

PLI Analysis of April 17, 2002 PTO Attorney/Agent Exam

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General Comments: The morning was harder than the afternoon by a reasonable margin. Oddly only 5-6 word-for-word repeats, along with all the usual topical repeats. Only two PCTs and strangely three 37 CFR 48(f) questions. In terms of dead bang appealable I find only one: AM 11. It is a mess, predictably so, since it had to do with amended 102(e). Questionable for appeal, look at AM 12 and PM 13. This number (3) plus the PTO gifts (2) add up to the usual number of questions out of the 100 that do not make the final cut. There are doubtless many issues in many other questions that can create dubious interpretations and miss-understandings sufficient to base an appeal. Just do not go overboard!

This analysis is to be read in conjunction with the Official PTO model answers for this exam.

Morning Section:

1. Means-plus-function “112 6th para.” Guidelines answer right from the back of MPEP 2100. Use the magic word “means” and qualify it with function. C is the only one that meets the guidelines.
2. An IDS question. Timing, timing, timing. The issue fee has not been paid, so submit the information along with a fee and a statement that it hadn’t been cited more than 3 months prior. A is wrong because there is nothing to withdraw since the issue fee hasn’t been paid and, besides, it would delay everything. B is unacceptable because of the lack of knowledge about which “foreign patent office” is being referred to in the answer. C is okay, although the 30 day limit tried to lead you astray because it relates to PTA and not whether the IDS will be considered. D is wrong because it is the first foreign patent office mailing date that matters, not the second.
3. Ah, PCT. As predictable as ever. Belle wants all the advantages she can have: earlier effective filing date, early priority, plus the international preliminary examination report. She wants it all! Okay. In A she doesn’t put off the US national stage and begins before the Preliminary exam report. So A fails because it doesn’t meet one of Belle’s requirements. B is wrong because the application is no longer entering the US national phase, but is now a regular US national application with restriction, etc, and no exam report. C is so, so, so wrong. A provisional in the midst of all this chicanery? I think not! So, by elimination, D

- is it. August 10, 2001 is 19 months away from her priority, so she makes the demand, obtains the report, and files in the US within 30 months, i.e., July 10, 2002.
4. Easy. B. You can never, ever, ever, add new matter.
 5. Designs, watch out for filing dates and the fact that CPA's are and remain the quickie continuation mechanism for designs. Nothing on the list works because it is all RCEs and they do not work with designs, so E is it.
 6. Once you have a filing date in a utility application past May 29, 2000, the quickie continuation is an RCE. Here we have a filing date of 12/29/00, so an RCE is it. What is the recipe for an RCE? A request for an RCE, \$\$\$, and a reply. What are we missing: a proper request and no \$\$\$\$. What happens is abandonment. Ugly and unfair, but true. So D is the answer.
 7. What are attorney arguments worth? Nothing without factual support to back them up. Since the answer is what "will not" work, D jumps out.
 8. This is directed to the 102(e), (f), (g)/103(c) exceptions. This is 102(a)/103 prior art and, therefore, does not qualify. Hence, that makes D the wrong choice and answer since that is what the question seeks.
 9. Repeat, repeat. A "general allegation" that this is unpredictable art is enough to undermine an application disclosure? No way! So C is the answer since it is not in accord with PTO procedure.
 10. Is this a change in inventorship? No. An executed oath has not been filed. All you have to do is file a signed oath with the correct inventors and you're done. A is that choice.
 11. I am surprised at this question inasmuch as it focuses attention on the bizarre 102(e)(1) and (2) situation. In addition, the question is fatally flawed and unanswerable. You see, the publish in English, designate U.S. revisions cannot have effect on a document filed prior to the effective date of the law. The MPEP contradicts the chosen PTO model answer absolutely and unequivocally at MPEP 706.02(a) at page 700-22, right hand column, 2/3 of the way down. It says 4 elements are necessary for a published PCT reference to have a 102(e)(1) date, to wit: international application designates U.S., 2) publishes in English, 3) **the international application was filed on or after November 29, 2000**, and, 4) the application entered the US national stage. Here the PCT is filed as an international application on February 27, 1997, clearly before November 29, 2000, and therefore clearly not entitled to a 102(e) date as of Feb. 27, 1997. I agree that the PTO answer follows the literal wording of the statute, but it completely contradicts the MPEP guidelines. The question is unanswerable.

