

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

APRIL 15, 2003

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. 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, USPTO rules, and the procedures set forth in the Manual of Patent Examining Procedure (MPEP). 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.**

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1. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following statements is most correct?

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

2. A registered practitioner filed in the USPTO a client’s utility patent application on December 30, 2002. The application was filed with a request for nonpublication, certifying that the invention disclosed in the U.S. application has not and will not be the subject of an application in another country, or under a multilateral international agreement, that requires eighteen month publication. Subsequently, the client files an application in Japan on the invention and some recent improvements to the invention. The improvements are not disclosed or supported in the utility application. Japan is a country that requires eighteen month publication. Two months after filing the application in Japan, and before filing any other papers in the USPTO, the client remembers that a nonpublication request was filed and informs the practitioner about the application that was filed in Japan. Which of the following courses of action is in accordance with the USPTO rules and the procedures set forth in the MPEP?

- (A) The application is abandoned because the practitioner did not rescind the nonpublication request and provide notice of foreign filing within 45 days of having filed the application in Japan. The applicant must now file a petition and fee to revive under 37 CFR 1.137(b).
- (B) The application is abandoned because the applicant did not rescind the nonpublication request before filing the application in Japan. The applicant must now file a petition and fee to revive under 37 CFR 1.137(b).
- (C) The applicant should file an amendment to the specification of the U.S. application, adding the recent improvements to the disclosure in the specification.
- (D) The application is abandoned because the applicant did not rescind the nonpublication request by notifying the Office under 37 CFR 1.213(c) within the appropriate time. The applicant must now file a petition and fee to revive under 37 CFR 1.137(b).
- (E) The applicant could today notify the USPTO of the foreign filing. It is not necessary to file a petition and fee to revive for the application to continue to be examined in the USPTO.

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

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

4. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following presents a Markush group in accordance with proper PTO practice and procedure?

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

5. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following may not be filed by facsimile transmission?

- (A) A request for continued examination under 37 CFR 1.114 along with a submission.
- (B) A continued prosecution application under 37 CFR 1.53(d).
- (C) An amendment in reply to a non-final Office action.
- (D) The filing of a provisional patent application specification and drawing for the purpose of obtaining an application filing date.
- (E) (B) and (D).

6. According to the USPTO rules and the procedures set forth in the MPEP, in which of the following situations would the finality of an Office action rejection be improper?

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

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

7. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following is true?

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

8. Following a restriction requirement and election, a registered practitioner received a first Office action dated Friday, December 1, 2000. The primary examiner indicated that claims 1 to 10 were rejected and claims 11 to 20 were withdrawn from consideration. The first Office action set a 3 month shortened statutory period for reply. On February 28, 2001, the practitioner properly filed an express abandonment in the application and at the same time filed a request for continuing application. In a non-final Office action dated May 1, 2001 in the continuing application, the examiner indicated in that claims 1 to 20, all of the pending claims, are rejected. The practitioner filed a notice of appeal on Monday, July 2, 2001. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following most accurately describes the propriety of the practitioner's reply to the May 1st Office action?

- (A) The notice of appeal is not a proper response because the claims of the continuing application have not been finally rejected.
- (B) The notice of appeal is not a proper reply because all of the claims in the continuing application have not been twice rejected.
- (C) The filing of a notice of appeal is not a proper reply because not all the claims in the continuing application have been twice rejected.
- (D) A notice of appeal is never a proper response to a non-final rejection.
- (E) The reply is proper.

9. Which of the following is not in accordance with the provisions of the USPTO rules and the procedures set forth in 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.

10. A registered practitioner filed a patent application naming Sam as the sole inventor without an executed declaration under 37 CFR 1.63. The USPTO mailed a Notice to File Missing Parts dated January 3, 2000. The Notice to File Missing Parts set a two-month period for reply. Which of the following statements is in accordance with proper USPTO rules and the procedure set forth in the MPEP?

