

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

APRIL 17, 2002

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*. Each question has only one most correct answer.. 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 that 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 that would make the statement *true*. If it is determined by the USPTO that there is more than one most correct answer to a question, each most correct answer will be accepted, but only one point will be given for the question. The presence of multiple most correct answers does not, in itself, render the question ambiguous. 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 statutes and rules that have been changed as a result of the enactment of the American Inventors Protection Act of 1999, Pub. L. No. 106-113 (“Act”). The 8th Edition of the Manual of Patent Examining Procedure should be used. The examination will apply rules that are in effect as April 1, 2002. The rule changes are posted under the heading “Recent Patent-Related Notices” on the USPTO web site (www.uspto.gov/web/offices/pac/dapp/ogsheet.html). A group of rule changes, published in 67 Federal Regulations 520 (January 4, 2002) under the name “Revision of the Time Limit for National Stage Commencement in the United States for Patent Cooperation Treaty Applications,” will be in effect on April 1, 2002. This rule change is also available at the USPTO web site cited above under the heading “Recent Patent Related Notices.”

1. Which of the following is the best way to recite a claim limitation so that it will be interpreted by the examiner in accordance with 35 U.S.C. § 112, paragraph 6?

- (A) dot matrix printer for printing indicia on a first surface of a label.
- (B) dot matrix printer means coupled to a computer.
- (C) means for printing indicia on a first surface of a label.
- (D) printer station for printing indicia on a first surface of a label.
- (E) All of the above.

2. Registered practitioner Pete received on September 13, 2001 a notice of allowance dated September 10, 2001 in a utility application filed December 5, 2000. The client for whom the application is being prosecuted has repeatedly stressed to counsel how valuable the invention is, and that it will remain so throughout the entire life of any patent that should issue. Pete is determined to take no chances with this application, particularly since patent term adjustment has been accumulated and the lack of any action or inaction by applicant that would cause loss of patent term adjustment. Thus, Pete is ready to pay the issue fee on the very day the Notice of Issue Fee Due is received. Before payment of the issue fee, the client faxes Pete information identifies prior art first cited on September 3, 2001 by the foreign office examining a foreign counterpart application. This prior art was not previously cited by another foreign patent office. The invention had been filed with a second foreign office that mailed the same prior art at a later date than the first foreign office. Also, this prior art was previously unknown to the client. The client is very desirous of having this cited art made of record in the file. Which of the following alternatives would best achieve the client's objectives of maximizing patent term and having the foreign cited prior art considered by the USPTO?

- (A) Pete should file a petition for withdrawal from issue of the allowed application for consideration of a request for continued examination based on an information disclosure statement (IDS) and include in the petition an offer to file the request and IDS upon the petition being granted.
- (B) As it is still within three months from the date cited by the foreign office, Pete can submit the prior art in the allowed application up to the last day of the three month period making any required statements and fee payments.
- (C) Pete should submit an IDS citing the prior art in the allowed application within 30 days of the September 3, 2001 mailing by the foreign office with any appropriate fees and statements.
- (D) If, Pete could use the date of mailing by the second foreign office to file the IDS in the allowed application within three months of the communication of prior art by the second foreign office thereby allowing the client extra time to evaluate the allowed claims and still have the IDS entered.
- (E) (B) and (D).

3. Belle Bordeaux files a French patent application for a rejuvenating lotion in the French Patent Office on January 10, 2000. On January 10, 2001, she files a PCT Chapter I Request in the EPO Receiving Office, in which she requests that the European Patent Office act as the International Searching Authority. In her PCT application, Bordeaux claims priority to the French application, and indicates the U.S. as a designated state. Bordeaux makes an appointment to meet with you on June 8, 2001, to discuss filing a patent application in the USPTO on the rejuvenating lotion, in which she wants to claim priority not only to the PCT application, but also the French application. In preparing for your meeting with Bordeaux, you realize that she has several options here, and so you prepare an analysis of the various options, which are detailed below. Before entering the U.S. national stage, Bordeaux wishes to have an official international preliminary search report that indicates claims having the best chance of being patentable. Which of the following will achieve Bordeaux's objective in accordance with proper USPTO practice and procedure?

- (A) Bordeaux should enter the national stage by filing an application under 35 U.S.C. § 371 on or before September 10, 2001.
- (B) Bordeaux should file an application under 35 U.S.C. § 111(a) on or before September 10, 2001, claiming priority under 35 U.S.C. § 120 to the PCT application, and claiming priority under 35 U.S.C. § 119 to the French application.
- (C) Bordeaux should first file a PCT Chapter II Demand in the USPTO on or before August 10, 2001, and then file a provisional application under 35 U.S.C. § 111 on or before September 4, 2001.
- (D) Bordeaux should first file a PCT Chapter II Demand in the USPTO on or before August 10, 2001, and then enter the national stage by filing an application under 35 U.S.C. § 371 on or before July 10, 2002.
- (E) All of the above.

4. The specification in your client's patent application has been objected to for lack of enablement. To overcome this objection, your client may do any of the following except:

- (A) traverse the objection and specifically argue how the specification is enabling.
- (B) traverse the objection and submit an additional drawing to make the specification enabling.
- (C) file a continuation-in-part application that has an enabling specification.
- (D) traverse the objection and file an amendment without adding new matter in an attempt to show enablement.
- (E) traverse the objection and refer to prior art cited in the specification that would demonstrate that the specification is enabling to one of ordinary skill.

5. 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.

6. Applicant Jones filed a request for a first continued prosecution application (CPA) on December 29, 2000 in a utility application that was filed on April 28, 2000. Jones received a final Office action mailed on June 28, 2001. In response, Jones filed an amendment amending the claims in the first CPA. Jones received an advisory action on September 27, 2001 stating that the proposed amendment to the first CPA would not be entered because it raises new issues that would require further consideration. Additionally, the proposed amendment did not meet the requirements for a complete reply under 37 CFR 1.111. On December 28, 2001, Jones filed a petition for a 3-month extension of time with appropriate petition fee, a request for a second continued prosecution application, a request for suspension of action, and appropriate processing fee for the request for suspension of action. No application filing fee was filed with the request for the second CPA. Which of the following would be a proper communication mailed by the Office based on Jones’ actions?

- (A) A Notice of Allowability.
- (B) A Notice to File Missing Parts.
- (C) A first Office action on the merits.
- (D) A notice of improper Request for Continued Examination (RCE) and a notice of abandonment.
- (E) A letter granting the suspension of action.

7. Evidence of unexpected results is relied upon to overcome a *prima facie* case of obviousness. Which of the following is incorrect?

- (A) The evidence must compare the claimed invention to the closest prior art.
- (B) The evidence must be commensurate in scope with the claims.
- (C) Data relied upon to show unexpected results need not cover the full range of the claims if one of ordinary skill in the art could ascertain a trend in the data that would allow that person to reasonably extend the probative value of the data to the full scope of the claims.
- (D) Unexpected results can be shown by factual evidence or, if no factual evidence is available to the applicant, by sound argument by the applicant's agent or attorney.
- (E) The evidence need not be in an affidavit or declaration under 37 CFR 1.132 if the evidence is presented in the specification of an application to which the applicant has attested.

8. On March 20, 2000, Patsy Practitioner filed a patent application on widget Y for the ABC Company based on a patent application filed in Germany for which benefit of priority was claimed. The sole inventor of widget Y is Clark. On September 13, 2000, Patsy received a first Office action on the merits rejecting all the claims of widget Y under 35 U.S.C. § 103(a) as being obvious over Jones in view of Smith. When reviewing the Jones reference, Patsy notices that the assignee is the ABC Company, that the Jones patent application was filed on April 3, 1999, and that the Jones patent was granted on January 24, 2000. Jones does not claim the same patentable invention as Clark's patent application on widget Y. Patsy wants to overcome the rejection without amending the claims. Which of the following replies independently of the other replies would not be in accordance with proper USPTO practice and procedures?

- (A) A reply traversing the rejection by correctly arguing that Jones in view of Smith fails to teach widget Y as claimed, and specifically and correctly pointing out claimed elements that the combination lacks.
- (B) A reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.131 that antedates the Jones reference.
- (C) A reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.132 containing evidence of criticality or unexpected results.
- (D) A reply traversing the rejection by stating that the invention of widget Y and the Jones patent were commonly owned by ABC Company at the time of the invention of widget Y, and therefore, Jones is disqualified as a reference via 35 U.S.C. § 103(c).
- (E) A reply traversing the rejection by perfecting a claim of priority to Clark's German application, filed March 21, 1999, disclosing widget Y under 35 U.S.C. § 119(a)-(d).

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. A nonprovisional patent application was filed by a registered practitioner in the USPTO with a declaration under 37 CFR 1.63. The declaration named the individuals known to the practitioner to be the inventors of the claimed invention, but the declaration was not signed by any of the individuals. Within two weeks of the filing the application, the practitioner discovered that there is one more individual, who was not named on the unexecuted declaration, who is an inventor in the claimed invention. Which of the following actions, if undertaken by the practitioner, would properly correct the inventorship in the patent application?

- (A) File a new declaration under 37 CFR 1.63, identifying all the inventors including the newly discovered inventor, which is signed by each of the inventors.
- (B) File only a letter requesting that the inventorship be changed to add the newly discovered inventor.
- (C) File a petition under 37 CFR 1.48(a) for correction of inventorship. The petition contains only a request to add the newly discovered inventor. File with the petition (1) a new oath or declaration identifying and signed by only the newly discovered inventor, and (2) the petition fee set forth in 37 CFR 1.17(i).
- (D) File a petition under 37 CFR 1.48(a) for correction of inventorship consisting only of a request to add the newly discovered inventor, a statement by the newly discovered inventor that the error occurred without deceptive intention on his part and a petition fee set forth in 37 CFR 1.17(i).
- (E) All of the above.

Questions 11 and 12 are based on the following factual background. Consider questions 11 and 12 independently of each other.

Applicant files a patent application in Japan on February 28, 1996. Applicant files a PCT international application designating the United States on February 27, 1997, based on the Japanese application. The international application is published in English on August 28, 1997. The international application enters the national stage in the United States on August 28, 1998. The USPTO publishes the application on June 7, 2001 at the request of the applicant. The application issues as a United States patent on December 4, 2001.

11. When examining an application filed on or after November 29, 2000 or any application that has been voluntarily published, what is its earliest possible prior art date, for the June 7th U.S. published application in view of 35 U.S.C. § 102(e) as amended by the American Inventors Protection Act of 1999?

- (A) February 28, 1996.
- (B) February 27, 1997.
- (C) August 28, 1997.
- (D) August 28, 1998.
- (E) June 7, 2001.

12. For the United States patent, what is the patent's earliest date, for prior art purposes as a patent, in view of the amendment to 35 U.S.C. § 102(e) by the American Inventors Protection Act of 1999?

- (A) February 28, 1996.
- (B) February 27, 1997.
- (C) August 28, 1997.
- (D) August 28, 1998.
- (E) December 4, 2001.

13. Which of the following could never qualify as a small entity under 37 CFR 1.27 for certain fee reductions?

- (A) A nonprofit organization.
- (B) A two-person business concern with a \$4,000,000 income.
- (C) A federal government agency.
- (D) A university in Canada.
- (E) A person.

14. 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) Third party requesters have the option of attending interviews, but their presence is not mandatory.
- (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) An interview does not remove the necessity for reply to Office actions as specified in 37 CFR 1.111.

15. Able is a registered solo practitioner. Ben asks Able to prepare and prosecute an application for a utility patent. As part of the application, Able prepares a declaration and power of attorney, which Ben reviews and signs. Able files the application, the declaration, and power of attorney with the USPTO. Able quickly recognizes that help is necessary and contacts another registered practitioner, Chris, who often assists Able in such instances. Able, with Ben's consent, sends a proper associate power of attorney to the Office for Ben's application and directs that correspondence be sent to Chris. The examiner in the application takes up the application in the regular course of examination and sends out a rejection in an Office action. Chris sends a copy of the action to Ben to obtain Ben's comments on a proposed response. Unfortunately, after the first Office action, Able becomes terminally ill and dies. Ben does not know what to do, so Ben calls the examiner at the number on the Office action and explains that A died and Ben is worried how to proceed. Which of the following statement(s) is/are true?

- (A) Chris should inform Ben that the Office will not correspond with both the registered representative and the applicant and therefore, Ben should not have any further contact with the Office and let Chris send in a proper response.
- (B) Ben should send in a new power of attorney for anyone Ben intends to represent him before the Office.
- (C) Ben should execute and sent to the USPTO a new power of attorney for any registered patent practitioner that Ben intends to have represent him before the Office.
- (D) (B) and (C).
- (E) None of the above.

16. Jill, a registered patent agent, receives a Notice of Allowance from the USPTO with a mail date of November 13, 2001, regarding a utility patent application for an improved garden hose which she had filed on behalf of one of her small entity clients. The Notice of Allowance specifies a sum that must be paid within three months of the mailing date to avoid abandonment. The sum specified includes both the issue fee and the publication fee. As a result of a small fire in her office building, Jill is unable to resurrect her files until the last day of the three month period. Jill mails a letter to the USPTO on February 13, 2002 using the U.S. Postal Service. Jill does not employ the procedures of 37 CFR 1.8 or 1.10 to mail the letter. The letter is received in the USPTO on February 15, 2002. The letter correctly identifies the application. The letter authorizes the USPTO to charge the proper issue fee for a small entity to her deposit account. The account has been identified in a previously filed authorization to charge fees. At the time the letter was filed in the USPTO, the account had a balance of \$1000.00 in funds. Nothing in the letter authorized payment of the publication fee, no petition for an extension of time was filed, and an Office-provided issue fee transmittal form was not filed. No postal emergency was involved in filing the letter. Which of the following statements accords with proper USPTO practice and procedure?

- (A) The application will become abandoned because Jill did not authorize payment of the publication fee.
- (B) The application will not become abandoned because the authorization to charge fees operates as a request to charge the correct fees to any deposit account identified in a previously filed authorization to charge fees.
- (C) The application will become abandoned because Jill's letter did not include a petition for an extension of time accompanied by the proper fee.
- (D) The application will become abandoned because a completed Office-provided issue fee transmittal form, PTOL-85B, did not accompany Jill's letter.
- (E) The application will become abandoned because Jill's letter was not timely filed in the USPTO and it was not mailed in accordance with the provisions of 37 CFR 1.8 or 1.10.

17. Which one of the following applications is eligible for Patent Term Adjustment under the Patent Term Guarantee Act of 1999?

- (A) A plant application filed June 8, 1995.
- (B) A utility application filed June 8, 1995.
- (C) A design application filed May 29, 2000.
- (D) A continued prosecution application (CPA) filed on June 6, 2001 where the CPA is based upon a plant application originally filed on February 2, 2000.
- (E) A utility application originally filed on February 2, 2000 when a request for continued examination (RCE) was filed on June 6, 2001.

18. 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.

19. On June 9, 2000, you file two complete patent applications on behalf of your client, ABC Inc. The subject matter of the patent applications relates to a new automotive body design. One of the applications is filed as a utility application (A#1), and other is filed as a design application (A#2). Prosecution of each application moves forward independently of each other, and you receive final office actions in each application rejecting the respective claim(s) in each application. Your client, in consultation with you, decides that she would rather pursue prosecution in each case rather than appeal the final rejections. Which of following options is available to you under the USPTO rules and procedures ?

- (A) File a request for continuing examination (RCE) for both A#1 and A#2.
- (B) File a request for continuing examination (RCE) for A#1 and a continuing prosecution application (CPA) for A#2.
- (C) File a request for continuing examination (RCE) for A#2 but not A#1.
- (D) File a continuing prosecution application (CPA) for both A#1 and A#2.
- (E) File a continuing prosecution application (CPA) for A#1 but not A#2.

20. J. Q. Practitioner represents the IMAKECOPY Corp., which is an importer of widgets into the USA. At the request of his client, J. Q. Practitioner is reviewing the prosecution history of a published patent application filed under 35 U.S.C. § 111, that contains process claims for making widgets and other claims directed to the widget products. The application lists Rob M. Blind as the inventor and Wesue Corp. as the assignee. Rob M. Blind is an employee of the Wesue Corp. which is a competitor of the IMAKECOPY Corp. The prosecution history of the published patent application contains a restriction requirement made by the examiner followed by an election of the process claims by the applicant, and cancellation of the non-elected product claims. No related patent applications are referenced in the published patent application or its prosecution history. A search of public USPTO databases indicates no divisional patent application has been published or issued as a patent. J. Q. Practitioner wants to obtain more information concerning the cancelled product claims. Which of the following statements is true?

- (A) J. Q. Practitioner cannot obtain other information because no information about pending unpublished applications is available under 35 U.S.C. § 122, except for previously filed applications.
- (B) J. Q. Practitioner may obtain a copy of the originally filed application and a copy of all unpublished divisional applications containing the non-elected product claims.
- (C) J. Q. Practitioner may obtain a copy of all unpublished applications including their prosecution histories for any patent application containing the non-elected product claims.
- (D) J. Q. Practitioner may file a written request for the File Information Unit (FIU) to ascertain if there are any earlier or subsequently filed applications claiming benefit under 35 U.S.C. § 120 of the published application and their status.
- (E) J. Q. Practitioner may request, either in person or in writing, that the File Information Unit (FIU) ascertain and disclose if there are any subsequently filed applications claiming benefit under 35 U.S.C. § 120 of the published application and their status.

21. Company X competes with Patentee Y. In response to an accurate notification from Company X, acting as a third party, that Patentee Y's patent contains a printing error, incurred through the fault of the USPTO, the USPTO:

- (A) must issue a certificate of correction.
- (B) must reprint the patent to correct the printing error.
- (C) need not respond to Company X.
- (D) should include Company X's notification in the patent file.
- (E) must notify Company X of any USPTO decision not to correct the printing error.

22. 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 consisting of the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (B) 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.
- (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).