12. This is easier in that a patent has always been prior art both before and after the AIPA. This scenario is the “disappearing reference” trick under new vs. old 102(e) that I talked about in class. Potentially, a “patent” can lose its 102(e) date and only have a date as prior art as of its issue date. This is, obviously, not an intuitive result. However, the way the question is phrased makes the question almost unanswerable. The “patent” has no 102(e) date. It has a 102(a) date. I think the question should be tossed, but if they don’t they should at least clean it up next time they use it.
13. The small entity question. Non-profits; fewer than 500 employees, and sole inventors all qualify. The government doesn’t fall out under that list. So (C) is the answer.
14. Ex parte reexam means only one party at a time. No third parties. (B) is correct for that reason.
15. B and C are similar, but C is more complete and is therefore most likely correct.
16. What happens when you pay an issue fee late, i.e., after three months have passed? Abandonment, that’s what. Remember, you can pay it late, with reasons similar to abandonment, otherwise you’re out of luck no matter how much you’re prepared to pay.
17. PTA applies to utilities and plants filed on or after May 29, 2000. D is the only answer that has an application having a filing date after May 29, 2000. Remember an RCE is not considered a new application.
18. C is the obvious answer here. If you claim something you haven’t described elsewhere, chances are you did not possess it sufficiently to claim it as your own in the first place.
19. RCEs do not apply to Designs. And, since you’re post May 29, 2000, a CPA won’t work for the utility application. Hence, file an RCE for utility and a CPA for the design. Accordingly, B is the answer.
20. PTO humor! Ha, ha, ha, ha, where do they get this stuff? The question is an easy status question. Can you find out any info about a later filed divisional from an earlier application? Maybe. If a later application was filed, you might find something out because, indirectly, the application you have access to is mentioned in another application. It sounds backwards and would likely never happen, but this is the exam world, not the real world.
21. The PTO deals with the party having an interest for purposes of corrections, i.e., the owner, inventor, etc. A third party cannot make the PTO do much, and certainly this case wouldn’t qualify.

22. Whenever “consisting” is the transitional phrase, be suspicious. In this case, answer A cannot be modified by the dependent claim because of this very narrow phrase.
23. Another PCT question! A trend perhaps? 20 months is no longer the rule. This was changed and all examinees should have known about this who took the PLI course. With the rule change you can put off the National Stage until the 30th month without the demand having been made.
24. You’re facing final rejection. Your options: appeal, re-file, file an amendment, abandon. If you file an amendment, a reasonable insurance policy to keep the whole thing pending is to simultaneously file a “Notice of Appeal”. This strategy is B. C and D are wrong since a reference is useful for whatever it does disclose, even if it is deficient in terms of 112. E is wrong since this is 103 not 102.
25. This application is eligible for PTE. Time lost from the term for a successful interference is restored. Of course, the answer they say is correct is wrong inasmuch as the filing date is not specified as the starting point for the calculation. But I suppose E is better than the other answers.
26. Remember that for an incorrect fee in the small entity realm, you have a limited period to request a refund. In addition, answer B just seems too reasonable for the PTO, doesn’t it?
27. More PTO humor (“Antiagra” for deer overpopulation! These guys are hysterical!) Now, after the humor, the question. When a restriction is made, what do you do? ELECT, ELECT, ELECT. No one wrote anything down in A and it was your job to do so, so A is wrong. B & C have no ELECTION being made and D is late. Both December and January are 31 day months. Hence, E is it by process of elimination.
28. You have to argue what is in the claims, not whatever else you’d like to argue. The only difference between the reference and the claim is the hormonal v. non-hormonal distinction. A and B each argue something in claim 8, not 6. D argues claim 7, not 6. E is not an argument. So, C must be the answer.
29. Analogous art is necessary in a 103 rejection. The inherency argument fails in A since there is still no reason for the combination. Salt’s awareness or lack of awareness makes no difference in B since it is the person of ordinary skill and no one else. D and E fail because the claim is supported and can be understood in light of the specification. So, again, C is it.
30. A multiple dependent claim question. And, one with a twist. A claim in this format should be considered as a bunch of single dependent claims written in an efficient manner. As such, the claim includes the alternatives as alternatives, not

as one big bunch of stuff as A implies. Hence, A is the answer since it is wrong and not in accord with PTO practice.