- I. Submit an appropriate reply to the Notice to File Missing Parts by filing, on August 3, 2000, a declaration under 37 CFR 1.63 executed by Sam, accompanied by a petition under 37 CFR 1.136(a) for an extension of five months, and the fee set forth in 37 CFR 1.17(a).
- II. In no situation can any extension requested by the practitioner carry the date on which a reply is due to the Notice to File Missing Parts beyond Monday, July 3, 2000.
- III. An appropriate reply by the practitioner to the Notice to File Missing Parts is to file, on August 3, 2000 a declaration under 37 CFR 1.63 executed by Sam, accompanied by a petition under 37 CFR 1.136(b).

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

11. In accordance with the USPTO rules and procedures set forth in the MPEP, a Certificate of Correction effectuates correction of an issued patent where:

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

12. The Potter patent application was filed on June 6, 2002, claiming subject matter invented by Potter. The Potter application properly claims priority to a German application filed on June 6, 2001. A first Office action contains a rejection of all the claims of the application under 35 USC 103(a) based on a U.S. patent application publication to Smith in view of a U.S. patent to Jones. A registered practitioner prosecuting the Potter application ascertains that the relevant subject matter in Smith's published application and Potter's claimed invention were, at the time Potter's invention was made, owned by ABC Company or subject to an obligation of assignment to ABC Company. The practitioner also observes that the Smith patent application was filed on April 10, 2001 and that the patent application was published on December 5, 2002. Smith and Potter do not claim the same patentable invention. To overcome the rejection without amending the claims, which of the following timely replies would comply with the USPTO rules and the procedures set forth in the MPEP to be an effective reply for overcoming the rejection?

- (A) A reply that only contains arguments that Smith fails to teach all the elements in the only independent claim, and which specifically points out the claimed element that Smith lacks.
- (B) A reply that properly states that the invention of the Potter application and the Smith application were commonly owned by ABC Company at the time of the invention of the Potter application.
- (C) A reply that consists of an affidavit or declaration under 37 CFR 1.132 stating that the affiant has never seen the invention in the Potter application before.
- (D) A reply that consists of an affidavit or declaration under 37 CFR 1.131 properly proving invention of the claimed subject matter of Potter application only prior to June 6, 2001.
- (E) A reply that consists of a proper terminal disclaimer and affidavit or declaration under 37 CFR 1.130.

13. In accordance with the USPTO rules and the procedures set forth in the MPEP, impermissible recapture in an application exists _____

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

14. With the exception that under 37 CFR 1.53 an application for patent may be assigned a filing date without payment of the basic filing fee, USPTO fees and charges payable to the USPTO requesting any action by the Office for which a fee or charge is payable, are required to be paid, in accordance with the MPEP and USPTO rules and procedure:

- (A) in advance, that is, at the time of requesting any action.
- (B) upon written notice from the USPTO.
- (C) within 20 days of requesting any action.
- (D) by the end of the fiscal year.
- (E) there are no fees.

15. In which of the following final Office action rejections is the finality of the Office action rejection in accordance with the USPTO rules and the procedures set forth in the MPEP?

- (A) The final Office action rejection is in a second Office action and uses newly cited art under 35 USC 102(b) to reject unamended claims that were objected to but not rejected in a first Office action.
- (B) The final Office action rejection is in a first Office action in a continuation-in-part application where at least one claim includes subject matter not present in the parent application.
- (C) The final Office action rejection is in a first Office action in a continuing application, all claims are drawn to the same invention claimed in the parent application, and the claims would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the parent application.
- (D) The final Office action rejection is in a first Office action in a substitute application that contains material that was presented after final rejection in an earlier application but was denied entry because the issue of new matter was raised.
- (E) None of the above.