23. An international application designating the United States is filed with the USPTO in its capacity as a Receiving Office, which properly accords the application an international filing date of 02 August 2001. The application properly claims priority solely to an earlier British application filed 02 August 2000. A Demand was not filed within 19 months from this priority date. On 10 April 2002, applicant filed a “Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Filing Under 35 U.S.C. § 371” (Form PTO-1390), which identified the international application, and was accompanied by payment in full of the basic national fee. An oath or declaration, as required under 35 U.S.C. § 371(c)(4), was not submitted. As of 10 April 2002, the U.S. national stage application was:

- (A) Abandoned for failure to submit the basic national fee within 20 months from the priority date.
- (B) Abandoned for failure to submit the basic national fee and copy of the international application within 20 months from the priority date.
- (C) Abandoned for failure to submit the basic national fee, copy of the international application, and oath or declaration within 20 months from the priority date.
- (D) Abandoned for failure to submit the basic national fee within 20 months from the international filing date.
- (E) Not abandoned.

24. Mr. Brick, the inventor, files an application with the USPTO on January 2, 2001 containing a single claim for his invention: a new bouncing ball called “Y”. Brick receives a first Office action dated June 4, 2001 from the primary examiner handling Brick’s application. The examiner rejected Brick’s claim only under 35 U.S.C. § 103 on the grounds that Reference X teaches a bouncing ball called “Q,” and that although “Y” and “Q” are not the same, it would have been obvious to one of ordinary skill to make changes to the “Q” ball in order to obtain a ball just like Brick’s “Y” ball.

On August 2, 2001, Brick responds by stating that his new “Y” ball bounces unexpectedly higher than the “Q” ball described in Reference X. Brick includes a declaration, signed by Mrs. Kane, that includes extensive data comparing the bouncing results for the “Y” and “Q” balls and showing that the “Y” ball bounces unexpectedly higher than the “Q” ball. Brick argues that the rejection under 35 U.S.C. § 103 should be withdrawn because he has proven that, in view of the unexpectedly higher bounce of the “Y” ball as compared to the “Q” ball, it would not have been obvious to one of ordinary skill in the art to make changes to the “Q” ball to obtain Brick’s “Y” ball.

On October 2, 2001, Brick receives a final rejection from the examiner. The rejection states, in its entirety: “The response has been reviewed but has not been found persuasive as to error in the rejection. The claim is finally rejected under 35 U.S.C. § 103 for the reasons given in the first Office action.” Brick believes he is entitled to a patent to his new bouncing ball “Y.” How should Brick proceed?

- (A) Brick should give up because the declaration did not persuade the examiner of the merits of Brick’s invention.
- (B) Brick should timely file a Request for Reconsideration asking the examiner to reconsider the rejection on the basis of the Kane declaration and, as a precaution against the Request for Reconsideration being unsuccessful, also timely file a Notice of Appeal.
- (C) Brick should respond by submitting a request for reconsideration presenting an argument that Reference X does not provide an enabling disclosure for a new ball with the unexpectedly higher bounce of his “Y” ball.
- (D) Brick should respond by submitting a request for reconsideration presenting an argument that Reference X does not provide a written description for a new ball with the unexpectedly higher bounce of his “Y” ball.
- (E) Brick should respond by submitting a request for reconsideration presenting an argument the declaration data proves that the “Q” ball and the “Y” are not identical.

25. John filed a utility patent application for a high strength steel composition on June 9, 1997. During prosecution of the application, an interference under 35 U.S.C. § 135(a) was declared on June 9, 1998 between John's application and an unexpired patent. Subsequently, the interference was terminated in John's favor on June 9, 2000. The year 2000 was a leap year having 366 days. Ultimately, John's application was allowed and issued as a patent on June 12, 2001. Based on proper USPTO practice and procedure, and absent any other events necessitating adjustment of the patent term, when should John's patent expire?

- (A) Twenty (20) years from issue date.
- (B) Twenty (20) years and one day from filing date.
- (C) Twenty (20) years plus three years inasmuch as granting of the patent was delayed by the interference.
- (D) Twenty (20) years plus the number of days in the period beginning the date prosecution is suspended in another application that is not in the interference, but is related to the application in interference.
- (E) Twenty (20) years plus the period beginning on the date the interference was declared and ending on the date that the interference was terminated with respect to the application.

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.

Questions 27 through 29 are based on the following factual background. Consider questions 27 through 29 independently of each other.

James Salt developed an environmentally friendly technique for controlling deer overpopulation. Briefly, Salt discovered a non-hormonal substance XYZ (“Antiagra”) that efficiently suppresses sexual function in male deer with minimal side effects. Salt determined that the use of a non-hormonal substance eliminated adverse long-term health effects that may be experienced with hormonal substances. He then dissolved an effective amount of Antiagra in salt water, poured the resulting solution into a plurality of twenty-gallon tubs, and heated the tubs to evaporate the water. The resulting blocks of salt, throughout which Antiagra was evenly disbursed, were distributed in overpopulated areas during deer mating season to serve as salt licks. Stags that used the salt lick show no interest in mating, thereby lowering the pregnancy rate among does and helping to control the deer population. Salt has retained you to conduct a prior art search and, if appropriate, prepare and file a patent application. The only relevant prior art located during the prior art search is a patent to Deere that discloses a salt lick on which a hormonal substance is sprayed. A doe that uses the salt lick ingests the hormonal substance which, in turn, suppresses ovulation and thereby reduces the pregnancy rate. You prepare and file a patent application that provides a fully enabling disclosure and includes four claims sets. Claims 1-5 are directed specifically to the non-hormonal substance (Antiagra), claims 6-9 are directed to a salt lick laced with a non-hormonal substance that, when ingested by a male deer, suppresses sexual function in the male deer, claims 9-14 are directed to the method of forming the salt lick, and claims 14-20 are directed to a method for controlling deer population by distributing salt licks that are treated with an effective amount of XYZ to reduce pregnancy rates. You also properly establish small entity status on behalf of Salt at the time the application is filed.

27. Upon initial examination, the patent examiner issues a requirement for restriction on the basis that the application claims two or more independent and distinct inventions. Specifically, the examiner requires an election between (a) claims directed to the non-hormonal substance *per se* (claims 1-5); (b) claims directed to the salt lick and to the method of forming the salt lick (claims 6-14); and (3) claims directed to the method of controlling deer population by distributing salt licks that are treated with XYZ to reduce pregnancy rates (claims 15-20). The restriction requirement was set forth in an Office action dated December 12, 2001, and the examiner set a one month (not less than 30 days) shortened statutory period for response. December has 31 calendar days. Which of the following is most likely to be treated by the USPTO as a timely, fully responsive reply to the Office action.

- (A) You contact the examiner on the telephone on December 27, 2001 and make an oral election of the subject matter of claims 6-14 without traverse, and request cancellation of claims 1-5 and 15-20 without prejudice to resubmission of those claims in a continuation application. You do not, however, subsequently confirm the substance of the telephone conversation in writing and the examiner does not complete an Interview Summary Record.
- (B) On February 12, 2002, you file a Reply to Office Action, a Petition for One Month Extension of Time and all necessary fees. The Reply to Office Action traverses the restriction requirement on the basis that the requirement would force the small entity applicant to file multiple patent applications and is therefore unduly burdensome. The Reply to Office Action requests reconsideration of the restriction without making an election.
- (C) On February 12, 2002, you file a Reply to Office Action, a Petition for Two Month Extension of Time and all necessary fees. The Reply to Office Action does not make an election. Instead, the Reply to Office Action traverses the restriction requirement and requests reconsideration of the restriction without specifically pointing out the supposed errors in the examiner's action.
- (D) On February 14, 2002, you file a Reply to Office Action, a Petition for One Month Extension of Time and all necessary fees. The Reply to Office Action traverses the restriction requirement on the basis that the claims as originally presented in a single application do not pose a serious burden on the examiner, and therefore requests reconsideration of the election requirement. The Reply to Office Action provisionally elects the subject matter of claims 6-14. There is no authorization to charge a deposit account.
- (E) On February 12, 2002, you file a Reply to Office Action, a Petition for One Month Extension of Time and all necessary fees. The Reply to Office Action elects claims 6-14 without traverse.

28. Claim 6 of the application reads: “A composition for reducing the pregnancy rate among wild deer population, said composition comprising salt and a non-hormonal substance that, when ingested by a male deer, is operable to suppress sexual function in the male deer.” Claim 7 reads: “The composition of claim 6, wherein said non-hormonal substance is XYZ.” Claim 8 reads, “The composition of claim 6, wherein said composition is formed in a block and wherein said non-hormonal substance is interspersed substantially evenly throughout said block.” Each of these claims is fully supported by the specification. An Office action is mailed March 15, 2002. Claim 6 was rejected under 35 U.S.C. § 103 as being unpatentable over the Deere patent. Which of the following arguments, if presented in a timely reply to the March 15 Office action, is most likely to persuade the examiner to remove the § 103 rejection without presenting unpersuasive arguments?

- (A) “The invention of claim 6 provides an advantageous feature in that the substance that helps reduce the pregnancy rate is interspersed throughout the salt lick. Thus, the present invention is effective to reduce the pregnancy rate in deer so long as any portion of the salt lick is available to deer. In contrast, the Deere patent utilizes a substance that is sprayed on the outer surface of the salt lick and, therefore, is effective only so long as the outer portion of the salt lick is available.”
- (B) “The invention of claim 6 provides an advantageous feature in that the substance that helps reduce the pregnancy rate is interspersed throughout the salt lick. Thus, the present invention is effective to reduce the pregnancy rate in deer so long as any portion of the salt lick is available to deer. In contrast, the Deere patent utilizes a substance that is sprayed on the outer surface of the salt lick and, therefore, is effective only so long as the outer portion of the salt lick is available.”
- (C) “In contrast to the present invention, the Deere patent calls for the use of a hormonal substance that suppresses ovulation in female deer. Deere neither discloses nor suggests the use of a non-hormonal substance that, when ingested by a male deer, is operable to suppress sexual function in the male deer, as set forth in claim 6.”
- (D) “The present invention relates to a technique for reducing deer overpopulation by causing male deer to ingest a novel substance (XYZ) that is operable to suppress sexual function in the male deer. The Deere patent neither discloses nor suggests such a technique and, therefore, claim 6 is neither anticipated nor rendered obvious by the Deere patent.”
- (E) “Applicant was aware of the Deere patent prior to filing of the present application, and the claims were carefully drafted to distinguish the present invention over the Deere patent. Accordingly, reconsideration and withdrawal of the § 103 rejection of claim 6 is respectfully requested.”

29. Claim 15 of the application reads: “A method for reducing pregnancy rate in wild deer population comprising the step of placing at least one salt lick containing an effective amount of XYZ in a location accessible to wild male deer so that XYZ is ingested by said male deer.” The specification provides adequate disclosure as to what constitutes an “effective amount” of XYZ. In addition to the Deere patent, the examiner locates a prior art patent to John Doe that discloses the non-hormonal substance XYZ for use as a softening agent in skin cream. There is no disclosure or suggestion in the Doe patent of any other potential use for XYZ. Which of the following statements is most consistent with proper USPTO practice and procedure?

- (A) The Examiner may properly reject claim 15 under 35 U.S.C. §103 as being obvious over Deere in view of Doe because Deere teaches the method of distributing salt licks treated with a substance to reduce pregnancy rates and suppression of sexual activity in male deer is merely an inherent characteristic of a known substance XYZ.
- (B) The examiner may not rely on the Doe patent in a 35 U.S.C. § 103 obviousness rejection because there is no evidence that Salt was aware of its teachings at the time the invention was made and therefore the invention could not have been obvious to Salt at that time.
- (C) The examiner may rely on the Doe patent in making an obviousness rejection under 35 U.S.C. § 103 only if the Doe patent is in the field of Salt’s endeavor or, if not in that field, then reasonably pertinent to the problem with which Salt was concerned.
- (D) The examiner may properly reject claim 15 under the first paragraph of 35 U.S.C. §112 because the specification is inadequate to enable a person skilled in the art to which it pertains to practice the invention.
- (E) The examiner may properly reject claim 15 under the second paragraph of 35 U.S.C. § 112 because the recitation of “an effective amount of XYZ” renders the claim indefinite.

30. 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.

31. Which of the following practices or procedures may be properly employed to overcome a rejection properly based on 35 U.S.C. § 102(a)?

- (A) Perfecting a claim to priority under 35 U.S.C. § 119(a)-(d) based on a foreign application having a foreign priority filing date that antedates the reference.
- (B) Filing a declaration under 37 CFR 1.131 showing that the cited prior art antedates the invention.
- (C) Filing a declaration under 37 CFR 1.132 showing that the reference invention is by “others.”
- (D) Perfecting priority under 35 U.S.C. §§ 119(e) or 120 by, in part, amending the declaration of the application to contain a specific reference to a prior application having a filing date prior to the reference.
- (E) (A), (B) (C), and (D).

32. Johnnie owns a supermarket store in Cleveland, Ohio, and is constantly frustrated when little children drop their chewing gum on Johnnie's clean floor in the supermarket. In her spare time, Johnnie develops an entirely novel type of coating material that she applies to floor tile. The coating material resists adhesion to chewing gum. In order to check out the effectiveness of the floor tile coating material, on December 31, 2000, she secretly covers the floor tiles in her supermarket with the new chewing gum resistant floor tile coating material. Johnnie is amazed at the results inasmuch as cleaning the floor was never easier. On January 30, 2001, Johnnie, satisfied with the experimental use results, ceased testing the use of the coating material. The ability of the coating material to withstand chewing gum adhesion continued unabated throughout the remainder of 2001. On January 1, 2002, one of Johnnie's many customers, James, remarked at how clean the floor looked. Johnnie then told James of her invention. James thinks for one moment and suggests that the floor tile coating material may be useful in microwave ovens, so that food will not stick to the interior sides of the microwave oven. James discusses getting patent protection with Johnnie. Which of the following is true?

- (A) Johnnie could never be entitled to a patent on a floor tile in combination with a coating material affixed to the outer surface of the tile.
- (B) James can be named as a coinventor with Johnnie in a patent application claiming a microwave oven wherein the internal surfaces of the oven are coated with the coating material.
- (C) Since for one year Johnnie told nobody that the floor tile in her supermarket contained the new chewing gum resistant coating material, she would never be barred from obtaining patent protection for the floor coating material.
- (D) Use of the floor tile coating material in microwave ovens would have been obvious to one of ordinary skill in the art, since James thought of it within seconds after first learning of the floor tile coating material, and James was not skilled in the art.
- (E) The floor tile having the coating material affixed to the outer surface of the tile, an article of manufacture, would not be patentable as of January 1, 2002 inasmuch as the article was in public use on the supermarket floor for one year.

33. 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 in December 2002?

- (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).

34. Applicant received a final rejection dated and mailed Wednesday, February 28, 2001. The final rejection set a three month shortened statutory period for reply. In reply, applicant filed an amendment on Wednesday, March 21, 2001. In the amendment, applicant requested that block diagrams, figures 32-34, be amended by inserting the term - -computer- - in place of [CPU] in block “2” of each block diagram. Applicant further supplied a clean version of the entire set of pending claims. Applicant did not provide the proposed changes to the drawings on separate sheets marked in red nor did the applicant supply a marked-up version of any claim. The examiner upon receipt and review of the amendment discovered that the applicant made changes to pending claims 2 and 15 and that the applicant added claims 21-25 to the application. The examiner in an Advisory Action notifies the applicant that the amendment fails to comply with the requirements of 37 CFR 1.121. Which of the following answers is most correct?

- (A) Applicant is given a time period of one month or thirty days from the mailing date of the Advisory Action, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. This time period is in addition to any remaining period of time set in the final rejection.
- (B) Applicant may not provide a clean version of the entire set of pending claims because the applicant may only consolidate all previous versions of pending claims into a single clean version in an amendment after a non-final Office action.
- (C) Applicant must submit the proposed changes to figures 32-34 on a separate paper showing the proposed changes in red and a marked up version of new claims 21-25 as required by 37 CFR 1.121(c).
- (D) Applicant should request reconsideration by the examiner, pointing out that the Final Rejection was mailed on February 28, 2001, which precedes the March 1, 2001 effective date of the changes to patent rule 37 CFR 1.121.
- (E) Applicant must submit the changes to figures 32-34 on separate paper showing the proposed changes in red and a marked up version of rewritten claims 2 and 15 showing all changes (relative to the previous version of claims 2 and 15) shown by any conventional marking system as required by 37 CFR 1.121(c). Applicant should also indicate the status of claims 2 and 15, e.g. “amended,” “twice amended,” etc. on both the clean version of the claims and the marked up version.

35. Joe Inventor received a patent in July 1999, containing claims to both an article and an apparatus. When filed in the USPTO, the application contained disclosure of a method, but the method was not claimed. The patent contained the same disclosure of the method, but the method had never been claimed in the application. In May 2001, Joe asks Pete Practitioner to file a reissue application to add claims to the method disclosed in the specification. Once filed, which of the following will most likely occur during the prosecution of the reissue application in accordance with published USPTO practice and procedure?

- (A) The examiner should reject the added method claims on the basis of not being for the invention claimed in the original patent, under 35 U.S.C. § 251, citing *In re Rowand*, 187 USPQ 487, and allow the original unamended article and apparatus patent claims in the reissue application.
- (B) Following a restriction requirement by the examiner in the reissue application, the original unamended article and apparatus patent claims will be constructively elected, examined, and, if found allowable, passed to issue, while the non-elected method claims should be filed in a divisional application.
- (C) Following a restriction requirement in the reissue application and the filing of a divisional application to claim the method, the applicant should request a duplicate copy of the original patent so that a copy of said patent can be surrendered in each reissue application.
- (D) Following a restriction requirement by the examiner in the reissue application, the original unamended article and apparatus patent claims will be considered constructively elected; if after examination they become allowable in unamended form, they will be held in abeyance in a withdrawn status inasmuch as no “error” under 35 U.S.C. §251 exists, while Joe prosecutes the claims to the method in a divisional application.
- (E) A three-way restriction requirement among the article, apparatus and method claims should be made by the examiner in the reissue application, and an election made by applicant. Each invention should issue in a separate reissue patent.

