about by the enactment of the Act. Some, but not all, questions use the statute and rules, comments to the rules, and guidelines in place subsequent to November 28, 1999, including the following rule changes and guidelines in effect on or before January 20, 2001:

? Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule. 65 FR 50092 (Aug. 16, 2000) (including the adoption of changes set forth in Interim Rule, 65 FR 14865 (Mar. 20, 2000) to §§ 1.7, 1.17(e) and (i), 1.53(d)(1), 1.78(a)(3), 1.97(b), 1.104(c)(4), 1.113, 1.116, 1.198, 1.312, and 1.313(a), (b), (c)(1), (c)(3), and (d)).

? Changes to Permit Payment of Patent and Trademark Fees by Credit Card; Final Rule. 65 FR 33452 (May 24, 2000).

? Revision of Patent Fees for Fiscal Year 2001; Final Rule. 65 FR 49193 (Aug. 11, 2000).

? Changes To Implement the Patent Business Goals; Final Rules. 65 FR 54604 (Sept. 8, 2000).

? Changes to Implement the Patent Business Goals; Final Rule and corrections to final rules. 65 FR 78958 (Dec. 18, 2000).

? Changes to Implement Patent Business Goals; Final Rule, Correction. 65 Fed. Reg. 80755 (Dec. 22, 2000).

? Changes To Implement Patent Term Adjustment Under Twenty-Year Patent Term; Final Rules. 65 FR 56366, (Sept. 18, 2000).

? Changes to Implement Eighteen-Month Publication of Patent Applications; Final Rule. 65 FR 57024 (Sept. 20, 2000).

? Changes To Implement Eighteen-Month Publication of Patent Applications; Correction. Final Rule; correction. 65 FR 66502 (Nov. 6, 2000).

? Treatment of Unlocatable Patent Application and Patent Files; Final Rule. 65 FR 69446 (Nov. 17, 2000).

? Simplification of Certain Requirements in Patent Interference Practice; Final Rule. 65 FR 70489 (Nov. 24, 2000).

? Reestablishment of the Patent and Trademark Office as the United States Patent and Trademark Office, 65 Fed. Reg. 17858 (April 5, 2000).

? Guidelines Concerning the Implementation of Changes to 35 U.S.C. 102(g) and 103(c) and the Interpretation of the Term “Original Application” in the American Inventors

? Protection Act of 1999, 1233 O.G. 54-56 (April 11, 2000).

? Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, para. 6, 65 Fed. Reg. 38510-38516 (June 21, 2000); 1236 O.G. 98-104 (July 25, 2000).

? Guidelines Setting Forth a Modified Policy Concerning the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 U.S.C. 103(c), 1241 O.G. 96-97 (December 26, 2000).

? Assignment of Confirmation Number and Time Period for Filing a Copy of an Application by EFS for Eighteen-Month Publication Purposes, 1241 O.G. 97-98 (December 26, 2000).

? Utility Examination Guidelines, 66 F.R. 1092-1099 (January 5, 2001).

Guidelines for Examination of Patent Applications Under the 35 U.S.C. Sec. 112, para. 1 "Written Description" Requirement 66 F.R. 1099-1111 (January 5, 2001).

1. 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 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.
- (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 passed to the Board, the Board will consider the Affidavit concurrently with the Appeal Brief.

2. You are deciding whether to file continued prosecution applications (CPA) for prior applications before the earliest of payment of any issue fee on the prior application (and absent any petition under 37 C.F.R. § 1.313(c)), abandonment of the prior application, or termination of proceedings on the prior application. In which of the following circumstances is it proper to use the CPA procedure to file the application?

- (A) To file a divisional application of a prior complete provisional application for a utility invention filed under 35 U.S.C. § 111(b). The provisional application has an actual filing date after June 8, 1995.
- (B) To file a continuation-in-part application of a prior complete nonprovisional utility application filed under 35 U.S.C. § 111(a). The nonprovisional application has an actual filing date prior to November 29, 1999.
- (C) To file a continuation utility application of a prior complete nonprovisional utility application filed under 35 U.S.C. § 111(a). The nonprovisional application has an actual filing date prior to May 29, 2000.
- (D) To file a continuation utility application of a prior complete CPA utility application. The prior CPA application has an actual filing date of June 1, 2000, and is a continuation application of a prior complete utility application filed under 35 U.S.C. § 111(a) having an actual filing date of November 28, 1999.
- (E) To file a divisional application of a prior complete nonprovisional plant application filed under 35 U.S.C. § 111(a). The nonprovisional application has an actual filing date after May 29, 2000.

3. Which of the following is not in accordance with proper USPTO practice and procedure regarding patent applications filed in March 2001?

- (A) If a non-English reference is submitted in an information disclosure statement, the applicant shall include a copy of the translation if a written English-language translation of the non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c).
- (B) Each U.S. patent listed in an information disclosure statement must be identified by inventor, application number, and issue date.
- (C) Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.
- (D) When the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications, provided that it is stated that these other patents or publications are cumulative.
- (E) A copy of any patent, publication, pending U.S. application or other information listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application, unless: (1) the earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120; and (2) the information disclosure statement submitted in the earlier application is in full compliance with appropriate regulations.

4. A maintenance fee in the correct amount is received by the USPTO on February 8, 2001, prior to the due date. The maintenance fee payment includes identification of a U.S. patent number. In accordance with proper USPTO rules and procedure, in which of the following situations may the USPTO return the maintenance fee payment?

- (A) The maintenance fee payment is submitted by the patentee's grandmother, without authorization by the patentee, and includes identification of the U.S. application number for patent.
- (B) The maintenance fee payment is submitted by the attorney of record in the application, without authorization by the patentee, and includes identification of the U.S. application number for the patent.
- (C) The maintenance fee payment is submitted by the attorney of record in the application, with authorization by the patentee, and does not include identification of the U.S. application number for the patent.
- (D) (A) and (B).
- (E) None of the above.

Please answer questions 5 and 6 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.

5. 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 Practitioner’s address prior to September 2000.
- (C) Larry Practitioner’s address subsequent to September 1, 2000.
- (D) The fee address designated by Larry Practitioner at the time he paid the issue fee.
- (E) The address of the assignee as indicated on the assignment recorded in the USPTO.

6. 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 Practitioner’s address prior to September 2000.
- (C) Larry Practitioner’s address subsequent to September 1, 2000.
- (D) The fee address designated by Larry Practitioner at the time he paid the issue fee.
- (E) The address of the assignee as indicated on the assignment recorded in the USPTO.

7. For purposes of determining whether a request for continued examination is in accordance with proper USPTO rules and procedure, in which of the following situations will prosecution be considered closed?

- (A) The last Office action is a final rejection.
- (B) The last Office action is an Office action under *Ex Parte Quayle*.
- (C) A notice of allowance has issued following a reply to a first Office action.
- (D) The application is under appeal.
- (E) All of the above.

8. Which of the following is not in accord with proper USPTO practice and procedure regarding *ex parte* reexaminations filed in March 2001?

- (A) In every instance of an interview with an examiner in an *ex parte* reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner.
- (B) An interview does not remove the necessity for reply to Office actions as specified in 37 CFR § 1.111.
- (C) A patent owner's reply to an outstanding Office action after the interview does not remove the necessity for filing the written statement of the reasons presented at the interview as warranting favorable action.
- (D) The written statement must be filed as a separate part of a reply to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.
- (E) Third party requesters have the option of attending interviews, but their presence is not mandatory.

9. Which of the following is not in accord with proper USPTO practice and procedure?

- (A) A written description as filed in a nonprovisional patent application is presumed adequate under 35 U.S.C. § 112 in the absence of evidence or reasoning to the contrary.
- (B) An examiner may show that a written description as filed in a nonprovisional patent application is not adequate by presenting a preponderance of evidence why a person of ordinary skill in the art would not recognize in the applicant's disclosure a description of the invention defined by the claims.
- (C) A general allegation of "unpredictability in the art" is sufficient to support a rejection of a claim for lack of an adequate written description.
- (D) When filing an amendment, a practitioner should show support in the original disclosure for new or amended claims.
- (E) When there is substantial variation within a genus, an applicant must describe a sufficient variety of species to reflect the variation within the genus.

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. Registered practitioner Ethel prepares a utility patent application (not a CPA) for inventor Fred, using her only copy of a published article, "Engineering Design," published June 8, 1995, to draft the application. Thereafter, Ethel accidentally runs the copy of the article through her paper shredder. Ethel duly files the application in the USPTO on May 29, 1999. The examiner sends Ethel a non-final Office action dated December 7, 2000, setting a three-month period for reply, including a rejection of claim 1 and a requirement for information under 37 CFR § 1.105 requiring her to submit a copy of the article, "Engineering Design." Which of the following will properly be accepted by the USPTO as a complete reply to the requirement for information?

- (A) An information disclosure statement, filed by Ethel on Monday, January 15, 2001, that complies with the provisions of 37 CFR § 1.98, listing a foreign patent, and stating that each item of information contained in the information disclosure statement was first cited in a communication from a foreign patent office less than three months prior to the filing of the information disclosure statement.
- (B) A statement filed by Ethel on Wednesday, March 7, 2001, stating that Ethel is not an individual identified under 37 CFR § 1.56(c).
- (C) A statement filed by Ethel on Thursday, March 8, 2001, with the appropriate petition and fee for a one-month extension, that states that the information required to be submitted is not readily available to the party from which it was requested.
- (D) A statement filed by Ethel on Thursday, March 8, 2001, with the appropriate petition and fee for a one month extension, which states that Ethel has a good faith belief that the information required is not material to patentability.
- (E) None of the above.

12. In January 2000, 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.

13. 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.

14. 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 dependent claim may refer back to any preceding independent claim.
- (D) 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.”
- (E) Each claim begins with a capital letter and ends with a period.

15. Which of the following is/are information which the USPTO may require an attorney of record in a reissue application to submit in a reply to a first Office action dated April 12, 2001?

- (A) Information used in invention process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.
- (B) The publication date of an undated document mentioned by applicant which may qualify as printed publication prior art.
- (C) Comments on a new decision by the Federal Circuit that appears on point in the examination of the application.
- (D) (A), (B), and (C).
- (E) None of the above.

16. 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) The explicit admission by the registered practitioner, who formerly represented Stan, that the Acme patent constituted prior art is binding on Stan in any later proceeding involving the patent.
- (C) 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.
- (D) Since the 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 the registered practitioner 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).

17. Which of the following statements involving an examiner's statement of reasons for allowance in a Notice of Allowance dated February 8, 2001, is in accordance with USPTO rules and procedure?

- (A) Failure by applicant or patent owner to file a statement commenting on the reasons for allowance cannot give rise to any implication that the applicant or patent owner agrees with or acquiesces in the reasoning of the examiner.
- (B) If applicant files a statement commenting on the reasons for allowance, failure by the examiner to respond to applicant's statement gives rise to the implication that the examiner agrees with applicant's statement.
- (C) If applicant files a statement commenting on the reasons for allowance, failure by the examiner to respond to applicant's statement does not give rise to any implication.
- (D) (A) and (C)
- (E) None of the above.

18. Registered practitioner Joe files a design patent application under 37 CFR § 1.53(b) having one claim on May 6, 1999. The USPTO sends Joe a notice of allowance dated November 10, 2000. Joe pays the issue fee on November 15, 2000. On November 23, 2000, Joe learns about a publication (the “Smith Reference”) which he knows to be material to patentability of the claim, but which was not considered by the examiner during prosecution of the application. Joe prepares an information disclosure statement that complies with the provisions of 37 CFR § 1.98, listing the Smith reference. Which of the following actions, if taken by Joe on November 24, 2000, will result in a request for continued examination of the application being granted in accordance with USPTO rules and procedure?

- (A) Filing a request for continued examination of the application with the information disclosure statement listing the Smith Reference, without the fee set forth in 37 CFR § 1.17(e).
- (B) Filing a request for continued examination of the application with the information disclosure statement listing the Smith Reference, and the fee set forth in 37 CFR § 1.17(e).
- (C) Filing a request for continued examination of the application with the information disclosure statement listing the Smith Reference, the fee set forth in 37 CFR § 1.17(e), and a petition under 37 CFR § 1.313 with the fee set forth in 37 CFR § 1.17(h).
- (D) (B) or (C) above.
- (E) None of the above.

19. In early 1999, 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 1999. In August 2000, MC files a patent application in the United States for the reverse automobile heating system. In December 2000, 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 1999. Which of the following is true?

- (A) 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.
- (B) 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.
- (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) (A) and (C).
- (E) None of the above.

20. 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.

21. Which of the following is true?

- (A) For a nonprovisional utility patent application filed in the USPTO on January 10, 2001, formal drawings are required to overcome an objection issued during initial review that drawings in the application do not comply with 37 C.F.R. § 1.84(g) and (u)(1).
- (B) If the primary examiner requires formal drawings at the time a patent application is allowed and sets a three month period of time from the mail date of a notice of allowability within which to file the drawings to comply with 37 C.F.R. § 1.84, the applicant may obtain an extension of time to file the formal drawings by filing a petition for an extension of time under 37 CFR § 1.136(a) or (b) and the appropriate fee.
- (C) For a nonprovisional application filed on November 2, 2000, to claim the benefit under 35 U.S.C. § 119(e) of the filing date of a provisional application filed on November 6, 1999, the nonprovisional application must be copending with the provisional application.
- (D) In those instances in which an applicant seeks to add new matter to the disclosure of an application, a request for continued examination is not a proper procedure for adding the new matter.
- (E) A nonprovisional utility application in the name of inventor Smith filed on January 18, 2001, may properly claim the benefit of the filing date of a provisional utility application filed in Smith's name on January 24, 2000, where the provisional application is entitled to a filing date even though the basic filing fee for the provisional application was not paid.

22. Where the reference relied upon in a 35 U.S.C. § 103 rejection qualifies as prior art only under 35 U.S.C. § 102(f), or (g), which of the following represents the most comprehensive answer in accord with proper USPTO practice and procedure as to the action an applicant should take to overcome the rejection?

- (A) Present proof that the subject matter relied upon and the claimed invention are currently commonly owned.
- (B) Present proof that the subject matter relied upon and the claimed invention were commonly owned at the time the later invention was made.
- (C) Present proof that the subject matter relied upon and the claimed invention were subject to an obligation to assign to the same person at the time the later invention was made.
- (D) (A) and (B).
- (E) (C) and (D).

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 Mitch's agent should sign on behalf of Mac, since he continues to represent Mac.
- (E) Mitch should sign the Request and accompany it with a statement providing a satisfactory explanation for the lack of Mac's signature.

24. An amendment filed January 8, 2001, in an unassigned nonprovisional application seeks to cancel claims so that fewer than all of the currently named inventors are the actual inventors of the invention being claimed. The amendment includes a request to delete the names of the persons who are not inventors. In accordance with proper USPTO rules and procedure, the request may be signed by which of the following?

- (A) A registered practitioner not of record who acts in a representative capacity under 37 CFR § 1.34(a).
- (B) All of the applicants (37 CFR § 1.41(b)) for patent.
- (C) A registered practitioner of record appointed pursuant to 37 CFR § 1.34(b).
- (D) (B) and (C).
- (E) (A), (B), and (C).

25. Which of the following is not in accordance with proper USPTO practice and procedure?
- (A) Conversion of a provisional application to a nonprovisional application will result in the term of any patent to issue from the application being measured from at least the filing date of the provisional application.
 - (B) Conversion of a provisional application to a nonprovisional application cannot adversely impact on the term of any patent to issue from the application.
 - (C) An applicant having filed a provisional application can avoid any adverse patent term impact resulting from converting the provisional application to a nonprovisional application by instead filing a nonprovisional application claiming the benefit of the provisional application under 35 U.S.C. § 119(e).
 - (D) An applicant filing a nonprovisional application claiming the benefit under 35 U.S.C. § 119(e) and 37 C.F.R. § 1.78 of an earlier provisional application, and not requesting conversion of the provisional to a nonprovisional application can avoid the fee required to convert a provisional application to a nonprovisional application, as well as an adverse patent term effect that would result from a conversion.
 - (E) The twelve month period of pendency of a provisional application extends to the next secular or business day which is not a Saturday, Sunday, or Federal holiday in the District of Columbia if the day that is twelve months after the filing date of the provisional application under 35 U.S.C. § 111(b) and 37 C.F.R. § 1.53(c) falls on a Saturday, Sunday, or a Federal holiday in the District of Columbia.
26. Which of the following is not in accord with proper USPTO practice and procedure?
- (A) If a practitioner, “by mistake,” files an application and basic filing fee, the submission of the filing fee with the application is treated by the Office as not a fee paid by mistake, and the fee will not be refunded.
 - (B) If, in April 2001, a practitioner files an application, properly establishes the applicant’s small entity status, and “by mistake” pays the filing fee by submitting a check drawn in the amount that is twice the amount of the small entity filing fee, a refund of the excess fee may be obtained upon request filed any time during pendency of the application and life of any patent granted on the application.
 - (C) The paragraphs of the specification of an original utility patent application filed in January 2001 may, but are not required to be numbered at the time the application is filed.
 - (D) If a provisional application is filed in a language other than English, an English language translation of the non-English language provisional application will not be required in the provisional application.
 - (E) If a table having more than 50 pages of text is submitted on compact disc, the specification of a patent application must contain an incorporation-by-reference of the material on a compact disc in a separate paragraph, identifying each compact disc by the names of the files contained on each compact disc, their date of creation, and their sizes in bytes.

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

28. Practitioner Smith filed a utility patent application on January 5, 2001, with informal drawings. Upon review of the drawings, the USPTO concluded that the drawings were not in compliance with 37 C.F.R. § 1.84(a)(1) and (k), and were not suitable for reproduction. In an Office communication, Smith was notified of the objection and given two months to correct the drawings in order to place the application in the files of a Technology Center for examination. Which of the following complies with USPTO practices and procedures for a complete *bona fide* attempt to advance the application to final action?

- (A) Smith timely files a response requesting that the objections to the drawings be held in abeyance until allowable subject matter is indicated.
- (B) Smith timely files a response requesting that the objections to the drawings be held in abeyance since the requirement increases up-front costs for the patent applicant, and the costs can be avoided if patentable subject matter is not found.
- (C) Smith timely files a response requesting that the objections to the drawings be held in abeyance until fourteen months from the earliest claimed priority date.
- (D) Smith timely files a response correcting the drawings to comply with 37 C.F.R. § 1.84(a)(1) and (k), and making them suitable for reproduction.
- (E) All of the above.

29. 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 disclosure publicly posted on the INTERNET, but containing no publication or retrieval date.
- (D) A doctoral thesis indexed, cataloged and shelved in a university library.
- (E) Applicant's labeling of one of the figures in the drawings submitted with his application as prior art.

30. Which of the following is in accord with proper USPTO practice and procedure?
- (A) A utility application was filed in October 1999. Following a restriction requirement, the applicant elected claims 1-5, and the examiner withdrew non-elected claims 6-10. After a final rejection of claims 1-5 in January 2001, the applicant may submit an amendment canceling previously examined claims and present claims to the previously non-elected invention of claims 6-10 when filing a request for continued examination under 37 CFR § 1.114.
 - (B) Claims in an allowed application may be amended as a matter of right after payment of the issue fee inasmuch as the Office may not rule on amendment filed after a notice of allowance until after the period for payment of the issue fee has expired.
 - (C) If, at the time an application is allowed in January 2001, a corrected drawing is required or formal drawing is needed, the applicant is given a three month period in the notice of allowability to file the same, and is permitted to file corrected or formal drawings after payment of the issue fee upon filing a request of an extension of time and payment of the requisite fee.
 - (D) Where, after a final rejection, a request for continued examination complying with 37 CFR § 1.114, is filed in April 2001 accompanied by a request to suspend action by the Office for a period not exceeding three months to provide time to submit an information disclosure statement, and the requisite fees, the Office may grant the requested suspension.
 - (E) Where an examiner has finally rejected all the claims in a utility application in January 2001, and sets a three month shortened statutory period for reply, the Office may grant a request to suspend action by the applicant for a period not exceeding six months to provide time to gather and submit evidence, if the request and requisite fees are filed within the three month reply period.
31. 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 publication date is more than one year before applicant's effective filing date.
 - (B) Where the reference is a prior U.S. patent to the same entity, claiming the same invention.
 - (C) Where the subject matter relied on in the reference is prior art under 35 U.S.C. § 102(g).
 - (D) 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.
 - (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.

32. Which of the following is in accordance with proper USPTO practice and procedure?
- (A) After issuance of a notice of allowance in November 2000, a petition to withdraw an application from issue and requisite fee are required if a request for continued examination, submission, and requisite fee are filed prior to the issuance of the patent.
 - (B) After issuance of a notice of allowance in April 2001 for an application, an amendment of the claims in the application may be filed before, with, or after payment of the issue fee.
 - (C) The Office ensures that any petition to withdraw an application from issue, filed after payment of the issue fee, will be acted upon prior to the scheduled date of patent grant.
 - (D) If a request for continued examination under 37 CFR § 1.114, accompanied by the requisite fee, but not a submission, are filed in March 2001, after an application was allowed in January 2001, the Office will notify the applicant and set a time period within which the deficiency must be corrected.
 - (E) An amendment filed in the Office in April 2001 in reply to a final rejection must comply with either the provisions of 37 CFR § 1.114 or the provisions of 37 CFR § 1.116(b) and (c).

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 – 36. The following facts apply to the following three questions. For purposes of these questions, it should be assumed that the statutes and regulations effective as of April 18, 2001 apply for all time periods covered by the questions.

Joseph, a citizen and resident of the United States, invented a new brake for in-line skates and filed a nonprovisional utility patent application in the USPTO on February 8, 2001. The application as filed included a specification and claims in compliance with 35 USC § 112, three sheets of publication quality drawings, an abstract of the disclosure, and an information sheet listing the name and address of the inventor. The application was initially filed without an executed inventor's oath or declaration and without the required filing fee. The Office issued a "Notice to File Missing Parts – Filing Date Granted" on April 2, 2001. The Notice informed Joseph that he must submit an executed oath or declaration by the inventor, pay the required filing fee, and pay a surcharge for late submission of these items within two (2) months of the date of the Notice. Joseph received the Notice on April 9, 2001.