16. In accordance with the USPTO rules and the procedures set forth in the MPEP, for a nonprovisional application to receive a filing date in the USPTO under 37 CFR 1.53(b), all of the following must be filed except:

- (A) The basic filing fee required by 37 CFR 1.16(a).
- (B) A specification as prescribed by the first paragraph of 35 USC 112.
- (C) A description pursuant to 37 CFR 1.71.
- (D) At least one claim pursuant to 37 CFR 1.75.
- (E) Any drawing required by 37 CFR 1.81(a).

17. In accordance with the USPTO rules and the procedures set forth in the MPEP, 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.

18. In accordance with the USPTO rules and the procedures set forth in the MPEP, 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.

19. 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) All of the above.
- (E) None of the above.

20. During his summer vacation to the mountains, Eric discovered and isolated a microorganism which secretes a novel compound. Eric purified and tested the compound in tumor-containing control mice and found that the tumors disappeared after one week; whereas tumor-containing mice which did not receive the compound died. Eric was very excited about his results and so he did a few additional experiments to characterize the microorganism and the compound which it was secreting. Eric determined that the microorganism was an S. spectaculus, and that the secreted compound was so unlike any other compounds that Eric named it spectaculysem. Eric told his friend Sam about his discovery, who urged him to apply for a U.S. patent on the microorganism and the secreted product. Eric did so, but to his amazement, a primary examiner rejected all the claims to his inventions. Which of the following, if made by the examiner, would be a proper rejection in accordance with USPTO rules and procedures set forth in the MPEP?

- (A) The examiner's rejection of the claims to the microorganism under 35 USC 101 as being unpatentable because microorganisms are living matter and living matter is non-statutory subject matter.
- (B) The examiner's rejection of the claims to the compound under 35 USC 101 as having no credible utility because Eric has only tested the compound in mice and curing mice of cancer has no "real world" value. The examiner also states that Eric must demonstrate that the compound works in humans in order to show that it has a patentable utility.
- (C) The examiner's rejection of the claims to the compound under 35 USC 103, stating that it would have been obvious to one of ordinary skill in the art to test the by product of a newly-discovered microorganism for therapeutic uses.
- (D) The examiner's rejection of the claims to the microorganism under 35 USC 102/103 over a reference which teaches an S. spectaculus microorganism stating that Eric's claimed microorganism is the same as, or substantially the same as, the microorganism described in the prior art.
- (E) None of the above.

21. Assuming that any rejection has been properly made final, which of the following statements is not in accordance with the USPTO rules and the procedures set forth in the MPEP?

- (A) An objection and requirement to delete new matter from the specification is subject to supervisory review by petition under 37 CFR 1.181.
- (B) A rejection of claims for lack of support by the specification (new matter) is reviewable by appeal to the Board of Patent Appeals and Interferences.
- (C) If both the claims and the specification contain the same new matter, and there has been both a rejection and objection by the primary examiner, the new matter issue should be decided by petition, and is not appealable.
- (D) If both the claims and the specification contain the same new matter, and there has been both a rejection and objection by the examiner, the new matter issue is appealable, and should not be decided by petition.
- (E) None of the above.

22. On January 2, 2001, a registered practitioner filed a patent application with the USPTO for inventor Beck. The application includes a specification and a single claim to the invention which reads as follows:

1. Mixture Y made by the process Q1.

In the specification, Mr. Beck discloses that mixture Y has a melting point of 150° F. On June 2, 2001, the practitioner received an Office action from the primary examiner rejecting the claim. The claim is rejected under 35 USC 102/103 as being clearly anticipated by or obvious over Patent A. The examiner states “Patent A teaches mixture Y but made by a different process Q2.” Beck believes he is entitled to a patent to mixture Y. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following would be the best reply to the rejection of his claim?