31. Funny, funny, stuff. What can overcome a 102(a)? Swear behind, use priority, or show it is your own work. A works. B and C are the exact opposite of what you'd try and do. D is adding new matter in the way I read the phrasing and, in addition, why add to the declaration since it is the application you're concerned about!
32. As long as each contributes something to the conception of one claim, they can be co-inventors. Hence, B is correct. You are still within 1 year of the experimental use finishing up, so you're okay for filing.
33. A new rule repeat, already! Everybody who has a duty under 1.56 has to respond to a Requirement under 105. D is the obvious answer.
34. This is an easy one if you have already practiced for a little while. Otherwise it was a toughie. A is wrong because you know the PTO never gives away time when it can charge. B is wrong because of the limitation on non-final rejections. C is wrong since it is incomplete and why would you need a marked up set of newly submitted claims? The drawing corrections have always been a separate sheet response requirement, regardless. Hence, D, being most complete is correct.
35. You can now file a reissue to fix the forgotten divisional problem, but only if you do it within 2 years and never made a claim to the subject matter in the original application. In this case, you'd file a reissue and face a restriction owing to the newly added method claims. Can a reissue issue without an error? No. So only the method ends up being pursued in a divisional while the original good and error free claims fall away. Answer D finds its way there.
36. Remember you can file as many, reasonably, as you're prepared to pay for. The basic fee covers 20, including three independent and 17 dependent. Hence, (C) is silly and is the answer.
37. You have one year, minus one day, from the issue date of a patent to copy claims in that patent. A is correct. B and C do not qualify owing to the timing and D and E make no sense inasmuch as you cannot patent the same thing twice, even if you could swear behind it or file other affidavits.
38. Ah, 102(b), our familiar friend. Events more than one year prior in the US, documents, including patents, anywhere prior to one year before the US filing date. The filing date: September 6, 2001, the date you need, anything September 5, 2000 or prior. Only D, the Japanese patent has sufficient info to qualify.

39. No CPA for a CIP. So A is out. No divisionals from provisionals, so B is out. C is okay. A filing date after May 29, 2000, disqualifies D. A filing date on May 29, 2000, disqualifies E.
40. Again, if you practice this one was easy. For the postcard to be useful it has to be fairly specific. Only D is sufficiently specific.
41. So, so, so, so, easy, if you memorized the NAFTA (Dec. '93) and WTO (Jan. '96) dates. Answer A goofs it all up and is therefore correct as the answer because it is wrong.
42. IDS, timing, timing, timing. Non-final first action. Homer can pay or make a statement to have his IDS considered. A is wrong because the application has a filing date after May 29, 2000 and a CPA is inappropriate anyway because the action is non-final. B is wrong for an RCE since the action is non-final. C is wrong since a 103 suspension is only available in conjunction with either an RCE or CPA. D is a solid shot at responding but fails to include a clean copy of the claims, etc. E is woefully incomplete and has no IDS, which is what Homer wants to include.
43. How often will this occur? Almost never, which makes it perfect exam fodder. The PTO can, of course, fix its own mistakes. If the PTO can sua sponte initiate a reexam, surely it can also do a certificate of correction for printing errors, etc. So D is correct.
44. Deletions are odd ducks at the PTO. Who looks out for the interests of the deleted inventors, obviously no one. Deletions can simply be made as long as they are correct, obviously. So E is correct.
45. 102(e): amend, swear back, show it is your own work. E is all of these.
46. A is obviously incorrect. A product-by-process claim is to a "thing". The steps play no role in distinguishing the "thing" that is claimed. Consequently, a reference need only show the "thing" and it is a good rejection.
47. Please, they have to tell you Canada is a NAFTA country. Where do they think we live, in caves! Can a provisional claim priority from anything, even a Canadian application? No. So A is wrong. B is wrong since that is not the way term is calculated. C is also wrong because it implies that the Canadian priority somehow sticks. It doesn't. So that makes the balance of the answer true and makes C correct in a backhanded kind of way.
48. Small entity is a non-profit, sole inventor, or fewer than 500 hundred employees. If a license breaks you out of these parameters, then small entity no longer is available.

49. They must really want you to know what to do with a 102(e). Remember: swear back, establish priority, or file an affidavit showing it is your own work. However, they screwed up the question, so you win anyway.
50. Ah, 102(d). More than 12 months have passed, a foreign patent exists, and it is based on that foreign filing. A is the answer since publication doesn't matter. It is the enforceable right that matters.