Joseph brought the Notice with him when he left for an extended overseas business trip the next day, April 10, 2001. Unfortunately, the Notice was placed in luggage that was lost during the trip. Upon his return to the United States on July 26, 2001, Joseph obtained a copy of the Notice and, on August 2, 2001 filed a Reply in full compliance with the Notice. A Petition for a two-month extension of time and all required fees accompanied the Reply. Joseph also requested waiver and a refund of fees associated with the Petition for extension of time on the basis that the delay was a result of his lost luggage and his extended trip overseas. In Joseph's view, even though he could have replied within the two-month period, it was unfair to penalize him for lost luggage. The request for waiver of fees was denied.

A first substantive Office action on the merits of the application issued December 19, 2001 and set a three-month shortened statutory time for reply. All pending claims were rejected on the basis of prior art. Joseph filed a fully responsive Amendment on March 19, 2002, and a final Office action issued August 12, 2002 with a three-month shortened statutory period for reply. The final Office Action allowed certain claims and rejected other claims on substantially the same grounds set forth in the first Office action. Joseph filed a Notice of Appeal on September 19, 2002 and an Appeal Brief on March 18, 2003. A Petition for extension of time and proper authorization to charge a deposit account for any required fees accompanied the Appeal Brief.

An Examiner's Answer issued on April 2, 2003, and Joseph filed a Reply Brief on April 15, 2003. The Board of Patent Appeals and Interferences reversed the Examiner's rejections on August 19, 2003. A Notice of Allowance and Issue Fee Due was mailed September 3, 2003. Joseph paid the Issue Fee on September 15, 2003 and the patent issued March 9, 2004.

34. The Office determined that the applicant failed to engage in reasonable efforts to conclude prosecution of the application. Which of the following statements is most true?

- (A) Joseph is entitled to no patent term extension because neither the Uruguay Round Agreements Act nor the Patent Term Guarantee Act of 1999 applies to Joseph's patent application.

- (B) Although the Patent Term Guarantee Act of 1999 applies to Joseph's application, Joseph forfeited any patent term extension by failing to engage in reasonable efforts to conclude prosecution of the application.
- (C) Joseph is entitled to a total patent term extension of approximately two (2) months because the application was pending for more than three (3) years.
- (D) Joseph's successful appellate review adds approximately 11 months to any calculation of patent term extension.
- (E) By replying to the Notice to File Missing Parts approximately two (2) months after the deadline set by the USPTO, Joseph reduced any patent term extension by two (2) months.

35. In addition to the facts set forth in connection with the previous question, Joseph's application had not and would not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing. At the time he filed his application in the USPTO, Joseph submitted a nonpublication request and supporting materials that fully complied with all requirements for nonpublication of the application at 18 months. Which of the following statements is most correct?

- (A) By requesting nonpublication of the application, Joseph "opted out" of the statutory framework for patent term extension and, therefore, no patent term extension is available.
- (B) Submission of the nonpublication request does not affect any patent term extension that might be available to Joseph.
- (C) Joseph may rescind his nonpublication request at any time.
- (D) Statements (A) and (C) are true.
- (E) Statements (B) and (C) are true.

36. In the facts set forth in connection with the preceding two questions, what if any extension of time was required by Joseph for filing an Appeal Brief on March 18, 2003?

- (A) No extension of time was available and the Appeal Brief should have been rejected because it was filed more than six months after the final Office action issued.
- (B) No extension of time was available and the Appeal Brief should have been rejected because it was filed more than six months after the Notice of Appeal was filed.
- (C) A three-month extension of time was required.
- (D) A four-month extension of time was required.
- (E) A five-month extension of time was required.

37. In which of the following instances is the filing of a request for continued examination (RCE) of an application, together with a submission and payment of the appropriate fee, in accordance with proper USPTO practice and procedure?

- (A) The RCE, including an amendment to the written description, is filed on April 17, 2001, in a nonprovisional utility application having a filing date in July 1998. A Notice of Appeal to the Board of Patent Appeals and Interferences had been filed in November 2000, and as of April 17th the appeal is awaiting a decision.
- (B) The RCE, including an amendment to the written description, is filed on April 17, 2001, in a nonprovisional utility application having a filing date in July 1996. A Notice of Appeal to the United States Court of Appeals for the Federal Circuit was properly filed in January 2001, and the appeal has not terminated as of April 17th.
- (C) The RCE, including an amendment to the written description, is filed on April 17, 2001, in a nonprovisional utility application having a filing date in July 1999. The issue fee was filed in the Office on Friday, January 19, 2001, but a petition and fee to withdraw the application has not been filed.
- (D) The RCE, including an amendment to the written description, is filed on April 17, 2001, for a nonprovisional utility application having a filing date in July 1996. On Monday, April 2, 2001, Applicant withdrew a Notice of Appeal to the United States Court of Appeals for the Federal Circuit. There were no allowed claims in the application, and the Court's dismissal of the appeal did not indicate any further action to be taken by the Office.
- (E) The RCE, including an amendment to the written description, is filed on April 17, 2001, for a provisional utility application having a filing date in July 2000.

38. A registered practitioner filed a nonprovisional U.S. patent application in the USPTO on Monday, October 9, 2000. The full basic fee for other than a small entity accompanied the application. The practitioner later realized that a mistake had occurred because only the basic fee for a small entity should have been paid. On Thursday, November 9, 2000, the practitioner completed proper establishment of the applicant's small entity status by filing an assertion under 37 C.F.R. § 1.27(c) with the USPTO. On Monday, December 11, 2000, the practitioner filed a petition under 37 CFR 1.136, and the fee required by 37 CFR 1.17(a) for a one month extension of time to file a request for a refund of the excess amount paid based on establishment of small entity status. Absent any other action, which of the following is the latest date that the practitioner can properly file a request for refund and obtain the same in accordance with proper USPTO practice and procedure?

- (A) Thursday, November 9, 2000.
- (B) Friday, December 8, 2000.
- (C) Monday, December 11, 2000.
- (D) Tuesday, January 9, 2001.
- (E) Thursday, January 11, 2001.

39. Which of the following is/are required to be included in a request for reexamination submitted by a person other than the patent owner on January 12, 2001?

- (A) A statement pointing out each substantial question of patentability based on the arguments stated by the examiner in the first Office action.
- (B) A statement that, in the opinion of the requester, the application to which the request is directed meets the requirements of 35 U.S.C. 112.
- (C) A copy of the entire patent including the front face, drawings, and specification/claims, in double column format on single-sided sheets, for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent.
- (D) A certification that a copy of the request has been served in its entirety on “the patent owner at the address as provided for in § 1.33(c),” without indicating the name and address of the party served.
- (E) None of the above.

40. In June 1998, 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 1998, when Jack returns to the United States he begins to make and sell an identical knife to the one seen in Vietnam. In July 1999, 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 2000. 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 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.
- (B) 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.
- (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).

41. Which of the following is not in accordance with proper USPTO practice and procedure regarding design patent applications filed in March 2001?

- (A) The expedited treatment available for design applications under 37 CFR § 1.155 expedites design application processing by, among other things, decreasing clerical processing time as well as the time spent routing the application between processing steps.
- (B) The “petition to make special” procedure is also available for designs and the petition fee is less than the fee for expedited examination.
- (C) To qualify for expedited examination: (1) the application must include drawings in compliance with 37 CFR § 1.84; (2) the applicant must have conducted a preexamination search; and (3) the applicant must file a request for expedited examination including: (i) The appropriate fee; and (ii) a statement that a preexamination search was conducted. The statement must also indicate the field of search and include an information disclosure statement in compliance with 37 CFR § 1.98.
- (D) If the design application is not effectively expedited by the Office, the fee for expediting the application will be refunded.
- (E) The Office will not examine an application that is not in condition for examination (*e.g.*, missing basic filing fee) even if the applicant files a request for expedited examination under this section.

42. Registered practitioner Rick files a utility patent application under 37 CFR § 1.53(b) in the USPTO having one claim on May 6, 1998. Following a proper final rejection dated June 28, 2000, of claim 1 Rick files a request for continued examination with the appropriate fee on September 12, 2000, and submits an amendment to claim 1 with the request. On October 7, 2000, Rick learns about a publication (the “Columbus reference”) which he knows to be material to patentability of claim 1, but which was not considered by the examiner during prosecution of the application. Rick prepares an information disclosure statement that complies with the provisions of 37 CFR § 1.98, listing the Columbus reference. The finality of the action dated June 28, 2000, is withdrawn in an Office action, dated November 20, 2000, which is after the filing of the request for continued examination. Which of the following actions, if taken by Rick, will properly result in the Columbus reference being considered by the Office during the pendency of the application?

- (A) Filing the information disclosure statement on November 15, 2000, without any further statement and without the fee set forth in § 1.17(p).
- (B) Filing the information disclosure statement on December 11, 2000, without any further statement and without the fee set forth in § 1.17(p).
- (C) Filing the information disclosure statement on December 13, 2000, without any further statement and without the fee set forth in § 1.17(p).
- (D) Choices (A) or (B) above.
- (E) None of the above.

43. As a new member of a law firm, you are assigned to continue the prosecution of a patent application that was prosecuted by Stewart, who recently joined another law firm. After reviewing the file, you note that Stewart's reply to a first Office included two amendments: Amendment #1 introduced a change to the specification which did not affect the claims; Amendment #2 introduced a change to the specification, which change was also introduced to all of the claims currently in the application. You also note that the examiner in a current Office action has taken the position that both amendments constituted new matter, required cancellation of the new matter, and rejected all the claims on the ground that they recited elements without support in the original disclosure under 35 U.S.C. 112, first paragraph. For the purpose of reviewing the examiner's requirement, which of the following statements accords with proper USPTO practice and procedure?

- (A) Both Amendment #1 and Amendment #2 give rise to appealable questions.
- (B) Review of the examiner's requirement for cancellation of both Amendment #1 and Amendment #2 is by way of petition.
- (C) Review of the examiner's requirement for cancellation of Amendment #1 is by way of petition, and review of the examiner's requirement for cancellation of Amendment #2 is by way of appeal.
- (D) Review of the examiner's requirement for cancellation of Amendment #1 is by way of appeal, and review of the examiner's requirement for cancellation of Amendment #2 is by way of petition.
- (E) Both Amendment #1 and Amendment #2 give rise to questions which may be reviewed either by petition or on appeal.

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. In regard to patent application drawings, which of the following is in accord with proper USPTO practice and procedure?

- (A) Views in a drawing may be connected by projection lines, and views may contain center lines in patent applications filed in April 2001.
- (B) Photographs must be developed on paper that is DIN size A4 or 8½ by 11 inches, and meet margin requirements set by regulation in applications filed in April 2001.
- (C) Color drawings are permitted by regulation, and without further authorization, in an application submitted under the Office electronic filing system in April 2001.
- (D) The Office will accept black and white photographs in utility or design applications filed in April 2001 only if three copies of black and white photographs, and a petition and fee are filed to have such photographs accepted.
- (E) In applications filed in April 2001, the scale of a drawing must be properly indicated by statements such as “actual size” or “scale ½.”

46. 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) Powers of attorney to firms submitted in applications filed in the year 2001 are recognized by the United States Patent and Trademark Office.
- (B) The associate attorney may appoint another attorney.
- (C) The filing and recording of an assignment will operate as a revocation of a power or authorization previously given.
- (D) Revocation of the power of the principal attorney or agent does not revoke powers granted by him or her to other attorneys or agents.
- (E) 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.

47. An examiner has properly established a prima facie showing of no specific and substantial credible utility for the claimed invention in a patent application filed in February 2001. An applicant can sustain the burden of rebutting and overcoming the showing by:

- (A) Providing reasoning or arguments rebutting the basis or logic of the prima facie showing.
- (B) Amending the claims.
- (C) Providing evidence in the form of a declaration under 37 C.F.R. § 1.132 rebutting the basis or logic of the prima facie showing.
- (D) Providing evidence in the form of a printed publication rebutting the basis or logic of the prima facie showing.
- (E) All of the above.

48. Your Canadian client, UpNorth Incorporated, came to you on February 11, 2001 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 in December 1, 1999, 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 learned that two months ago, in December 2000, that 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 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.
- (D) 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.
- (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.

49. In regard to disclosure of a utility in a nonprovisional utility patent application filed in the Office in April 2001, which of the following is not in accord with proper USPTO practice and procedure?

- (A) For each claimed invention an applicant need only provide one credible assertion of specific and substantial utility to satisfy the utility requirement.
- (B) A patent examiner can properly support a rejection based on lack of utility by providing documentary evidence regardless of the publication date to show a factual basis for the prima facie showing of no specific and substantial credible utility.
- (C) Using a complex claimed invention as landfill is an example of a specific and substantial utility for the claimed invention.
- (D) An invention has a well-established utility if a person of ordinary skill in the art would immediately appreciate why the invention is useful based on the characteristics of the invention, and the utility is specific, substantial, and credible.
- (E) Where the asserted specific and substantial utility is not credible, a prima facie showing of no specific and substantial utility must establish that it is more likely than not that a person skilled in the art would not consider credible any specific and substantial utility asserted by the applicant for the claimed invention.

50. An article in a popular scientific journal, dated January 13, 2000, 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 a metallic shoelace or suggest using the same as an antenna or for any other purpose. Which of the following claims in an application filed January 22, 2001 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 telecommunication device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and a metallic shoelace.

Claim 2. A telecommunications device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and optionally 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 2 and 3.
- (E) None of the above.

THIS PAGE INTENTIONALLY LEFT BLANK

THIS PAGE INTENTIONALLY LEFT BLANK

Test Number 456
Test Series 101

Name _____

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

APRIL 18, 2001

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. 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 court decision, a notice in the *Official Gazette*, or a notice in the *Federal Register*. 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 that 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 addresses provisions of the Patent Statute, regulations and MPEP which were not changed as a result of the enactment of the American Inventors Protection Act of 1999, Pub. L. No. 106-113 (“Act”). This examination also does address and test changes to the Patent Statute or regulations brought about by the enactment of the Act. Some, but not all, questions use the statute and rules, comments to the rules, and guidelines in place subsequent to November 28, 1999, including the following rule changes and guidelines in effect on or before January 20, 2001:

? Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule. 65 FR 50092 (Aug. 16, 2000) (including the adoption of changes set forth in Interim Rule, 65 FR 14865 (Mar. 20, 2000) to §§ 1.7, 1.17(e) and (i), 1.53(d)(1), 1.78(a)(3), 1.97(b), 1.104(c)(4), 1.113, 1.116, 1.198, 1.312, and 1.313(a), (b), (c)(1), (c)(3), and (d)).

? Changes to Permit Payment of Patent and Trademark Fees by Credit Card; Final Rule. 65 FR 33452 (May 24, 2000).

? Revision of Patent Fees for Fiscal Year 2001; Final Rule. 65 FR 49193 (Aug. 11, 2000).

? Changes To Implement the Patent Business Goals; Final Rules. 65 FR 54604 (Sept. 8, 2000).

? Changes to Implement the Patent Business Goals; Final Rule and corrections to final rules. 65 FR 78958 (Dec. 18, 2000).

? Changes to Implement Patent Business Goals; Final Rule, Correction. 65 Fed. Reg. 80755 (Dec. 22, 2000).

? Changes To Implement Patent Term Adjustment Under Twenty-Year Patent Term; Final Rules. 65 FR 56366, (Sept. 18, 2000).

? Changes to Implement Eighteen-Month Publication of Patent Applications; Final Rule. 65 FR 57024 (Sept. 20, 2000).

? Changes To Implement Eighteen-Month Publication of Patent Applications; Correction. Final Rule; correction. 65 FR 66502 (Nov. 6, 2000).

? Treatment of Unlocatable Patent Application and Patent Files; Final Rule. 65 FR 69446 (Nov. 17, 2000).

? Simplification of Certain Requirements in Patent Interference Practice; Final Rule. 65 FR 70489 (Nov. 24, 2000).

? Reestablishment of the Patent and Trademark Office as the United States Patent and Trademark Office, 65 Fed. Reg. 17858 (April 5, 2000).

? Guidelines Concerning the Implementation of Changes to 35 U.S.C. 102(g) and 103(c) and the Interpretation of the Term “Original Application” in the American Inventors

? Protection Act of 1999, 1233 O.G. 54-56 (April 11, 2000).

? Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, para. 6, 65 Fed. Reg. 38510-38516 (June 21, 2000); 1236 O.G. 98-104 (July 25, 2000).

? Guidelines Setting Forth a Modified Policy Concerning the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 U.S.C. 103(c), 1241 O.G. 96-97 (December 26, 2000).

? Assignment of Confirmation Number and Time Period for Filing a Copy of an Application by EFS for Eighteen-Month Publication Purposes, 1241 O.G. 97-98 (December 26, 2000).

? Utility Examination Guidelines, 66 F.R. 1092-1099 (January 5, 2001).

Guidelines for Examination of Patent Applications Under the 35 U.S.C. Sec. 112, para. 1 "Written Description" Requirement 66 F.R. 1099-1111 (January 5, 2001).

1. Which of the following is in accord with proper USPTO practice and procedure?
- (A) Upon request to convert a provisional application to a nonprovisional utility application, the nonprovisional application is accorded a filing date as of the date on which the request to convert was filed, but the original filing date of the provisional application is preserved.
 - (B) If a provisional application does not have a claim as filed, and a claim is not filed with a timely request to convert the provisional application to a nonprovisional utility application, the Office will notify the applicant and set a time period for submitting a claim for examination.
 - (C) A provisional application filed in November 2000 is entitled to the right of priority under 35 U.S.C. § 119 of a copending utility application for patent filed in Great Britain in January 2000.
 - (D) A request filed in January 2001, to convert a provisional application filed in the USPTO in April 2000, to a nonprovisional utility application is timely if filed after the abandonment of the provisional application, i.e., after the pendency of the provisional application, but within twelve months of the filing date of the provisional application provided no petition to revive has been filed and granted.
 - (E) A nonprovisional utility application filed under the provisions of 37 CFR § 1.53(b) in January 2001, and claiming the benefit of the earlier filing date of a provisional application must be filed during the pendency of the provisional application.

2. Select from the following an answer which completes the following statement, such that the completed statement accords with proper USPTO practice and procedure: “When the reference in question is a noncommonly owned U.S. patent claiming the same invention as applicant, and its issue date is _____”

- (A) less than one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of requesting an interference.
- (B) exactly one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of requesting an interference.
- (C) more than one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of requesting an interference.
- (D) less than one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of affidavit or declaration “swearing back” of reference.
- (E) less than one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of affidavit or declaration traversing the ground of rejection.

3. Which of the following is an incorrect statement concerning the difference between the request for continued examination procedure under 37 CFR § 1.114 and the continued prosecution application (CPA) procedure under 37 CFR § 1.53(d)?

- (A) The filing of a CPA is the filing of a new application, whereas a request for continued examination under 37 CFR § 1.114 merely continues the examination of the same application.
- (B) The fee for a request for continued examination under 37 CFR § 1.114 does not have an additional claims fee component, but the filing fee for a CPA includes a fee based on the number of claims remaining in the application after entry of any amendment accompanying the request for CPA and entry of any amendments under 37 CFR § 1.116 unentered in the prior application which applicant has requested to be entered in the CPA.
- (C) A CPA may be filed before prosecution in the prior application is closed, but a request for continued examination under 37 CFR § 1.114 is not permitted unless prosecution in the application is closed.
- (D) None of the above are incorrect statements.
- (E) (B) and (C) are incorrect statements.

4. Which of the following may properly be required to submit information in reply to a requirement for information under 37 CFR § 1.105 in a patent application filed December 5, 2000?

- (A) A named inventor in the application.
- (B) An assignee of the entire interest in the application.
- (C) An attorney who prepares and prosecutes the application.
- (D) All of the above.
- (E) (A) or (C).

5. Which of the following is or are a factor that will be considered in disapproving a preliminary amendment in an application filed November 10, 2000?

- (A) The nature of any changes to the claims or specification that would result from entry of the preliminary amendment.
- (B) The state of preparation of a first Office action as of the date of receipt of the preliminary amendment by the Office.
- (C) The state of preparation of a first Office action as of the certificate of mailing date under 37 CFR § 1.8, of the preliminary amendment.
- (D) All of the above.
- (E) (A) and (B).

6. 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 4, 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."

7. Which of the following is not in accordance with proper USPTO practice and procedure regarding design patent applications filed in March 2001?

- (A) The elements of the design application, if applicable, should appear in the following order: (1) design application transmittal form; (2) fee transmittal form; (3) application data sheet; (4) specification; (5) drawings or photographs; and (6) executed oath or declaration.
- (B) The specification should include the following sections in order: (1) preamble, stating the name of the applicant, title of the design, and a brief description of the nature and intended use of the article in which the design is embodied; (2) cross-reference to related applications (unless included in the application data sheet); (3) statement regarding federally sponsored research or development; (4) description of the figure or figures of the drawing; (5) feature description; and (6) a single claim.
- (C) The text of the specification sections, if applicable, should be preceded by a section heading in uppercase letters without underlining or bold type.
- (D) The elements of the design application, if applicable, should appear in the following order: (1) design application transmittal form; (2) fee transmittal form; (3) photographs; (4) application data sheet; (5) specification; (6) drawings; and (7) executed oath or declaration.
- (E) None of the above.

8 – 9. The following facts apply to the following two questions.

While travelling through Germany (a WTO member country) in December 1999, Thomas (a Canadian citizen) conceived of binoculars for use in bird watching. The binoculars included a pattern recognition device that recognized birds and would display pertinent information on a display. Upon Thomas' return to Canada (a NAFTA country) in January 2000, he enlisted his brothers Joseph and Roland to help him market the product under the tradename "Birdoculars." On February 1, 2000, without Thomas' knowledge or permission, Joseph anonymously published a promotional article written by Thomas and fully disclosing how the Birdoculars were made and used. The promotional article was published in the Saskatoon Times, a regional Canadian magazine that is also widely distributed in the United States. Thomas first reduced the Birdoculars to practice on March 17, 2000 in Canada. A United States patent application properly naming Thomas as the sole inventor was filed September 17, 2000. That application has now been rejected as being anticipated by the Saskatoon Times article.