- (A) An argument that the claimed product has an unexpectedly low melting point of 150° F, supported by an affidavit showing that the mixture Y made by process Q2 exhibits a melting point of 300° F.
- (B) An argument that the processes used by applicant and patent A are different, supported by a third-party declaration stating only that the processes are different.
- (C) An argument that the claimed product has an unexpectedly low melting point of 150° F, supported by a third-party declaration stating only that the products are different.
- (D) An argument that the processes used by applicant and patent A are different, supported by an affidavit showing that the mixture Y made by process Q2 exhibits a melting point of 300° F.
- (E) An argument that the claimed product has an unexpectedly low melting point of 150° F because the claimed mixture Y has a melting point of 150° F and the mixture Y of patent A has a melting point of 300° F.

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

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

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

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

25. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following is not a proper basis on which the Board of Patent Appeals and Interferences may remand a case to the examiner?

- (A) Remand for a fuller description of the claimed invention.
- (B) Remand for a clearer explanation of the pertinence of the references.
- (C) Remand for a selection by the primary examiner of a preferred or best ground of rejection when multiple rejections of a cumulative nature have been made by the examiner.
- (D) Remand to the primary examiner with instructions to consider an affidavit not entered by the examiner which was filed after the final rejection but before the appeal.
- (E) Remand to the primary examiner to prepare a supplemental examiner's answer in response to a reply brief.

26. A registered practitioner filed a utility application on February 11, 2002. On April 4, 2002, the practitioner filed an information disclosure statement (IDS) in the application. The practitioner received a notice of allowance dated January 3, 2003 soon after it was mailed. When discussing the application with the practitioner on January 21, 2003, and before paying the issue fee, the client notices for the first time that a reference, which is one of many patents obtained by the client's competitor, was inadvertently omitted from the IDS. The client has been aware of this reference since before the application was filed. The client is anxious to have this reference appear on the face of the patent as having been considered by the USPTO. Which of the following actions, if taken by the practitioner, would not be in accord with the USPTO rules and the procedures set forth in the MPEP?

- (A) Before paying the issue fee, timely file an IDS citing the reference, along with the certification specified in 37 CFR 1.97(e), and any necessary fees.
- (B) Within three months of the mail date of the notice of allowance, without paying the issue fee, timely file a Request for Continued Examination (RCE) under 37 CFR 1.114, accompanied by the fee for filing an RCE, and an IDS citing the reference.
- (C) Within three months of the mail date of the notice of allowance, without paying the issue fee, timely file a continuing application under 37 CFR 1.53(b), an IDS citing the reference, and any necessary fees.
- (D) After paying the issue fee, timely file a petition to withdraw the application from issue to permit the express abandonment of the application in favor of a continuing application, a continuation application under 37 CFR 1.53(b), an IDS citing the reference, and any necessary fees.
- (E) After paying the issue fee, timely file a petition to withdraw the application from issue to permit consideration of a Request for Continued Examination (RCE) under 37 CFR 1.114, the fee for filing an RCE, and an IDS citing the reference.

27. 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 the USPTO rules and the procedures set forth in the MPEP?

- (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.

28. A non-final Office action dated Friday, November 8, 2000 set a three month shortened statutory period for reply. The practitioner petitioned for a one-month extension of time on Monday, February 10, 2003 and paid the appropriate one-month extension fee. An amendment responsive to the Office action was filed on Tuesday, March 11, 2003. Each independent claim in the application was revised and two dependent claims were cancelled. No claim was added by the amendment. In the Remarks portion of the amendment, the practitioner express his belief that no fees are required by the amendment, but nevertheless authorized charging any necessary fees to the practitioner's deposit account, including fees for any required extension of time. A duplicate copy of the amendment was filed. No fees were submitted with the amendment. Assuming a valid deposit account, which of the following statements is in accord with the USPTO rules and the procedures set forth in the MPEP?

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

29. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following papers is precluded from receiving the benefit of a certificate of mailing or transmission under 37 CFR 1.8?

- (A) An amendment, replying to an Office action setting a period for reply, transmitted by mail with a certificate of mailing to the USPTO from a foreign country.
- (B) An amendment, replying to an Office action setting a period for reply, transmitted by facsimile with a certificate of transmission to the USPTO from a foreign country.
- (C) An information disclosure statement (IDS) under 37 CFR 1.97 and 1.98 transmitted after the first Office action.
- (D) A request for continued examination (RCE) under 37 CFR 1.114.
- (E) An appeal brief.