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

- (A) Product and process claims should be separately grouped.
- (B) Claims should be arranged in order of scope so that the first claim presented is the least restrictive.
- (C) Every application should contain no more than three dependent claims.
- (D) A claim which depends from a dependent claim should not be separated from that dependent claim by any claim which does not also depend from the dependent claim.
- (E) Each claim should start with a capital letter and end with a period.

37. 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.

38. Applicant files an application claiming a nutritional supplement comprising ingredients (1) through (9) on September 6, 2001. The examiner’s search on November 12, 2001 retrieved several documents, each of which provides an enabling disclosure of a nutritional supplement comprising ingredients (1) through (9). Which of the following documents retrieved by the examiner may be properly used by the examiner to reject applicant’s claims under 35 U.S.C. § 102(b)?

- (A) An advertisement in the September 2000 issue of Dieticians and Nutritionists Health Weekly where the examiner is not able to determine the actual date of publication.
- (B) A printout on November 12, 2001 by the examiner of a MEDLINE database abstract 123456 of an article by Food et al., “Nutritional supplements for infants,” published in Azerbaijan Pediatrics, Vol. 33, No. 8, pp. 33-37 (September 2000). The printout does not include the date on which the MEDLINE abstract was publicly posted.
- (C) A printout, on November 12, 2001 by the examiner, of a product brochure from the Internet website of PRO-BIOTICS VITAMIN CORP. The examiner determines that the brochure was posted on September 7, 2000 on the website.
- (D) A Japanese patent application published on September 1, 2000.
- (E) All of the above.

39. 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 CFR 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 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.
- (B) 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.
- (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.

40. Which of the following identifications of document(s) set forth in a return postcard that is stamped and returned by the USPTO will suffice for the postcard receipt to serve as *prima facie* evidence of the USPTO's receipt of the document(s) specified where the USPTO cannot locate the document(s)?

- (A) For all pages of a complete new application **B** an identification stating: "the items listed in the transmittal letter that accompanied the application", where the registered practitioner can furnish a copy of the transmittal letter, and where the transmittal letter contained a list of the component parts of a complete application.
- (B) For all pages of a complete new application **B** an identification stating: "a complete application".
- (C) For all pages of a complete new application containing the following components **B** an identification stating: "specification (including written description, claims and abstract), drawings, declaration".
- (D) For two sheets of drawings **B** an identification stating "2 sheets of drawings".
- (E) All of the above.

41. Regarding an affidavit or declaration filed pursuant to 37 CFR 1.131, which of the following statements is incorrect?

- (A) The affidavit or declaration may establish a date of completion of applicant's claimed invention before January 1, 1996 in a NAFTA country or before December 8, 1993 in a WTO member country other than a NAFTA country.
- (B) The affidavit or declaration cannot be used to overcome a rejection under 35 U.S.C. § 102(e) based on a U.S. patent which claims the same patentable invention as defined in 37 CFR 1.601(n).
- (C) The affidavit or declaration may be used to overcome a rejection under 35 U.S.C. § 103 based on reference to a foreign patent which qualifies as prior art under 35 U.S.C. § 102(a).
- (D) The affidavit or declaration containing references to notebook entries may properly include reproductions of the notebook entries, as opposed to the original notebook pages.
- (E) The affidavit or declaration must show facts establishing reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to subsequent actual reduction to practice or to the filing of the application.

42. Applicant Homer filed a nonprovisional utility application on December 3, 2001 with 3 sheets of drawings. He received a non-final Office action on the merits on March 1, 2002 rejecting all claims under 35 U.S.C. § 102(b) with reference A and including objections to the drawings. The Office action set a shortened statutory period of 3 months for reply. Homer wants to submit several references in an information disclosure statement (IDS) for the examiner's consideration. Under proper USPTO practices and procedures which of the following actions, if taken, would avoid abandonment?

- (A) Homer timely files a continued prosecution application under 37 CFR 1.53(d) with an IDS and required fees.
- (B) Homer timely files a request for continued examination under 37 CFR 1.114 with an IDS and required fees.
- (C) Homer timely files a request for suspension of action under 37 CFR 1.103 with an IDS and required fees.
- (D) Homer timely files a photocopy of the originally filed claims with proposed amendments marked in red, arguments that support the claims are patentable over the reference, proposed drawing corrections, an IDS, and any required fees or certification.
- (E) Homer timely files conclusory arguments that the examiner's rejection is without merit and has no statutory basis.

43. The Commissioner may issue a certificate of correction to correct a mistake in a patent, incurred through the fault of the Office:

- (A) only if demanded by a third party having standing with the Office and the third party pays the fee required by 37 CFR 1.20(a).
- (B) without notifying the patentee, (including any assignee of record) if the correction is of a nature that the meaning intended is obvious from the context of the portion of the patent where the mistake occurs.
- (C) only if the request for correction relates to a patent involved in an interference.
- (D) acting *sua sponte*, after first notifying the patentee, for mistakes that the Office discovers.
- (E) only if patentee or the patentee's assignee makes a request.

44. An amendment filed in January 8, 2002, 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).

45. Which of the following practices or procedures may be properly employed to overcome a rejection properly based on 35 U.S.C. § 102(e)?

- (A) Persuasively arguing that the claims are patentably distinguishable from the prior art.
- (B) Filing an affidavit or declaration under 37 CFR 1.132 showing that the reference invention is not by "another."
- (C) Filing an affidavit or declaration under 37 CFR 1.131 showing prior invention, if the reference is not a U.S. patent that either claims the same invention or claims an obvious variation of the subject matter in the rejected claim(s).
- (D) (A) and (C).
- (E) (A), (B) and (C).

46. A product-by-process claim is properly rejected over a reference under 35 U.S.C. § 102(b). Which of the following statements is incorrect?

- (A) There is no anticipation unless each of the process steps recited in the claim is disclosed or inherent in the applied reference.
- (B) If the applied reference reasonably indicates that a product disclosed therein is the same or substantially the same as the claimed product, the burden shifts to the applicant to provide evidence to the contrary.
- (C) The rejection cannot be overcome by evidence of unexpected results.
- (D) The rejection can be overcome by evidence that the product in the reference does not necessarily or inherently possess a characteristic of the applicant's claimed product.
- (E) An affidavit or declaration under 37 CFR 1.131 cannot overcome a proper rejection under 35 U.S.C. § 102(b) over a reference.

47. Xavier residing in Canada, a NAFTA country, files an application for a Canadian patent Monday, September 18, 2000. At the same time, Xavier forwards a copy of the Canadian application to registered practitioner Young in the United States, asking that Young prepare a U.S. application based on the Canadian application and claim the benefit of the Canadian filing. Young advises Xavier on the relative merits of filing a provisional versus a non-provisional application and Xavier decides to have Young initially file a provisional U.S. application. Young prepares the application and files it as a provisional application on Friday, January 19, 2001, claiming the benefit of the Canadian application. In August 2001, Young reminds Xavier that the filing was only provisional and that Xavier must decide whether to file a non-provisional application. In early January 2002, Xavier directs Young to get a non-provisional application, with a certified copy of the English language Canadian application, into the Office, which Young does on Friday January 11, 2002. Young files no other correspondence prior to the first Office action. Which of the following is true?

- (A) Because of the federal holiday, the filing of the non-provisional is timely to maintain a priority claim to the provisional application under 35 U.S.C. § 119(e), and therefore also to maintain a priority claim to the Canadian application filed less than 12 months before the initial US application.
- (B) If Young files the non-provisional application by converting the provisional application to a non-provisional application. The patent term will be measured from the date of conversion.
- (C) If Young files the non-provisional application by submitting a new application that claims the benefit of the provisional application and the Canadian application, in a first Office action rejection an examiner may apply a reference published September 19, 2000 as a prior art publication.
- (D) (A) and (B).
- (E) All of the above.

48. Engineers and scientists at Poly Tech Institute (PTI) have invented a new system for a wireless computer network. On November 9, 2001, they asked you to file a U.S. patent application for their invention. PTI is located in the United States, has an attendance of over 5,000 students, and (1) admits, as regular students, only persons having a certificate of graduation from a school providing secondary education, or the recognized equivalent of such a certificate, (2) is legally authorized within the jurisdiction in which it operates to provide a program of education beyond secondary education, (3) provides an educational program for which it awards a bachelor's degree or provides less than a 2-year program which is acceptable for full credit toward such a degree, (4) is a public institution, and (5) is accredited by a nationally recognized accrediting agency. You also find out that Poly Tech's research which led to the invention of the new system was funded by Atlantic Telcom Corporation (ATC) (a for profit corporation with over 500 employees and that does not meet the small business standard defined in 13 CFR 121) and a license agreement has been signed which would give ATC the right to participate in the prosecution of the patent application and also the right to make and use the invention, upon the payment of royalties, if the application ultimately issues as a patent. Based on the above facts, you should advise PTI that:

- (A) the application must be filed under large entity status because enrollment in the university exceeds 500.
- (B) the application must be filed under large entity status because PTI has entered into a license agreement.
- (C) the application may be filed under small entity status because the enrollment at PTI exceeds 5000 students.
- (D) the application may be filed under small entity status because PTI is an institution of higher education located in the United States.
- (E) None of the above.

49. Which of the following practices or procedures may be properly employed to overcome a rejection properly based on 35 U.S.C. § 102(e)?

- (A) Claiming priority under 35 U.S.C. § 119(a)-(d) based on a foreign application having a foreign priority filing date that antedates the reference.
- (B) Claiming priority under 35 U.S.C. §§ 119(e) or 120 by filing an application data sheet under 37 CFR 1.76 that contains a specific reference to the prior application in accordance with 37 CFR 1.78(a), where the prior application has a filing date prior to the reference.
- (C) Claiming priority under 35 U.S.C. §§ 119(e) or 120 by amending the specification of the application to contain a specific reference to a prior application having a filing date prior to the reference.
- (D) Amending the claims to patentably distinguish over the prior art.
- (E) (A), (B), (C), and (D).

50. 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.

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

APRIL 17, 2002

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*. Each question has only one most correct answer.. 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 that 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 that would make the statement *true*. If it is determined by the USPTO that there is more than one most correct answer to a question, each most correct answer will be accepted, but only one point will be given for the question. The presence of multiple most correct answers does not, in itself, render the question ambiguous. 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 statutes and rules that have been changed as a result of the enactment of the American Inventors Protection Act of 1999, Pub. L. No. 106-113 (“Act”). The 8th Edition of the Manual of Patent Examining Procedure should be used. The examination will apply rules that are in effect as April 1, 2002. The rule changes are posted under the heading “Recent Patent-Related Notices” on the USPTO web site (www.uspto.gov/web/offices/pac/dapp/ogsheet.html). A group of rule changes, published in 67 Federal Regulations 520 (January 4, 2002) under the name “Revision of the Time Limit for National Stage Commencement in the United States for Patent Cooperation Treaty Applications,” will be in effect on April 1, 2002. This rule change is also available at the USPTO web site cited above under the heading “Recent Patent Related Notices.”

1. Mr. Block, the inventor, files an application with the USPTO on January 2, 2001 containing a single claim for his invention: a new bouncing ball called “O.” As part of his duty of disclosure, he also files a copy of a written agreement that he and Mrs. Cone signed on January 2, 1998. The agreement states, in its entirety, that “Mr. Block will transfer my new bouncing ball ‘O’ to Mrs. Cone for experimental uses only to perfect the ball’s bounce. Mr. Block retains full control over the new bouncing ball ‘O.’” The primary examiner has no evidence that the ball was ever actually delivered to Cone.

On June 2, 2001, Block receives an Office action dated June 4, 2001 from the primary examiner. The examiner has rejected Block’s claim only under 35 U.S.C. § 102(b). The examiner explains in the Office action that “the 1998 written agreement signed by Block and Cone proves that the new bouncing ball ‘O’ was in public use more than one year prior to the January 2, 2001 filing date of the application.” Block believes he is entitled to a patent for his new bouncing ball “O.” How should Block respond to the rejection of his claim?

- (A) Block should give up because the agreement is dated more than one year before the filing date of the application and that is enough to statutorily bar Block from getting a patent under 35 U.S.C. § 102(b).
- (B) Block should respond by arguing that although the agreement was signed more than one year prior to the filing date of the application, it was never published and therefore cannot be relied upon as a “printed publication” under 35 U.S.C. § 102(b).
- (C) Block should respond by presenting evidence by way of an oath or declaration of experimental use and arguing that any use of the ball by Cone would have been experimental use, not “public” use.
- (D) Block should respond by arguing the agreement was signed by him, the same person who filed the application, which means that the invention was not “known or used by others in this country.”
- (E) Block should respond by arguing that even though the agreement may suggest that the ball was in use more than one year prior to the filing of the application, it does not indicate that the ball was put on sale in this country.

2. 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.

3. When filing a reissue application in November 2001 for the purpose of expanding the scope of the original patent claims, which of the following would not be in accordance with the USPTO rules of practice and procedure?

- (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) Applicant's intent to broaden the scope of the claims can be made known in a reissue application filed within 2 years of the patent grant date by presenting in the application when filed new or amended claims.
- (C) Any amendments made to the original patent by physically incorporating the changes within the specification or by way of a preliminary amendment must comply with the revised amendment practice of 37 CFR 1.121(b) and (c) and include appropriate "clean" and "marked-up" versions of the paragraphs or claims being amended.
- (D) Applicant's intent to broaden the scope of the claims can be made in a reissue application filed within 2 years of the patent grant date by specifying in the reissue declaration as one of the errors on which the reissue is based is that applicant claimed less than he had a right to claim.
- (E) None of the above.

4. 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 CFR 1.131 affidavit or declaration, it is sufficient to allege that applicant or patent owner has been diligent.
- (B) In a 37 CFR 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 CFR 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 CFR 1.131 affidavit or declaration, it is sufficient to show conception and reduction to practice in any country.
- (E) In a 37 CFR 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.

5. Regarding correction of inventorship in a pending application, where no waiver is granted, which of the following is not required under USPTO practice and procedure?

- (A) In connection with filing an amendment to correct inventorship in a nonprovisional application, seeking the deletion of one of the four co-inventors, because, in light of the cancellation of three claims, that inventor's invention is no longer being claimed, the submission of a statement from the person whose name is being deleted that there was no deceptive intent on his part in being named in the original application.
- (B) In connection with filing an amendment to correct inventorship in a provisional application, seeking the deletion of one of the four co-inventors, the submission of a statement from the person whose name is being deleted that there was no deceptive intent on his part in being named in the original application.
- (C) In connection with filing an amendment to correct inventorship by adding previously omitted inventors to a nonprovisional application that has been assigned, the submission of a written consent from the assignee.
- (D) In connection with filing an amendment to correct inventorship by adding previously omitted inventors to a provisional application, the submission of a statement that the inventorship error occurred without deceptive intention on the part of the omitted inventors.
- (E) In connection with filing an amendment to correct inventorship in a nonprovisional application involved in an interference, the submission of a motion under 37 CFR 1.634.

6. Patent practitioner files a patent application on behalf of inventors X, Y and Z. The patent application includes ten claims. X, Y and Z are joint inventors of the subject matter of claims 1-5. X and Y are joint inventor of the subject matter of claims 6-8. Y invented the subject matter of claim 9. Z is the inventor of the subject matter of claim 10. A patent examiner properly rejects independent claim 10 under 35 U.S.C. § 102(a) as anticipated by reference A, which is not a patent. In an attempt to overcome this rejection, a declaration that clearly antedates reference A is filed under 37 CFR 1.131. The declaration is signed by inventor Z, but not by X and Y. The declaration is:

- (A) improper because all named inventors of an application must sign a declaration filed under 37 CFR 1.131.
- (B) improper because the patent practitioner did not sign the declaration.
- (C) proper if it shows that inventor Z is the sole inventor of the subject matter of claim 10.
- (D) proper because 37 CFR 1.131 has no requirement on who must sign the declaration.
- (E) proper because 37 CFR 1.131 only requires that the declaration be signed by an inventor named in the application.

7. 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 CFR 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 CFR 1.53(c) falls on a Saturday, Sunday, or a Federal holiday in the District of Columbia.

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

- (A) Applicant can pay a fee to file an information disclosure statement pursuant to 37 CFR 1.97(c) that is less than the fee required to be paid by other than a small entity.
- (B) Applicant can file a Continued Prosecution Application (“CPA”) using 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 CPA.
- (C) Applicant can pay a fee to file a petition for revival of an unavoidably abandoned application under 35 U.S.C. § 111 that is less than the fee required to be paid by other than a small entity.
- (D) After issuance of a non-final first action, but before the close of the prosecution in a patent application, applicant may properly file a Request for Continued Examination and pay a fee that is less than the fee required to be paid by other than a small entity.
- (E) None of the above.

9. An applicant's claim stands rejected under 35 U.S.C. § 103 as being obvious over Larry in view of Morris. Larry and Morris are references published more than one year before applicant's effective filing. Although the examiner cites no suggestion or motivation for combining the references, they are, in fact, combinable. Which of the following arguments could properly show that the claim is not obvious?

- (A) The inventions disclosed by Larry and Morris cannot be physically combined.
- (B) Neither Larry nor Morris provides an express suggestion to combine the references.
- (C) As recognized by businessmen, the high cost of Larry's device teaches away from combining it with the simpler device of Morris.
- (D) Absent a suggestion or motivation, the examiner has not shown that combining Larry's with Morris's device would have been within the level of ordinary skill of the art.
- (E) None of the above.

10. 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.