8. Which of the following statements is most correct?

- (A) The promotional article in the Saskatoon Times constituted an offer to sell that operates as an absolute bar against Thomas' patent application.
- (B) Thomas, as the inventor, can overcome the rejection by establishing he is also the author of the promotional article.
- (C) The Saskatoon Times article is not *prima facie* prior art because it was published without Thomas' knowledge or permission.
- (D) The Saskatoon Times article is not *prima facie* prior art because it does not evidence knowledge or use in the United States.
- (E) The promotional article cannot be used as prior art because the Birdoculars had not been reduced to practice at the time the article appeared in the Saskatoon Times.

9. Which of the following statements is most correct?

- (A) Thomas can rely on his activities in Canada in establishing a date of invention prior to publication of the Saskatoon Times article.
- (B) In a priority contest against another inventor, Thomas can rely on his activities in Canada in establishing a date of invention.
- (C) In a priority contest against another inventor, Thomas can rely on his activities in Germany in establishing a date of invention.
- (D) Statements (A) and (B) are correct, but statement (C) is incorrect.
- (E) Statements (A), (B), and (C) are each correct.

10. Sally, an employee of Ted, conceived of and reduced to practice a spot remover for Ted on May 1, 1998. Sally's spot remover was made from water, chlorine, and lemon juice. On June 2, 1998, 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 referenced in her application. On June 12, 1999, 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 25, 1999, the USPTO granted Sally a patent. On November 5, 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 March 2001, 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.

11. Which of the following is not in accord with proper USPTO practice and procedure?

- (A) If a claim limitation invokes the sixth paragraph of 35 U.S.C. § 112, it must be interpreted to cover the corresponding structure, material, or acts in the specification and "equivalents thereof."
- (B) If means-plus-function language is employed in a claim, the specification must set forth an adequate disclosure showing what that language means.
- (C) A means-plus-function claim limitation satisfies the second paragraph of 35 U.S.C. § 112 if the written description links or associates particular structure, material, or acts to the function recited in a means-plus-function claim limitation.
- (D) A step-plus-function claim limitation satisfies the second paragraph of 35 U.S.C. § 112 if it is clearly based on the disclosure in the application that one skilled in the art would have known what structure, material, or acts perform the function recited in a step-plus-function limitation.
- (E) The invocation of the sixth paragraph of 35 U.S.C. § 112 exempts an applicant from compliance with the first and second paragraphs of 35 U.S.C. § 112.

12. Which of the following is in accordance with proper USPTO practice and procedure regarding patent applications filed in March 2001?

- (A) An applicant in a nonprovisional application may only claim the benefit of the filing date of the earliest one of prior foreign applications under the conditions specified in 35 U.S.C. §§ 119(a) through (d) and (f), 172, and 365(a) and (b).
- (B) In an original application filed under 35 U.S.C. § 111(a), the claim for priority must be presented within either four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application, whichever occurs earlier.
- (C) Notwithstanding the fact that the claim for foreign priority was not filed within either four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application, if the claim for priority and the certified copy of the foreign application specified in 35 U.S.C. § 119(b) or PCT Rule 17 is filed before the patent is granted and the claim was unintentionally delayed, a petition to accept a delayed claim for priority, with the appropriate fee and statement, may be filed.
- (D) The claim for foreign priority need only identify foreign applications for which priority is claimed.
- (E) A claim for foreign priority may be based upon an inventor's certificate provided it is accompanied by a statement by the applicant that patent coverage was not available.

13. In August 2000, 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 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.
- (C) 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.
- (D) The agent advertises on television and radio as a registered patent agent and accepts patent cases on a reasonable contingent fee.
- (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.

14. Which of the following statements concerning a restriction requirement in a reissue application filed January 10, 2001, is in accordance with proper USPTO rules and procedure?

- (A) The Office cannot properly make a restriction requirement in the reissue application between claims added in the reissue application and the original patent claims, where the added claims are directed to an invention which is separate and distinct from the invention defined by the original patent claims.
- (B) The Office cannot properly make a restriction requirement involving only subject matter of the original patent claims.
- (C) If restriction is required by the Office, the subject matter of the original patent claims will not be held to be constructively elected unless a disclaimer of all the patent claims is filed in the reissue application, which disclaimer cannot be withdrawn by applicant.
- (D) (A) and (B)
- (E) None of the above.

15. 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.

16. In June 1998 Michael buys a television set with a remote control for automatically changing channels on the television set. In June 2000, 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 2000. 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 1998, 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) 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.
- (C) Although the device was bought in June 1998, Michael did not use it to open a garage door until 2000. 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 1998, and 35 U.S.C. § 102(b) does not apply.
- (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. To satisfy the written description requirement of the first paragraph of 35 U.S.C. § 112, an applicant must show possession of the invention. An applicant's lack of possession of the invention may be evidenced by:

- (A) Describing an actual reduction to practice of the claimed invention.
- (B) Describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.
- (C) Requiring an essential feature in the original claims, where the feature is not described in the specification or the claims, and is not conventional in the art or known to one of ordinary skill in the art.
- (D) Amending a claim to add a limitation that is supported in the specification through implicit or inherent disclosure.
- (E) Amending a claim to correct an obvious error by the appropriate correction.

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

- (A) 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.
- (B) The foreign application must be filed more than 12 months before the effective filing date of the United States application.
- (C) The foreign and United States applications must be filed by the same applicant, his or her legal representatives or assigns.
- (D) 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.
- (E) The same invention must be involved.

19. An application is transmitted to the USPTO on January 12, 2001, without an oath or declaration by any of the inventors. Which of the following, prior to the filing of an oath or declaration, may properly change the address to which the Office will direct all notices, official letters, and other communications relating to the application?

- (A) A registered practitioner that filed the application.
- (B) Any registered practitioner named in the transmittal papers accompanying the original application, if the application was filed by a registered practitioner.
- (C) One inventor who solely filed the application, where two inventors are named in the transmittal papers accompanying the original application.
- (D) (A), (B), and (C).
- (E) (A) and (B).

20. In July 2000, Pete Practitioner files a reissue application for Sam's patent on a combination washing machine and dryer, which issued on August 4, 1998. 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) 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.
- (B) 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.
- (C) 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.
- (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.

21. Which of the following is not a USPTO recommendation or requirement?

- (A) Every application should contain no more than three dependent claims.
- (B) Claims should be arranged in order of scope so that the first claim presented is the least restrictive.
- (C) Product and process claims should be separately grouped.
- (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.

22. A rejection based on 35 U.S.C. § 102(a) cannot be overcome by:
- (A) Filing an affidavit under 37 C.F.R. § 1.131 “swearing back” of a U.S. patent which substantially shows or describes, and claims the same patentable invention as the rejected invention.
 - (B) Filing an affidavit under 37 C.F.R. § 1.132 showing that the reference invention is not by “another.”
 - (C) Perfecting a claim to priority under 35 U.S.C. § 119(a)-(d).
 - (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. Mr. and Mrs. Noteworthy (Henry and Alice) are registered patent practitioners maintaining an office. After completing their busiest year since opening their practice, the Notworthys decide to take a break from their hectic business routine and embark on a two week vacation in Acapulco, Mexico. On the third day of their vacation, Henry fell ill, and was laid up in bed for two days. Feeling somewhat better on the second day of his illness, and bored while Alice was on the beach, Henry phoned his office and learned from his secretary that an Office action in a case that he had overlooked contained a shortened statutory period (SSP) which expires on the very same day. He immediately had the Office action faxed to him, and upon receipt, he worked feverishly to prepare a reply. Upon completion of the reply, Henry prepared a certificate of mailing in accordance with the suggested format set forth in MPEP § 512 and deposited the reply accompanied by the certificate of mailing, properly addressed to the USPTO, in the local post office on the very same day before the post office closed. On the 5th day of their vacation, Alice became ill and required bed rest. While Henry was on the beach, Alice called her office and learned that one of her cases had a SSP expiring on the same day. Alice immediately had the Office action faxed to her. Upon receipt of the fax, Alice prepared a proper response and forwarded same to the USPTO by facsimile accompanied by a certificate of transmission in accordance with the suggested format set forth in MPEP § 512 and in compliance with 37 C.F.R. § 1.6(d). Assume the certificate of mailing and the certificate of transmission recite deposit and transmission dates that are the same as their respective SSP expiration dates. Also assume that both communications are received in the USPTO after their respective SSP expiration dates and are stamped with the actual date of receipt. Which of the following statements is true?

- (A) The application wherein Henry filed a reply is abandoned because the USPTO stamped date is controlling.
- (B) The application wherein Henry filed a reply is not abandoned because the certificate of mailing date is controlling.
- (C) The application wherein Alice filed a reply is abandoned because the USPTO stamped date is controlling.
- (D) Both the application wherein Henry filed a reply and the application wherein Alice filed a reply are abandoned.
- (E) Neither the application wherein Henry filed a reply nor the application wherein Alice filed a reply is abandoned.

24. Which of the following is entitled to the benefit of a certificate of mailing under 37 CFR § 1.8?

- (A) Filing a request for continued examination under 37 CFR § 1.114.
- (B) Filing a request for a continued prosecution application under 37 CFR § 1.53(d).
- (C) Filing a reply under 37 CFR § 1.111 in a non-provisional patent application.
- (D) (A) and (C).
- (E) All of the above.

25. Which of the following is in accordance with proper USPTO practice and procedure?

- (A) The filing of a request for continued examination and payment of the fee for the request in a nonprovisional utility application that was filed in January 2000, is sufficient to toll the running of any time period set in a final rejection for reply to avoid abandonment of the application.
- (B) Where a request for continued examination, a submission, and requisite fee are filed in April 2001 for a nonprovisional utility application that was filed in January 2000, the submission will be considered though it was filed after the application became abandoned in February 2001.
- (C) An applicant in a utility application originally filed on or after June 8, 1995, and before May 29, 2000, may obtain further examination either by timely filing a request for continued examination, a proper submission, and requisite fee, or by timely filing a continued prosecution application.
- (D) An applicant in a utility application originally filed on or after June 8, 1995, and before May 29, 2000, may obtain further examination by timely filing in April 2001 a request for continued examination, a proper submission, and requisite fee, and the application is entitled to patent term adjustment provisions of the Patent Statute.
- (E) An applicant in a utility application originally filed on or after June 8, 1995, and before May 29, 2000, may obtain further examination by timely filing in April 2001 a continued prosecution application under 37 C.F.R. § 1.53(d), but the CPA application is not entitled to patent term adjustment provisions of the Patent Statute.

26. In accordance with proper USPTO practice and procedure, a submission for a request for continued examination does not include:

- (A) An appeal brief or reply brief (or related papers).
- (B) New arguments in support of patentability.
- (C) New evidence in support of patentability.
- (D) An amendment of the drawings.
- (E) An amendment of the claims.

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. In December 1988, 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 2000, 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, 2001. Molly, after seeing the success of Troy's invention in the marketplace, decides to file an application, also on February 1, 2001. 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 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.
- (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 invented the cutter before Troy, she is entitled to a patent and not Troy.
- (E) None of the above.

29. 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) 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.
 - (C) 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.
 - (D) 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.
 - (E) In an ex parte reexamination proceeding of a patent that arises from an application filed in the United States before November 29, 1999, 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.
30. 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, 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.
 - (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. Diligence need not be considered.
 - (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.

31. 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.

32. 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. 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 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.

Claim 3. A composition for bonding asphalt shingles to wood sheathing, comprising 10% A, 30% B, and 60% C.

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

33. 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. 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.
- II. 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.
- 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.

34. Registered practitioner Mike files a utility patent application in the USPTO having one claim on May 6, 1998. Following a proper final rejection dated June 28, 2000, of claim 1, Mike files a notice of appeal with the appropriate fee on September 12, 2000, and an appeal brief with the appropriate fee on October 12, 2000. On February 14, 2001, Mike learns about a publication (the "Valentine reference") which he knows to be material to patentability of claim 1. The Valentine reference was not considered by the examiner during prosecution of the application. According to proper USPTO rules and procedure, which of the following actions if taken by Mike on February 16, 2001, prior to a decision on the appeal, will be treated by the USPTO as a request to withdraw the appeal?

- (A) Filing a request for continued examination of the application with an information disclosure statement that complies with the provisions of 37 CFR § 1.98, listing the Valentine reference, submitting the fee set forth in 37 CFR § 1.17(e), and notifying the Board of Patent Appeals and Interferences of the same.
- (B) Filing a request for continued examination of the application, and submitting the fee set forth in 37 CFR § 1.17(e), without filing any other submission, and notifying the Board of Patent Appeals and Interferences of the same.
- (C) Filing a request for continued examination of the application, and filing an information disclosure statement that complies with the provisions of 37 CFR § 1.98, listing the Valentine reference, without submitting the fee set forth in 37 CFR § 1.17(e), and notifying the Board of Patent Appeals and Interferences of the same.
- (D) Filing a request for continued examination of the application, without submitting the fee set forth in 37 CFR § 1.17(e), and without filing any other submission, and notifying the Board of Patent Appeals and Interferences of the same.
- (E) All of the above.

35. A patent application filed in the USPTO contains the following dependent claim:

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) Claim 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.
- (B) Claim 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.
- (C) Claim 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) Claim 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. A member of the public submits a protest under 37 CFR § 1.291 relating to a public sale of the subject matter of a patent application (effective filing date June 1, 1999). The protest includes submission of a business circular authored by the assignee of the invention. In a first Office action dated January 10, 2001, the examiner includes a requirement for information requesting the date of publication of the business circular. The reply to the requirement for information states that the publication date is “approximately June 1, 2000.” Which of the following would be proper for the examiner to include in the next Office action?

- (A) A requirement that the date in the reply be made more specific.
- (B) A holding that the previous reply is incomplete.
- (C) A requirement seeking confirmation that “approximately June 1, 2000” is the most specific date that was obtained or can be obtained based on a reasonable inquiry if that is not already clear from the reply.
- (D) (A) and (C).
- (E) None of the above.

37. Which of the following is not in accordance with proper USPTO practice and procedure regarding patent applications filed in March 2001?

- (A) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed before the examiner allows the claims.
- (B) If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by the processing fee set forth in 37 CFR § 1.17(i), but the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and 37 CFR § 1.323.
- (C) In an application that entered the national stage from an international application after compliance with 35 U.S.C. § 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT.
- (D) If a U.S. patent application publication or patent incorporates by reference, or includes a specific reference under 35 U.S.C. §§ 119(e) or 120 to, a pending or abandoned application, a copy of that application-as-filed may be provided to any person upon written request including the fee set forth in 37 CFR § 1.19(b)(1).
- (E) If an international application, which designates the U.S. and which has been published in accordance with PCT Article 21(2), incorporates by reference or claims priority under PCT Article 8 to a pending or abandoned U.S. application, a copy of that application-as-filed may be provided to any person upon written request including a showing that the publication of the application in accordance with PCT Article 21(2) has occurred and that the U.S. was designated, and upon payment of the appropriate.

38. Which of the following statements concerning preliminary amendments is/are in accordance with proper USPTO rules and procedure?

- (A) A preliminary amendment filed in a continuation-in-part application cannot be disapproved if it is filed within three months from the December 7, 2000, filing date.
- (B) A preliminary amendment filed in a continued prosecution application cannot be disapproved if it is filed four months from the December 7, 2000, filing date with a petition for a one month extension of time.
- (C) A preliminary amendment filed in a continued prosecution application cannot be disapproved if it is filed four months from the December 7, 2000, filing date with a petition for a one month extension of time and the appropriate fee for the extension.
- (D) A preliminary amendment filed in a continuation prosecution application after the filing date of the application cannot be disapproved.
- (E) None of the above.

39. Which of the following requests by the registered practitioner of record for an interview with an examiner concerning an application will be granted in accordance with proper USPTO rules and procedure?

- (A) A request for an interview in a substitute application prior to the first Office action, for the examiner and attorney of record to meet in the practitioner's office without the authority of the Commissioner.
- (B) A request for an interview in a continued prosecution application prior to the first Office action, to be held in the examiner's office.
- (C) A request for an interview in a non-continuing and non-substitute application, prior to the first Office action to be held in the examiner's office.
- (D) None of the above.
- (E) All of the above.

40. 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) Amending the claim by canceling element A from the Markush group.
- (C) Arguing that the reference is not relevant because it lacks elements B and C.
- (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."

41. A nonprovisional patent application was filed on December 1, 2000, including a patent application declaration and an application data sheet. The application data sheet that includes the applicant's full name, residence, mailing address, and citizenship. The application data sheet does not include any foreign priority information. Which of the following must be identified in the declaration?

- (A) Applicant's mailing address.
- (B) Applicant's citizenship.
- (C) Any foreign application for patent for which a claim for priority is made by Applicant pursuant to 37 CFR § 1.55.
- (D) (B) and (C).
- (E) All of the above.

42. 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) You should recommend filing a petition to make special on the basis of Inventor Joe's age.
- (B) 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.
- (C) 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.
- (D) Statements (A), (B) and (C) are equally correct.
- (E) Statements (A), (B) and (C) are each incorrect.

43. 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 claim 1, wherein the base member is rectangularly shaped.
- (B) 3. An apparatus as in claim 2, wherein the wheels connected to each of the elongated members are plastic.
- (C) 3. An apparatus as in any of the preceding claims, in which the circular back member is wooden.
- (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.

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 only for the process which includes the essential step.
- (B) 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.
- (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) 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.

45. The USPTO mails a final Office action dated November 8, 2000, in a utility patent application filed May 5, 1999, to registered practitioner Ted. The final Office action includes claim rejections and objections. Which of the following, with a request for continued examination along with the required fee filed by Ted on January 8, 2001, is a proper submission in accordance with the provisions of 37 CFR § 1.114?

- (A) A telephone call from Ted to the examiner on January 8, 2001, wherein Ted distinctly and specifically points out the supposed errors in the examiner's action, and wherein Ted presents arguments addressing each ground of objection and rejection in the Office action dated November 8, 2000.
- (B) A written reply to the Office action dated November 8, 2000, with no amendments or new claims, which distinctly and specifically points out the supposed errors in the examiner's action, addresses each ground of objection and rejection in the Office action, and presents arguments pointing out the specific distinctions believed to render the claims patentable over the references applied by the examiner.
- (C) A written reply to the Office action dated November 8, 2000, which does not present arguments pointing out the specific distinctions believed to render the claims patentable over the references applied by the examiner, and which requests that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated.
- (D) All of the above.
- (E) None of the above.

46. Which of the following is in accordance with proper USPTO practice and procedure?
- (A) The fee an applicant must pay to request continued examination of an application is set in an amount equal to the basic filing fee the same applicant must pay for a utility patent application.
 - (B) A Certificate of Mailing or Transmission under 37 C.F.R. § 1.8 is proper for filing a Continued Prosecution Application under 37 C.F.R. § 1.53(d) to obtain the date of the Certificate as the filing date for the application.
 - (C) The Office does not charge a fee for processing a fee paid by a check that has been refused, i.e., dishonored and returned, by a financial institution.
 - (D) To first request conversion of a provisional application containing a claim to a nonprovisional application after the provisional application has become abandoned, a petition to revive, accompanied by the appropriate fees, a showing of unavoidable delay, and a request for the conversion must be filed within one year of the date of abandonment.
 - (E) The conversion of a provisional application, for which a basic filing fee was properly paid, to a nonprovisional application will result in the savings of filing and other fees over the filing of a nonprovisional application claiming the benefit under 35 U.S.C. § 119(e) and 37 C.F.R. § 1.78 of the earlier provisional filing date.

47. Applicant receives a rejection and objection in a non-final Office action dated December 12, 2000. Applicant timely files a reply dated February 12, 2001, that distinctly and specifically points out the supposed errors in the examiner's action. The reply addresses every ground of objection and rejection in the Office action dated December 12, 2000, by presenting arguments pointing out specific distinctions believed to render the claims, including any newly presented claims, patentable over the applied references. Applicant mails a second reply. Thereafter, Applicant mails a third reply to the USPTO, which would result in a change to the specification only, if entered. In accordance with proper USPTO rules and procedure, which of the following are factors that will be considered in deciding whether to disapprove Applicant's third reply?

- (A) Whether Applicant's reply dated February 12, 2001, includes a request that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated.
- (B) The state of preparation of an Office action responsive to the Applicant's reply dated February 12, 2001, as of the date of receipt of Applicant's third reply.
- (C) The nature of any changes to the specification that would result from entry of Applicant's second reply.
- (D) (A), (B), and (C).
- (E) (B) and (C).

48. Which of the following is in accord with proper USPTO practice and procedure for filing a reissue application in April 2001?

- (A) The specification, including the claims, of the patent for which reissue is requested must be furnished in the form of a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper.
- (B) The specification, including the claims, of the patent for which reissue is requested must be furnished in the form of cut-up soft copies of the printed patent, with only a single column of the printed patent securely mounted on a separate sheet of paper.
- (C) The specification, including the claims, of the patent for which reissue is requested must be furnished in the form of a copy of the printed patent, in single column format, each page on only one side of a single sheet of paper.
- (D) The specification, including the claims, of the patent for which reissue is requested must be furnished in the form of a copy of the printed patent, in double column format, each page on both sides of a single sheet of paper.
- (E) The specification, including the claims, of the patent for which reissue is requested must be furnished in the form of cut-up soft copies of the printed patent, with only a single column of the printed patent securely mounted on both sides of a single sheet of paper.

49. Which of the following is not in accordance with proper USPTO practice and procedure regarding patent applications filed in March 2001?