30. A patent application includes the following Claim 1:

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

- (i) heating a base made of carbon to a first temperature in the range of 1875°C to 1925°C;
- (ii) passing a first gas over said heated base, said first gas comprising a mixture of hydrogen, SiCl₄, phosphorus, and methane, whereby said first gas decomposes over said heated base and thereby forms a first deposited layer of silicon, phosphorus and carbon on said heated base;
- (iii) heating said base having said deposited layer to a second temperature of approximately 1620°C; and
- (iv) passing a second gas over said base heated to said second temperature, said second gas consisting of a mixture of hydrogen, SiCl₄, AlCl₃, and methane, whereby said second gas decomposes over said heated base to form a second deposit layer adjacent said first layer, said second layer comprising silicon, aluminum and carbon.

Assuming proper support in the specification, which of the following claims, if presented in the same application, is a proper claim in accordance with the USPTO rules and the procedures set forth in the MPEP?

- (A) Claim 2. The method of claim 1, wherein said first temperature is in the range of 1800°C to 2000°C.
- (B) Claim 3. The method of claim 1, wherein said first gas further comprises an inert gas.
- (C) Claim 4. The method of claim 1, wherein said second gas further comprises Argon.
- (D) Claim 5. The method of claim 1, wherein said first gas is an inert gas such as Argon.
- (E) Claim 6. The method of claim 1, wherein said second gas consists of a mixture of hydrogen, SiCl₄ and AlCl₃ only.

31. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following documents, if any, must also contain a separate verification statement?

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

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

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

33. A claim in a pending patent application for an electric toothbrush is rejected under 35 USC 102 as being anticipated by a U.S. Patent, which was issued to Lancer, the sole name inventor, for a similar electric toothbrush. The Lancer patent was issued one day before the filing date of the application in question. The claim in the pending application contains a limitation specifying the location of an on/off switch. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following arguments, if true, would overcome the rejection?

- (A) The Lancer patent discloses and claims an electric toothbrush, but does not mention whether its toothbrush includes a power supply.
- (B) Evidence is submitted to show the electric toothbrush claimed in the application is commercially successful.
- (C) The Lancer patent teaches away from the bristles of the claimed toothbrush.
- (D) Lancer is one of the three named inventors of the claimed toothbrush in the pending application.
- (E) The on/off switch in the Lancer patent is on a different side of the body than that recited in the claim for the electric toothbrush in the patent application.

34. Inventor files an application containing the following original Claim 1:

- 1. A widget comprising element A, and element B.

In a first Office action on the merits, a primary examiner rejects claim 1 under 35 USC 103 as being obvious over reference X. Reference X explicitly discloses a widget having element A, but it does not disclose element B. The examiner, however, takes official notice of the fact that element B is commonly associated with element A in the art and on that basis concludes that it would have been obvious to provide element B in the reference X widget. In reply to the Office action, the registered practitioner representing the applicant makes no amendments, but instead requests reconsideration of the rejection by demanding that examiner show proof that element B is commonly associated with element A in the art. Which of the following actions, if taken by the examiner in the next Office action would be in accord with the USPTO rules and the procedures set forth in the MPEP?

- I. Vacate the rejection and allow the claim.
 - II. Cite a reference that teaches element B commonly associated with element A in the art and make the rejection final.
 - III. Deny entry of applicant's request for reconsideration on the ground that it is not responsive to the rejection and allow applicant time to submit a responsive amendment.
- (A) I and II only.
 - (B) II only.
 - (C) II and III only.
 - (D) I, II, and III.
 - (E) I and III only.