11. While vacationing in Mexico on April 14, 2001, Henrietta invented a camera that operated at high temperature and is waterproof. She carefully documented her invention and filed a provisional application in the USPTO on April 30, 2001. She conducted tests in which the camera withstood temperatures of up to 350 degrees Fahrenheit. However, when the camera was placed in the water leaks were discovered rendering the camera inoperable. On April 12, 2002, Henrietta conceived of means that she rightfully believed will fix the leakage issue. Henrietta came to you and asked whether she can file another application. Henrietta desires to obtain the broadest patent protection available to her. Which of the following is the best manner in accordance with proper USPTO practice and procedure for obtaining the patent covering both aspects of her invention?

- (A) She can file a nonprovisional application on April 30, 2002 claiming benefit of the filing date of the provisional application, disclosing the means for fixing the leak and presenting a claim covering a camera that operates at high temperatures and a claim covering a camera that is waterproof, or presenting a claim covering a camera that both operates at high temperatures and is waterproof.
- (B) Henrietta cannot rightfully claim a camera that is waterproof in a nonprovisional application filed on April 30, 2002, since she tested the camera and the camera developed leaks.
- (C) Henrietta can file another provisional application on April 30, 2002 and obtain benefit of the filing of the provisional application filed on April 30, 2001.
- (D) Henrietta may establish a date of April 14, 2001 for a reduction to practice of her invention for claims directed to the waterproofing feature.
- (E) Henrietta should file a nonprovisional application on April 30, 2002 having claims directed only to a camera that withstands high temperatures since the camera that she tested developed leaks.

12. An applicant's claim stands rejected as being obvious under 35 U.S.C. § 103 over Lance in view of Barry. Lance and Barry are patents that issued and were published more than one year before applicant's effective filing date. Which of the following arguments could properly overcome the rejection?

- (A) Barry's device is too large to combine with Lance's device.
- (B) The Barry reference is nonanalogous art, because, although pertinent to the particular problem with which Lance was concerned, it relates to a different field of endeavor than the applicant's invention.
- (C) The combination of Lance and Barry would have precluded Lance's device from performing as Lance intended.
- (D) The Barry reference does not show all of the claimed elements arranged in the same manner as the elements are set forth in the claim.
- (E) All of the above.

13. 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).

14. On November 7, 2000, registered practitioner Toby files in the USPTO a utility patent application having only one claim. The USPTO sends Toby a non-final Office action dated May 11, 2001 setting a three month shortened statutory period for reply, and properly rejecting the claim under 35 U.S.C. § 102(b). On June 1, 2001, Toby learns about a publication (“the Jones reference”). Toby determines that the Jones reference is material to patentability of the claim, but the publication has not been considered by the examiner during prosecution of the application. Toby prepares a complete reply (“complete reply”) to the Office action dated May 11, 2001, pursuant to 37 CFR 1.111 traversing the rejection. Toby also prepares an information disclosure statement (“IDS”) that complies with the provisions of 37 CFR 1.98, listing the Jones reference. In accordance with USPTO rules and procedure, which of the following actions, if taken by Toby, will result in the examiner considering the Jones reference during prosecution of the application?

- (A) On July 2, 2001, submitting to the USPTO a request for continued examination (“RCE”) and fee for an RCE, with the complete reply and the IDS, but with neither the fee set forth in 37 CFR 1.17(p) nor the statement required by 37 CFR 1.97(e).
- (B) On October 12, 2001, submitting to the USPTO a request for continued examination (“RCE”) and fee for an RCE, with the complete reply and the IDS, but with neither the fee set forth in 37 CFR 1.17(p) nor the statement required by 37 CFR 1.97(e).
- (C) On October 12, 2001, submitting to the USPTO the complete reply and the IDS, but with neither the fee set forth in 37 CFR 1.17(p) nor the statement required by 37 CFR 1.97(e).
- (D) On July 2, 2001, submitting to the USPTO the complete reply and the IDS, and the fee set forth in 37 CFR 1.17(p), but without the statement required by 37 CFR 1.97(e).
- (E) None of the above.

15. Applicant files a preliminary amendment on Friday, March 2, 2001, in an application filed on November 6, 2000. In the preliminary amendment, applicant provides instructions to amend paragraph one of the specification to include a claim for priority to a previously filed U.S. patent application as required by 35 U.S.C. § 120. Applicant provides instructions to insert the priority claim in line one of paragraph one on page one of the specification. Applicant also directs that page 20 of the specification be replaced with a new page 20 supplied therewith and that claims 9 and 10 be cancelled. Upon receipt and review of the preliminary amendment in the Technology Center, wherein the application has been assigned, the designated USPTO Legal Instruments Examiner (LIE) mails applicant a Notice of Non-Compliant Amendment. Select from the following an answer that completes the following statement, such that the completed statement accords with proper USPTO practice and procedure: “Applicant has received the Notice of Non-Compliant Amendment _____”

- (A) in error because applicant’s preliminary amendment was filed in an application filed on November 6, 2000, which precedes the effective date, November 7, 2000, of the Patent Business Goals rules.
- (B) due to applicant’s failure to amend the specification at page one (1) and page 20 by providing a clean version of the paragraph(s), with no underlining or bracketing, with an instruction to substitute it for the pending paragraph(s), and an accompanying marked-up version of the paragraph(s) with all changes, relative to the prior paragraph(s), being shown by any conventional comparison system as required by 37 CFR 1.121(b).
- (C) due to applicant’s failure to provide a marked-up version of claims 9 and 10.
- (D) due only to applicant’s failure to amend the specification at page 20 by providing a clean version of the paragraph(s), with no underlining or bracketing, with an instruction to substitute it for the pending paragraph, and an accompanying marked-up version of the paragraph(s) with all changes, relative to the prior paragraph(s), being shown by any conventional comparison system as required by 37 CFR 1.121(b).
- (E) and now has a one month extendable time period in which to resubmit the preliminary amendment in compliance with revised 37 CFR 1.121. Extensions of time may be granted under 37 CFR 1.136.

16. 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. 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."
- (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.

17. It is a late spring day in 2001. Mr. Gordon bursts into your office. "I want you to get rid of my competitor's patents," shouts Mr. Gordon "They're no good. Look at these references! But I've got to tell the USPTO what's really going on." The first patent, P1, issued on March 6, 2001, based on an application filed on November 29, 1999. The second patent, R2, is a reissue, filed on January 3, 2000, of a patent issued in 1995. The third patent, P3, issued on March 6, 2001, based on an application filed in 1994. Mr. Gordon wants to participate as much as possible in the proceedings at the USPTO. Which of the following options should be followed to accomplish Mr. Gordon's objective?

- (A) File requests for inter partes reexaminations of P1, R2, and P3.
- (B) File requests for ex parte reexaminations of P1 and P3, and a request for inter partes reexamination of R2.
- (C) File requests for ex parte reexaminations of R2 and P3, and a request for inter partes reexamination of P1.
- (D) File requests for ex parte reexamination of P1, R2, and P3.
- (E) File requests for inter partes reexaminations of P1 and P3, and a request for ex parte reexamination of R2.

Questions 18 through 20 are based on the following factual background. Consider questions 18 through 20 independently of each other.

Roger Rocket is a designer of paper cups at Paper America. During his free time, he likes to attend baseball games at Yankee Stadium. One day, while seated in the stands, he caught a fly ball. He took the baseball home and played catch with his friends Andy Cannon, Orlando Torpedo, and Mariano Missile. Unfortunately for Rocket, Cannon has a problem with accuracy. Cannon threw the ball over Rocket's head and straight through a neighbor's front window. The shattered glass ripped the lining off of the baseball. Instantly, Rocket conceived a more durable baseball with an exterior similar to that of a golf ball. Rocket worked for months on his invention in Missile's garage. His new baseball was comprised of a titanium core, and a plastic shell having circular dimples and V-shaped laces. Torpedo realized and told Rocket that Y-shaped laces would enable baseball players to throw the ball faster. Cannon, an engineer in a radar gun laboratory, tested the velocity of the baseball with both V and Y-shaped laces. To Cannon's surprise, the baseball traveled 10 M.P.H. faster with the Y-shaped laces. Rocket wanted patent protection for a baseball having a titanium core, and a plastic shell having circular dimples and Y-shaped laces, so he approached Yogi Practitioner for assistance. Rocket has no obligation, contractual or otherwise, to assign his inventions to Paper America.

18. In accordance with proper USPTO practice and procedure, who should execute the oath?

- (A) Rocket
- (B) Rocket and Torpedo
- (C) Rocket and Cannon
- (D) Rocket, Torpedo, and Cannon
- (E) Rocket, Torpedo, Cannon, and Missile

19. Before executing the oath, Rocket wanted to ask Practitioner a question. On his way to Practitioner's office, Rocket was instantly killed when a drunk driver hit his car. The officers or employees of Paper America are not related to Rocket. Who can execute an oath on Rocket's behalf?

- (A) The President of Paper America
- (B) The CEO of Paper America
- (C) Rocket's manager at Paper America
- (D) Rocket's legal representative
- (E) None of the above

20. On October 12, 2001, Practitioner received all of the proper papers required to receive a filing date. However, due to an unexpected emergency, he had to fly out of the country that evening to conduct discovery in another matter. Practitioner knew that he would be out of the office for at least 4 weeks, so before leaving, he left a note instructing his assistant to file the Rocket application on October 13, 2001, using an Express Mailing label. His assistant did not see the note until 8:00 P.M. on Friday, October 19, 2001. On Monday, October 22, 2001, Rocket's assistant deposited the Rocket application in the United States Postal Service with a proper Express Mailing label. The Postal Service properly completed a legible label showing an October 22, 2001 date in. The correspondence was received in the USPTO on October 27, 2001. What is the filing date of the Rocket application absent any Postal Service Emergency?

- (A) October 12, 2001
- (B) October 13, 2001
- (C) October 19, 2001
- (D) October 22, 2001
- (E) October 27, 2001

21. 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.

22. Patentee, Iam Smarter, filed and prosecuted his own nonprovisional patent application on November 29, 1999, and received a patent for his novel cellular phone on June 5, 2001. He was very eager to market his invention and spent the summer meeting with potential licensees of his cellular phone patent. Throughout the summer of 2001, all of the potential licensees expressed concern that the claim coverage that Smarter obtained in his cellular phone patent was not broad enough to corner the market on this technology, and therefore indicated to him that they feel it was not lucrative enough to meet their financial aspirations. By the end of the summer, Smarter is discouraged. On September 5, 2001, Smarter consults with you to find out if there is anything he can do at this point to improve his ability to market his invention. At your consultation with Smarter, you learn the foregoing, and that in his original patent application, Smarter had a number of claims that were subjected to a restriction requirement, but were nonelected and withdrawn from further consideration. You also learn that Smarter has no currently pending application, that the specification discloses Smart's invention more broadly than he ever claimed, and that the claims, in fact, are narrower than the supporting disclosure in the specification. Which of the following will be the best recommendation in accordance with proper USPTO practice and procedure?

- (A) Smarter should immediately file a divisional application under 37 CFR 1.53(b) including the nonelected claims that were subjected to a restriction requirement in the nonprovisional application that issued as the patent.
- (B) Smarter should file a reissue application under 35 U.S.C. § 251, including the nonelected claims that were subjected to the restriction requirement in the nonprovisional application that issued as the patent.
- (C) Smarter should file a reissue application under 35 U.S.C. § 251, broadening the scope of the claims of the issued patent, and then file a divisional reissue application presenting only the nonelected claims that were subjected to a restriction requirement in the nonprovisional application which issued as the patent.
- (D) Smarter should simultaneously file two separate reissue applications under 35 U.S.C. § 251, one including broadening amendments of the claims in the original patent, and one including the nonelected claims that were subjected to a restriction requirement in the nonprovisional application which issued as the patent.
- (E) Smarter should file a reissue application under 35 U.S.C. § 251 on or before June 5, 2003, broadening the scope of the claims of the issued patent.

23. On September 12, 2001, Jill and Jack invent a new electrically charged brush that removes lint from black wool sweaters and coats. Jill and Jack draft a nonprovisional application and send it to the USPTO and the mailing envelope is postmarked September 13, 2001. They fail to use Express Mail and their application becomes delayed in the mail for over a month. The USPTO finally receives the Jill and Jack application on December 3, 2001. On September 14, 2001, Mike and Millie invent a new electrically charged brush that removes lint from black wool sweaters and coats. Mike and Millie had no knowledge of Jill and Jack and/or their invention on September 14, 2001. Mike and Millie draft a nonprovisional application and send it to the USPTO on September 15, 2001, using U.S. Postal Service Express Mail and include the Express Mail label number on the cover sheet of their application. The mailing envelope received by the U.S. Postal Service and the date-in is clearly marked on the Express Mail label as September 15, 2001. The application of Mike and Millie becomes delayed in the mail for two months. The USPTO receives the Mike and Millie application on December 5, 2001. Assume the inventions of Jill and Jack, and of Mike and Millie are the same. Also assume that no Postal Service Emergency was involved in the delivery of the mail. Which of the following is true?

- (A) The nonprovisional application of Mike and Millie will be accorded a filing date of September 15, 2001 upon receipt in the USPTO, and their filing date will be prior to that of Jill and Jack's application.
- (B) Since the time the application was lost in the mail was unforeseeable, Jill and Jack will be entitled upon petition the USPTO to the benefit of a filing date as of the time they mailed their application on September 13, 2001.
- (C) Since Jill and Jack were the first inventors, unless Jill and Jack draft their claims so as to read directly on or substantially for the same invention as Mike and Millie claim, both applications would issue as patents since the United States has a first to invent patent system.
- (D) The application for the invention of Jill and Jack will be accorded a September 13, 2001 filing date in the USPTO, since the postmark or date placed on the envelope by the U.S. Postal Service is the determinative date for the purposes of according a filing date.
- (E) Since the application of Mike and Millie sent by Express Mail was not received until December 5, 2001, Mike and Millie will need to certify that they mailed their application on September 15, 2001, before the USPTO will accord them a filing date of September 15, 2001.

24. In 1995 Patent Agent filed a U.S. patent application containing five claims (Application 1). All five claims are fully supported under 35 U.S.C. § 112 by the disclosure of Application 1. In 2000, Patent Agent filed a U.S. patent application (Application 2) that was a continuation-in-part of Application 1. Application 2 adds new subject matter to the disclosure of Application 1, and ten additional claims. Of the fifteen claims in Application 2, claims 1-5 are exactly the same as Application 1, claims 6-10 are fully supported under 35 U.S.C. § 112 by the disclosure of Application 1, and claims 11-15 are fully supported under 35 U.S.C. § 112 only by the newly added subject matter of Application 2. The effective filing date for claims in Application 2 is:

- (A) 1-15 is 2000.
- (B) 1-15 is 1995.
- (C) 1-10 is 1995.
- (D) 11-15 is 2000.
- (E) (C) and (D).

25. 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.

26. Jack Flash filed an application for patent on December 16, 1998, disclosing and claiming self-extinguishing safety candles, methods of making them, and a special reflective housing for holding the burning candles. Following a three-way restriction, Mr. Flash prosecuted the claims for the candle, and was granted a patent (“P1”), which issued on April 6, 1999. Mr. Flash filed a divisional application containing claims for the method of making the candles and for the reflective housing on April 5, 1999. The examiner did not restrict the claims, but before the first action on the merits was mailed, Mr. Flash suffered business reversals and canceled the claims to the reflective housing to reduce the cost of obtaining his patent. A patent on the method of making the candles (“P2”), issued on November 30, 1999. Although you reviewed and signed all of the papers in the prosecution of the applications, your assistant, Annie, did all the work under your supervision.

On April 1, 2001, Mr. Flash jumps into your office. He has just won a million dollars on some television game show you’ve never heard of, and he wants to “revive his patents.” He is also concerned about an article he tore out of the February 1986 issue of the trade publication Wicks and Sticks, that shows a drawing of a dissimilar candle that would nevertheless raise a question of patentability, with the caption “It’s just a dream: it can’t be made we’ve tried a thousand times, don’t bother.” He also has a video tape first sold by a local hobbyist at his store in October 1999, showing a process of candle making that may be within the scope of his process claims. “But it’s such a stupid way to do things - it’s expensive and it doesn’t work very well-it doesn’t even make a safety candle,” Jack shouts, jumping on your desk. He is so excited he can barely get the words out. Annie volunteers to work with him to figure out what he can do. On the next day, Friday, April 2, just as you are getting ready to close up and head for the LeTort Creek with your cane rod Annie drops five proposals on your desk. After reviewing Annie’s proposals, but before you leave, you must instruct her to take the action that will best protect Mr. Flash’s patent rights. Which of the following acts would be in accordance with proper USPTO practice and procedure, and Annie should be authorized to follow?

- (A) File a broadening reissue application on P1, alleging error in failing to claim sufficiently broadly by not filing claims for the reflective housing.
- (B) File a request for reexamination of P1 based on the Wicks and Sticks article.
- (C) File a new, nonprovisional patent application claiming benefit of the filing date of parent application that issued as patent P2.
- (D) File a request for reexamination of P2 in view of the video tape, intending to narrow the process claims to avoid the video tape if the USPTO finds a significant new question of patentability, and seeking to add claims to the reflective housing.
- (E) File a broadening reissue of P2, alleging error in claiming the process too broadly, because it covers the process disclosed on the video tape, and alleging further error in claiming less than the inventor had a right to claim, by not claiming the reflective housing.

27. Judy Practitioner is preparing the declaration form (PTO/SB/01) for her clients, inventors A and B, to sign prior to filing their utility patent application. Inventor A lives in California, and inventor B lives in Germany. Prior to sending declaration forms to the inventors, only inventor A had reviewed the final version of the application. Which of the following situations below would result in the declaration form(s) being compliant with 37 CFR 1.63(a) and (b)?