- (A) Status information is available for Application B, that is a continuation of an application A, when application A has been published under 35 U.S.C. § 122(b).
- (B) A person requesting status information may be provided the filing date if the eight-digit numerical identifier is not available and the last six digits of the numerical identifier is available.
- (C) If a U.S. patent application publication or patent incorporates by reference, or includes a specific reference under 35 U.S.C. §§ 119(e) or 120 to, a pending or abandoned application, a copy of that application-as-filed may be provided to any person upon written request including the fee set forth in 37 CFR § 1.19(b)(1).
- (D) A coinventor in a pending application may gain access to the application if his name appears as an inventor in the application, even if he did not sign the oath or declaration.
- (E) Notwithstanding the fact that only a redacted copy of an application has been published, a member of the public is entitled to see the entire application upon written request.

50. 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 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, March 9, 2001, and the application being received in the USPTO on Monday, March 12, 2001.
- (B) 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, March 10, 2001, and the application being received in the USPTO on Tuesday, March 13, 2001.
- (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, March 8, 2001, and the application being received in the USPTO on Wednesday, March 14, 2001.
- (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, March 22, 2001, and the application being received in the USPTO on Monday, March 26, 2001.
- (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, March 24, 2001, and the application being received in the USPTO on Monday, March 26, 2001.

THIS PAGE INTENTIONALLY LEFT BLANK

THIS PAGE INTENTIONALLY LEFT BLANK

Test Number 123
Test Series 201

Name _____

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

OCTOBER 17, 2001

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. 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 USPTO 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 court decision, a notice in the *Official Gazette*, or a notice in the *Federal Register*. 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 that 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 addresses provisions of the Patent Statute, regulations and MPEP which were not changed as a result of the enactment of the American Inventors Protection Act of 1999, Pub. L. No. 106-113 (“Act”). This examination also does address and test changes to the Patent Statute or regulations brought about by the enactment of the Act. Some, but not all, questions use the statute and rules, comments to the rules, and guidelines in place subsequent to November 28, 1999, including the following rule changes and guidelines in effect on or before January 20, 2001:

- ? Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule. 65 FR 50092 (Aug. 16, 2000) (including the adoption of changes set forth in Interim Rule, 65 FR 14865 (Mar. 20, 2000) to §§ 1.7, 1.17(e) and (i), 1.53(d)(1), 1.78(a)(3), 1.97(b), 1.104(c)(4), 1.113, 1.116, 1.198, 1.312, and 1.313(a), (b), (c)(1), (c)(3), and (d)).
- ? Changes to Permit Payment of Patent and Trademark Fees by Credit Card; Final Rule. 65 FR 33452 (May 24, 2000).
- ? Revision of Patent Fees for Fiscal Year 2001; Final Rule. 65 FR 49193 (Aug. 11, 2000).
- ? Changes To Implement the Patent Business Goals; Final Rules. 65 FR 54604 (Sept. 8, 2000).
- ? Changes to Implement the Patent Business Goals; Final Rule and corrections to final rules. 65 FR 78958 (Dec. 18, 2000).
- ? Changes to Implement Patent Business Goals; Final Rule, Correction. 65 Fed. Reg. 80755 (Dec. 22, 2000).
- ? Changes To Implement Patent Term Adjustment Under Twenty-Year Patent Term; Final Rules. 65 FR 56366, (Sept. 18, 2000).
- ? Changes to Implement Eighteen-Month Publication of Patent Applications; Final Rule. 65 FR 57024 (Sept. 20, 2000).
- ? Changes To Implement Eighteen-Month Publication of Patent Applications; Correction. Final Rule; correction. 65 FR 66502 (Nov. 6, 2000).
- ? Treatment of Unlocatable Patent Application and Patent Files; Final Rule. 65 FR 69446 (Nov. 17, 2000).
- ? Simplification of Certain Requirements in Patent Interference Practice; final Rule. 65 FR 70489 (Nov. 24, 2000).
- ? Reestablishment of the Patent and Trademark Office as the United States Patent and Trademark Office, 65 Fed. Reg. 17858 (April 5, 2000).
- ? Guidelines Concerning the Implementation of Changes to 35 U.S.C. 102(g) and 103(c) and the Interpretation of the Term “Original Application” in the American Inventors Protection Act of 1999, 1233 O.G. 54-56 (April 11, 2000).
- ? Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, para. 6, 65 Fed. Reg. 38510-38516 (June 21, 2000); 1236 O.G. 98-104 (July 25, 2000).
- ? Guidelines Setting Forth a Modified Policy Concerning the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 U.S.C. 103(c), 1241 O.G. 96-97 (December 26, 2000).
- ? Assignment of Confirmation Number and Time Period for Filing a Copy of an Application by EFS for Eighteen-Month Publication Purposes, 1241 O.G. 97-98 (December 26, 2000).
- ? Utility Examination Guidelines, 66 F.R. 1092-1099 (January 5, 2001).
- ? Guidelines for Examination of Patent Applications Under the 35 U.S.C. Sec. 112, para. 1 “Written Description” Requirement 66 F.R. 1099-1111 (January 5, 2001).

1. Office policy has consistently been to follow *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), in the consideration and determination of obviousness under 35 U.S.C. § 103. Each of the following are the four factual inquires enunciated therein as a background for determining obviousness except:

- (A) Determining the scope and contents of the prior art.
- (B) Resolving any issue of indefiniteness in favor of clarity.
- (C) Ascertaining the differences between the prior art and the claims in issue.
- (D) Resolving the level of ordinary skill in the pertinent art.
- (E) Evaluating evidence of secondary considerations.

2. You are a registered practitioner. Earl, your new associate, has been assigned the task of filing information disclosure statements for patents and publications submitted by a client Tony, who is the named inventor on several patent applications, all of which were filed on or after January 1, 2001. Earl wants to know what information must be included on the information disclosure statements. Which of the following is not accurate with respect to proper USPTO procedure?

- (A) If a non-English reference is submitted in an information disclosure statement, the applicant shall include a copy of the translation if a written English-language translation of a non-English-language document, or portion thereof, if it is within the possession, custody, or control of, or is readily available to any individual designated in 37 CFR 1.56(c).
- (B) Each U.S. patent listed in an information disclosure statement must be identified by inventor, application number, and issue date.
- (C) Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.
- (D) When the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications, provided that it is stated that these other patents or publications are cumulative.
- (E) A copy of any patent, publication, pending U.S. application or other information listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application, unless: (1) the earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. § 120; and (2) the information disclosure statement submitted in the earlier application is in full compliance with appropriate regulations.

3. Which of the following is not in accordance with proper USPTO practice and procedure regarding patent applications filed in October 2001?

- (A) If a U.S. patent application publication or patent incorporates by reference, or includes a specific reference under 35 U.S.C. §§ 119(e) or 120, to a pending or abandoned application, a copy of that application-as-filed may be provided to any person upon written request including the fee set forth in 37 CFR 1.19(b)(1).
- (B) If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by the processing fee set forth in 37 CFR § 1.17(i), but the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. § 255 and 37 CFR 1.323.
- (C) In an application that entered the national stage from an international application after compliance with 35 U.S.C. § 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT.
- (D) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. § 119(b) or PCT Rule 17 must, in any event, be filed before the examiner allows the claims.
- (E) If an international application, which designates the U.S. and which has been published in accordance with PCT Article 21(2), incorporates by reference or claims priority under PCT Article 8 to a pending or abandoned U.S. application, a copy of that application-as-filed may be provided to any person upon written request including a showing that the publication of the application in accordance with PCT Article 21(2) has occurred and that the U.S. was designated, and upon payment of the appropriate.

4. Assuming a PCT international application has been filed by a resident of France designating the U.S., a written request for a copy of _____ will be honored upon a showing that the international application was published in accordance with PCT Article 21(2) and the appropriate fee was paid. Fill in the blank with the answer that accords with proper USPTO practice and procedure.

- (A) the home copy, where the international application was filed with the U.S. Receiving Office
- (B) the search copy, where the U.S. acted as the International Searching Authority
- (C) the examination copy, preliminary to issuance of the International Preliminary Examination Report, where the U.S. acted as the International Preliminary Examination Authority, and the U.S. was elected
- (D) the English language translation of the home copy, where the international application was filed with the U.S. Receiving Office
- (E) the English language translation of the examination copy, preliminary to issuance of the International Preliminary Examination Report, where the U.S. acted as the International Preliminary Examination Authority, and the U.S. was elected

5. You have agreed to represent an independent inventor in connection with a patent application that was filed in the USPTO by the inventor on a *pro se* basis. As filed, the application included a detailed written description that, when viewed together with four accompanying color photographs, enabled one of ordinary skill in the pertinent art to make and use the invention. The application was filed with an inventor's declaration in compliance with 37 CFR 1.63, a small entity statement (independent inventor) under 37 CFR 1.27, and all necessary small entity filing fees. MEGACORP, a very large multi-national corporation, licensed rights in the invention after the application was filed.

You have been asked to suggest steps to remove any formal objections that can be expected from the patent 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. You correctly recall that the Office announced in the Official Gazette in May 2001 (1246 OG 106) that it is *sua sponte* waiving 37 CFR 1.84(a)(2)(iii), and is no longer requiring a black and white photocopy of any color drawing or color photograph. Which of the following represents the most reasonable advice to the independent inventor?

- (A) 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) 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 three sets of the color photograph, a proposed amendment to insert language concerning the color photograph as the first paragraph of the specification and the required petition fee. The photographs must be sufficient quality that all details in the photographs are reproducible in a printed patent.
- (C) 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) 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) File a rewritten application 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.

6. In connection with the utility of an invention described in a patent application, which of the following conforms to proper USPTO practice and procedure?

- (A) A deficiency under 35 U.S.C. § 101 also creates a deficiency under 35 U.S.C. § 112, first paragraph.
- (B) To overcome a rejection under 35 U.S.C. § 101, it must be shown that the claimed device is capable of achieving a useful result on all occasions and under all conditions.
- (C) A claimed invention is properly rejected under 35 U.S.C. § 101 as lacking utility if the particular embodiment disclosed in the patent lacks perfection or performs crudely.
- (D) To overcome a rejection under 35 U.S.C. § 101, it is essential to show that the claimed invention accomplishes all its intended functions.
- (E) A claimed invention lacks utility if it is not commercially successful.

7. Sue has discovered a plant variety that has been asexually reproduced for which she desires patent protection. She comes to you for advice as to how she may file for a plant patent. Which of the following is not accurate with respect to proper USPTO procedure in relation to **plant** patent applications filed on or after January 1, 2001?

- (A) The specification must be drafted so as to contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. For a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.
- (B) View numbers and reference characters must be used for the plant patent drawings unless excused by the examiner.
- (C) The elements of her plant application should be organized in the following order: (1) plant patent application transmittal form, (2) fee transmittal form, (3) application data sheet, (4) specification, (5) drawings (in duplicate), and (6) executed oath or declaration under 37 CFR 1.162.
- (D) The specification should include the following sections in order: (1) title of the invention, which may include an introductory portion stating the name, citizenship, and residence of the applicant, (2) cross-reference to related applications (unless included in the application data sheet), (3) statement regarding federally sponsored research or development, (4) latin name of the genus and species of the plant claimed, (5) variety denomination, (6) background of the invention, (7) brief summary of the invention, (8) brief description of the drawing, (9) detailed botanical description, (10) a single claim, and (11) abstract of the disclosure.
- (E) A section heading in upper case, without underlining or bold type, should precede each section of the plant specification.

8. Joan comes to you wanting to know the status of the applications of her competitor Pete. During Joan's previous relationship with Pete she believes she may have been a coinventor on one of the applications filed by Pete. Pete owns Applications A, B, C and D. Application B is a continuation of application A and a redacted copy of application A has been published under 35 U.S.C. § 122(b). Joan is listed as a coinventor on Application C. Pete has an issued patent that claims priority to Application D. Assume only the last six digits of the numerical identifier are available for Application D and Application D is abandoned. Which of the following is not true?

- (A) Joan may obtain status information for Application B that is a continuation of an application A since application A has been published under 35 U.S.C. § 122(b).
- (B) Joan may be provided status information for Application D that includes the filing date if the eight-digit numerical identifier is not available and the last six digits of the numerical identifier are available.
- (C) Joan may obtain status information for Application D since a U.S. patent includes a specific reference under 35 U.S.C. §120 to Application D, an abandoned application. Joan may obtain a copy of that application-as-filed by submitting a written request including the fee set forth in 37 CFR 1.19(b)(1).
- (D) Joan may obtain status information as to Application C since a coinventor in a pending application may gain access to the application if his or her name appears as an inventor in the application, even if she did not sign the §1.63 oath or declaration.
- (E) Joan may obtain access to the entire Application A by submitting a written request, since, notwithstanding the fact that only a redacted copy of Application A has been published, a member of the public is entitled to see the entire application upon written request.

9. John, unaware of the existence of Jane's U.S. patent, which issued on Tuesday, July 11, 2000, files a patent application on Friday, January 11, 2001. John's application and Jane's patent are not commonly owned. On Thursday, July 11, 2001, in reply to an Office action rejecting all of his claims, John files an amendment canceling all of his claims and adding claims setting forth, for the first time, "substantially the same subject matter" as is claimed in Jane's patent. The examiner rejects John's claims on the basis of 35 U.S.C. § 135(b). Which of the following statements accords with proper USPTO practice and procedure?

- (A) The rejection is improper because 35 U.S.C. § 135(b) relates to interferences.
- (B) The rejection is proper because 35 U.S.C. § 135(b) is not limited to *inter partes* proceedings, but may be used as a basis for *ex parte* rejections.
- (C) Since John's claims would interfere with Jane's unexpired patent, the proper procedure is for the examiner to declare an interference rather than to reject John's claims.
- (D) The rejection is proper merely by reason of the fact that John's claims are broad enough to cover the patent claims.
- (E) The rejection is improper inasmuch as John is claiming "substantially the same subject matter" as is claimed in the patent.

10. 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 date indicated on any Certificate of Mailing under 37 CFR 1.8 attached to 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 Office date of receipt of 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.

11. In which of the following final Office action rejections is the finality of the Office action rejection proper?

- (A) The final Office action rejection is in a second Office action and uses newly cited art under 35 U.S.C. § 102(b) to reject unamended claims that were objected to but not rejected in a first Office action.
- (B) 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 parent application.
- (C) 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 parent 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 parent application.
- (D) The final Office action rejection is in a first Office action in a substitute application that contains material that was presented after final rejection in an earlier application but was denied entry because the issue of new matter was raised.
- (E) None of the above.

12. You are a registered practitioner. Lucy, your new associate, wants to know whether she must file an application data sheet with a provisional patent application of a client and what information she should include on the application data sheet. Lucy has previously submitted an application data sheet with a previously filed application for another client, but has discovered a discrepancy with the information contained in the declaration and application data sheet. Lucy wonders if she needs to correct the error if the correct information is contained in the declaration. She also asks how errors may be corrected. With respect to the filing of an application data sheet, which of the following is not accurate under proper USPTO procedure for applications filed on or after January 1, 2001?

- (A) An application data sheet is a sheet or sheets that may be voluntarily submitted in either provisional or nonprovisional applications, which contains bibliographic data, arranged in a format specified by the Office. If an application data sheet is provided, the application data sheet is part of the provisional or nonprovisional application for which it has been submitted.
- (B) Bibliographic data on an application data sheet includes: (1) applicant information, (2) correspondence information, (3) application information, (4) representative information, (5) domestic priority information, (6) foreign priority information, and (7) assignee information.
- (C) Once captured by the Office, bibliographic information derived from an application data sheet containing errors may not be corrected and recaptured by a request therefor accompanied by the submission of a supplemental application data sheet, an oath or declaration under 37 CFR 1.63 or § 1.67; nor will a letter pursuant to 37 CFR 1.33(b) be acceptable.
- (D) In general, supplemental application data sheets may be subsequently supplied prior to payment of the issue fee either to correct or update information in a previously submitted application data sheet.
- (E) The Office will initially capture bibliographic information from the application data sheet notwithstanding whether an oath or declaration governs the information. Thus, the Office shall generally not look to an oath or declaration under 37 CFR 1.63 to see if the bibliographic information contained therein is consistent with the bibliographic information captured from an application data sheet (whether the oath or declaration is submitted prior to or subsequent to the application data sheet).

13. In accordance with proper USPTO practice and procedure, a submission for a request for continued examination does not include:

- (A) An amendment of the drawings.
- (B) New arguments in support of patentability.
- (C) New evidence in support of patentability.
- (D) An appeal brief or reply brief (or related papers).
- (E) An amendment of the claims.

14. Which of the following is not in accord with proper USPTO practice and procedure?
- (A) A written description as filed in a nonprovisional patent application is presumed adequate under 35 U.S.C. § 112 in the absence of evidence or reasoning to the contrary.
 - (B) An examiner may show that a written description as filed in a nonprovisional patent application is not adequate by presenting a preponderance of evidence why a person of ordinary skill in the art would not recognize in the applicant's disclosure a description of the invention defined by the claims.
 - (C) A general allegation of "unpredictability in the art" is sufficient to support a rejection of a claim for lack of an adequate written description.
 - (D) When filing an amendment, a practitioner should show support in the original disclosure for new or amended claims.
 - (E) When there is substantial variation within a genus, an applicant must describe a sufficient variety of species to reflect the variation within the genus.

15. Sam is a sole proprietor of *Sam's Labs*, which has no other employees. Sam invented a new drug while doing research under a Government contract. Sam desires to file a patent application for his invention and assign it to *Sam's Labs*. Sam has licensed Rick, also a sole proprietor with no employees, to make and use his invention. Sam wants to claim small entity status when filing a patent application for his invention. Sam also wants to grant the Government a license, but will not do so if he will be denied small entity status. Sam has limited resources and wants to know whether, how, and to what extent he may claim small entity status. Which of the following is not accurate with respect to proper USPTO procedure in relation to applications filed on or after January 1, 2001?

- (A) *Sam's Labs* is a small business concern for the purposes of claiming small entity status for fee reduction purposes.
- (B) If Sam grants a license to the Government resulting from a rights determination under Executive Order 10096, it will not constitute a license so as to prohibit claiming small entity status.
- (C) The establishment of small entity status permits the recipient to pay reduced fees for all patent application processing fees charged by the USPTO.
- (D) Sam may establish small entity status by a written assertion of entitlement to small entity status. A written assertion must: (i) be clearly identifiable; (ii) be signed; and (iii) convey the concept of entitlement to small entity status, such as by stating that applicant is a small entity, or that small entity status is entitled to be asserted for the application or patent.
- (E) While no specific words or wording are required to assert small entity status, the intent to assert small entity status must be clearly indicated in order to comply with the assertion requirement.

The following facts apply to Questions 16 and 17.

Claims 1 and 2, fully disclosed and supported in the specification of a patent application having an effective filing date of March 15, 2000, for sole inventor Ted, state the following:

Claim 1. An apparatus intended to be used for aerating water in a fish tank, comprising:

- (i) an oxygen source connected to a tube, and
- (ii) a valve connected to the tube.

Claim 2. An apparatus as in claim 1, further comprising an oxygen sensor connected to the valve.

16. Which of the following claims, if fully disclosed and supported in the specification, and included in the application, provides a proper basis for an objection under 37 CFR 1.75(c)?

- (A) Claim 3. An apparatus as in any one of the preceding claims, in which the tube is plastic.
- (B) Claim 3. An apparatus according to claims 1 or 2, further comprising a temperature sensor connected to the valve.
- (C) Claim 3. An apparatus as in the preceding claims, in which the tube is plastic.
- (D) Claim 3. An apparatus as in any preceding claim, in which the tube is plastic.
- (E) Claim 3. An apparatus as in either claim 1 or claim 2, further comprising a temperature sensor connected to the valve.

17. Which of the following, if relied on by an examiner in a rejection of claim 2, can be a statutory bar under 35 U.S.C. § 102 of claim 2?

- (A) A U.S. patent to John, issued February 2, 1999, that discloses and claims an apparatus intended to be used for aerating ice cream, having an oxygen source connected to a tube, a valve connected to the tube, and a battery coupled to the oxygen source.
- (B) A U.S. patent to John, issued April 6, 1999, that discloses and claims an apparatus intended to be used for aerating water in a fish tank, having an oxygen source connected to a tube, a valve connected to the tube, and an oxygen sensor connected to the tube.
- (C) A U.S. patent to Ned, issued February 9, 1999, that discloses, but does not claim, an apparatus intended to be used for aerating ice cream, having an oxygen source connected to a tube, a valve connected to the tube, an oxygen sensor connected to the valve, and a battery coupled to the oxygen source.
- (D) A foreign patent to Ted issued April 12, 2000, on an application filed on March 12, 1997. The foreign patent discloses and claims an apparatus intended to be used for aerating water in a fish tank, having an oxygen source connected to a tube, a valve connected to the tube, and an oxygen sensor connected to the tube.
- (E) None of the above.

18. Which of the following is in accord with proper USPTO practice and procedure?
- (A) Satisfaction of the enablement requirement of the first paragraph of 35 U.S.C. § 112 by the disclosure in a specification also satisfies the written description requirement of the second paragraph of 35 U.S.C. § 112
 - (B) A claim to a process consisting solely of mathematical operations, *i.e.*, converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a process eligible for patent protection.
 - (C) A claim for a machine can encompass only one machine, such as a single computer, for performing the underlying process.
 - (D) A claim that recites nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, *per se*, and as such are statutory natural phenomena.
 - (E) A composition of matter is a single substance, as opposed to two or more substances, whether it be a gas, fluid, or solid.

19. Mr. Adams was touring the central Mexican highland desert when he came across a small tequila production facility. While touring the facility, Adams saw a unique machine for squeezing the sap from the blue agave plant and preparing the sap for fermentation. The machine, which had been in operation for more than three years, was highly efficient and helped produce excellent tequila from a minimal number of agave plants. The owner of the production facility had sold a number of identical machines to other local tequila producers over the past two years. All of the machines remained local and none of the producers sold their tequila outside the local area. Aware that the blue agave plant was becoming increasingly rare, Adams immediately recognized the commercial possibilities of such an efficient machine. Adams returned to the facility under cover of night and took numerous photographs of the machine. Upon Adams' return to the United States, he worked from the photographs to make detailed technical drawings of the machine. He then promptly filed a patent application directed to the machine. Which of the following statements is correct?