Afternoon Section:

1. This is an example of the "experimental use" exception to 102(b) art that vests with the inventor. Block maintained control, it was for experimental purposes, etc. This qualifies and C is the answer.
2. All of the answers relate to the evidence of the close of prosecution and, hence, E is the answer since it includes all of them.
3. In a reissue a "marked up" version of anything is the only amendment format they want inasmuch as that is the version that will be printed so as to show what changed during the prosecution. Hence, C mentions a "clean copy" of an amendment and is therefore wrong and is the correct choice since it violates PTO procedure.
4. Diligence raises its head. It must be proven from a moment in time at least prior to the reference date and should be uninterrupted through reduction to practice or filing. B corresponds to these rules.
5. The deceptive intent statement makes no sense where an amendment is what has necessitated the deletion. Hence, A is the answer. The remaining answers simply track rule 48.
6. One way to skirt a 102(a) reference is to show that it is your own work and not the work of "another". Here Z is trying to do just that. So C is the answer.
7. This is a topic the PTO likes to preach on. They really do not want applicants converting provisionals to regular utilities. Only bad things result, like term calculation shortening. B contradicts what will happen so it is the right choice here.
8. Small entity = 1/2 off most fees, except petition type fees. A is a petition fee and is not reduced. B is silly, since no one can pull that off, not even small entities. C is correct. D is a situation where a RCE cannot be done, prosecution hasn't closed.

9. "A suggestion of success is all you need." Here there is no suggestion for the combination to provide guidance to one of ordinary skill. D is better than B since B includes "express" in the answer language.
10. Repeat, repeat, same answer as last time. C is it. If the PTO knows what the money is for, they take it. They do not care who pays it.
11. A provisional holds your place in line for whatever it includes in its disclosure. If you add more stuff when the non-provisional is filed you can still obtain benefit for whatever the two applications shared. A is the answer.
12. You cannot destroy one reference to get to a suitable combination to make a rejection under 103. Such an attempt really indicates how unobvious it is to make such a combination, I think. So C is the best of the lot.
13. They are really, really, reaching to rely on a Federal Register statement to write a question. A cheap shot if there ever was one on the exam. "Rule history" now becomes a valid question basis? What bunk. If it isn't in the MPEP it should be tested. Of course, they would take into account the mailing date, anyway, if the mail is unreasonably delayed, just as they did after Sept. 11, 2001 and the following anthrax issues for mail going to the PTO. The question and answer C are in line with recent PTO policy. All answers should be accepted.
14. IDS, timing, timing, timing. Between the actions, Toby can pay or make the statement that he knew about the reference for fewer than three months. A and B make no sense since an RCE is not appropriate. C is no good because you have to pay by now since more than three months have passed and Toby has known since June. So D is it.
15. Fairly straightforward amendment format question. You need a mark-up to show what changed along with a clean copy of everything. B points out the deficiencies best.
16. A is bad form for a multiple dependent claim. C and D leave out parts of the invention so B is best for the repeat question since it is the same answer as before. Although, really, product-by-process claims are rarely the right answer.
17. Our first inter-parte reexam question and it has to do with eligibility. I predicted this in class! Inter-parte is available only for applications having filing dates on or after November 29, 1999. P1 is okay for inter parte. R2 and P3 no way. According to this assessment, C is the answer.
18. Joint inventorship is based on conception only, not reduction to practice. Rocket conceived of the basic titanium ball and Torpedo came up with the laces. B is the answer.

19. Bizarre macabre facts. A PTO specialty. An estate rep. can sign for Rocket since Paper America is completely out of the picture.
20. Express Mail “date in” is the filing date. Answer D.
21. Tricky, tricky, tricky. You’d have to be extra sharp to catch this one. Spec changes are objected to and are petitionable; rejections are law based and are appealable. Tricky, tricky, tricky.
22. The forgotten divisional problem. Iam Smarter is outa luck here. E is all he’s got left. No recapturing what he failed to file a divisional for even under the new more flexible reissue approach.
23. See, Express Mail always wins. This one was easy. A is the obvious answer since the PTO is trying to demonstrate, again, that all applications should be filed by Express Mail since nothing else really assures you of a filing date.
24. The characterizing feature of a CIP is multiple filing dates. This question again illustrates that the PTO wants you to know this feature. C and D set forth that the claims are split between the two applications. Easy question if you remember the CIP axiom of multiple filing dates. (By the way it also has multiple 102(e) dates as a reference, but we’ll save that for another day!)
25. E is silly. D results in an abandoned application. C has an application proceeding to issue. So it is down to A and B. A is correct and is a fairly typical scenario for an RCE. B is not the best choice because it seems reasonable that once the PTO loses control of it, you cannot jerk it back by simply filing a paper at the PTO alone.
26. PTO humor “jumping jack flash”! A violates recapture. B is okay. C has no hope of co-pendency. D violates recapture in a reissue let alone the basic violation of never broadening in a reexam! E violates recapture by trying to get in the reflective housing, again.
27. Practice time here helps. A is okay with a fax dec. since he has seen the application in final form. B has seen nothing and needs to look at everything. In A, B gets left out from looking at the application. In B they do not know that each other is an inventor. C is okay. D leaves out the co-inventor B. E is just stupid and Judy shouldn’t be practicing if she is going to do stuff like E!
28. Finally a question less than a page long! Whew! Simple question. An RCE is not an appeal, so A is the answer.
29. An access question. Rare! You can only see the redacted version since that is what published. However, it is up to the applicant to make sure the PTO has a