- (A) Judy mailed only a copy of the declaration form (PTO/SB/01), which identified the application and both inventors by their full names and citizenships, to inventor A with the instruction to return to her after he signs the declaration form. After inventor A returned the form, Judy then proceeded to mail out the declaration form to inventor B. After inventor B signed the declaration, Judy then attached the declaration, signed by both inventors, to the application and filed it with the USPTO.
- (B) Judy mailed to inventor A only a copy of the declaration form (PTO/SB/01) which identified the application and only inventor A's full name and citizenship. At the same time, Judy sent by facsimile to inventor B only a copy of the declaration form, which identified the application and only inventor B's full name and citizenship. Judy then attached both signed declaration forms to the patent application and filed it with the USPTO.
- (C) Judy sent by facsimile (e.g. fax) to inventor A only a copy of the declaration form (PTO/SB/01) which identified the application and both inventors by their full names and citizenships. At the same time, Judy mailed to inventor B a copy of the application and a copy of the declaration form, which identified the application and both inventors by their full name and citizenship. Judy then attached both signed declaration forms to the patent application and filed it with the USPTO.
- (D) Judy mailed only a copy of the declaration form (PTO/SB/01), which identified the application and both inventors by their full names and citizenships, to inventor A. Judy then attached the declaration, signed only by inventor A, to the application and filed it with the USPTO.
- (E) Judy files a petition under 37 CFR 1.48 just stating that inventor B's signature could not be obtained at this time, and files a copy of the declaration form (PTO/SB/01), which identified the application and both inventors by their full names and citizenships, signed by only inventor A.

28. 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.

29. On June 1, 2001, a redacted copy of a pending patent application is filed by the inventor, I. M. Abridged and is published pursuant to 35 U.S.C. § 122(b). J. Q. Practitioner has reason to believe that the application is still pending. J. Q. Practitioner is not an attorney or agent for I. M. Abridged. J. Q. Practitioner is entitled to see or obtain copies of which, if any, portions of the Abridged application?

- (A) J.Q. Practitioner may order only the redacted printed publication document since pending patent applications are otherwise preserved in confidence.
- (B) J.Q. Practitioner may order a copy of the redacted printed publication document, and inspect, but not copy, the file.
- (C) J.Q. Practitioner may inspect the contents of the entire patent application file and obtain copies thereof in addition to obtaining copies of the redacted application publication.
- (D) J.Q. Practitioner may inspect and obtain copies of only the redacted application and no other documents unless applicant I. M. Abridged supplied them in a redacted form.
- (E) J.Q. Practitioner may obtain a copy of the entire application and the file contents if applicant I. M. Abridged failed to submit redacted copies of those documents forming the subsequent prosecution history; otherwise, J.Q. Practitioner may obtain a copy of the redacted application including the redacted contents of the file.

30. 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 tables and chemical formulas.
- (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 graphical illustrations or flowcharts.
- (E) The specification may include a reservation for a future application of subject matter disclosed but not claimed in the application.

31. Applicant Smith filed a nonprovisional utility application on January 2, 2001 claiming the benefit of a prior provisional application filed January 3, 2000. He received a filing receipt with a projected publication date of July 5, 2001. He did not want his application to be published under the provisions of eighteen-month publication. On April 2, 2001, Applicant Smith asked you what is the best way to avoid pre-grant publication of his application with respect to proper USPTO procedure. Which of the following represents the best advice to Applicant Smith without forfeiting his patent rights if you are representing him?

- (A) File a nonpublication request that certifies that the invention disclosed in the nonprovisional application has not been and will not be the subject of an application filed in another country (or under international agreement) that requires eighteen-month publication.
- (B) File a petition to convert the nonprovisional application to a provisional application under 37 CFR 1.53(c)(2) accompanied by the petition fee, and then file a second non-provisional application with a nonpublication request that includes a proper certification, claiming the benefit of the prior provisional application under 35 U.S.C. § 119(e).
- (C) File a petition for express abandonment to avoid publication under 37 CFR 1.138(c) accompanied by the petition fee.
- (D) File (1) a continued prosecution application under 37 CFR 1.53(d) claiming the benefit of the prior applications under 35 U.S.C. §§ 119(e) and 120 with a nonpublication request that includes a proper certification, (2) a petition for express abandonment to avoid publication under 37 CFR 1.138(c) for the application filed on January 2, 2001, and (3) the required fees.
- (E) File (1) a continuing application under 37 CFR 1.53(b) claiming the benefit of the prior applications under 35 U.S.C. §§ 119(e) and 120 with a nonpublication request that includes a proper certification, (2) a petition for express abandonment to avoid publication under 37 CFR 1.138(c) for the application filed on January 2, 2001, and (3) the required fees.

32. On behalf of your client you have appealed to the Board of Patent Appeals and Interferences a final rejection of claims in the client's patent application. To request an oral hearing for the appeal, you must in a timely manner:

- (A) show that the hearing is necessary and desirable for a proper presentation of the appeal.
- (B) telephone the Board to schedule the hearing and pay the appropriate fee.
- (C) visit the Board to schedule the hearing and pay the appropriate fee.
- (D) confer with the examiner for a date, file a written request, and pay the appropriate fee.
- (E) file a written request and pay the appropriate fee.

33. 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.

34. On June 9, 1995 you filed a nonprovisional utility patent application on behalf of your client. On May 30, 2000, you have successfully obtained allowance of the claims, and you have paid the issue fee. After further discussions with your client you discover that the client would like to amend the claims by possibly adding new claims that are fully supported by the original disclosure. The new claims would likely be allowable over the prior art in the record. Shortly after paying the issue fee, but before issuance of a patent on the application, you file a request for continued examination along with a proposed amendment and the necessary fee. No other documents are filed. Have you done all that is necessary for your request for continued examination to be granted?

- (A) Yes, since prosecution was closed and your filing date was after June 8, 1995, you can file an RCE upon submitting a request, a submission and the proper fee.
- (B) No, because after the issue fee is paid, you cannot file an RCE unless you have successfully withdrawn the case from issue by petition under 37 CFR 1.313.
- (C) Yes, because the application had not yet been abandoned.
- (D) No, because the application was not a provisional application.
- (E) Yes, because the patent had not been issued at the time the request was filed.

35. Ramone filed a nonprovisional patent application in the USPTO on November 5, 1999. A patent was granted on the application on December 5, 2000. On January 5, 2001, Ramone files an application for reissue of the patent accompanied by an amendment enlarging the scope of the claims. On February 5, 2001, Ramone also files in the USPTO a copy of the application, as amended, in compliance with the Office electronic filing system requirements. Which of the following statements is true based upon proper USPTO practice and procedure?

- (A) The copy of the reissue application as amended is subject to pre-grant publication because it was supplied to the USPTO within one month of the actual filing date of the reissue application, i.e., within one month of January 5, 2001.
- (B) The copy of the reissue application as amended is subject to pre-grant publication because it was supplied to the USPTO within fourteen months of the filing date of the issued patent, i.e., within fourteen months of November 5, 1999.
- (C) The reissue application is subject to pre-grant publication because it was not accompanied by a nonpublication request at the time of filing.
- (D) The reissue application is exempt from pre-grant publication.
- (E) The reissue application unchanged by the amendment is subject to pre-grant publication.

36. 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.

37. Applicant Einstein files a patent application on November 26, 1999, that claims a new type of football pads. Prosecution is conducted and the application issues as a patent to Einstein on April 3, 2001. A competitor, Weisman, who has been making and selling football pads since April of 1998, learns of Einstein's patent when Einstein approaches him on May 3, 2001, with charges of infringement of the Einstein patent. Weisman makes an appointment to see you to find out what he can do about Einstein's patent, since Weisman believes that he is the first inventor of the claimed subject matter. At your consultation on May 17, 2001, with Weisman, you discover that Weisman widely distributed printed publications containing a fully enabling disclosure of the invention and all claimed elements in the Einstein patent. Weisman used the printed publication for marketing his football pads in April of 1998. Weisman explains that he wishes to avoid litigation. Which of the following is a proper USPTO practice and procedure that is available to Weisman?

- (A) Weisman should file a petition to correct inventorship under 37 CFR 1.324 in the patent, along with a statement by Weisman that such error arose without any deceptive intention on his part, requesting that a certificate of correction be issued for the patent under 35 U.S.C. §256, naming the correct inventive entity, Weisman.
- (B) Weisman should file a reissue application under 35 U.S.C. § 251, requesting correction of inventorship as an error in the patent that arose or occurred without deceptive intention, wherein such error is corrected by adding the inventor Weisman and deleting the inventor Einstein, as well as citing Joe Weisman's April 1998 printed publication for the football pads as evidence that Weisman is the correct inventor.
- (C) Weisman should file a prior art citation under 35 U.S.C. § 301, citing the sales in April 1998 of football pads, and explain the pertinency and manner of applying such sales to at least one claim of the Einstein patent.
- (D) Weisman should file a request for *ex parte* reexamination of the Einstein patent under 35 U.S.C. § 302, citing the April 1998 printed publication of football pads in, and explain the pertinency and manner of applying such prior art to at least one claim of the Einstein patent.
- (E) Weisman should file a request for *inter partes* reexamination of the Einstein patent under 35 U.S.C. § 311, citing public use of the football pads in April 1998, and explain the pertinency and manner of applying such prior use to at least one claim of the Einstein patent.

38. Which of the following can correct the inventorship of a patent application in accordance with proper USPTO practice and procedure?

- (A) An unexecuted nonprovisional application was filed January 3, 2001 naming Jones and Smith as inventors. Smith was named an inventor in error. A Notice to File Missing Parts of Application was mailed by the Office, that requested a surcharge and an executed oath or declaration under 37 CFR 1.63 by Jones and Smith. A registered practitioner in timely response to the Notice submitted the requested surcharge and a declaration under 37 CFR 1.63 that named only Jones as the inventor, which declaration was only executed by Jones. The registered practitioner had determined that a request to correct inventorship under 37 CFR 1.48(a) was unnecessary. No papers were submitted, by Smith, clarifying that she is not an inventor.
- (B) A nonprovisional application was filed January 3, 2001 with a declaration under 37 CFR 1.63 naming Jones and Smith as inventors, which declaration was signed only by Jones. Smith was named an inventor in error. A Notice to File Missing Parts of Application was mailed by the Office that requested a surcharge and an executed oath or declaration by Smith. A registered practitioner timely responded to the Notice by submitting the requested surcharge and a new declaration under 37 CFR 1.63 that identified Jones as the sole inventor, which declaration was executed only by Jones.
- (C) A nonprovisional application was filed February 28, 2000 that improperly named Jones as the sole inventor in a declaration under 37 CFR 1.63. Only Jones executed the declaration. Applicant need only re-file the application as a continued prosecution application naming the correct inventorship of Jones and Smith in the new application's transmittal letter.
- (D) A continuation application was filed under 37 CFR 1.53(b) using a copy of an executed declaration from the prior application for which a continuation was filed to correct the inventorship. The continuation application papers were accompanied by a request by a registered practitioner, in the continuation application transmittal paper, that Smith, named as an inventor in the prior application, be deleted as an inventor in the continuation application.
- (E) (A) and (D).

39. A nonprovisional application under 37 CFR 1.53(b) is filed with a check for the exact amount of a small entity basic filing fee. A registered practitioner's well trained legal assistant when filing the application forgot to also submit a written assertion of entitlement to small entity status that had been executed by the sole assignee who is a small entity. Which of the following is/are in accordance with proper USPTO practice and procedure?

- (A) Applicant need not supplement the initial filing with the omitted written assertion of small entity status as the payment of the small entity filing fee will suffice to accord small entity status.
- (B) If the application is allowed, applicant cannot pay the issue fee in the small entity amount unless the fee is accompanied by a written assertion of small entity status.
- (C) If after filing of the application small entity status becomes no longer appropriate, applicant may continue to pay small entity fees for newly added claims in a response to a first Office action rejection.
- (D) If the application is allowed, a registered practitioner could pay a small entity issue fee solely based on the assignee's written assertion of small entity status that was not originally submitted if the practitioner now submits it with the issue fee.
- (E) (A) and (C).

40. 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 the preceding claims, further comprising a pressure-sensing device connected to the base member.
- (D) 3. An apparatus as in any of the preceding claims, in which the circular back member is wooden.
- (E) None of the above.

41. Which of the following USPTO practices or procedures may be properly employed to overcome a rejection properly based on 35 U.S.C. § 102(b)?

- (A) Timely perfecting a claim to priority under 35 U.S.C. § 119(a)-(d) based on a foreign application having a foreign priority filing date that antedates the reference.
- (B) Filing a declaration under 37 CFR 1.131 that antedates the cited prior art.
- (C) Timely perfecting priority under 35 U.S.C. §§ 119(e) or 120 by amending the specification of the application to contain a specific reference to a prior application having a filing date that antedates the reference.
- (D) (A) and (C).
- (E) (A), (B) and (C).

42. 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.

43. On December 24, 2001, you were retained to file a U.S. nonprovisional patent application for inventions X, and Y. In preparing the U.S. patent application, you discovered that the same inventors filed an application for invention X in Germany on December 28, 2000 and an application for inventions X and Y in France on March 13, 2001. The German application was never published and was abandoned on July 2, 2001. What is the latest date you could file a U.S. patent application at the USPTO to properly have the right of priority for the inventions disclosed in the U.S. patent application?

- (A) December 27, 2001 (Thursday)
- (B) December 28, 2001 (Friday)
- (C) January 2, 2002 (Wednesday)
- (D) March 12, 2002 (Tuesday)
- (E) March 13, 2002 (Wednesday)

44. A U.S. patent application discloses an adhesive composition described as useful for causing a football to stick to human skin. The application discloses that the composition is made of known materials in equal amounts by weight of A and B. The application discloses that A must be at a temperature between 10 and 30 degrees Celsius, and that B can be either of known materials X or Y. The application discloses that by adding different effective amounts of known material C to the composition, the composition's stickiness or hardness can be changed. In one example, the application discloses an effective amount of material C that can be added to the composition to increase stickiness of the composition. The application also discloses in another example a different effective amount of material C that must be added to the composition to increase the composition's hardness. The effective amounts of material C used in the two examples differ, and the examples describe the effective amounts. Which of the following claims, included in the application, complies with the requirements of 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 101?

- (A) Claim 1. A process for using a composition to cause a football to stick to human skin.
- (B) Claim 2. A composition comprising equal amounts by weight of A and B, wherein A is at a temperature between 10 and 30 degrees Celsius, and B is X or Y.
- (C) Claim 3. A composition comprising equal amounts by weight of A and B, and an effective amount of C, wherein A is at a temperature between 10 and 30 degrees Celsius.
- (D) Claim 4. A composition comprising equal amounts by weight of A and B, wherein A is at a temperature between 10 and 30 degrees Celsius, preferably between 15 and 20 degrees Celsius.
- (E) Claim 5. A composition comprising equal amounts by weight of A and B and a process of using the composition to cause a football to stick to human skin.

45. 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).

46. 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.

47. Practitioner prepared a patent application containing a table of 52 pages and a computer program listing of 360 lines (up to 72 characters per line). The application is sent via the U.S. Mail to the USPTO. Which of the following identifies the proper submission using electronic media in accordance with USPTO rules and procedure?

- (A) The computer program listing must be submitted on a duplicate set of compact discs, while the table may be submitted on a duplicate set of compact discs.
- (B) The computer program listing may be submitted on a magnetic floppy disc and the rest of the application must be submitted on paper.
- (C) The computer program listing and the table may be submitted on a magnetic floppy disc, magnetic tape or paper.
- (D) The table must be submitted, and optionally the computer program listing may be submitted, on either magnetic floppy disc, compact disc, magnetic tape.
- (E) The entire application may be sent on a single copy of a compact disc.

48. On March 29, 2002, you received a Notice of Allowability (PTO-37) and Notice of Allowance (PTOL-85) on the first application that you filed as a registered practitioner. The Notice of Allowability and the Notice of Allowance were dated March 26, 2002, and mailed from the USPTO on March 26, 2002. Each notice set a three month period for reply. The Notice of Allowability indicated that new drawings were required to incorporate the proposed drawing correction you filed with your reply to the final Office action. The Notice of Allowance indicated that you must pay the issue fee and publication fee. What is the latest date you could file new drawings to prevent the abandonment of the application?

- (A) June 25, 2002 (Tuesday).
- (B) June 26, 2002 (Wednesday).
- (C) July 29, 2002 (Monday), with a petition for a one-month extension of time.
- (D) August 26, 2002 (Monday), with a petition for a two-month extension of time.
- (E) September 25, 2002 (Wednesday), with a petition for a three-month extension of time.

49. On January 2, 2001, Mr. Star filed a patent application naming Mr. Stripe, Ms. Ross and Mr. Flag as joint inventors using the Express Mail service of the United States Post Office. The filing fee was included with the application on filing. The application that was filed on January 2, 2001 was not filed with an executed declaration, but the transmittal letter for the application clearly identified Stripe, Ross and Flag as joint inventors. On February 15, 2001, a "Notice to File Missing Parts of Application" was mailed, requiring an executed oath or declaration, and a surcharge for their late filing. Star mailed a copy of a blank declaration naming Stripe, Ross and Flag as joint inventors and a copy of the application papers (specification, claims and drawings) to each named inventor. Ross and Flag contact Star and inform him that Stripe was not an inventor. Stripe does not reply and Star is unable to reach Mr. Stripe. Star investigates the matter, and determines that the correct inventorship is Ross and Flag. Which of the following should be filed in reply to the Notice, together with a surcharge?

- (A) A declaration under 37 CFR 1.63 that names Stripe, Ross, and Flag as inventors, and is signed by Ross and Flag.
- (B) A request to delete Mr. Stripe as an inventor under 37 CFR 1.48 and an executed declaration signed by Ross and Flag.
- (C) A petition under 37 CFR 1.47 to accept a declaration under 37 CFR 1.63 signed by Ross and Flag, but without the signature of Stripe.
- (D) A declaration under 37 CFR 1.63 that names only Ross and Flag as inventors, and is signed by Ross and Flag.
- (E) A request to hold the requirements of the notice in abeyance pending further inquiry into the inventorship.