- (A) Adams may not obtain a patent on the machine because it was known by others in a NAFTA country before Mr. Adams made technical drawings of the machine.
- (B) Adams may not obtain a patent on the machine because the machine had been sold more than a year before Adams' application filing date.
- (C) Adams is entitled to a patent because all sales of the machine and the tequila produced by the machine were in Mexico; a goal of the patent system is public disclosure of technical advances; and the machine likely would not have been disclosed to the United States public without Adams.
- (D) Adams may not obtain a patent on the machine because the machine was in public use more than a year before Adams' application filing date.
- (E) Statements (A), (B), (C) and (D) are each incorrect.

20. Which of the following is true?
- (A) The statement, "Whether claims 1 and 2 are unpatentable," complies with the requirement of 37 CFR 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) 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.
 - (D) 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.
 - (E) In an *ex parte* reexamination proceeding of a patent that arises from an application filed in the United States before November 29, 1999, 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.
21. An inventor, working with prior art subject matter, changes the subject matter, and thereafter files a patent application only claiming the changed subject matter. Which of the following changes might render the claimed subject matter patentable?
- (A) Where the only difference between the prior art device and the claimed device was a recitation of relative dimensions of the claimed device and the claimed device would not perform differently than the prior art device.
 - (B) Where the only difference between the prior art device and the claimed device is the configuration of the claimed device, and the configuration is a matter of choice without significance regarding the use of the device.
 - (C) Where the difference between the prior art, an impure material, and the claimed subject matter, the purified form of the impure material, is the purity of the material and the utility of the purified material, which differs from the impure material.
 - (D) Where the only difference between the prior art device and the claimed device is a reversal of the parts that move relative to each other, and without any unexpected results.
 - (E) Where the only difference between the prior art device and the claimed device is elimination of an element and its function, and elimination of the function was desired, required, or expected.

22. Tony, an inventor/client in several pending applications which you have filed, comes to you with several publications and patents which he has discovered for the first time while cleaning out his brother-in-law's attic last week. Tony's brother-in-law was not an individual within the scope of 37 CFR 1.56. Tony's brother-in-law has what appears to be material prior art for four of Tony's applications, A, B, C and D. Tony wants to know if it is too late to file information disclosure statements to have the examiner consider the information. Tony also wants to know if he does file an information disclosure statement, is he making a statement that a search has been conducted and that the items he discovered are material? Application A was filed two months ago and no Office action has issued. Application B was filed six months ago and a first, non-final, action has issued. In Application C, a Notice of Allowability has issued and the issue fee has not been paid. In Application D, a Notice of Allowability has issued and the issue fee has been paid. Which of the following is not true with respect to the proper USPTO procedure in relation to Tony's applications, all of which were filed on or after January 1, 2001?

- (A) The USPTO would consider an information disclosure statement signed by Tony in regard to application B, if the statement signed by Tony is filed within three months of Tony knowing the information and before the mailing date of a final action under 37 CFR 1.113, a notice of allowance under 37 CFR 1.311, or an action that otherwise closes prosecution in the application. The information disclosure statement must be accompanied by one either (1) the appropriate fee or (2) a statement that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application. Further, the statement must include Tony's certification, after making reasonable inquiry, to his knowledge that no item of information contained in the information disclosure statement was known to any individual within the scope of 37 CFR 1.56(c) more than three months prior to the filing of the information disclosure statement.
- (B) For application C, an information disclosure statement must be considered by the Office if the statement, signed by Tony, is filed after Notice of Allowance was mailed and on or before payment of the issue fee, and is accompanied by both the appropriate fee, and a statement that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application. Further, the statement must include Tony's certification, after making reasonable inquiry, to his knowledge that that no item of information contained in the information disclosure statement was known to any individual within the scope of 37 CFR 1.56(c) more than three months prior to the filing of the information disclosure statement.
- (C) No extensions of time for filing an information disclosure statement are permitted under 37 CFR 1.136, however, if a *bona fide* attempt is made to comply with 37 CFR 1.98, but part of the required content is inadvertently omitted, additional time may be given to enable full compliance.
- (D) A properly filed information disclosure statement shall be construed as a representation that a diligent and thorough search has been made.
- (E) The filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in 37 CFR 1.56(b).

23. Roberto files a U.S. patent application fourteen months after he perfects an invention in Europe. Which of the following would establish a statutory bar against the granting of a U.S. patent to Roberto?

- (A) A foreign patent issued to Roberto 11 months prior to the filing date of Roberto's U.S. patent application. The foreign patent was granted on an application that was filed 23 months prior to the effective filing date of Roberto's U.S. patent application. The foreign patent application and the U.S. patent application claim the same invention.
- (B) The invention was described in a printed publication in the United States, 11 months prior to the filing date of the U.S. patent application.
- (C) The invention was in public use in the United States, less than one year prior to the filing date of the U.S. patent application.
- (D) The invention was on sale in a foreign (NAFTA member) country, more than one year prior to the filing date of the U.S. patent application.
- (E) None of the above.

24. Able and Baker conceived an improved gas grille for cookouts. Using elements A, B, C, D, E and F found in their backyards, as well as elements G, H, I, J, K, L, M and N purchased at a local hardware store, they successfully constructed and used a gas grille conforming to their concept. The grille includes subcombination of elements K, L and M conceived by Able, and subcombination C, D, F, G and M conceived by Baker. Able and Baker conceived their respective subcombinations separately and at different times. Able and Baker retain you to prepare and file a patent application for them. You are considering whether and what can be claimed in one patent application. Which of the following is true?

- (A) For Able and Baker to properly execute an oath or declaration under 37 CFR 1.63 in a patent application claiming not only the grille, but also the two subcombinations, Able and Baker must be joint inventors of the grille, and each of the two subcombinations.
- (B) A characteristic of U.S. patent law that is generally shared by other countries is that the applicant for a patent must be the inventor.
- (C) If Able and Baker execute an oath or declaration under 37 CFR 1.63 as joint inventors and file an application claiming the grille (a combination of elements A, B, C, D, E, F, G, H, I, J, K, L, M and N), the existence of the claim to the grille is evidence of their joint inventorship of the individual elements.
- (D) Able and Baker may properly execute an oath or declaration under 37 CFR 1.63 as joint inventors and file an application containing claims to the grille (a combination of elements A, B, C, D, E, F, G, H, I, J, K, L, M and N), claims to the subcombination conceived by Able, and claims to the subcombination conceived by Baker.
- (E) Able and Baker could not properly claim the combination unless they successfully and personally reduced the grille to practice.

25. Ada invented a computer memory retrieval system in the United States. In June 1999, at the request of MC Computer Corp. and with the benefit of an export license, Ada demonstrates her invention at a testing facility in England. MC Computer Corp. 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 Ada, MC Computer Corp. installs the computer memory retrieval system on its MC computers and begins selling its computers in England in September 1, 1999, with Ada's memory retrieval system. The first sale in the United States of MC Computer Corp.'s computers with Ada's memory retrieval system occurs on October 1, 1999. On August 1, 2000, MC Computer Corp. publishes an advertisement in the United States, and files a U.S. patent application that discloses but does not claim the memory retrieval system invented by Ada. The MC Computer Corp.'s patent issues on October 1, 2001. On September 12, 2000, Ada files a patent application. On October 15, 2001, the examiner rejects all the claims in Ada's application based upon MC Computer Corp.'s advertisement published on August 1, 2000. Which of the following is true?

- (A) Since the MC Computer Corp. misappropriated the invention and since Ada did not authorize the sales in England on September 1, 1999, or the advertisement on August 1, 2000 in the United States, the rejection may be overcome by showing that the idea was misappropriated by MC Computer and the sales were not authorized by Ada.
- (B) Ada is not entitled to a patent since the invention was on sale more than one year prior to the date of the application for patent in the United States.
- (C) Ada may file a declaration pursuant to 37 CFR 1.131 to antedate MC Computer Corp.'s published advertisement.
- (D) Ada may file a request for reexamination of the MC Computer Corp.'s patent on the grounds that her idea was misappropriated.
- (E) The MC Computer Corp.'s patent is invalid for breach of the confidentiality agreement and disclosing the invention of another.

26. Where a reference relied upon in a 35 U.S.C. § 103 rejection qualifies as prior art only under 35 U.S.C. § 102(f), or (g), which of the following represents the most comprehensive answer in accord with proper USPTO practice and procedure as to the action an applicant should take to overcome the rejection?

- (A) Present proof that the subject matter relied upon and the claimed invention are currently commonly owned.
- (B) Present proof that the subject matter relied upon and the claimed invention were commonly owned at the time the later invention was made.
- (C) Present proof that the subject matter relied upon and the claimed invention were subject to an obligation to assign to the same person at the time the later invention was made.
- (D) (A) and (B).
- (E) (C) and (D).

27. A U.S. patent application for inventor William Tull discloses a target-shooting gun for improved accuracy, and a bullet impregnated with a new chemical composition. The new chemical composition minimizes damage to a target struck by the bullet. In a non-final Office action, an examiner includes a restriction requirement between a group of claims drawn to the target-shooting gun (Group 1), and a group of claims drawn to the bullet (Group 2). Which of the following, included in a timely reply to the non-final Office action, preserves Tull's right to petition for review of the restriction requirement, if the requirement is made final?

- (A) A reply that distinctly points out supposed errors in the restriction requirement, and also states, "The restriction requirement is traversed, and no election is made, thereby preserving Applicant's right to petition for review of the restriction requirement."
- (B) A reply that states, "Applicant elects Group 2 and traverses the restriction requirement because the requirement for restriction between Group 1 and Group 2 is in error."
- (C) A reply that distinctly and specifically points out supposed errors in the restriction requirement, and states, "Applicant traverses the restriction requirement and elects Group 2."
- (D) A reply that states, "The restriction requirement between Group 1 and Group 2 is traversed because it is in error, and no election is made, thereby preserving Applicant's right to petition for review of the restriction requirement."
- (E) None of the above.

28. Which of the following is true?

- (A) When an applicant successfully petitions to make his case special, the special status ends if applicant appeals the case to the Board of Patent Appeals and Interferences.
- (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.

The following facts apply to Questions 29 through 32.

Kat Forrest has been a famous golf prodigy since childhood and currently enjoys phenomenal success on the professional golf tour, having won four straight major titles. Kat conceived, constructed and successfully tested a golfer's aid to help less-skilled players. Briefly, the aid includes a distance-finder that determines the precise distance from the golfer's ball to a target such as a fairway landing area or the hole. The aid obtains data concerning playing conditions (*e.g.*, wind speed and direction, soil moisture, *etc.*) from a series of sensors distributed throughout a golf course. A global positioning system provides accurate positional coordinates for the ball location and the target location. A user interface allows manual input of situational data (*e.g.*, ball in divot) and permits the user to override system settings and sensor data. The golfer's aid also includes computer memory that stores performance data calibrated to a specific golfer. In use, a digital processor determines a suggested play based on playing conditions and golfer skill level, and automatically displays information concerning the suggested play (*e.g.*, recommended golf club and preferred line of flight for the ball). Other information can be displayed in reply to user requests.

Kat comes to you in September 2001 and asks you to prepare and file a patent application on her behalf. She informs you that she has shown the golfer's aid only to her caddie and only under terms of strict confidentiality, and that she finalized the design on June 5, 2001. Her golfer's aid has not been sold or offered for sale. She also informs you that she derived the general idea for the golfer's aid, in part, from (1) an article appearing in the July 2000 edition of a golf magazine concerning a commercial distance finder and (2) a customized personal digital assistant (PDA) she saw on a store shelf while traveling in Thailand in April 2001. The distance finder has been available for sale in the United States since August 2000. The customized PDA was first offered for sale in the United States on June 8, 2001, but has not been disclosed in any publication or patent document. You prepare a patent application with claims that you believe are likely to be found patentably distinct over the commercially available distance finder and the golf magazine article, either alone or in combination. The application is filed with the USPTO on September 17, 2001.

29. Which of the following statements is most true?
- (A) Kat should disclose the golf magazine article to the USPTO for consideration by the examiner, but need not disclose information concerning the customized PDA.
 - (B) Kat need not disclose either the golf magazine article or information concerning the customized PDA to the USPTO for consideration by the examiner.
 - (C) Kat should disclose both the golf magazine article and information concerning the customized PDA to the USPTO for consideration by the examiner.
 - (D) Kat's observation of the customized PDA is not material to patentability because the observation took place in Thailand and the PDA was not offered for sale in the United States until June 2001, the PDA has not been described in a publication, and the PDA has not been patented.
 - (E) Kat's observation of the customized PDA cannot be material to patentability because golfer's aids are nonanalogous art.

30. Which of the following is most likely to be considered in a proper obviousness determination?

- (A) Evidence demonstrating the manner in which the invention was made.
- (B) Evidence that a combination of prior art teachings, although technically compatible, would not be made by businessmen for economic reasons.
- (C) Evidence demonstrating the level of ordinary skill in the art.
- (D) Evidence that one of ordinary skill in the art, after reading Kat's application, would readily be able to make and use Kat's invention without undue experimentation.
- (E) Evidence that the distance finder described in the July 2000 golf magazine has enjoyed great commercial success.

31. A United States patent issued to Jack Nichols on September 18, 2001 based on an application filed in the USPTO in May 2000. The Nichols patent claimed priority from a German application that was filed in April 2000 and was first published in October 2001. The Nichols U.S. application was an exact translation of the German priority application, and fully anticipated the subject matter of Kat's broadest claims. The Examiner locates the Nichols U.S. patent and the Nichols published priority application during prosecution. Which of the following actions, if taken by the Examiner, would be most proper (keeping in mind that the Examiner has no evidence of Kat's activities prior to September 17, 2001)?

- (A) Reject Kat's broadest claims under 35 U.S.C. §102(a) because Nichols' U.S. patent is evidence that the claimed subject matter was known by others prior to Kat's invention.
- (B) Reject Kat's broadest claims under 35 U.S.C. § 102(a) because the claimed subject matter was patented or described in a printed publication by Nichols before Kat's invention.
- (C) Reject Kat's broadest claims under 35 U.S.C. § 102(b) because the claimed subject matter was patented or described in a printed publication by Nichols before Kat's invention.
- (D) Reject Kat's broadest claims under 35 U.S.C. § 102(d) because the claimed subject matter was first patented or caused to be patented in a foreign country on an application filed more than twelve months before Kat's filing date.
- (E) Reject Kat's broadest claims under 35 U.S.C. § 102(e) because the claimed subject matter was described in a U.S. patent granted to Nichols on an application filed before Kat's invention.

32. Kat's patent application includes the following incomplete independent claim 8 and complete dependent claims 9 and 10:

Claim 8. An aid for assisting a golfer comprising:

- i) a display device;
- ii) an input device adapted to receive user inputs from said golfer;
- iii) _____;
- iv) a memory for storing user specific data indicating, at least in part, a skill level for said golfer; and
- v) a processor which (1) obtains signals from said input device, said receiver, and said memory, (2) calculates a suggested play based at least in part on said signals from said input device, said receiver, and said memory, and (3) displays said suggested play on said display device.

Claim 9. The aid of claim 8, wherein said plurality of remote devices includes multiple sensors distributed on a golf course for detecting and transmitting playing condition data.

Claim 10. The aid of claim 9, wherein said plurality of remote devices further includes a global positioning system for obtaining position data.

Which of the following best completes claim 8?

- (A) a plurality of remote devices operable to detect playing conditions and position and to generate sensor signals that indicate playing condition data and position data;
- (B) a plurality of remote devices, said plurality of remote devices including at least one device that indicates playing condition data and at least one device that indicates position data;
- (C) means for receiving playing condition data and position data transmitted by a plurality of remote devices;
- (D) a receiver operable to obtain data transmitted by a plurality of remote devices, said plurality of remote devices including at least one device that transmits playing condition data and at least one device that transmits position data;
- (E) a receiver operable to obtain a plurality of remote sensor signals, said remote sensor signals indicating playing condition data and position data;

33. Igor, a refugee from the civil turmoil that recently befell his native country, filed a design patent application in the USPTO on January 24, 2000, which issued as a design patent on January 23, 2001. Igor's design patent covered a design of a cell phone holder for motor vehicles and became immediately popular with cell phone owners, resulting in numerous inquiries for licenses from various manufacturers. Igor would like to financially exploit his patent by licensing for five years. However, in appreciation for the benefits bestowed upon him since immigrating to the U.S., Igor has decided to dedicate five years of his patent term to the public. Which of the following is in accord with proper USPTO practice and procedure, while best allowing Igor to pursue his intentions?

- (A) Record in the USPTO an assignment of all right, title, and interest in the patent to the public, conditioned on the receipt by Igor of all royalties from licensing the patent after the first five years of the patent term.
- (B) File a disclaimer in the USPTO dedicating to the public the first five years of the patent term.
- (C) File a disclaimer in the USPTO dedicating to the public that portion of the term of the patent from January 24, 2015 to January 24, 2020.
- (D) File a disclaimer in the USPTO dedicating to the public half of all royalties received from licensing the patent for the terminal part of the term of the patent.
- (E) File a disclaimer in the USPTO dedicating to the public that portion of the term of the patent from January 24, 2010 to January 23, 2015.

34. A patent application filed in the USPTO contains the following dependent claim:

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) Claim 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.
- (B) Claim 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.
- (C) Claim 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) Claim 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.
- (E) (B) and (C).

35. During their period of courtship, Amy and Pierre invented and actually reduced to practice an improved frying pan, wherein the sides and integral handle are formed from a metal having a low coefficient of conductivity, and a base providing the cooking surface formed from a metal having a high coefficient of conductivity. While the basic concept was old in the art, Amy's concept was to sandwich a layer of aluminum between layers of copper, while Pierre's concept was to sandwich a layer of copper between layers of aluminum. Accordingly, acting as *pro se* joint inventors, they filed a nonprovisional patent application in the USPTO on January 10, 2001, along with a proper nonpublication request. The application disclosed both Amy's and Pierre's concepts in the specification, and contained three independent claims: claim 1 was generic to the two concepts; claim 2 was directed to Amy's concept, and claim 3 was directed to Pierre's concept. Thereafter, Amy and Pierre had a "falling out" and Pierre returned to his home in France where he filed a corresponding patent application in the French Patent Office on January 31, 2001. Pierre was completely unaware of any obligation to inform the USPTO of the French application. Amy first learned of Pierre's application in the French Patent Office on October 10, 2001. Once Amy learns of the French application, which of the following actions should she take which accords with proper USPTO practice and procedure and which is in her best interest?

- (A) Immediately notify the USPTO of the filing of the corresponding application in the French Patent Office.
- (B) Promptly submit a request to the USPTO under Amy's signature to rescind the nonpublication request.
- (C) File an amendment under Amy's signature deleting claim 3 and requesting that Pierre's name be deleted as an inventor on the ground that he is not an inventor of the invention claimed.
- (D) Promptly file a document, jointly signed with Pierre, giving notice to the USPTO of the filing of the corresponding application in the French Patent Office and showing that any delay in giving the notice was unintentional.
- (E) File an application for a reissue patent that is accompanied by an amendment paper with proper markings deleting Pierre's concept from the specification and a statement canceling claims 1 and 3.

36. The claims of a pending patent application were rejected in an Office action mailed Thursday, November 23, 2000. The Examiner set a three-month shortened statutory period for reply. The applicant petitioned for a one-month extension of time on Friday, February 23, 2001 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 23, 2001.
- (B) Friday, March 23, 2001.
- (C) Saturday, March 24, 2001.
- (D) Monday, March 26, 2001.
- (E) Thursday, May 24, 2001.

37. An application includes independent claims 1 and 2. Which of the following, in a reply to a non-final Office action, provides the proper basis for a rejection under 35 U.S.C. § 112, first paragraph?

- (A) Applicant amends claim 2 of the originally filed application by adding a limitation which was previously written only in claim 1 of the originally filed application, and one of ordinary skill in the art is enabled by the original disclosure to make and use the invention as claimed in amended claim 2.
- (B) Applicant amends claim 1 of the originally filed application by adding a limitation that was written in the original disclosure of the application, but the original disclosure does not enable one of ordinary skill in the art to make or use the invention as claimed in amended claim 1.
- (C) Applicant amends and broadens claim 2 by removing a limitation which was written in the original disclosure of the application, and one of ordinary skill in the art is enabled by the original disclosure to make and use the invention as claimed in amended claim 2.
- (D) Applicant adds new matter to the disclosure, but does not amend the claims of the originally filed application, and one of ordinary skill in the art is enabled by the original disclosure to make and use the invention as described in each of the claims.
- (E) None of the above.

38. Registered practitioner Roni files a utility patent application under 37 CFR 1.53(b) in the USPTO having one claim on May 6, 1998. A proper final rejection of claim 1 was mailed on June 28, 2000. Roni files a request for continued examination with the appropriate fee on September 12, 2000, and submits an amendment to claim 1 with the request. On October 7, 2000, Roni learns about a publication (the “Columbus reference”) which she knows to be material to patentability of claim 1, but which was not considered by the examiner during prosecution of the application. Roni prepares an information disclosure statement that complies with the provisions of 37 CFR 1.98, listing the Columbus reference. The finality of the action on June 28, 2000, is withdrawn in an Office action on November 20, 2000, which is after the filing of the request for continued examination. Which of the following actions, if taken by Roni, will properly result in the Columbus reference being considered by the Office during the pendency of the application?

- (A) Filing the information disclosure statement on November 15, 2000, without any further statement and without the fee set forth in 37 CFR 1.17(p).
- (B) Filing the information disclosure statement on December 11, 2000, without any further statement and without the fee set forth in 37 CFR 1.17(p).
- (C) Filing the information disclosure statement on December 13, 2000, without any further statement and without the fee set forth in 37 CFR 1.17(p).
- (D) (A) or (B) above.
- (E) None of the above.