35. Igor filed a design patent application in the USPTO on January 24, 2000, which issued as a design patent on January 23, 2001. Igor's design patent covered a design that became immediately popular, resulting in numerous inquiries for licenses from various manufacturers. Igor would like to financially exploit his patent by licensing for five years. However, Igor has decided to dedicate five years of his patent term to the public. Which of the following is in accord with the USPTO rules and the procedures set forth in the MPEP, while best allowing Igor to pursue his intentions?

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

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

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

37. Applicant properly appealed the primary examiner's final rejection of the claims to the Board of Patent Appeals and Interferences (Board). Claims 1 to 10 were pending in the application. The examiner did not reject the subject matter of claims 7 to 10, but objected to these claims as being dependent on a rejected base claim. Claim 1 was the sole independent claim and the remaining claims, 2 through 10, were either directly or indirectly dependent thereon. After a thorough review of Appellant's brief and the examiner's answer, the Board affirmed the rejection of claims 1 to 6. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following is the appropriate action for the examiner to take upon return of the application to his jurisdiction when the time for appellant to take further action under 37 CFR 1.197 has expired?

- (A) Abandon the application since the Board affirmed the rejection of independent claim 1.
- (B) Convert the dependent claims 7 to 10 into independent form by examiner's amendment, cancel claims 1 to 6, and allow the application.
- (C) Mail an Office action to applicant setting a 1-month time limit in which the applicant may rewrite dependent claims 7 to 10 in independent form. If no timely reply is received, the examiner should amend the objected to claims, 7 to 10, and allow the application.
- (D) Mail an Office action to applicant with a new rejection of claims 7 to 10 based on the Board's decision.
- (E) No action should be taken by the examiner since the Board affirmed the rejection of independent claim 1, the application was abandoned on the date the Board decision was mailed.

38. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following is true?

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

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

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

40. In accordance with USPTO rules and the procedure set forth in the MPEP, which one of the following is not required for a provisional application filed in the USPTO?

- (A) A specification.
- (B) A drawing as prescribed by 35 USC 113.
- (C) An application fee.
- (D) A claim.
- (E) A cover sheet complying with the rule.

41. A claim in a pending patent application is rejected under 35 USC 103(a) as being obvious over Barry in view of Foreman. The Barry reference is a U.S. Patent that was issued on an application filed before the date of the application in question. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following arguments, if true, would overcome the rejection?

- (A) The Foreman reference is nonanalogous art, but the reference may be reasonably pertinent to Barry's endeavor to solving the particular problem with which Barry was concerned.
- (B) The rejection does not address a claimed limitation, and neither of the references teaches the claimed limitation.
- (C) The Barry patent issued after the filing date of the pending patent application.
- (D) The original specification states that the results achieved by the claimed invention are unexpected. (The statement is unsubstantiated by evidence).
- (E) The Foreman patent issued 105 years before the filing date of the pending patent application.

42. Which of the following practices or procedures may be employed in accordance with the USPTO rules and the procedures set forth in the MPEP 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).

43. Regarding a power of attorney or authorization of agent in a patent application, which of the following is in accordance with the USPTO rules and the procedure set forth in the MPEP?

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

44. A claim in an application recites “[a] composition containing: (a) 35-55% polypropylene; and (b) 45-65% polyethylene.” The sole prior art reference describes, as the only relevant disclosure, a composition containing 34.9% polypropylene and 65.1% polyethylene. In accordance with USPTO rules and procedures set forth in the MPEP, the primary examiner should properly:

- (A) Indicate the claim allowable over the prior art because there is no teaching, motivation or suggestion to increase the amount of polypropylene from 34.9% to 35% and decrease the amount of polyethylene from 65.1% to 65%.
- (B) Reject the claim under 35 USC 102 as anticipated by the prior art reference.
- (C) Reject the claim under 35 USC 103 as obvious over the prior art reference.
- (D) Reject the claim alternatively under 35 USC 102 as anticipated by or under 35 USC 103 as obvious over the prior art reference.
- (E) None of the above.