50. 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.

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

OCTOBER 16, 2002

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*. Each question has only one most correct answer. 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 that 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 that would make the statement *true*. If it is determined by the USPTO that there is more than one most correct answer to a question, each most correct answer will be accepted, but only one point will be given for the question. The presence of multiple most correct answers does not, in itself, render the question ambiguous. 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

1. In accordance with the MPEP and USPTO rules and procedure, an application for patent may be made on behalf of a joint inventor in certain situations. Who, by petition, may make application on behalf of a joint inventor who has refused to sign the application (“nonsigning inventor”), if the other joint inventor (“signing inventor”) executes the application?

- (A) A person other than the signing inventor, to whom the nonsigning inventor has assigned the invention.
- (B) A person other than the signing inventor, with whom the nonsigning inventor has agreed in writing to assign the invention.
- (C) The signing inventor.
- (D) A person other than the signing inventor, who shows a strong proprietary interest in the invention.
- (E) All of the above.

2. To satisfy the written description requirement of the first paragraph of 35 USC 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.

3. Which of the following is not in accordance with the recommended format for a claim set forth in the provisions of the MPEP?

- (A) Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation.
- (B) A claim may include plural indentations to further segregate subcombinations or related steps.
- (C) The claim or claims must commence on a separate sheet after the detailed description of the invention.
- (D) Each claim should end with a period.
- (E) A claim should always begin with “A”, “An” or “In.”

4. 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.

5. Where a final rejection of claims has been made, any question of prematureness of the final rejection should be raised, if at all:

- (A) as a ground of appeal.
- (B) as the basis of a complaint before the Board of Patent Appeals and Interferences.
- (C) by petition under 37 CFR 1.181 while the application is pending before the examiner.
- (D) after 2 months from the examiner’s answer plus mail room time, if no reply brief has been timely filed during an appeal to the Board of Patent Appeals and Interferences.
- (E) after a supplemental examiner’s answer, pursuant to a remand from the Board of Patent Appeals and Interferences has been mailed.

6. 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 USC 102(d) based on a foreign patent granted in a non-WTO country.
- (C) A rejection properly made under 35 USC 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 USC 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.

7. Paul, a registered patent practitioner and counsel for Superior Aircraft, Inc. (“Superior”), filed a patent application naming chief engineer Davis as sole inventor, and claiming a titanium and aluminum alloy designed for use in advanced gas turbine engines in aircraft. The application described the alloy as having unexpectedly excellent and improved room temperature ductility. The application was filed with an assignment document transferring all right, title and interest in the application to Superior. During prosecution of the application, the examiner had an interview with Paul and Davis of Superior. The examiner noted the existence of a prior art publication that disclosed test data demonstrating that the claimed alloys exhibited poor room temperature ductility, and stated that he had personal knowledge that the alloy was old and well known. Davis agreed with the examiner, and stated that such information was “old hat,” but that they overcame the ductility problem by simply resorting to a 3-step process of microstructure refinement. Paul concurred and pointed to the fact that not only had they disclosed the process in the application, but that microstructure refinement of alloys to improve ductility was so well-known that the technique was even taught in metallurgy courses in college. Which of the following statements is false?

- (A) The examiner may reject the alloy claims on the basis of the prior art publication.
- (B) The examiner may not reject the alloy claims on the basis of the prior art publication, because the alloys of the application are characterized by unexpected, improved ductility properties.
- (C) The examiner may rely upon the chief engineer’s statement as an admission against patentability.
- (D) The examiner may rely upon the patent counsel’s statement as an admission against patentability.
- (E) The examiner, having facts within his or her personal knowledge, may rely on the facts in rejecting the alloy claims.

8. The MPEP and USPTO rules and procedure provide for ways that a nonstatutory double patenting rejection can be overcome. Which of the following is an effective way to overcome a nonstatutory double patenting rejection?

- (A) Filing a 37 CFR 1.131 affidavit to swear behind the patent on which the rejection is based.
- (B) Filing a terminal disclaimer under 37 CFR 1.321(c).
- (C) Filing a 37 CFR 1.131 affidavit arguing that the claims are for different inventions that are not patentably distinct.
- (D) Filing a reply arguing that there is only one common inventor regarding the claims of the application and the claims of the patent.
- (E) All of the above.

9. Which of the following is not in accordance with the provisions of the MPEP?

- (A) The title of the invention should be placed at the top of the first page of the specification unless it is provided in the application data sheet.
- (B) The title need not be technically accurate, but should be descriptive and should contain fewer than 10 words.
- (C) Inasmuch as the words “improved,” “improvement of,” and “improvement in” are not considered as part of the title of an invention, these words should not be included at the beginning of the title of the invention and will be deleted when the Office enters the title into the Office’s computer records, and when any patent issues.
- (D) If a satisfactory title is not supplied by the applicant the examiner may, at the time of allowance, change the title by examiner’s amendment. If the change to the title is the only change being made by the examiner at the time of allowance, a separate examiner’s amendment need not be prepared and the examiner is to indicate the change in title in the file.
- (E) A title in a U.S. application need not be identical to the corresponding foreign filed application.

10. 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.

11. In accordance with MPEP § 1500, relating to design patent applications:
- (A) the invention may be properly represented in a single application by both an ink drawing and a black and white photograph.
 - (B) the invention may be properly represented in a single application by a black and white photograph disclosing environmental structure by broken lines, in lieu of an ink drawing if the invention is shown more clearly in the photograph.
 - (C) the invention may be properly represented in a single application by both an ink drawing and a color photograph, and the application should be accompanied by the required petition, fee, three sets of color photographs, and an amendment to the specification.
 - (D) the invention may be properly represented by a color photograph disclosing environmental structure by broken lines, in lieu of an ink drawing if the invention is not capable of being illustrated in an ink drawing.
 - (E) the invention may be properly represented by a color photograph if the invention is not capable of being illustrated in an ink drawing, and if the application is accompanied by the required petition, fee, and an amendment to the specification is presented to insert required language regarding the color photographs, and three sets of color photographs.

12. Inventor A filed a patent application and assigned the entire interest in the application to his employer, MegaCorp. The application issued as a utility patent on July 9, 2002. In June 2004, MegaCorp's management first learns that a second inventor, Inventor B, should have been named as a co-inventor with respect to at least one claim of the issued patent. There was no deceptive intent in failing to name Inventor B in the original application. Inventor A, who is unfamiliar with patent law and concepts of inventorship, incorrectly believes that he should be the sole named inventor on the patent, and refuses to cooperate with any effort by MegaCorp to change the named inventive entity. The issued patent contains no other error. In accordance with the Manual of Patent Examining Procedure, which of the following procedures is/are available for MegaCorp to seek correction of the named inventive entity without any agreement, cooperation or action from Inventor A?

- (A) File, on or before July 9, 2004, a reissue application, made by MegaCorp only, that seeks to add Inventor B.
- (B) File, after July 9, 2004, a reissue application, made by MegaCorp only, that seeks to add Inventor B.
- (C) Request a Certificate of Correction to add Inventor B as a named inventor.
- (D) Submit in the issued patent file: a Request for Correction of Inventorship Under the Provisions of 37 CFR 1.48 that sets forth the desired inventorship change; a statement by Inventor B that the error in inventorship occurred without deceptive intention on her part; an oath or declaration executed by Inventor B; all required fees; and the written consent of MegaCorp.
- (E) A and B are each available procedures.

13. Which of the following statements concerning reliance by an examiner on common knowledge in the art, in a rejection under 35 USC 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.

14. 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 USC 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 USC 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 USC 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 USC 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.

15. The MPEP and USPTO rules and procedure provide for ways that a statutory double patenting rejection can be overcome. Which of the following is an effective way to overcome a statutory double patenting rejection?

- (A) Filing a 37 CFR 1.131 affidavit to swear behind the patent on which the rejection is based.
- (B) Filing a terminal disclaimer under 37 CFR 1.321(c).
- (C) Filing a 37 CFR 1.131 affidavit and arguing that the conflicting claims are coextensive in scope.
- (D) Amending the conflicting claims so that they are not coextensive in scope.
- (E) All of the above.

16. Applicant received a final rejection dated and mailed Wednesday, February 28, 2001. The final rejection set a three month shortened statutory period for reply. In reply, applicant filed an amendment on Wednesday, March 21, 2001. In the amendment, applicant requested that block diagrams, figures 32-34, be amended by inserting the term - -computer- - in place of [CPU] in block “2” of each block diagram. Applicant further supplied a clean version of the entire set of pending claims. Applicant did not provide the proposed changes to the drawings on separate sheets marked in red nor did the applicant supply a marked-up version of any claim. The examiner upon receipt and review of the amendment discovered that the applicant made changes to pending claims 2 and 15 and that the applicant added claims 21-25 to the application. The examiner in an Advisory Action notifies the applicant that the amendment fails to comply with the requirements of 37 CFR 1.121. Which of the following answers is most correct?

- (A) Applicant is given a time period of one month or thirty days from the mailing date of the Advisory Action, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. This time period is in addition to any remaining period of time set in the final rejection.
- (B) Applicant may not provide a clean version of the entire set of pending claims because the applicant may only consolidate all previous versions of pending claims into a single clean version in an amendment after a non-final Office action.
- (C) Applicant must submit the proposed changes to figures 32-34 on a separate paper showing the proposed changes in red and a marked up version of new claims 21-25 as required by 37 CFR 1.121(c).
- (D) Applicant should request reconsideration by the examiner, pointing out that the Final Rejection was mailed on February 28, 2001, which precedes the March 1, 2001 effective date of the changes to patent rule 37 CFR 1.121.
- (E) Applicant must submit the changes to figures 32-34 on separate paper showing the proposed changes in red and a marked up version of rewritten claims 2 and 15 showing all changes (relative to the previous version of claims 2 and 15) shown by any conventional marking system as required by 37 CFR 1.121(c). Applicant should also indicate the status of claims 2 and 15, e.g. “amended,” “twice amended,” etc. on both the clean version of the claims and the marked up version.

17. Which of the following statements is true?

- (A) In the context of 35 USC 102(b), a magazine need only be placed in the mail to be effective as a printed publication.
- (B) The earliest date declassified printed material may be taken as *prima facie* evidence of prior knowledge under 35 USC 102(a) is as of the date the material is cataloged and placed on the shelf of a public library.
- (C) Declassified printed material is effective as a printed publication under 35 USC 102(b) as of the date of its release following declassification.
- (D) The American Inventors Protection Act (AIPA) amended 35 USC 102(e) to provide that U.S. patents, U.S. application publications, and certain international application publications can be used as prior art under 35 USC 102(e) based on their earliest effective filing date only against applications filed on or after November 29, 2000.
- (E) The American Inventors Protection Act (AIPA) amended 35 USC 102(e) to provide that U.S. patents, U.S. application publications, and certain international application publications can be used as prior art under 35 USC 102(e) based on their earliest effective filing date only against applications filed prior to November 29, 2000 which have been voluntarily published.

18. While traveling 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. 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.

19. Which of the following is not in accordance with the provisions of the MPEP Chapter 600?

- (A) A request for a refund must be filed within two years from the date the fee was paid or, in the case of a fee paid by mistake, within one year from the time the error was discovered.
- (B) A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid, including an application, an appeal or a request for an oral hearing, will not entitle a party to a refund of such fee.
- (C) The Office will not refund amounts of twenty-five dollars or less, unless a refund is specifically requested.
- (D) Any refund of a fee paid by credit card will be by a credit to the credit card account to which the fee was charged.
- (E) When a fee is paid where no fee is required, this is considered to be a fee paid by mistake.

20. 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).

21. Which of the following documents is not open to public inspection?

- (A) The abandoned parent application of a divisional application. A patent was granted on the divisional application, which refers to the abandoned parent application.
- (B) Assignment document relating to both an issued patent and a patent application not published under 35 USC 122(b).
- (C) Assignment document relating to a pending reissue application.
- (D) Copy of assignment record relating to both a pending patent application and an abandoned patent application not published under 35 USC 122(b).
- (E) Assignment document relating to both an abandoned patent application not published under 35 USC 122(b) and a pending reissue application.

22. Which of the following is not in accordance with provisions of the MPEP?
- (A) In return for a patent, the inventor gives a complete disclosure of the invention for which protection is sought.
 - (B) Amendments filed after the filing date that lack descriptive basis in the original disclosure involve new matter.
 - (C) If during the course of examination of a patent application, an examiner notes the use of language that could be deemed offensive to any race, religion, sex, ethnic group, or nationality, he or she should object to the use of the language as failing to comply with the Rules of Practice.
 - (D) The examiner should object to application drawings that include depictions or caricatures that might reasonably be considered offensive to any race, religion, sex, ethnic group or nationality.
 - (E) Where an amendment is filed with a patent application that has no signed oath or declaration, a subsequently filed oath or declaration must refer to both the application and amendment, but in any case the amendment will not be considered as part of the original disclosure and will be treated as new matter.
23. Which of the following is the best way to recite a claim limitation so that it will be interpreted by the examiner in accordance with 35 USC 112, paragraph 6?
- (A) dot matrix printer for printing indicia on a first surface of a label.
 - (B) dot matrix printer means coupled to a computer.
 - (C) means for printing indicia on a first surface of a label.
 - (D) printer station for printing indicia on a first surface of a label.
 - (E) All of the above.
24. Which of the following is not in accordance with Office practice under 35 USC 42?
- (A) The Director may refund any fee paid by mistake or any amount paid in excess of that required.
 - (B) A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent for which the fee was paid, including an application, an appeal or a request for an oral hearing, will not entitle a party to a refund of such fee.
 - (C) Even if an applicant specifically requests a refund, the Office will not refund amounts of twenty-five dollars or less.
 - (D) Any refund of fee paid by credit card will be by a credit to the credit card account to which the fee was charged.
 - (E) If an applicant mistakenly files an application, the filing fee is not considered a fee paid by mistake.

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

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

26. Which of the following is not in accordance with the recommended form for an abstract of the disclosure as provided for in the MPEP?

- (A) A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains.
- (B) If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure.
- (C) If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement.
- (D) In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or a use thereof.
- (E) The abstract should compare the invention with the prior art.

27. 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 USC 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.

The following facts apply to Questions 28 and 29.

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.

28. 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.

29. Which of the following, if relied on by an examiner in a rejection of claim 2, can be a statutory bar under 35 USC 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.

30. In accordance with the MPEP, and USPTO rules and procedure, a patent application may be made by someone other than the inventor in certain situations. In which of the following situations would an application not be properly made by someone other than the inventor?

- (A) The inventor is deceased, and the application is made by the legal representative of the deceased inventor.
- (B) The inventor is deceased, and the application is made by one who has reason to believe that he or she will be appointed legal representative of the deceased inventor.
- (C) The inventor is a minor (under age 18) who understands and is willing to execute the declaration, but the application is made by the minor's legal representative.
- (D) The inventor is insane, and the application is made by the legal representative of the insane inventor.
- (E) The inventor is legally incapacitated, and the application is made by the legal representative of the legally incapacitated inventor.

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. A product-by-process claim is properly rejected over a reference under 35 USC 102(b). Which of the following statements is incorrect?

- (A) There is no anticipation unless each of the process steps recited in the claim is disclosed or inherent in the applied reference.
- (B) If the applied reference reasonably indicates that a product disclosed therein is the same or substantially the same as the claimed product, the burden shifts to the applicant to provide evidence to the contrary.
- (C) The rejection cannot be overcome by evidence of unexpected results.
- (D) The rejection can be overcome by evidence that the product in the reference does not necessarily or inherently possess a characteristic of the applicant's claimed product.
- (E) An affidavit or declaration under 37 CFR 1.131 cannot overcome a proper rejection under 35 USC 102(b) over a reference.

33. Xavier files a complete first reply exactly 2 months after the mailing date of a final Office action which sets a 3 month shortened statutory period for reply. An Examiner's Amendment is necessary for the purpose of placing the application in condition for allowance. Which of the following statements is true?

- (A) If the Examiner's Amendment is mailed exactly 5 months after Xavier's reply, the application will be allowed.
- (B) The Examiner's Amendment must be made within the 3 month shortened statutory period of the final Office action to avoid abandonment of the application.
- (C) If the Examiner's Amendment is made exactly 4 months after Xavier's reply, the application will be allowed.
- (D) The Examiner's Amendment may be made at any time within 6 months of Xavier's reply to avoid abandonment.
- (E) Abandonment of the application will be avoided if Xavier accompanies his reply with a request for extension of time accompanied by the proper fee and the Examiner's Amendment is made within 6 months of Xavier's reply.

34. Jane files a nonprovisional application with the USPTO containing at least one drawing figure under 35 USC 113 (first sentence) and at least one claim. Subsequently, Jane receives a "Notice of Omitted Items" from the USPTO indicating that the application which Jane filed lacks page 5 of the specification. Assuming that the application without page 5 satisfies 35 USC 112, which of the following statements is true based on proper USPTO practice and procedure?

- (A) If Jane is willing to accept the application as filed, she need not respond to the Notice, and the Office will accord the filing date of the original application. Jane will need to file an amendment renumbering the pages consecutively and canceling incomplete sentences caused by the missing page 5.
- (B) Jane must promptly submit the omitted page and accept an application filing date as of the date of submission of the omitted page.
- (C) Jane must promptly submit the omitted page and will be accorded a filing date as of the date of filing the original application.
- (D) Within 3 months of the Notice date, Jane must file an affidavit asserting that page 5 was in fact deposited in the USPTO with the original application. Jane will be accorded the filing date of the original application.
- (E) Within 3 months of the Notice date, Jane must file a proper petition asserting that page 5 was in fact deposited in the USPTO with the original application, accompanied by the proper petition fee and evidence that page 5 was in fact deposited as alleged. Jane will be accorded the original filing date of the application.