39. A non-final Office action in a pending patent application was mailed on Friday, March 16, 2001. The patent examiner set a three month shortened statutory period for reply. The applicant petitioned for a one-month extension of time on Monday, June 18, 2001 and paid the appropriate one-month extension fee. An Amendment responsive to the Office action was filed Tuesday, July 17, 2001. In the Remarks portion of the Amendment, the applicant stated: "It is believed that no fees are required by the present Amendment. However, if any fees are necessary, including fees for any required extension of time, the Director of the United States Patent and Trademark Office is hereby authorized to charge any such fees to applicant's deposit account number nn-nnnn. A duplicate copy of this paper is enclosed." No fees were submitted with the Amendment. Assuming nn-nnnn is a valid deposit account with sufficient funds deposited, which of the following statements is true?

- (A) The Amendment should not be entered because it is untimely.
- (B) The Amendment should be entered with no fees charged to applicant's deposit account.
- (C) The Amendment should be entered, but the fee for a second month extension of time should be charged to applicant's deposit account.
- (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 (A) and (D) are true.

40. Mike and Alice, who are not related, are shipwrecked on a heretofore uninhabited and undiscovered island in the middle of the Atlantic Ocean. In order to signal for help, Mike invents a signaling device using bamboo shoots. Alice witnesses but does not assist in any way in the development of the invention. The signaling device works and a helicopter comes and rescues Alice. However, Mike remains on the island due to overcrowding on the helicopter. Unfavorable weather conditions have prevented Mike's rescue to date. Alice comes to you, a registered patent practitioner, to file an application for a patent and offers to pay you in advance. Which of the following is true?

- (A) Since Mike invented the invention, Alice cannot properly file an application for a patent in her name even though Mike is unavailable.
- (B) Since Mike is unavailable, you may properly file an application for a patent without his consent. You can accept the money from Alice as payment for the application.
- (C) Since Mike is not available and cannot be reached, Alice may properly sign the declaration on his behalf since she has witnessed the invention and knows how to make and use it.
- (D) Alice should file an application in her name since she has witnessed the invention and knows how to make and use it. Subsequently, when Mike becomes available, the inventorship may be changed to the correct inventorship.
- (E) Even though Mike and Alice are not related, Alice may properly file an application on Mike's behalf.

41. For purposes of determining whether a request for continued examination is in accordance with proper USPTO rules and procedure, in which of the following situations will prosecution be considered closed?

- (A) The last Office action is a final rejection.
- (B) The last Office action is an Office action under *Ex parte Quayle*.
- (C) A notice of allowance has issued following a reply to a first Office action.
- (D) The application is under appeal.
- (E) All of the above.

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

Claim 1. A doughnut making machine comprising:

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

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

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

43. Which of the following establishes a statutory bar under 35 U.S.C. § 102 to patentability of Applicant's claimed invention?

- (A) To further develop the invention, Applicant's invention was tested and experimented with in the United States more than one year prior to applicant's effective U.S. filing date, but the invention at the time was not fit for its intended purpose and important modifications concerning the claimed features resulted from the experimentation. The first actual reduction to practice occurred after the effective U.S. filing date.
- (B) Applicant's invention was sold in a WTO member country outside the United States more than one year prior to applicant's effective U.S. filing date, and the sale was merely market testing of the invention to determine product acceptance.
- (C) Applicant's invention is rendered obvious by the combination of two U.S. patents, both of which were patented more than one year prior to applicant's effective filing date.
- (D) Applicant's invention was sold outside the United States in a non-WTO member country, more than one year prior to applicant's effective U.S. filing date, but the sale was merely an attempt at market penetration.
- (E) None of the above.

44. Registered practitioner Joe duly files a non-provisional utility patent application on May 6, 1999. The USPTO sends Joe a notice of allowance dated November 13, 2000. On November 23, 2000, Joe learns about a publication ("Smith reference") which he knows to be material to patentability of the claims presented in the application, but which was not considered by the examiner during prosecution of the application. Joe prepares an information disclosure statement that complies with the provisions of 37 CFR 1.98, listing the Smith reference. In accordance with USPTO rules and procedure which of the following actions, if taken by Joe, will result in the examiner considering the Smith reference during prosecution of the application?

- (A) Prior to Wednesday, February 14, 2001, filing a request for continued examination of the application, the information disclosure statement, and the fee for a request for continued examination, but not paying the issue fee.
- (B) Timely paying the issue fee, and thereafter filing a request for continued examination of the application together with the information disclosure statement, and the fee for a request for continued examination, but not submitting a petition under 37 CFR 1.313.
- (C) After Tuesday, February 13, 2001, filing a request for continued examination of the application together with the information disclosure statement, and the fee for a request for continued examination, but not paying the issue fee.
- (D) Timely paying the issue fee, and after the patent issues filing a request for continued examination of the application, the information disclosure statement, the fee for a request for continued examination, and a petition under 37 CFR 1.313.
- (E) None of the above.

45. Which of the following statements accords with proper USPTO practice and procedure?
- (A) A request for publication of a provisional application on a certain date will be treated as a request for publication as soon as possible.
 - (B) If an applicant filed an application in a foreign country and the description of the invention in the foreign application is less extensive than the description of the invention in the application filed in the USPTO, the applicant may submit a redacted copy, eliminating the description not contained in the foreign application, for publication within 12 months after the filing date for which a benefit is sought under 35 U.S.C.
 - (C) Early publication of a reissue application may be honored only if accompanied by a copy of the application in compliance with the Office electronic filing system requirements.
 - (D) If an applicant filed an application in a foreign country and the description of the invention in the foreign application is more extensive than the description of the invention in the application filed in the USPTO, the applicant may submit a redacted copy, eliminating the description not contained in the foreign application, for publication within 14 months after the filing date for which a benefit is sought under 35 U.S.C.
 - (E) Re-publication of a patent application is available where the Office makes a material mistake apparent from the records and the request for re-publication is filed within 3 months from the date of the patent application publication.

46. In early 1999, at the request of MC Motors, Eve demonstrated her 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 heating system on its MC cars and begins selling its cars with the heating system in the United States in September 1999. In August 2000, MC files a patent application in the United States for the automobile heating system. In December 2000, 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 1999. Which of the following is true?

- (A) MC Motors is entitled to a patent even though it misappropriated the idea for the invention from Eve since the misappropriation was beyond the jurisdiction of the USPTO.
- (B) 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.
- (C) 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.
- (D) (A) and (C).
- (E) None of the above.

47. Registered practitioner Rick drafted a patent application for inventor Sam. The application was filed in the USPTO on May 15, 2000, with a power of attorney appointing Rick. On March 15, 2001, Sam filed a revocation of the power of attorney to Rick, and a new power of attorney appointing registered practitioner Dave. In a non-final Office action dated September 12, 2001, the examiner included a requirement for information, requiring Dave to submit a copy of any non-patent literature, published application, or patent that was used to draft the application. Which of the following, if timely submitted by Dave in reply to the requirement for information, will be accepted as a complete reply to the requirement for information?

- (A) A statement by Dave that the information required to be submitted is unknown and is not readily available to Dave.
- (B) A statement by Dave that the requirement for information is improper because it was included in a non-final Office action.
- (C) A statement by Dave that the requirement for information is improper because Dave is not an individual identified under 37 CFR 1.56(c).
- (D) A statement by Dave that the requirement for information is improper because information used to draft a patent application may not be required unless the examiner identifies the existence of a relevant database known by Sam that could be searched for a particular aspect of the invention.
- (E) None of the above.

48. An Office action was mailed in which a three month shortened statutory period for reply was set. 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 CFR 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) 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.
- (D) The petition for a one-month extension of time will be construed as a petition requesting the appropriate period of extension.
- (E) Each of statements (A), (B), (C) and (D) is untrue.

49. Joe files a nonprovisional patent application containing claims 1 through 10 in the USPTO and properly receives a filing date of December 6, 2000. The first Filing Receipt including a confirmation number for the application was mailed on December 20, 2000. On January 30, 2001, the examiner mails Joe a NOTICE indicating that a nucleotide sequence listing in accordance with 37 CFR§ 1.821-1.825 is required. On February 27, 2001, Joe files the required sequence listing as well as a preliminary amendment adding claims 11 through 13 to the application, along with a copy of the application as amended in compliance with the Office electronic filing system requirements. Assuming the Office has not started the publication process at such time and that Joe's application is subsequently published pursuant to 35 U.S.C. § 122(b), which of the following statements accords with proper USPTO practice and procedure?

- (A) The published application will contain claims 1 through 10 only because the preliminary amendment adding claims 11 through 13 was not submitted in reply to the NOTICE.
- (B) The published application will contain claims 1 through 13 because a copy of the application as amended in compliance with the Office electronic filing system requirements was filed.
- (C) The published application will contain claims 1 through 10 only because the copy of the application as amended in compliance with the Office electronic filing system requirements was not filed within one month of the actual filing date of the application.
- (D) The published application may contain claims 1 through 13 because the Office may use an untimely filed copy of the application as amended in compliance with the Office electronic filing system requirements where the Office has not started the publication process.
- (E) The published application will contain claims 1 through 10 only because publication is based solely on the application papers deposited on the filing date of the application.

50. 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 CFR 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) The explicit admission by the registered practitioner, who formerly represented Stan, that the Acme patent constituted prior art is binding on Stan in any later proceeding involving the patent.
- (C) 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.
- (D) Since the 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 the registered practitioner 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).

THIS PAGE INTENTIONALLY LEFT BLANK

THIS PAGE INTENTIONALLY LEFT BLANK

Test Number 456
Test Series 201

Name _____

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

OCTOBER 17, 2001

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. 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 USPTO 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 court decision, a notice in the *Official Gazette*, or a notice in the *Federal Register*. 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 that 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 addresses provisions of the Patent Statute, regulations and MPEP which were not changed as a result of the enactment of the American Inventors Protection Act of 1999, Pub. L. No. 106-113 (“Act”). This examination also does address and test changes to the Patent Statute or regulations brought about by the enactment of the Act. Some, but not all, questions use the statute and rules, comments to the rules, and guidelines in place subsequent to November 28, 1999, including the following rule changes and guidelines in effect on or before January 20, 2001:

- ? Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule. 65 FR 50092 (Aug. 16, 2000) (including the adoption of changes set forth in Interim Rule, 65 FR 14865 (Mar. 20, 2000) to §§ 1.7, 1.17(e) and (i), 1.53(d)(1), 1.78(a)(3), 1.97(b), 1.104(c)(4), 1.113, 1.116, 1.198, 1.312, and 1.313(a), (b), (c)(1), (c)(3), and (d)).
- ? Changes to Permit Payment of Patent and Trademark Fees by Credit Card; Final Rule. 65 FR 33452 (May 24, 2000).
- ? Revision of Patent Fees for Fiscal Year 2001; Final Rule. 65 FR 49193 (Aug. 11, 2000).
- ? Changes To Implement the Patent Business Goals; Final Rules. 65 FR 54604 (Sept. 8, 2000).
- ? Changes to Implement the Patent Business Goals; Final Rule and corrections to final rules. 65 FR 78958 (Dec. 18, 2000).
- ? Changes to Implement Patent Business Goals; Final Rule, Correction. 65 Fed. Reg. 80755 (Dec. 22, 2000).
- ? Changes To Implement Patent Term Adjustment Under Twenty-Year Patent Term; Final Rules. 65 FR 56366, (Sept. 18, 2000).
- ? Changes to Implement Eighteen-Month Publication of Patent Applications; Final Rule. 65 FR 57024 (Sept. 20, 2000).
- ? Changes To Implement Eighteen-Month Publication of Patent Applications; Correction. Final Rule; correction. 65 FR 66502 (Nov. 6, 2000).
- ? Treatment of Unlocatable Patent Application and Patent Files; Final Rule. 65 FR 69446 (Nov. 17, 2000).
- ? Simplification of Certain Requirements in Patent Interference Practice; final Rule. 65 FR 70489 (Nov. 24, 2000).
- ? Reestablishment of the Patent and Trademark Office as the United States Patent and Trademark Office, 65 Fed. Reg. 17858 (April 5, 2000).
- ? Guidelines Concerning the Implementation of Changes to 35 U.S.C. 102(g) and 103(c) and the Interpretation of the Term “Original Application” in the American Inventors Protection Act of 1999, 1233 O.G. 54-56 (April 11, 2000).
- ? Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, para. 6, 65 Fed. Reg. 38510-38516 (June 21, 2000); 1236 O.G. 98-104 (July 25, 2000).
- ? Guidelines Setting Forth a Modified Policy Concerning the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 U.S.C. 103(c), 1241 O.G. 96-97 (December 26, 2000).
- ? Assignment of Confirmation Number and Time Period for Filing a Copy of an Application by EFS for Eighteen-Month Publication Purposes, 1241 O.G. 97-98 (December 26, 2000).
- ? Utility Examination Guidelines, 66 F.R. 1092-1099 (January 5, 2001).
- ? Guidelines for Examination of Patent Applications Under the 35 U.S.C. Sec. 112, para. 1 “Written Description” Requirement 66 F.R. 1099-1111 (January 5, 2001).

1. A U.S. patent application discloses a first embodiment of an invention, a composition made of known materials in equal amounts by weight of A, B, and C. The application discloses a second embodiment of the invention comprising equal amounts by weight of A, B, and C, and an effective amount of D, a known material, to reduce excess moisture from the composition. The application also discloses a third embodiment of the invention comprising equal amounts by weight of A, B, and C, and an effective amount of D to reduce the acidity of the composition. The application fully discloses guidelines for determining an effective amount of D to reduce excess moisture from the composition, and determining an effective amount of D to reduce the acidity of the composition. The application discloses that the amount of D needed to reduce excess moisture from the composition differs from the amount of D needed to reduce the acidity of the composition. Which of the following claims, if included in the application, provides a proper basis for a rejection under 35 U.S.C. § 112, second paragraph?

- (A) Claim 1. A composition comprising: equal amounts by weight of A, B, and C, and an effective amount of D to reduce the acidity of the composition.
- (B) Claim 1. A composition comprising: equal amounts by weight of A, B, and C, and an effective amount of D.
- (C) Claim 1. A composition comprising: equal amounts by weight of A, B, and C, and an effective amount of D to reduce excess moisture from the composition.
- (D) Claim 1. A composition comprising: equal amounts by weight of A, B, and C.
- (E) None of the above.

2. Able conceived the invention claimed in a patent application. In conceiving the invention, Able used and adopted ideas and materials known in the art and invented by others. Ben, Able's employee, reduced the invention to practice at Able's request and totally pursuant to Able's suggestions. Being unable to afford a patent practitioner's fees to prepare and prosecute the application, Able convinced John to pay for the practitioner's services in return for an interest in the invention. John did nothing more than provide the funds for the practitioner. Which of the following is in accordance with proper USPTO practice or procedure?

- (A) Able need not be the one to reduce the invention to practice so long as the reduction to practice occurred on his or her behalf. Able can be properly named as inventor in the application.
- (B) To be named an inventor, it is not necessary for John to have contributed to the conception of the invention. Ben, not Able, can be named as inventor in the application.
- (C) In conceiving the invention, Able may not consider and adopt ideas and materials derived from any sources, such as ideas of previous inventors. Able cannot be properly named as inventor in the application.
- (D) John and Able may be properly named as joint inventors of the invention in the application.
- (E) John, Ben, and Able may be properly named as joint inventors of the invention in the application.

3. Practitioner Smith filed a utility patent application on January 5, 2001, with informal drawings. Upon review of the drawings, the USPTO concluded that the drawings were not in compliance with the 37 CFR 1.84(a)(1) and (k), and were not suitable for reproduction. In an Office communication, Smith was notified of the objection and given two months to correct the drawings so that the application can be forwarded to a Technology Center for examination. Which of the following complies with USPTO practices and procedures for a complete *bona fide* attempt to advance the application to final action?

- (A) Smith timely files a response requesting that the objections to the drawings be held in abeyance until allowable subject matter is indicated.
- (B) Smith timely files a response requesting that the objections to the drawings be held in abeyance since the requirement increases up-front costs for the patent applicant, and the costs can be avoided if patentable subject matter is not found.
- (C) Smith timely files a response requesting that the objections to the drawings be held in abeyance until fourteen months from the earliest claimed priority date.
- (D) Smith timely files a response correcting the drawings to comply with 37 CFR 1.84(a)(1) and (k), and making them suitable for reproduction.
- (E) All of the above.

4. In 1996, Sydney, while vacationing at the North Pole, invents a new method of ice fishing using a solar powered fishhook with a transmission device for indicating the presence of a fish. For 5 years, Sydney practiced his invention exclusively at the North Pole, outside of the United States, its possessions, or its territories or any WTO or NAFTA country. He showed his invention to only one person, his friend Charlie, while Charlie was visiting him at the North Pole in June 2001. Charlie spoke to no one in the United States about the idea and crafted a near duplicate and began to publicly use it upon his return to Wisconsin in September 2001. On October 18, 2001, Sydney telephones you and complains to you that Charlie, the only person who has ever seen Sydney's device, has begun using his device. In the October 18, 2001 phone conversation, Sydney asks you for advice as to the filing of a patent application. Which of the following is the best advice for Sydney?

- A) The witnessing of the fishhook by Charlie in June 2001 constitutes knowledge of the invention, and claims directed to Sydney's invention could be properly rejected under 35 U.S.C. §102(a).
- B) Use of the device in Wisconsin constitutes public use and since Sydney cannot establish prior invention through activities at the North Pole, he is precluded from antedating the date of the first public use in the United States.
- C) Since Sydney invented the fishing device in 1996, he is the prior inventor and can overcome the first date of public use by Charlie by filing a 37 CFR 1.131 affidavit or declaration.
- D) Since Charlie first used the fishing device in the United States, Charlie may file a patent application.
- E) Since Charlie's public use in Wisconsin was not authorized, Sydney may still file a patent application on the fishing device.

5. You are a registered patent agent with a busy patent practice in Arlington, Virginia. You are scheduled to leave for a long-awaited three-week trip to the Galapagos Islands on Friday, October 19, 2001. You recently completed a draft of a provisional patent application and forwarded it to the client for review and comment. On October 12 you left a message with the President of your client, a company, reminding her of your trip and inquiring about the status of her review. She returns your message on Wednesday, October 17 and informs you for the first time that the provisional patent application relates to an invention upon which the continued success of her business depends and that she first offered the invention for sale on October 21, 2000. She also informs you that the provisional application is ready for filing, but that she will be unable to forward to you a declaration signed by the inventors for at least four weeks. Understandably, you wish to make absolutely certain that the provisional application, having ten pages of specification, and three sheets of drawings, is properly filed with the USPTO and accorded a filing date before you leave for your trip, and that you are timely informed should anything be omitted. Which of the following scenarios provides the best evidence that the USPTO has received the provisional application with no missing parts, and the application is accorded a filing date?

- (A) You promptly hand-carry the provisional application, an application data sheet, and the appropriate filing fee to the USPTO Customer Service Window. You file these materials and have the attendant date stamp a card reciting that the deposited document is a new application and reciting the title of the invention and listing the names of the inventors.
- (B) You promptly mail the provisional application, an application data sheet, and the appropriate filing fee to the official USPTO address employing a proper Certificate of Mailing in accordance with 37 CFR 1.8.
- (C) You promptly mail the provisional application, an application data sheet and the appropriate filing fee to the official USPTO address employing Express Mail Post Office to Addressee service of the U.S. Postal Service in accordance with 37 CFR 1.10.
- (D) You promptly mail the provisional application to the official USPTO address accompanied by a Return Postcard identifying the type of deposited document as a new patent application and reciting the title of the invention and listing the names of the inventors.
- (E) You promptly hand-carry the provisional application and an application data sheet to the USPTO Customer Service Window. You file these materials and have the attendant date stamp a card reciting the title of the invention, the names of the inventors, and listing the number of pages of the cover sheet, the number of pages of specification, and the number of sheets of drawings.

6. An examiner has advanced a reasonable basis for questioning the adequacy of the enabling disclosure in the specification of your client's patent application, and has properly rejected all the claims in the application. The claims in the application are drawn to a computer program system. In accordance with proper USPTO practice and procedure, the rejection should be overcome by submitting _____

- (A) factual evidence directed to the amount of time and effort and level of knowledge required for the practice of the invention from the disclosure alone.
- (B) arguments by you (counsel) alone, inasmuch as they can take the place of evidence in the record.
- (C) an affidavit under 37 CFR 1.132 by an affiant, who is more than a routineer in the art, submitting few facts to support his conclusions on the ultimate legal question of sufficiency, *i.e.*, that the system "could be constructed."
- (D) opinion evidence directed to the ultimate legal issue of enablement.
- (E) patents to show the state of the art for purposes of enablement where these patents have an issue date later than the effective filing date of the application under consideration.

7. Izzy decides one day that the hydrogen fuel cell research in which he is engaged shows great potential and retains the services of a patent law firm. A patent application is promptly prepared and filed in the USPTO disclosing and claiming a hydrogen fuel cell wherein the electrodes employed to catalyze the hydrogen gas into positive ions and negative ions consist of a platinum catalyst. The original claims are fully supported by the application as filed. Two preliminary amendments are submitted after the original filing, but prior to initial examination. In the first preliminary amendment, the specification, but not the claims, is amended to recite that the electrodes may consist of a niobium catalyst. In the second preliminary amendment, the specification and the claims are amended to recite that the electrodes may consist of an iridium catalyst. In the first Office action, the examiner determined that both amendments involve new matter and required their cancellation. In addition, the examiner rejected all the claims under 35 U.S.C. § 112, first paragraph on the ground that they recited elements without support in the original disclosure. Ultimately, the examiner issued a Final Rejection on the same basis. Based upon proper USPTO practice and procedure, which of the following is correct?

- (A) Review of the determination that both the first preliminary amendment and the second preliminary amendment contain new matter is by appeal.
- (B) Review of the determination that both the first preliminary amendment and the second preliminary amendment contain new matter is by petition.
- (C) Review of the determination that the first preliminary amendment contains new matter is by appeal, and review of the determination that the second preliminary amendment contains new matter is by petition.
- (D) Review of the determination that the first preliminary amendment contains new matter is by petition, and review of the determination that the second preliminary amendment contains new matter is by appeal.
- (E) (A), (B), (C), and (D).