- redacted version, otherwise they'll give out the whole thing! E makes the most sense.
30. So, so, easy. A jumps right out. Right! Some of the others are even funny.
 31. Opting out of publication has to be done at the time of filing. Abandon this thing as soon as possible and re-file to preserve rights. E is the best choice given the late date at which you're trying to fix the situation.
 32. Within two months of the mailing of the Examiner's Answer, ask for a hearing and pay money. Simple, answer E.
 33. Repeat, repeat, same answer as last time. Eve is seriously out of luck here. I know it is unfair, but Eve is just outa luck. 102(b) is a terrible thing when it doesn't work out. Answer A.
 34. This one is terribly obvious. Withdraw from issue should've jumped out at you! Answer B.
 35. Reissues do not qualify for publication as an application. Makes sense since they've already been published as a patent anyway and will be published again if anything changes.
 36. Rule no. 1: Will the PTO ever give back ill gotten money? Answer: rarely. If you could challenge the effectiveness of PTO expediting, you'd never lose and they'd always owe you money back. You pays your money and you takes your chances in the PTO expediting realm. D is the answer.
 37. A textbook use of exparte reexam procedures. A printed publication under 102(b).
 38. C is obviously wrong since it is a CPA and not a 53(b) filing. B is wrong since the PTO will presume Jones signed on behalf of Smith, even though Smith's signature is missing. A and D are okay.
 39. A small entity statement is no longer necessary. Just pay the correct fee and that is enough to get the ball rolling. If your status changes during prosecution, the next fee due as a large entity is the issue fee! A ride at half price (for a little while, anyway!). E is your answer.
 40. A multiple dependent preamble claim. How predictable. D is the only one that works. The other answers either do not further limit the claim or they have antecedent problems.
 41. A gift.

42. Just have to know chapter 400 pretty well here and the answer is straightforward Sherlock. A-D can be eliminated, so even if you didn't know E was correct, you'd still get there.
43. The earliest foreign filing is controlling. Have to be on file by the one year anniversary unless that date itself is a weekend or holiday, which it isn't. So B it is.
44. Claim interpretation under 112. A is too broad and has no steps. B follows the specification and is okay. C fails because of the effective amount of C is unclear as to what is necessary owing to the lack of correlation to which effective amount of C in the spec is the one being referred to. D uses exemplary language "preferably". E mixes statutory classes of invention.
45. Repeat, repeat, repeat, same answer as last time. Anyone listed here can take care of this issue of fixing the address.
46. Rule 105 encapsulated and exemplified. Although I think the FR citations are cheap shots. If it isn't in the MPEP it shouldn't reasonably be tested. I do not believe "rule history" is a valid basis for test questions.
47. Straight out of MPEP 600 regarding rules for computer program submissions. Some item have to be submitted on a CD, long programs are among those things.
48. Can you file drawings more than three months from the mailing of the Notice of Allowance? No, No, No, not any more. You have three months, period. Answer B.
49. D jumps right out since you've committed 48(f) to memory and this is the third question on this exam that turns on your understanding of 48(f)! Unbelievable, really. Why is 48(f) so popular? The PTO must be getting a lot of unnecessary 48(a) petitions or something.
50. D just doesn't make much sense and, therefore, is the answer. Even the PTO tries to make sense in its rules, and D just doesn't measure up, even for the low threshold of the PTO. It also violates 37 CFR 1.75.