35. Where subject matter for which there is an enabling disclosure, but is not shown in the drawing or described in the detailed description preceding the claim(s), which of the following is not in accordance with the provisions of the MPEP?

- (A) In establishing a disclosure, applicant may rely not only on the description and drawing as filed but also on the original claims to show compliance with the first paragraph of 35 USC 112.
- (B) Where subject matter not shown in the drawing or described in the description is claimed in the application as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits, and the applicant should be required to amend the drawing and description to show this subject matter.
- (C) If subject matter appearing in the original claim is not found in the drawing or detailed description, the claim should be rejected for noncompliance with the first paragraph of 35 USC 112.
- (D) If the subject matter found in the claim is lacking in the drawing or detailed description, it is the drawing and description that are defective, not the claim.
- (E) The subject matter found in the original claims, but lacking in the drawing or detailed description, must be sufficiently specific and detailed to support an amendment of the drawing and detailed description.

36. 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 consisting of the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (B) 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.
- (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).

37. Which of the following is not in accordance with the provisions of the MPEP regarding an abstract of the disclosure?

- (A) The abstract of the disclosure has been interpreted to be a part of the specification for the purpose of compliance with paragraph 1 of 35 USC 112.
- (B) Any submission of a new abstract of the disclosure or amendment to an existing abstract should be carefully reviewed for introduction of new matter.
- (C) If an application is otherwise in condition for allowance except that the abstract of the disclosure does not comply with the guidelines, the examiner generally cannot make any necessary revisions by examiner's amendment, but should instead issue an *Ex parte Quayle* action requiring applicant to make the necessary revisions.
- (D) Under current practice, in all instances where the application contains an abstract of the disclosure when sent to issue, the abstract will be printed on the patent.
- (E) The content of a patent abstract should be such as to enable the reader thereof, regardless of his or her degree of familiarity with patent documents, to ascertain quickly the character of the subject matter covered by the technical disclosure and should include that which is new in the art to which the invention pertains.

38. Applicant files an application claiming a nutritional supplement comprising ingredients (1) through (9) on September 6, 2001. The examiner's search on November 12, 2001 retrieved several documents, each of which provides an enabling disclosure of a nutritional supplement comprising ingredients (1) through (9). Which of the following documents retrieved by the examiner may be properly used by the examiner to reject applicant's claims under 35 USC 102(b)?

- (A) An advertisement in the September 2000 issue of Dieticians and Nutritionists Health Weekly where the examiner is not able to determine the actual date of publication.
- (B) A printout on November 12, 2001 by the examiner of a MEDLINE database abstract 123456 of an article by Food et al., "Nutritional supplements for infants," published in Azerbaijan Pediatrics, Vol. 33, No. 8, pp. 33-37 (September 2000). The printout does not include the date on which the MEDLINE abstract was publicly posted.
- (C) A printout, on November 12, 2001 by the examiner, of a product brochure from the Internet website of PRO-BIOTICS VITAMIN CORP. The examiner determines that the brochure was posted on September 7, 2000 on the website.
- (D) A Japanese patent application published on September 1, 2000.
- (E) All of the above.

39. Which of the following is not in accordance with the provisions in the MPEP?
- (A) A continuation-in-part is an application filed during the lifetime of an earlier nonprovisional application by the same applicant, which repeat either some substantial portion or all of the earlier nonprovisional application, and adds matter not disclosed in the said earlier nonprovisional application.
 - (B) A continuation-in-part application may only be filed under 37 CFR 1.53(b).
 - (C) A continuation-in-part application cannot be filed as a continued prosecution application (CPA) under 37 CFR 1.53(d).
 - (D) An application claiming the benefits of a provisional application under 35 USC 119(e) should not be called a “continuation-in-part” of the provisional application.
 - (E) One of the formal requirements of 35 USC 120 is that a continuation-in-part application must be “filed before a notice of allowance or abandonment is mailed in the prior application.”
40. Which of the following is not a USPTO recommendation or requirement?
- (A) Product and process claims should be separately grouped.
 - (B) Claims should be arranged in order of scope so that the first claim presented is the least restrictive.
 - (C) Every application should contain no more than three dependent claims.
 - (D) A claim which depends from a dependent claim should not be separated from that dependent claim by any claim which does not also depend from the dependent claim.
 - (E) Each claim should start with a capital letter and end with a period.
41. 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.

42. Absent a Certificate of Mailing or Transmission, or use of Express Mail, which of the following actions requires a petition for an extension of time and the appropriate fee?

- (A) Applicant's complete first reply to a final Office action filed on the first day following the end of a shortened statutory period for reply. The Shortened Statutory Period ended on a Wednesday that was not a federal holiday, and the Office is open.
- (B) Interview with examiner conducted after the expiration of the shortened statutory period for reply to a final Office action, but within the 6 months statutory period.
- (C) Action by applicant to correct formal matters identified for the first time after a reply was made to a final Office action in an *Ex parte Quayle* action where the application is otherwise in condition for allowance.
- (D) Applicant's complete first reply to a final Office action filed within 2 months of the final Office action setting a 3 month shortened statutory period for reply.
- (E) Applicant's complete first reply to an Office action on the last day of a shortened statutory period for reply, where the Office action withdraws the finality of a previous Office action in view of a new ground of rejection.

43. 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 USC 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 USC 112, second paragraph, and not reject the claim as obvious.
- (D) When evaluating claims for obviousness under 35 USC 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).

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

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

45. John filed a nonprovisional patent application in the USPTO claiming two distinct inventions, a combination and a subcombination. At the time of filing the nonprovisional application, he recorded an assignment of all right, title, and interest in the inventions claimed in the application to ABC Corporation. In the first Office action, the examiner required restriction, and John elected the combination. A year later, during the pendency of the nonprovisional application, John filed a divisional patent application claiming the subcombination. At the time of filing the divisional application, John assigned all right, title, and interest in the inventions claimed in the divisional application to XYZ Corporation, and the latter party recorded the assignment within three months of the assignment. Following recordation of the assignment to XYZ Corporation, which of the following statements is false?

- (A) The Office should treat John as having no ownership rights in the combination.
- (B) The Office should treat John as having no ownership rights in the subcombination.
- (C) ABC Corporation has no ownership rights in the subcombination.
- (D) XYZ Corporation has no ownership rights in the combination.
- (E) XYZ Corporation has no ownership rights in the subcombination.

46. Which of the following statements relevant to a third party submission in a published patent application accords with proper USPTO practice and procedure?

- (A) A submission of patents by a member of the public must be made within 2 months of the date of publication of the application.
- (B) A submission of patents by a member of the public must be made prior to the mailing of a Notice of Allowance.
- (C) A submission of patents by a member of the public must be made within 2 months of the date of publication of the application or prior to the mailing of a Notice of Allowance, whichever is later.
- (D) A submission of patents by a member of the public must be made within 2 months of the date of publication of the application or prior to the mailing of a Notice of Allowance, whichever is earlier.
- (E) Any submission not filed within the period set forth in the patent rules will be accepted provided it is accompanied by the processing fee set forth in 37 CFR 1.17(i).

47. 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.

48. The MPEP and USPTO rules and procedure set out factual inquiries that are employed when making an obviousness-type double patenting analysis. Which of the following is not a factual inquiry that would be properly employed when making an obviousness-type double patenting determination with regard to a pending application vis-a-vis a claim in an issued patent?

- (A) Determine the level of ordinary skill in the pertinent art.
- (B) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue.
- (C) Evaluate any objective indicia of nonobviousness of the claim of the application at issue.
- (D) Determine the differences between the scope and content of: the patent claim and the prior art determined in choice (B) above and the claim in the application at issue.
- (E) None of the above (that is, each of the above factual inquiries is properly employed when making an obviousness-type double patenting determination with regard to an issued patent).

49. In accordance with the MPEP and USPTO rules and procedure, correspondence transmitted to the USPTO by facsimile is not permitted in certain situations. Which of the following facsimile transmissions to the USPTO will be accorded a date of receipt by the USPTO?

- (A) Facsimile transmission of a request for reexamination under 37 CFR 1.510 or 1.913.
- (B) Facsimile transmission of drawings submitted under 37 CFR 1.81, 1.83 through 1.85, 1.152, 1.165, 1.174, or 1.437.
- (C) Facsimile transmission of a response to a Notice of Incomplete Nonprovisional Application for the purpose of obtaining an application filing date.
- (D) Facsimile transmission of a correspondence to be filed in a patent application subject to a secrecy order under 37 CFR 5.1 through 5.5 and directly related to the secrecy order content of the application.
- (E) Facsimile transmission of a continued prosecution application under 37 CFR 1.53(d) and an authorization to charge the basic filing fee to a deposit account.

50. If a reissue application is filed within two years of the original patent grant, the applicant may subsequently broaden the claims during prosecution of the pending reissue prosecution beyond the two year limit, _____.

- (A) if the applicant indicates in the oath accompanying the reissue application that the claims will be broadened.
- (B) if an intent to broaden is indicated in the reissue application at any time within three years from the patent grant.
- (C) if the reissue application is filed on the 2-year anniversary date from the patent grant, even though an intent to broaden the claims was not indicated in the application at that time.
- (D) if the reissue application is a continuing reissue application of a parent reissue application, and neither reissue application contained an indication of an intent to broaden the claims until 4 years after the patent grant..
- (E) provided, absent any prior indication of intent to broaden, an attempt is made to convert the reissue into a broadening reissue concurrent with the presentation of broadening claims beyond the two year limit.

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

OCTOBER 16, 2002

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*. Each question has only one most correct answer. 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 that 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 that would make the statement *true*. If it is determined by the USPTO that there is more than one most correct answer to a question, each most correct answer will be accepted, but only one point will be given for the question. The presence of multiple most correct answers does not, in itself, render the question ambiguous. 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

1. Which of the following is not in accordance with the provisions of the MPEP?
- (A) Where joint inventors are named, the examiner should not inquire of the patent applicant concerning the inventors and the invention dates for the subject matter of the various claims until it becomes necessary to do so in order to properly examine the application.
 - (B) Under 35 USC 119(a), the foreign priority benefit may be claimed to any foreign application that names a U.S. inventor as long as the U.S. named inventor was the inventor of the foreign application invention and 35 USC 119(a)-(d) requirements are met.
 - (C) Where two or more foreign applications are combined in a single U.S. application, to take advantage of the changes to 35 USC 103 or 35 USC 116, the U.S. application may claim benefit under 35 USC 119(a) to each of the foreign applications provided all the requirements of 35 USC 119(a)-(d) are met.
 - (D) One of the conditions for benefit under 35 USC 119(a) is that the foreign application must be for the same or a nonobvious improvement of the invention described in the United States application.
 - (E) If a foreign application for which priority is being claimed under 35 USC 119 is filed in a country which does not afford similar privileges in the case of applications filed in the United States or to citizens of the United States and the foreign country is not a WTO member country, any claim for the foreign priority thereto by a U.S. application will not be effective.
2. 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 CFR 1.131 affidavit or declaration, it is sufficient to allege that applicant or patent owner has been diligent.
 - (B) In a 37 CFR 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 CFR 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 CFR 1.131 affidavit or declaration, it is sufficient to show conception and reduction to practice in any country.
 - (E) In a 37 CFR 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.

3. Which of the following establishes a statutory bar under 35 USC 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.

4. A patent examiner resigned from the USPTO on June 7, 2001, and returned to Sheboygan, Wisconsin. The next day, on June 8, 2001, the former examiner signed up for a one week seminar entitled, "How to Become Rich Without Really Working." During the seminar, the sponsors offered the former examiner a golden opportunity to purchase a 10% interest in a U.S. patent application that they stated is "guaranteed to produce significant royalties and give her a 1000% return on her investment." Soon after attending the seminar, the former examiner became a registered practitioner. Which of the following accords with proper practice and procedure?

- (A) The former examiner may accept the offer, but only if an ownership interest in the application is transferred to the former examiner by an instrument in writing.
- (B) The former examiner can accept the offer, but only if an ownership interest in the application is transferred to the former examiner by an instrument in writing, which is made of record in the assignment records of the USPTO.
- (C) The former examiner can accept the offer, but only if an ownership interest in the application is transferred to the former examiner by an instrument in writing, which is made of record in the file of the application.
- (D) The former examiner should accept the offer, but only if an ownership interest in the application is transferred to the former examiner by an instrument in writing, and the original or a true copy of the original instrument, in writing, is made of record in the assignment records of the USPTO and in the file of the application.
- (E) The former examiner cannot accept the offer because she is incapable of acquiring an interest in the application at that time under the circumstances.

5. In accordance with the MPEP and USPTO rules and procedure, certain individuals owe a duty to the USPTO to disclose all information known to be material to patentability of the claim(s) pending in an application. Which of the following parties does not have the duty?

- (A) An inventor named in the application who relies on a patent attorney to prepare and prosecute the application.
- (B) A corporation to which an assignment of the entire interest in the application is on record at the USPTO.
- (C) An agent who prepares the application.
- (D) An attorney who prosecutes the application.
- (E) A person, who is not an inventor named in the application, who is substantively involved in the preparation and prosecution of the application, and who is associated with an inventor named in the application.

6. 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 CFR 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.

7. 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.

8. 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 USC 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.

9. 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.

10. Which of the following is true?
- (A) There is no practical difference between an objection and rejection of a claim.
 - (B) If the form of the claim (as distinguished from its substance) is improper, an objection is made.
 - (C) An objection, if maintained by an examiner, is subject to review by the Board of Patent Appeals and Interferences.
 - (D) An example of a proper objection is where the claims are refused because they fail to comply with the second paragraph of 35 USC 112.
 - (E) An example of a proper rejection is a rejection of a dependent claim for being dependent on a claim that has been rejected only over prior art, where the dependent claim is otherwise allowable.
11. Which of the following practices or procedures may be properly employed to overcome a rejection properly based on 35 USC 102(e)?
- (A) Persuasively arguing that the claims are patentably distinguishable from the prior art.
 - (B) Filing an affidavit or declaration under 37 CFR 1.132 showing that the reference invention is not by “another.”
 - (C) Filing an affidavit or declaration under 37 CFR 1.131 showing prior invention, if the reference is not a U.S. patent that either claims the same invention or claims an obvious variation of the subject matter in the rejected claim(s).
 - (D) (A) and (C).
 - (E) (A), (B) and (C).
12. In accordance with the MPEP and USPTO rules and procedure, a joint inventor on behalf of himself or herself and a nonsigning joint inventor in certain circumstances may make a patent application. Which of the following is an acceptable reason for filing an application with a declaration signed by a joint inventor, who is not the legal guardian of the other joint inventor, on behalf of himself and the nonsigning joint inventor?
- (A) The nonsigning joint inventor refuses to join in the application.
 - (B) The nonsigning joint inventor is on vacation and is temporarily unavailable to sign the declaration.
 - (C) The nonsigning joint inventor is hospitalized and is temporarily unavailable to sign the declaration.
 - (D) The nonsigning joint inventor is out of town and is temporarily unavailable to sign the declaration.
 - (E) All of the above.

13. Which of the following is in accordance with the practice and procedures of Chapter 600 of the MPEP and/or 37 CFR 1.52(c)?

- (A) Handwritten alterations to the claims in a newly filed patent application should be dated and initialed or signed by the applicant on the same sheet of paper.
- (B) The Office will consider evidence of whether noninitialed and/or nondated alterations were made before or after the signing of the oath or declaration rather than require a new oath or declaration.
- (C) Any alteration to a patent application made by the applicant may be made after the application was signed and sworn to.
- (D) Non-initialed or non-dated handwritten alterations to the claims on an application filed in the USPTO are considered to be a minor informality. Thus, the Office personnel should not object to the same.
- (E) It is proper for an applicant to sign an oath or declaration even when the oath or declaration (i) does not identify a patent application or (ii) is not attached to or physically located together with the patent application.

14. Which of the following timely actions should you take to accord maximum patent protection at minimum government fees for your client whose invention is described in a provisional patent application that was filed 6 months ago with no claim?

- (A) File a request to convert the provisional application to a nonprovisional application, accompanied by a proper executed declaration, an amendment including at least one claim as prescribed by paragraph 2 of 35 USC 112 and the proper fee set forth in 37 CFR 1.17(i).
- (B) File a request to convert the provisional application to a nonprovisional application, accompanied by a proper executed declaration, an amendment including at least one claim as prescribed by paragraph 2 of 35 USC 112, the proper fee set forth in 37 CFR 1.17(i), and the basic filing fee for the nonprovisional application.
- (C) File a request to convert the provisional application to a nonprovisional application, accompanied by a proper executed declaration, an amendment including at least one claim as prescribed by paragraph 2 of 35 USC 112, the proper fee set forth in 37 CFR 1.17(i), the basic filing fee for the nonprovisional application, and the surcharge required by 37 CFR 1.16(e).
- (D) File a nonprovisional application including at least one claim accompanied by a proper executed declaration, and the basic filing fee. The application contains a specific reference to the provisional application in compliance with 37 CFR 1.78(a)(5).
- (E) File a nonprovisional application including at least one claim accompanied by a proper executed declaration but without the basic filing fee. The application contains a specific reference to the provisional application in compliance with 37 CFR 1.78(a)(5).

15. 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 USC 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 circumference 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.

16. 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.

17. 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 the preceding claims, further comprising a pressure-sensing device connected to the base member.
- (D) 3. An apparatus as in any of the preceding claims, in which the circular back member is wooden.
- (E) None of the above.

18. 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.

19. 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 USC 101 also creates a deficiency under 35 USC 112, first paragraph.
- (B) To overcome a rejection under 35 USC 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 USC 101 as lacking utility if the particular embodiment disclosed in the patent lacks perfection or performs crudely.
- (D) To overcome a rejection under 35 USC 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.