8. Select from the following an answer which completes the following statement, such that the completed statement accords with proper USPTO practice and procedure: “When the reference in question is a noncommonly owned U.S. patent claiming the same invention as applicant, and its issue date is _____”

- (A) less than one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of requesting an interference.
- (B) exactly one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of requesting an interference.
- (C) more than one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of requesting an interference.
- (D) less than one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of affidavit or declaration “swearing back” of reference.
- (E) less than one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of affidavit or declaration traversing the ground of rejection.

9. Bill was working toward a Ph.D. in physics from a university in Japan. As part of his doctoral program, Bill prepared (in Japanese) a thesis directed to his work in the semiconductor field. Following approval of the thesis by his faculty advisor on December 21, 2000, the sole copy of Bill’s thesis was placed on the shelves of the university library on January 29, 2001, 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, 2001, 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) Bill’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 4, 2002.
- (B) Bill’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 19, 2002.
- (C) Bill’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 6, 2002.
- (D) Each of statements (B) and (C) is correct.
- (E) Because the thesis was written in Japanese, it cannot be a prior art printed publication against a United States application for patent.

10. Harriet filed a nonprovisional patent application in the USPTO containing a written assertion of small entity status. Based upon proper USPTO practice and procedure, which of the following statements is correct?

- (A) If Harriet files a related, continuing application wherein small entity status is appropriate and desired, it will not be necessary to specifically establish assertion of such status in the continuing application.
- (B) If Harriet files a related, reissue application wherein small entity status is appropriate and desired, it will be necessary to specifically establish assertion of such status in the reissue application.
- (C) If Harriet files a related, divisional application under 37 CFR 1.53, wherein small entity status is appropriate and desired, it will not be necessary to specifically establish assertion of such status in the divisional application.
- (D) If Harriet refiles her application as a continued prosecution application under 37 CFR 1.53(d), wherein small entity status is appropriate and desired, it will not be necessary to specifically establish assertion of such status in the continued prosecution application.
- (E) If Harriet subsequently assigns her rights to another party for whom small entity status is appropriate and desired, it will be necessary to specifically re-establish assertion of such status.

11. 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 range of patent protection?

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

12. Mike and Mary jointly invented a cornhusk peeler. Mary invented a wrap around handle for the peeler that keeps the hand protected. Mike invented the portion that engages the cornhusk and removes the cornhusk without damaging the kernels. An application is filed and eighteen months later the patent issues listing Mike and Mary as joint inventors with claims to a cornhusk peeler having the portions invented by both Mike and Mary. Mike and Mary have an argument and never speak or communicate in any way with each other again. Subsequently, Mary sells all of her ownership in the patent to Bird's Beak, who then records the assignment in the USPTO. Mike comes to you for advice as to what he can do. Which of the following is true?

- (A) Mike should file a reissue application in which he names only himself as inventor and claims only the cornhusk-removing portion. Mike can then sue Bird's Beak to prevent them from manufacturing a device with the cornhusk-removing portion.
- (B) Since Mary invented only the handle portion, she can assign only the rights in the invention concerning the handle. Consequently, Bird's Beak received only the right to manufacture the handles but not the cornhusk-removing portion.
- (C) Mike should attempt to void the assignment by Mary since the patent was jointly owned. It takes the consent of both parties to assign the rights in the invention.
- (D) Mike can file a reissue application, but only with the consent of Bird's Beak, because it takes both the remaining inventor (Mary) and the assignee (Bird's Beak) to consent to the filing of a reissue application.
- (E) Mike may void the assignment to Bird's Beak by filing a disclaimer signed only by Mike disclaiming all claims directed to the portion of the invention that Mary developed.

13. Which of the following statements about the disclosure of the utility of an invention is true in accordance with proper USPTO practice and procedure?

- (A) A claimed utility invention that is disclosed to be neither a machine, an article of manufacture, a composition, nor a process is patentable in accordance with the patent law.
- (B) In a patent application claiming a compound, a disclosure by the applicant that the compound may be useful in treating unspecified disorders would be sufficient to define a specific utility for the compound.
- (C) In a patent application claiming a compound, a disclosure by the applicant that the compound has "useful biological" properties, would be sufficient to define a specific utility for the compound.
- (D) In a patent application claiming a compound, a disclosure by the applicant that the compound has a specific biological activity and reasonably correlates that activity to a disease condition would be sufficient to define a specific utility for the compound.
- (E) If a claimed invention does not have utility, the specification nevertheless can enable one to use it.

The following facts apply to Questions 14 through 16.

Thomas filed a nonprovisional utility patent application in the USPTO on February 8, 2001. The application as filed included a specification and claims in compliance with 35 U.S.C. §112, three sheets of publication quality drawings, an abstract of the disclosure, and an application data sheet listing the name and address of the inventor. The application was initially filed without an executed inventor's oath or declaration and without the required filing fee. The Office issued a "Notice to File Missing Parts – Filing Date Granted" on April 2, 2001. The Notice informed Thomas that he must submit an executed oath or declaration by the inventor, pay the required filing fee, and pay a surcharge for late submission of these items within two (2) months of the date of the Notice. Thomas received the Notice on April 9, 2001.

Thomas was occupied with other matters and did not file a reply in full compliance with the Notice until September 3, 2001. A Petition for a three-month extension of time and all required fees accompanied the reply.

A first substantive Office action on the merits of the application issued January 21, 2002 and set a three-month shortened statutory time period for reply. All pending claims were rejected on the basis of prior art. Thomas filed a fully responsive Amendment on April 15, 2002, and a final Office action issued September 12, 2002 with a three-month shortened statutory period for reply. The final Office Action allowed certain claims and rejected other claims on substantially the same grounds set forth in the first Office action. Thomas filed a Notice of Appeal on October 21, 2002 and an Appeal Brief on April 18, 2003. A Petition for extension of time and proper authorization to charge a deposit account for any required fees accompanied the Appeal Brief.

An Examiner's Answer issued on May 2, 2003, and Thomas filed a Reply Brief on May 15, 2003. The Board of Patent Appeals and Interferences affirmed the Examiner's rejections on September 17, 2003. With regard to the allowed claims, a Notice of Allowance and Issue Fee Due was mailed October 3, 2003. Thomas paid the Issue Fee on October 20, 2003 and the patent issued March 23, 2004.

14. The Director of the U.S. Patent and Trademark Office determined that Thomas failed to engage in reasonable efforts to conclude prosecution of the application from January 21, 2003 to April 18, 2003. Which of the following statements is most true?

- (A) Thomas is entitled to no patent term adjustment because the Patent Term Guarantee Act of 1999 does not apply to Thomas' patent application.
- (B) Although the Patent Term Guarantee Act of 1999 applies to Thomas' application, Thomas forfeited any patent term adjustment by failing to engage in reasonable efforts to conclude prosecution of the application from January 21, 2003 to April 18, 2003.
- (C) Thomas is entitled to a patent term adjustment of approximately two (2) months because the application was pending for more than three (3) years.
- (D) By responding to the Notice to File Missing Parts approximately three (3) months after the deadline set by the USPTO, Thomas reduced any patent term adjustment by approximately three (3) months.
- (E) Statements (A), (B), (C) and (D) are each incorrect.

15. In the facts set forth in connection with the preceding question, what, if any, extension of time was required by Thomas for filing an Appeal Brief on April 18, 2003?

- (A) A two-month extension of time was required.
- (B) A three-month extension of time was required.
- (C) A four-month extension of time was required.
- (D) No extension of time was available and the Appeal Brief should have been rejected because it was filed more than six months after the final Office action issued.
- (E) No extension of time was available and the Appeal Brief should have been rejected because it was filed more than six months after the Notice of Appeal was filed.

16. In addition to the facts set forth in connection with the previous two questions, Thomas' application had not and would not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing. At the time he filed his application in the USPTO, Thomas submitted a nonpublication request and supporting materials that fully complied with all requirements for nonpublication of the application at 18 months. Which of the following statements is most correct?

- (A) Thomas may rescind his nonpublication request at any time.
- (B) By requesting nonpublication of the application, Thomas "opted out" of the statutory framework for patent term adjustment and, therefore, no patent term adjustment is available.
- (C) Submission of the nonpublication request does not affect any patent term adjustment that might be available to Thomas.
- (D) Statements (A) and (C) are true.
- (E) Statements (B) and (C) are true.

17. There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." Which of the following are among the factors for determining whether necessary experimentation is "undue"?

- (A) The breadth of the claims.
- (B) The nature of the invention.
- (C) The state of the prior art.
- (D) The level of one of ordinary skill.
- (E) (A), (B), (C) and (D).

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

19. In accordance with proper USPTO practice and procedure, which of the following statements is true?

- (A) Where sole patent applicant Able claims his invention in a Jepson-type claim, and the specification discloses that the subject matter of the preamble was invented by Baker before applicant's invention, the preamble is properly treated as prior art.
- (B) Where the sole patent applicant Able claims his invention in a Jepson-type claim, and the specification makes it clear that the claimed invention is an improvement on Able's own prior invention, which Able discovered less than one year before the filing date of the application, the preamble in the claim is properly treated as prior art.
- (C) Where the sole patent applicant Able claims his invention in a Jepson-type claim, and the specification makes it clear that the claimed invention is an improvement on an invention that Able discovered and publicly used and commercially sold by Able in Texas for several years before the filing date of the application, the preamble in the claim cannot properly be treated as prior art.
- (D) Where the sole applicant, Baker, states that something is prior art, the statement can be taken as being admitted prior art only if corroborated by objective evidence proffered by Baker, or found by the examiner.
- (E) No claim, including a Jepson-type claim, carries with it an implied admission that the elements in the preamble are old in the art.

20. Which of the following is true?

- (A) In rejecting claims the examiner may rely upon facts within his own personal knowledge, unless the examiner qualifies as an expert within the art, in which case he is precluded from doing so, since only evidence of one of ordinary skill in the art is permitted.
- (B) If an applicant desires to claim subject matter in a reissue which was the same subject matter waived in the statutory invention registration of another, the applicant is precluded by the waiver from doing so, even though the applicant was not named in the statutory invention registration.
- (C) If an applicant, knowing that the subject matter claimed in his patent application was on sale in Michigan and sales activity is a statutory bar under 35 U.S.C. § 102(b) to the claims in his application, nevertheless withholds the information from the patent examiner examining the application, and obtains a patent including the claims in question, the applicant may remove any issue of inequitable conduct by filing a request for reexamination based on the sales activity.
- (D) An applicant for a patent may overcome a statutory bar under 35 U.S.C. §102(b) based on a patent claiming the same invention by acquiring the rights to the patent pursuant to an assignment and then asserting the assignee's right to determine priority of invention pursuant to 37 CFR 1.602.
- (E) None of the above.

21. An application, filed September 20, 2001, has not yet been examined. All claims in the application are drawn to a single invention. Which of the following, submitted (independently of each other) by a registered practitioner of record with an otherwise proper petition to make the application special, properly results in the application being advanced out of turn for examination?

- (A) A statement under 37 CFR 1.102 explaining how the invention contributes to the restoration of the basic life-sustaining elements to enhance the quality of the environment, without the petition fee set forth in 37 CFR 1.17(h).
- (B) A search made by a foreign patent office, one copy each of the references deemed most closely related to the subject matter encompassed by the claims, a detailed discussion of the references that points out with the particularity required by 37 CFR 1.111(b) and (c) how the claimed subject matter is patentable over the references, and the petition fee set forth in 37 CFR 1.17(h).
- (C) A doctor's certificate demonstrating that the applicant's health is such that he might not be available to assist in the prosecution of the application if it were to run its normal course, without the petition fee set forth in 37 CFR 1.17(h).
- (D) A birth certificate showing that applicant is 65 years of age, without the petition fee set forth in 37 CFR 1.17(h).
- (E) All of the above.

22. To satisfy the written description requirement of the first paragraph of 35 U.S.C. § 112, an applicant must show possession of the invention. An applicant's lack of possession of the invention may be evidenced by:

- (A) Original claims which recite an essential feature where the feature is not described in the specification or the claims, and is not conventional in the art or known to one of ordinary skill in the art.
- (B) A specification of a patent application that describes the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.
- (C) A specification of a patent application that describes an actual reduction to practice of the claimed invention.
- (D) An amendment to a claim seeking to add a limitation that is supported in the specification through implicit or inherent disclosure.
- (E) An amendment to a claim seeking to correct an obvious error by the appropriate correction.

23. Greene is a registered patent agent employed by an intellectual property law firm located in Arlington, Virginia. Greene is awakened at 5:30 AM one morning by a frantic call from Whyte, a senior partner at the law firm. Whyte informs Greene that Whyte has an examiner interview scheduled for 3:00 PM that day in connection with an important patent application Whyte is handling. However, a family emergency arose during the night and Whyte 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. Whyte requests that Greene conduct the examiner interview for Whyte and, based on the outcome of the interview, file appropriate papers with the Patent Office. Whyte tells Greene exactly where Greene can locate the file in Whyte's office. Greene has not been given a power of attorney in the application, but has been given a power to inspect the Patent Office file for the application. Assuming Greene has adequate time to prepare for the interview and will competently represent the applicant, which of the following statements is true?

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

24. Pete wants to file a protest against a patent application filed by a coworker. In the locker room at his place of employment, Pete overheard Sol talking about an application for a golf ball retriever. Pete feels that the invention strongly resembles a golf ball retriever device published in a 1995 edition of Popular Golf magazine. Pete comes to you to file a protest. Pete wants to know if it will be considered by the examiner, and if the applicant (Sol) is required to respond. Pete believes he heard Sol say the application was filed in May 2001, and wonders whether he should include evidence of fraud since Pete believes that his (Pete's) wife may have shown Sol the Popular Golf article. Which of the following is not accurate with respect to proper USPTO procedure in relation to applications filed on or after January 1, 2001?

- (A) Pete's protest against Sol's pending application will be referred to the examiner having charge of the subject matter involved provided Pete can adequately identify the application. Protests that do not adequately identify a pending patent application will be returned to the protestor and will not be further considered by the Office.
- (B) Pete's protest, provided it adequately identifies Sol's application, will be entered in the application file if: (1) the protest is submitted prior to the date the application was published or the mailing of a notice of allowance under § 1.311, whichever occurs first; and (2) the protest is either served upon Sol in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible.
- (C) If Pete submits evidence that his wife gave Sol a copy of the Popular Golf article and contends that Sol fraudulently copied the device from that disclosed in the article, the examiner will generally not comment on the issues related to fraud.
- (D) Pete's protest, provided it adequately identifies Sol's application and is submitted prior to the date the application was published or the mailing of a notice of allowance under § 1.311, and which is either served upon Sol in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible, will be considered by the Office if the application is still pending when the protest and application file are brought before the examiner, and the protest includes: (1) a listing of the patents, publications, or other information relied upon; (2) a concise explanation of the relevance of each listed item; (3) a copy of each listed patent or publication or other item of information in written form or at least the pertinent portions thereof; and (4) an English language translation of all the necessary and pertinent parts of any non-English language patent, publication, or other item of information in written form relied upon.
- (E) If Pete files the protest before the final office action, Sol has a duty to respond to the issues raised by Pete's protest even in the absence of a request by the USPTO for comments. If such issues are not addressed, the issues will be deemed admitted.

25. In accordance with USPTO rules and procedure, in which of the following situations may an applicant file a request on or after August 16, 2000 for continued examination of a non-provisional utility patent application with an earliest effective filing date of March 15, 1999?

- (A) The last Office action is a notice of allowance, the issue fee has been paid, and no petition to withdraw the application from issue has been granted.
- (B) The last Office action is a final action and the application is abandoned.
- (C) The last Office action is a non-final Office action containing a rejection of all claims under 35 U.S.C. § 102(b), and the applicant has filed no reply.
- (D) The last Office action is a notice of allowance, and after four months from the date of the notice of allowance, the issue fee has not been paid.
- (E) None of the above.

26. In a non-provisional utility patent application filed January 12, 1999, the examiner sends Applicant a final Office action dated February 14, 2001, rejecting claim 1 under 35 U.S.C. § 102(a), and objecting as to the form of claims 2 through 10. The examiner sets a three-month shortened statutory period for reply. According to USPTO rules and procedure, which of the following by Applicant ensures that the application does not go abandoned on Wednesday, August 15, 2001?

- (A) Mailing to the USPTO, using a certificate of mailing under 37 CFR 1.8, dated August 14, 2001, a petition and fee for an extension of three months, a request for a continued prosecution application, and the fee for a request for a continued prosecution application. The foregoing is received by the USPTO on August 17, 2001.
- (B) Mailing to the USPTO, using a certificate of mailing under 37 CFR 1.8, dated August 14, 2001, a petition and fee for an extension of three months, a request for continued examination with a submission that meets the reply requirements of 37 CFR 1.111, and the fee for a request for continued examination. The foregoing is received by the USPTO on August 17, 2001.
- (C) Mailing to the USPTO, using a certificate of mailing under 37 CFR 1.8, dated August 14, 2001, a petition and fee for an extension of three months. The foregoing is received by the USPTO on August 17, 2001. Also, telephoning the examiner on August 14, 2001 to discuss the rejections of claims in the final Office action, but without reaching an agreement with the examiner.
- (D) Mailing to the USPTO a petition and fee for an extension of three months, a request for continued examination with a reply that states, "Applicant requests that objections as to form be held in abeyance until allowable subject matter is indicated, at which time Applicant will reply to the rejection of claim 1," and the fee for a request for continued examination. The foregoing is received by the USPTO on August 14, 2001.
- (E) Each of items (A), (B), (C) and (D) would ensure that the application does not go abandoned on Wednesday, August 15, 2001.

27. Mary, a legally competent adult inventor, filed provisional application A on January 3, 2000, a nonprovisional application B one year later on January 3, 2001, and nonprovisional application C on February 28, 2001. Nonprovisional application B was abandoned when nonprovisional application C was filed. The provisional application and both nonprovisional patent applications were in Mary's name only, but a declaration has not yet been filed. Mary is living on a remote island in the middle of the Arctic Ocean where the only communication is in the summer months. Sam, the father of Mary, has been authorized by Mary to sign Mary's name to the § 1.63 declaration and also Sam's name. Sam, unbeknownst to Mary, also wants access to all three application files at the USPTO before he files the declaration to make certain Mary has properly described her invention. Sam acknowledges he is not an inventor but insists he must sign as an inventor so that he may act on behalf of Mary. Which of the following is not in accordance with proper USPTO procedure in relation to applications filed on or after January 1, 2001?

- (A) Sam may not add his name as an inventor since a patent is applied for only in the name or names of the actual inventor or inventors.
- (B) Since no declaration was filed during the pendency of application B, Sam may not see the Application papers for application B since he has not been authorized by Mary to see the application A and Sam is not an inventor.
- (C) Sam is not entitled to access to the provisional application A since he has not been authorized by Mary to see the application A and Sam is not an inventor.
- (D) Sam is precluded from access to the Application B since his name does not appear on the application papers and Sam is not an inventor.
- (E) Sam may sign Mary's name to the declaration since he was authorized by Mary to do so.

28. In which of the following instances is the reference properly available as prior art under 35 U.S.C § 102(d)?

- (A) A U.S. patent application is filed within the one year anniversary date of the filing date of the foreign application. The reference is the foreign application.
- (B) The applicant files a foreign application, later timely files a U.S. application claiming priority based on the foreign application, and then files a continuation - in - part (CIP) application, and the claims in the CIP are not entitled to the filing date of the U.S. parent application. The foreign application issues as a patent before the filing date of the CIP application and is used to reject the claims directed to the added subject matter under 35 U.S.C. §§ 102(d)/103. The reference is the foreign application.
- (C) The applicant files a foreign application, and later timely files a U.S. application claiming priority based on the foreign application. The examined foreign application has been allowed by the examiner and has not been published before the U.S. application was filed. The reference is the foreign application.
- (D) The reference is a defensive publication.
- (E) All of the above.

29. Which of the following is in accordance with proper USPTO practice and procedure?
- (A) A Certificate of Mailing or Transmission under 37 CFR 1.8 is proper for filing a Continued Prosecution Application under 37 CFR 1.53(d) to obtain the date of the Certificate as the filing date for the application.
 - (B) The fee an applicant must pay to request continued examination of an application is set in an amount equal to the basic filing fee the same applicant must pay for a utility patent application.
 - (C) The Office does not charge a fee for processing a fee paid by a check that has been refused, *i.e.*, dishonored and returned, by a financial institution.
 - (D) To first request conversion of a provisional application containing a claim to a nonprovisional application after the provisional application has become abandoned, a petition to revive, accompanied by the appropriate fees, a showing of unavoidable delay, and a request for the conversion must be filed within one year of the date of abandonment.
 - (E) The conversion of a provisional application, for which a basic filing fee was properly paid, to a nonprovisional application will result in the savings of filing and other fees over the filing of a nonprovisional application claiming the benefit under 35 U.S.C. § 119(e) and 37 CFR 1.78 of the earlier provisional filing date.

30. You file a nonprovisional patent application in the USPTO on December 27, 1999, on behalf of your client. On the basis of information provided to you, you assert entitlement to small entity status and pay the small entity status basic filing fee of \$345. On December 27, 2000, a first Office action is mailed. You file a reply to the Office action on February 2, 2001, accompanied by an Information Disclosure Statement (IDS) and the required fee of \$240 for filing the IDS at such time. You now learn that the small entity status was erroneous at the time it was established, although it was established in good faith, and the deficiency resulting from the previous erroneous payment must be paid and can be calculated from the following table:

	<u>Other than Small Entity</u>	<u>Small Entity</u>
Basic Fee at time of payment	\$690.00	\$345.00
IDS Fee at time of payment	\$240.00	\$240.00
Current Basic Fee	\$710.00	\$355.00
Current IDS Fee	\$180.00	\$180.00

In accordance with USPTO proper practice and procedure, which of the following is the proper deficiency amount?

- (A) \$365.00
- (B) \$355.00
- (C) \$305.00
- (D) \$295.00
- (E) \$335.00

31. Zak had expended a considerable amount of money, time, and effort in the pursuit of patent protection for an invention that he had conceived of many years before. His sacrifices had been large and his frustration and disappointment could be observed in the expression on his face when his attorney informed him that the Board of Patent Appeals and Interferences (“BPAI”) issued a decision on February 19, 2001, affirming the examiner’s rejection of all the claims in his application. Zak didn’t even think twice when he directed his attorney to immediately file a Request for Rehearing or Reconsideration. Assuming action on the Request for Rehearing or Reconsideration is unfavorable to Zak, which of the following options is available to Zak?

- (A) File a Notice of Appeal to the Court of Appeals of the Federal Circuit (“CAFC”) within 6 months of the BPAI decision, accompanied by a request for extension of time under 37 CFR 1.136 and the appropriate fee.
- (B) File a Notice of Appeal to the U.S. District Court of the District of Columbia (“DDC”) within 5 months of the BPAI decision, accompanied by a request for extension of time under 37 CFR 1.136 and the appropriate fee.
- (C) File a Notice of Appeal to the Court of Appeals of the Federal Circuit (“CAFC”) within 6 months after action on the Request for Rehearing or Reconsideration, accompanied by a request for extension of time under 37 CFR 1.136 and the appropriate fee.
- (D) File a Notice of Appeal to the U.S. District Court of the District of Columbia (“DDC”) within 5 months after action on the Request for Rehearing or Reconsideration, accompanied by a request for extension of time under 37 CFR 1.136 and the appropriate fee.
- (E) File a Notice of Appeal to the U.S. District Court of the District of Columbia (“DDC”) within 2 months after action on the Request for Rehearing or Reconsideration.

32. Which of the following is true?

- (A) Once the issue fee has become due, provided an original application has not been pending more than three years, the applicant may request and the Office may grant a request for deferral of payment of the issue fee.
- (B) The time period set for the payment of the issue fee is statutory and cannot be extended. However, if payment is not timely made and the delay in making the payment is shown to be unavoidable, upon payment of a fee for delayed payment, it may be accepted as though no abandonment had occurred, but there will be a reduction on the patent term adjustment for the period of abandonment.
- (C) Upon written request, a person citing patents and printed publications to the Office that the person believes has a bearing on the patentability of a particular patent, may request that his or her name remain confidential.
- (D) To obtain benefit of priority based on an earlier filed patent application, an applicant in a later filed continuation application is not required to claim priority under 35 U.S.C. § 120 to an earlier filed application.
- (E) Each of statements (B) and (C) is true.

The following facts pertain to questions 33 and 34.

Applicant Sonny filed a patent application having an effective U.S. filing date of February 15, 2000. The application fully discloses and claims the following:

- Claim 1. An apparatus for converting solar energy into electrical energy comprising:
- (i) a metallic parabolic reflector;
 - (ii) a steam engine having a boiler located at the focal point of the metallic parabolic reflector; and
 - (iii) an electrical generator coupled to the steam engine.

In a non-final Office action dated March 15, 2001, the examiner rejects claim 1 under 35 U.S.C. § 102(d) as anticipated by a patent granted in a foreign country to Applicant Sonny (“Foreign patent”). The Foreign patent was filed February 1, 1999, and was patented and published on January 17, 2000. The examiner’s rejection points out that the invention disclosed in the Foreign patent is a glass lens with a steam engine having a boiler at the focal point of the glass lens, and an electrical generator coupled to the steam engine. The rejection states that the examiner takes official notice that it was well known by those of ordinary skill in the art of solar energy devices, prior to Applicant Sonny’s invention, to use either a lens or a parabolic reflector to focus solar rays.

33. Sonny informs you that you should not narrow the scope of the claims unless absolutely necessary to overcome the rejection. Which of the following, in reply to the Office action dated March 15, 2001, is best?

- (A) Traverse the rejection arguing that the examiner’s use of the Foreign patent is improper because an applicant cannot be barred by a foreign patent issued to the same applicant.
- (B) Amend claim 1 to further include a feature that is disclosed only in the U.S. application, and point out that the newly added feature distinguishes Sonny’s invention over the invention in the Foreign patent.
- (C) Traverse the rejection arguing that the examiner does not create a *prima facie* case of obviousness because the examiner does not show why one of ordinary skill in the art of solar energy devices would be motivated to modify the Foreign patent.
- (D) Traverse the rejection arguing that the examiner’s rejection under 35 U.S.C. § 102(d) was improper because claim 1 is not anticipated by the Foreign patent.
- (E) Traverse the rejection arguing that it was not well known to use either a lens or a parabolic reflector to focus solar rays, and submit an affidavit under 37 CFR 1.132.

34. Which of the following claims, if fully disclosed and presented in Sonny's U.S. application, provides a proper basis for an objection under 37 CFR 1.75(c)?

- (A) Claim 2. An apparatus as in claim 1, further comprising a voltage regulator coupled to the electrical generator.
- (B) Claim 2. An apparatus as in claim 1, wherein the metallic parabolic reflector is aluminum.
- (C) Claim 2. An apparatus as in claim 1, wherein the steam engine has two cylinders.
- (D) Claim 2. An apparatus as in claim 1, wherein the parabolic reflector is either metallic or plastic.
- (E) Claim 2. An apparatus as in claim 1, further comprising an electronic pressure sensor coupled to the steam engine.

35. Tony, a client, comes to you with regard to a competitor's two published patent applications, A and B, which were published one month ago. Tony shows you several material prior art publications and patents that he discovered for the first time while cleaning out his brother-in-law's attic last week. Assume no Notice of Allowance has been mailed in application A and a Notice of Allowance has been mailed in application B. Tony wants to know if it is too late to submit the information to the USPTO for consideration by the examiner. He also wants to know how it is accomplished, if the applicant needs to be served a copy, whether a fee is required and whether an explanation is needed for each reference. Which of the following is not accurate with respect to proper USPTO procedure?

- (A) The submission by Tony of patents or publications relevant to pending published application A will be permitted without the necessity of paying the processing or petition fee required by 37 CFR 1.17(i) if the patents or publications are submitted within two months of the publication of the competitor's application.
- (B) Each submission must identify the application to which it is directed by application number and include: (1) the appropriate fee set forth in 37 CFR 1.17(p); (2) a list of the patents or publications submitted for consideration by the Office, including the date of publication of each patent or publication; (3) a copy of each listed patent or publication in written form or at least the pertinent portions; and (4) an English language translation of all the necessary and pertinent parts of any non-English language patent or publication in written form relied upon.
- (C) The submissions by Tony of patents or publications relevant to both of the pending published applications A and B need not be served upon the applicant.
- (D) The submissions by Tony of patents or publications relevant to the pending published applications A and B shall not include any explanation of the patents or publications, or any other information.
- (E) The submission by Tony of patents or publications relevant to pending published application B will be permitted only if accompanied by the processing fee as set forth in 37 CFR 1.17(i).

36. Upon examination of your client's patent application, the patent examiner is considering whether and what rejections to apply to the claims. One or more of the limitations in the claims is indefinite or lacks supporting disclosure. The examiner may not properly take which of the following actions or inactions?

- (A) If the claim is subject to plural interpretations due to a limitation being indefinite, the examiner may disregard any possibility of multiple interpretations.
- (B) If a claim is subject to more than one interpretation due to a limitation being indefinite, at least one of which would render the claim unpatentable over the prior art, the examiner should reject the claim as indefinite under 35 U.S.C. § 112, second paragraph, and should reject the claim over the prior art based on the interpretation of the claim that renders the prior art applicable.
- (C) If no reasonably definite meaning can be ascribed to certain claim language, the examiner should reject the claim as indefinite under 35 U.S.C. § 112, second paragraph, and not reject the claim as obvious.
- (D) When evaluating claims for obviousness under 35 U.S.C. § 103, all the limitations of the claims, including new matter lacking supporting disclosure in the originally filed specification, must be considered and given weight.
- (E) (C) and (D).

37. Which of the following is true?

- (A) A claim to a process omitting a step in a disclosed 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 only for the process which includes the essential step.
- (B) 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.
- (C) 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.
- (D) Where 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) The best mode requirement is the same as the enablement requirement of the first paragraph of 35 U.S.C. § 112.

38. Your clients, Able and Baker, filed a patent application. In accordance with proper USPTO practice and procedure, in which of the following instances, absent additional facts, is the reference or event either prior art or an act that may not be properly applied to reject claims in your client's application?

- (A) The patent application was filed on Tuesday, June 26, 2001 in the USPTO. The reference is an article in a trade magazine published on November 10, 2000. Able, Baker and McGeiver are the authors of the article. The article fully discloses the claimed invention and how to make and use it.
- (B) The patent application was filed on Monday, June 25, 2001 in the USPTO. Able and Baker placed the invention on sale in the United States on Monday, June 26, 2000. The public came into possession and understands the invention the day it is placed on sale. Your clients have disclosed this information when they filed the application.
- (C) The patent application was filed on Monday, June 25, 2001, in the USPTO. McGeiver, a friend of Baker, publicly used the invention in Hawaii on April 15, 2000. The public use was not experimental and was without Baker's knowledge or consent. The public came into possession of the invention the day it was used by McGeiver.
- (D) The patent application was filed on Monday, June 25, 2001, in the USPTO. The invention became known to the public in the United States in April 2000 as a result of disclosure on the Internet by Wilson, a party unknown to Able and Baker. The invention was not placed on sale or in public use prior to the filing date of the application.
- (E) More than one year prior to the filing in the USPTO of a patent application on Monday, June 25, 2001, in the USPTO, the invention, a machine, was used secretly by John, another inventor, to make a product. The details of the invention are ascertainable by inspection or analysis of the product made by John that was sold and publicly displayed.

39. A grant of small entity status entitles an applicant to which of the following?

- (A) Applicant will receive an accelerated examination by having the application advanced out of order.
- (B) Applicant can use a certificate of mailing under 37 CFR 1.8 to obtain a U.S. filing date that is earlier than the actual USPTO receipt date of the application.
- (C) Applicant will obtain a refund of all fees paid to the USPTO where applicant demonstrates: (i) a changed purpose for which the fees were paid, (ii) the fees were not paid by mistake, and (iii) the fees were not paid in excess of the amount required.
- (D) Applicant can pay a fee to file a request for continued examination pursuant to 37 CFR 1.114 that is less than the fee paid by other than a small entity.
- (E) None of the above.

40. Which of the following is not in accordance with proper USPTO practice and procedure?
- (A) Conversion of a provisional application to a nonprovisional application will result in the term of any patent to issue from the application being measured from at least the filing date of the provisional application.
 - (B) Conversion of a provisional application to a nonprovisional application cannot adversely impact on the term of any patent to issue from the application.
 - (C) An applicant having filed a provisional application can avoid any adverse patent term impact resulting from converting the provisional application to a nonprovisional application by instead filing a nonprovisional application claiming the benefit of the provisional application under 35 U.S.C. § 119(e).
 - (D) An applicant filing nonprovisional application claiming the benefit under 35 U.S.C. § 119(e) and 37 CFR 1.78 of the earlier provisional application, and not requesting conversion of the provisional to the nonprovisional application can avoid the fee required to convert a provisional application to a nonprovisional application, as well as any adverse patent term effect that would result from a conversion.
 - (E) The twelve month period of pendency of a provisional application extends to the next secular or business day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia if the day that is twelve months after the filing date of the provisional application under 35 U.S.C. § 111(b) and 37 CFR 1.53(c) falls on a Saturday, Sunday, or a Federal holiday in the District of Columbia.

41. Mark Twine obtains a patent directed to a machine for manufacturing string. The patent contains a single claim (Claim 1) which recites six claim elements. The entire interest in Twine's patent is assigned to the S. Clemens String Co., and Twine is available and willing to cooperate with S. Clemens String Co. to file a reissue application. A subsequent reissue application includes Claim 2, which is similar to original Claim 1. However, one of the elements recited in Claim 2 is broader than its counterpart element in the original claim. The remaining five elements are narrower than their respective counterpart elements in the original patent claim. Which of the following scenarios accords with USPTO proper practice and procedure?

- (A) The S. Clemens String Co. files the reissue application more than 2 years after the issue date of the original patent application.
- (B) The S. Clemens String Co. files the reissue application less than 2 years after the issue date of the original patent but more than 2 years after original application filing date.
- (C) Mark Twine files the reissue application less than 2 years after the issue date of the original patent but more than 2 years after original application filing date.
- (D) Mark Twine files the reissue application more than 2 years after the issue date of the original patent.
- (E) Mark Twine and the S. Clemens String Co. jointly file the reissue application more than 2 years after the issue date of the original patent.

42. A maintenance fee in the correct amount is received by the USPTO in September 2001, prior to the due date. The maintenance fee payment includes identification of a U.S. patent number. In accordance with proper USPTO rules and procedure, in which of the following situations may the USPTO return the maintenance fee payment?

- (A) The maintenance fee payment is submitted by the patentee's grandmother, without authorization by the patentee, and includes identification of the U.S. application number for the patent.
- (B) The maintenance fee payment is submitted by the attorney of record in the application, without authorization by the patentee, and includes identification of the U.S. application number for the patent.
- (C) The maintenance fee payment is submitted by the attorney of record in the application, with authorization by the patentee, and does not include identification of the U.S. application number for the patent.
- (D) (A) and (B).
- (E) None of the above.

43. A claim in your client's patent application has been rejected as being anticipated by a prior art reference. In which of the following instances is the claim not necessarily anticipated?

- (A) The prior art is a U.S. patent issued five years before the effective date of your client's application. In your client's application, the claim is a generic claim. The prior art clearly discloses a species falling within the claimed genus in your client's application.
- (B) The prior art is a U.S. patent issued two years before the effective date of your client's application. In your client's application, claim 4 is directed to a species. The prior art discloses forty-six species. The species claimed in claim 4 is clearly disclosed by name in the prior art. The remaining forty-five species disclosed in the prior art do not anticipate or render obvious any subject matter claimed in your client's application.
- (C) The prior art is a U.S. patent issued two years before the effective date of your client's application. In your client's application, claim 1 is directed to "composition comprising copper oxygen, and 10 to 20 mg of sulfur." The prior art discloses a composition "comprising copper, oxygen and 15 mg. of sulfur."
- (D) The prior art is a U.S. patent issued two years before the effective date of your client's application. Claim 1 in your client's application is drawn to a composition of gases, and contains a narrow range of the amount of oxygen. The prior art discloses composition of the same gases, and a broad range of the amount of oxygen that is inclusive of the claimed narrow range, but does not disclose specific examples falling within the claimed narrow range. Your client not only discloses a different utility for the claimed invention, but also unexpected results achieved within the narrow range.
- (E) (A), (B), (C) and (D).

44. A condition for patentability is that an inventor is entitled to a patent unless he has abandoned the invention. Your client has engaged in conduct or omissions that may or may not be construed as abandonment of her invention. In which of the following situations would it be proper for a patent examiner to conclude, in an *ex parte* proceeding, that an inventor has abandoned the invention?

- (A) From the inventor's inaction, following conception, to do anything over a period of time to develop or patent his or her invention, the inventor's ridicule of another person's attempts to develop that invention, and the inventor's active show of interest in promoting and developing the invention only after successful marketing by another of a device embodying that invention.
- (B) When acts of another can be imputed to the inventor as an intent to abandon the invention.
- (C) From the inventor's delay alone in filing a first patent application for the invention.
- (D) From an inventor's delay in reapplying for patent after abandonment of a previous patent application.
- (E) From the inventor's act of disclosing but not claiming the subject matter in a previously issued patent, even though the inventor claims the subject matter in another patent application that is filed within one year after the patent issued.

45. 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 also should be corrected. Assuming that you make a small 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.

46. According to USPTO rules and procedure, which of the following can be overcome by an affidavit under 37 CFR 1.131?

- (A) A rejection properly based on statutory double patenting.
- (B) A rejection properly made under 35 U.S.C. § 102(d) based on a foreign patent granted in a non-WTO country.
- (C) A rejection properly made under 35 U.S.C. § 102(a) based on a journal article dated one month prior to the effective filing date of the U.S. patent application. Applicant has clearly admitted on the record during the prosecution of the application that subject matter in the journal article relied on by the examiner is prior art.
- (D) A rejection properly made under 35 U.S.C. § 102(b) based on a U.S. patent that issued 18 months before the effective filing date of the application. The patent discloses, but does not claim, the invention.
- (E) None of the above.

47. Claims in your client's patent application have been rejected as unpatentable over prior art. In accordance with proper USPTO practice and procedure, which, if any, of the following statements is true?

- (A) The prior art is a U.S. patent issued five years before the effective date of your client's application. The claims are properly rejected under 35 U.S.C. § 102(b) of the disclosure in the patent that anticipates the claimed invention. Evidence of secondary considerations, such as unexpected results or commercial success, is relevant to the rejection and thus can overcome the rejection.
- (B) The prior art is a U.S. patent issued five years before the effective date of your client's application. The claims are properly rejected under 35 U.S.C. § 102(b) over the disclosure in the patent that anticipates the claimed invention. The rejection can be overcome by arguing that the alleged anticipatory prior art is "nonanalogous art."
- (C) The prior art is a U.S. patent issued five years before the effective date of your client's application. The claims are properly rejected under 35 U.S.C. § 102(b) over the disclosure in the patent that anticipates the claimed invention. The rejection can be overcome by arguing that the alleged anticipatory prior art teaches away from the invention.
- (D) The prior art is a U.S. patent issued five years before the effective date of your client's application. The claims are properly rejected under 35 U.S.C. § 102(b) over the disclosure in the patent that anticipates the claimed invention. The rejection can be overcome by arguing that the alleged anticipatory prior art is not recognized as solving the problem solved by the claimed invention.
- (E) None of the above.

48. Your longstanding client, Acme Chemical, comes to you for advice concerning a competitor's patent that Acme fears might cover Acme's key commercial product. Acme informs you that it began selling its product approximately eleven months before the competitor filed its patent application, and that a complete description of the product and how to make it was published in a trade magazine approximately ten months before the competitor's December 8, 1999 application filing date. Acme asks you to recommend options short of litigation that might be available to challenge validity of the patent. Acme also asks that in making your recommendation you take into account that Acme will not challenge the patent's validity unless it can be actively involved in all phases of the proceeding, even if that involvement will increase Acme's costs. Which of the following is the most reasonable advice to Acme?

- (A) You suggest that Acme request *ex parte* reexamination on the basis of the trade magazine publication and that Acme file a reply to any statement by the patent owner concerning any new question of patentability.
- (B) You suggest that Acme request *ex parte* reexamination on the basis of Acme's prior sales and the trade magazine publication.
- (C) You suggest that Acme request *inter partes* reexamination on the basis of the trade magazine publication only.
- (D) You suggest that Acme request *inter partes* reexamination on the basis of Acme's prior sales and the trade magazine publication.
- (E) You suggest that Acme inform the competitor in writing of the prior sales and trade magazine publication to force the competitor to inform the USPTO of this information and to force the competitor to initiate a reexamination of its own patent.

49. Which of the following statements accords with proper USPTO practice and procedure?

- (A) If a design patent was granted 3 years and 9 months ago, a maintenance fee paid today must include a surcharge because the payment is being made during the grace period.
- (B) If a design patent was granted 3 years and 9 months ago, and payment of the maintenance fee and surcharge is not paid through the day of the 4th anniversary of the grant for the first maintenance fee, the patent will expire.
- (C) If a plant patent was granted 7 years and 3 months ago, a maintenance fee must be paid, but a surcharge is not required, because the payment is not being made during the grace period.
- (D) If a utility patent was granted 7 years and 9 months ago, the first maintenance fee was timely paid, and the 8th anniversary of the patent grant falls on a Saturday, then the 2nd maintenance fee may be paid without surcharge on the next succeeding day which is not a Sunday or Federal holiday.
- (E) If a reissue application issues as a reissue patent exactly two years after the grant of the original patent, the maintenance fee for the 4th anniversary of the patent grant must be paid within eighteen months of the reissuance of the patent to avoid a surcharge.

50. On February 15, 2000, Debbie conceived a new, useful and nonobvious improvement in saddles for horses. Debbie spent the next four months working regularly on the idea and she built a prototype that implemented the concept on June 17, 2000. The prototype worked perfectly for its intended purpose. The next day, Debbie visited a patent attorney, Ginny, and asked her to prepare a patent application on Debbie's behalf. Ginny explained that her workload would prevent her from working on the application for at least four months. Ginny therefore declined representation of Debbie and gave her the names of a number of other qualified patent practitioners. Debbie, however, did not contact any of the individuals recommended by Ginny. Debbie visited Ginny again on December 1, 2000. At that time Ginny agreed to represent Debbie. A patent application was filed in the Patent Office on December 11, 2000.

On May 15, 2000, Billie conceived an idea substantively identical to Debbie's. Billie immediately prepared a detailed technical description including drawings and visited a patent attorney. Billie filed a patent application on June 14, 2000. Later, on July 9, 2000, Billie built a prototype that implemented the concept and had fully and successfully tested it by August 11, 2000.

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

- (A) Debbie will be awarded priority only if she can establish diligence for the entire time between May 14, 2000 and her actual reduction to practice in June 2000, and can establish that she did not suppress, abandon or conceal the invention.
- (B) Debbie will be awarded priority only if she can establish diligence for the entire time between her conception in February 2000 and actual reduction to practice in June 2000, and can establish that she did not suppress, abandon or conceal the invention.
- (C) Debbie will be awarded priority if she can establish diligence for the entire time between May 14, 2000 and her patent filing in December 2000, and can establish that she did not suppress, abandon or conceal the invention.
- (D) To encourage prompt disclosure of inventions to the public, priority is always awarded to the first to file an application, in this case Billie.
- (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.

THIS PAGE INTENTIONALLY LEFT BLANK

THIS PAGE INTENTIONALLY LEFT BLANK

THIS PAGE INTENTIONALLY LEFT BLANK