20. The specification in your client's patent application has been objected to for lack of enablement. To overcome this objection, your client may do any of the following except:

- (A) traverse the objection and specifically argue how the specification is enabling.
- (B) traverse the objection and submit an additional drawing to make the specification enabling.
- (C) file a continuation-in-part application that has an enabling specification.
- (D) traverse the objection and file an amendment without adding new matter in an attempt to show enablement.
- (E) traverse the objection and refer to prior art cited in the specification that would demonstrate that the specification is enabling to one of ordinary skill.

21. In accordance with the MPEP and USPTO rules and procedure, an applicant for a patent dissatisfied with the primary examiner's decision may appeal to the Board of Patent Appeals and Interferences ("the Board") in certain situations. In which of the following situations may the applicant properly appeal to the Board?

- (A) Applicant's claims have been twice objected to, but have not been rejected.
- (B) Applicant's claims have been rejected once in a non-final Office action during examination of a parent application, and once in a non-final Office action during examination of a continuing application.
- (C) Applicant's claims in an original application have been rejected only once.
- (D) Applicant's claims have been objected to only once, and have been rejected only once in a non-final Office action.
- (E) All of the above.

22. Which of the following is in accordance with the provisions in the MPEP?
- (A) In order to correct inventorship in a nonprovisional application where the statement of the lack of deceptive intent is not available from an inventor to be added, a petition under 37 CFR 1.181 may be properly filed.
 - (B) If a person A learns that a patent application has been filed by person B without naming A as coinventor, A may file in the USPTO a petition that protests inventorship and directs B to add A's name as a coinventor to the patent application.
 - (C) If the application is involved in an interference, and a petition under 37 CFR 1.48 is filed to correct inventorship, the Board of Patent Appeals and Interferences will remand the case to the primary examiner for consideration of the petition to ensure that a search of the relevant prior art is performed.
 - (D) When a second conversion under 37 CFR 1.48(a) is attempted by the practitioner, the conversion decision will be decided by the Technology Center Director.
 - (E) None of the above.
23. Which of the following statements relating to design patents does not accord with proper USPTO practice and procedure?
- (A) Both design and utility patents may be obtained on an article if the invention resides both in its utility and ornamental appearance.
 - (B) The design for an article consists of the visual characteristics embodied in or applied to an article.
 - (C) Design patent applications are included in the Patent Cooperation Treaty (PCT), and the procedures followed for PCT international applications are to be followed for design patent applications.
 - (D) A claim directed to a computer-generated icon shown on a computer screen complies with the "article of manufacture" requirement of 35 USC 171.
 - (E) A claimed design may encompass multiple articles or multiple parts within an article.
24. A claim, as required by the second through fifth paragraphs of section 112, shall not be required in a _____ patent application.
- (A) reissue
 - (B) design
 - (C) continuation
 - (D) provisional
 - (E) plant

25. Applicant Jones filed a request for a first continued prosecution application (CPA) on December 29, 2000 in a utility application that was filed on April 28, 2000. Jones received a final Office action mailed on June 28, 2001. In response, Jones filed an amendment amending the claims in the first CPA. Jones received an advisory action on September 27, 2001 stating that the proposed amendment to the first CPA would not be entered because it raises new issues that would require further consideration. Additionally, the proposed amendment did not meet the requirements for a complete reply under 37 CFR 1.111. On December 28, 2001, Jones filed a petition for a 3-month extension of time with appropriate petition fee, a request for a second continued prosecution application, a request for suspension of action, and appropriate processing fee for the request for suspension of action. No application filing fee was filed with the request for the second CPA. Which of the following would be a proper communication mailed by the Office based on Jones' actions?

- (A) A Notice of Allowability.
- (B) A Notice to File Missing Parts.
- (C) A first Office action on the merits.
- (D) A notice of improper Request for Continued Examination (RCE) and a notice of abandonment.
- (E) A letter granting the suspension of action.

26. 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. 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."
- (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.

27. Adams filed Application X on March 1, 2001. Beth filed application Y on May 1, 2001. Neither application has been published. Applications X and Y are copending and commonly assigned. Earlier filed application X claims the same invention as claimed in application Y using identical language. In accordance with the MPEP, which of the following actions should the examiner or assignee follow?

- (A) The claims to the same invention in application Y should be rejected under 35 USC 102(a) as being anticipated by application X.
- (B) The claims to the same invention in application Y should be rejected under 35 USC 102(b) as being anticipated by application X.
- (C) The claims to the same invention in application Y should be rejected under 35 USC 102(e) as being provisionally anticipated by application X.
- (D) The common assignee should file a terminal disclaimer in application Y to avoid any question of double patenting.
- (E) The claims to the same invention in application Y should be rejected under 35 USC 102(e) as being anticipated by application X.

28. Which of the following is not in accordance with the provisions of 35 USC 115 (Oath of applicant)?

- (A) The applicant shall make oath (or declaration) that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent.
- (B) In the oath or declaration, the applicant must state of what country he is a citizen.
- (C) An oath may be made before any person within the United States authorized by law to administer oaths.
- (D) An oath executed in a foreign country must be properly authenticated.
- (E) A declaration which accompanies a patent application must state on the document a warning that willful false statements and the like are punishable by fine or imprisonment or both under 18 USC 1001, and the declaration must be notarized.

29. 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.

30. The MPEP sets forth a procedure whereby an examiner may contact an applicant to discuss election of claims after the examiner determines that a restriction requirement should be made. Assume that a primary examiner contacts a practitioner representing applicant by telephone prior to any Office action on the merits, and the examiner orally makes a restriction requirement. During the telephone conversation, the practitioner orally makes an election of claims without traverse. On examination, the examiner finds the elected claims to be allowable. Which of the following would be improper for the examiner to include in a letter to the practitioner attached to a Notice of Allowability?

- (A) A cancellation of the non-elected claims.
- (B) A statement that the prosecution is closed.
- (C) A statement that a Notice of Allowance will be sent in due course.
- (D) A statement that the applicant's election is not upheld because an election must only be made in writing, and cannot be made by telephone.
- (E) All of the above.

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

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

32. Which of the following practices or procedures may be properly employed to overcome a rejection properly based on 35 USC 102(a)?

- (A) Perfecting a claim to priority under 35 USC 119(a)-(d) based on a foreign application having a foreign priority filing date that antedates the reference.
- (B) Filing a declaration under 37 CFR 1.131 showing that the cited prior art antedates the invention.
- (C) Filing a declaration under 37 CFR 1.132 showing that the reference invention is by "others."
- (D) Perfecting priority under 35 USC 119(e) or 120 by, in part, amending the declaration of the application to contain a specific reference to a prior application having a filing date prior to the reference.
- (E) (A), (B) (C), and (D).

33. Xavier files a complete first reply exactly 10 weeks after the mailing date of a final Office action that sets a 3 month shortened statutory period for reply. An Examiner's Amendment is necessary for the purpose of placing the application in condition for allowance. Which of the following statements is true?

- (A) If Xavier gives authorization for the Examiner's Amendment exactly 2 months after his reply, the application will be allowed.
- (B) Authorization for the Examiner's Amendment may be made at any time within 6 months of Xavier's reply to avoid abandonment of the application..
- (C) Unless Xavier gives authorization for the Examiner's Amendment within the 3 months shortened statutory period for reply, the application will be abandoned.
- (D) If Xavier gives authorization for the Examiner's Amendment exactly 2 months after his reply, the application will be abandoned unless accompanied by a proper petition and fee for an extension of time.
- (E) Abandonment of the application will be avoided if Xavier gives authorization for the Examiner's Amendment any time within 6 months of the mail date of a final Office action. No extension of time need be filed if Xavier gives the authorization between 3 months and 6 months after the Office action.

34. On Monday, May 13, 2002, John's secretary deposited in an "Express Mail" drop box prior to the last scheduled pick-up for that day, an envelope properly addressed to the USPTO for delivery to the USPTO by the "Express Mail Post Office to Addressee" service. The envelope was received by the USPTO on Wednesday, May 15, 2002, containing a reply to an Office action which set a shortened statutory period ("SSP") for reply ending on Tuesday, May 14, 2002. The reply was marked by the Office as being received on May 15, 2002. The number of the "Express Mail" mailing label had not been placed on the response papers, and upon receipt of the "Express Mail" mailing label John learned that the "date in" was not clearly marked. John promptly filed a petition requesting the filing date to be the date of deposit. The petition included a showing that the date of deposit accompanied by evidence of USPS corroboration of the deposit. Accordingly,

- (A) The reply will be regarded as timely filed in the USPTO on May 15, 2002.
- (B) The reply will be regarded as timely filed in the USPTO on May 14, 2002.
- (C) The reply will be regarded as timely filed in the USPTO on May 13, 2002.
- (D) The reply will be regarded as timely filed in the USPTO if a petition with proper fee for a one month extension of time is filed in the USPTO on or before June 14, 2002.
- (E) The reply will be regarded as timely filed in the USPTO if the number of the "Express Mail" mailing label is placed on each page of a copy of the original response and hand carried to the USPTO on May 15, 2002, rather than being sent by "Express Mail."

35. Which of the following is not in accordance with the provisions of the MPEP?
- (A) If there is a discrepancy between the information submitted in an application data sheet and the information submitted elsewhere in the application, the application data sheet will control except for the naming of the inventors and the citizenship of the inventors, which is governed by the oath or declaration.
 - (B) A patent examiner should object to text of a patent application if it contains an embedded hyperlink and /or other form of browser-executable code.
 - (C) All patent applicants should use the English units of measurement followed by the equivalent metric units when describing their inventions in the specifications of patent applications.
 - (D) The paper used for patent applications must have a surface such that amendments may be written thereon in ink; so-called “Easily Erasable” paper having a special coating so that erasures can be made more easily may not provide a permanent copy as is required.
 - (E) The following documents may be submitted to the Office on a compact disc: a computer program listing, a sequence listing, and a table that has more than 50 pages of text.

36. The USPTO notifies John, a registered patent agent who is representing applicant A, that after a reasonable search, the USPTO has been unable to locate applicant A’s patent application. By which of the following procedures may John avoid abandonment of applicant A’s application within the time period set by the USPTO?

- (A) Provide the USPTO with a copy of his record of all the correspondence between his office and the USPTO, assuming the existence of such record.
- (B) Provide the USPTO with a list of all the correspondence between his office and the USPTO, assuming the existence of such list, and a statement that the list is complete and accurate.
- (C) Provide the USPTO with a statement that he does not possess any record of the correspondence between his office and the USPTO because his files were destroyed.
- (D) Provide the USPTO with a record of all the correspondence between his office and the USPTO, and a statement that the papers produced are his complete record of all the correspondence between his office and the USPTO, assuming the existence of such record.
- (E) Provide the USPTO with a copy of his record of all the correspondence between his office and the USPTO, assuming the existence of such record, a list of all such correspondence, and a statement that he is not aware of any correspondence between his office and the USPTO that is not among his records.

37. Which of the following is not in accordance with the recommended characteristics set forth in the MPEP for the detailed description of the invention?

- (A) The detailed description of the invention must include a description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71.
- (B) The detailed description should be as short and specific as is necessary to describe the invention adequately and accurately.
- (C) Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described, and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail.
- (D) The detailed description of the invention may include reference characters to the parts of the invention that do not appear in the drawings.
- (E) Where particularly complicated nonessential subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, absent disclosure elsewhere in the application, the specification should refer to another patent or readily available publication that adequately describes the subject matter.

38. 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 USC 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 USC 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 USC 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 USC 112.

39. Which of the following is not in accordance with the recommended characteristics set forth in the provisions of the MPEP for the summary of the invention?

- (A) The summary is separate and distinct from the abstract and is directed toward the disclosure as a whole, rather than just the invention.
- (B) The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention).
- (C) In chemical cases the summary should point out in general terms the utility of the invention.
- (D) If possible, the summary should set forth the nature and gist of the invention or the inventive concept should be set forth.
- (E) Any stated objects of the invention should be treated briefly in the summary and only to the extent that they contribute to an understanding of the invention.

40. Which of the following does 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.

41. In 1995 Patent Agent filed a U.S. patent application containing five claims (Application 1). All five claims are fully supported under 35 USC 112 by the disclosure of Application 1. In 2000, Patent Agent filed a U.S. patent application (Application 2) that was a continuation-in-part of Application 1. Application 2 adds new subject matter to the disclosure of Application 1, and ten additional claims. Of the fifteen claims in Application 2, claims 1-5 are exactly the same as Application 1, claims 6-10 are fully supported under 35 USC 112 by the disclosure of Application 1, and claims 11-15 are fully supported under 35 USC 112 only by the newly added subject matter of Application 2. The effective filing date for claims in Application 2 is:

- (A) 1-15 is 2000.
- (B) 1-15 is 1995.
- (C) 1-10 is 1995.
- (D) 11-15 is 2000.
- (E) (C) and (D).

42. Evidence of unexpected results is relied upon to overcome a *prima facie* case of obviousness. Which of the following is incorrect?

- (A) The evidence must compare the claimed invention to the closest prior art.
- (B) The evidence must be commensurate in scope with the claims.
- (C) Data relied upon to show unexpected results need not cover the full range of the claims if one of ordinary skill in the art could ascertain a trend in the data that would allow that person to reasonably extend the probative value of the data to the full scope of the claims.
- (D) Unexpected results can be shown by factual evidence or, if no factual evidence is available to the applicant, by sound argument by the applicant's agent or attorney.
- (E) The evidence need not be in an affidavit or declaration under 37 CFR 1.132 if the evidence is presented in the specification of an application to which the applicant has attested.

43. 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.

44. The procedures in the MPEP do not require an applicant claiming foreign priority in a nonprovisional utility application to:

- (A) submit the processing fee set forth in 37 CFR 1.17(i) if the claim for priority or submission of the certified copy of the priority document is made after payment of the issue fee and before the patent is granted.
- (B) identify the foreign application for which priority is being claimed as well as any foreign application for the same subject matter having a filing date before that of the application for which priority is being claimed.
- (C) file the claim in the application.
- (D) have the same inventive entity listed in the foreign application as in the U.S. application in which the priority claim has been filed.
- (E) identify the intellectual property authority or country in or for which the foreign application was filed.

45. In accordance with Chapter 100 of the Manual of Patent Examining Procedure and 35 USC 122, which of the following statements is not true?

- (A) All requests for reexamination and related patent files are available to the public subject to the availability of the reexamination file.
- (B) The Board of Patent Appeals and Interferences handles all petitions for access to applications involved in an interference.
- (C) An abandoned application referenced in a U.S. patent application publication, U.S. patent or a U.S. application that is open to public inspection may be ordered for inspection by any member of the public.
- (D) The assignee of record of a part interest in an application may always intervene in the prosecution of the application, appointing a registered attorney or agent of his or her own choice, without participation by any or all other assignees.
- (E) All provisional patent applications are screened upon receipt in the USPTO for subject matter that, if disclosed, might impact the national security, and such applications are referred to appropriate agencies for consideration of restrictions on disclosure of the subject matter.

46. Which of the following statements does not accord with proper USPTO practice and procedure?

- (A) A protest may be filed by an attorney or other representative on behalf of an unnamed principal.
- (B) Information which may be relied on in a protest includes information indicating violation of the duty of disclosure under 37 CFR 1.56.
- (C) While a protest must be complete and contain a copy of every document relied on by the protestor, a protest without copies of prior art documents will not necessarily be ignored.
- (D) A protest must be submitted prior to the date the application was published or the mailing of a notice of allowance, whichever occurs later, provided the application is pending.
- (E) Since a protestor is not authorized to participate in the prosecution of a pending application, the examiner must not communicate in any manner with the protestor.

47. A registered practitioner's client, Apex Mfg. Corporation, bought the entire assets of Pinnacle Mfg. Corporation. Pinnacle gave Apex a list of its patent applications but did not maintain records of the patent assignments. Apex wishes to know which of the assignment documents, if any, of the pending patent applications in Pinnacle's patent portfolio were never recorded. In accordance with the MPEP, which of the following actions could the practitioner rely upon to most expeditiously answer this question?

- (A) Request certified copies of the patent applications as filed.
- (B) Request certified copies of the assignment documents of record of the patent applications.
- (C) Request certified copies of the patent applications as filed accompanied by the fees set forth in 37 CFR 1.19(b)(1)(i).
- (D) Request certified copies of the patent applications as filed accompanied by the fees set forth in 37 CFR 1.19(b)(1)(ii).
- (E) Request certified copies of the assignment documents of record of the patent applications accompanied by the fees set forth in 37 CFR 1.19(b)(5).

48. In accordance with the MPEP and USPTO rules and procedure, a registered attorney or agent may be appointed to prosecute a patent application for an applicant. In which of the following situations will the USPTO not recognize the appointment of an attorney or agent to prosecute a patent application for an applicant?

- (A) The principal agent of record appoints a registered associate attorney to prosecute the application.
- (B) The applicant executes a power of attorney naming only a law firm to prosecute the application.
- (C) The applicant executes a power of attorney appointing more than one registered individual to prosecute the application.
- (D) The principal attorney of record appoints an associate registered agent to prosecute the application.
- (E) The assignee of the entire interest of record, who has established the right to prosecute the patent application, executes a power of attorney appointing a registered attorney to prosecute the patent application.

49. 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.

50. An applicant's claim stands rejected under 35 USC 103 as being obvious over Larry in view of Morris. Larry and Morris are references published more than one year before applicant's effective filing. Although the examiner cites no suggestion or motivation for combining the references, they are, in fact, combinable. Which of the following arguments could properly show that the claim is not obvious?

- (A) The inventions disclosed by Larry and Morris cannot be physically combined.
- (B) Neither Larry nor Morris provides an express suggestion to combine the references.
- (C) As recognized by businessmen, the high cost of Larry's device teaches away from combining it with the simpler device of Morris.
- (D) Absent a suggestion or motivation, the examiner has not shown that combining Larry's with Morris's device would have been within the level of ordinary skill of the art.
- (E) None of the above.

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