45. An examiner's answer, mailed on January 2, 2003, contains a new ground of rejection in violation of 37 CFR 1.193(a)(2). If an amendment or new evidence is needed to overcome the new ground of rejection, what is the best course of action the appellant should take in accordance with the USPTO rules and the procedures set forth in the MPEP?

- (A) File a reply brief bringing the new ground of rejection to the attention of the Board of Patent Appeals and Interferences and pointing out that 37 CFR 1.193(a)(2) prohibits entry of the new ground of rejection.
- (B) File a timely petition pursuant to 37 CFR 1.181 seeking supervisory review of the examiner's entry of an impermissible new ground of rejection in the answer, after efforts to persuade the examiner to reopen prosecution or remove the new ground of rejection are unsuccessful.
- (C) File a reply brief arguing the merits of the new ground of rejection.
- (D) File an amendment or new evidence to overcome the new ground of rejection.
- (E) Ignore the new ground of rejection.

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

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

47. In accordance with USPTO rules and the procedures set forth in the MPEP, claims in a patent application may not contain:

- (A) chemical formulas.
- (B) mathematical equations.
- (C) drawings or flow diagrams.
- (D) only one sentence.
- (E) tables not necessary to conform with 35 USC 112.

48. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following does not constitute probative evidence of commercial success to support a contention of non-obviousness?

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

49. 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 the USPTO rules and the procedures set forth in the MPEP, 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.

50. Inventor files an application for a non-theoretical metal alloy. The application as originally filed contains the following Claim 1:

Claim 1. A metal alloy comprising at least 20% by volume of iron; at least 10% by volume of gallium, and at least 10% by volume of copper.

In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following claims would be properly held indefinite under 35 USC 112(2)?

- (A) Claim 2: The alloy of claim 1 containing 66% by volume of gallium and 14% by volume of copper.
- (B) Claim 2: The alloy of claim 1 containing at least 21% by volume of iron, 11% by volume of gallium, and 10.01% by volume of copper.
- (C) Claim 2: The alloy of claim 1 containing 20% by volume of iron, 10% by volume of gallium, and 10% by volume of copper.
- (D) Claim 2: The alloy of claim 1 containing 54% by volume of copper and 27% by volume of gallium.
- (E) Claim 2: The alloy of claim 1 containing at least 1% by volume of silver.

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

APRIL 15, 2003

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. 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, USPTO rules, and the procedures set forth in the Manual of Patent Examining Procedure (MPEP). 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.**

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1. Harriet filed a nonprovisional patent application in the USPTO containing a written assertion of small entity status. Based upon the USPTO rules and the procedures set forth in the MPEP, which of the following statements is correct?

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

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

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

3. In accordance with the USPTO rules and the procedures in the MPEP, in which of the following instances is the reference properly available as prior art under 35 USC 102(d)?

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

4. The Office mailed an Office action containing a proper final rejection dated July 8, 2002. The Office action did not set a period for reply. On January 7, 2003, in reply to the final rejection, a registered practitioner filed a request for continued examination under 37 CFR 1.114, a request for a suspension of action under 37 CFR 1.103(c) to suspend action for three months, and proper payment all required fees. No submission in reply to the outstanding Office action accompanied the request for continued examination. No other paper was submitted and no communication with the Office was held until after Midnight, January 8, 2003. Which of the following statements accords with the USPTO rules and the procedures set forth in the MPEP?

- (A) If an appropriate reply is submitted within the three month period of suspension permitted under 37 CFR 1.103(c), the application will not be held abandoned.
- (B) The application will not be held abandoned if an appropriate reply is submitted within the three month period of suspension and it is accompanied by a showing that the reply could not have been submitted within the period set in the final rejection. For example, the reply includes a showing based on an experiment that required 8 months to conduct.
- (C) No reply will prevent the application from being held abandoned.
- (D) If, on January 10, 2003, the primary examiner and applicant agree to an examiner's amendment that places the application in condition for allowance and a notice of allowance is mailed within the three month period of suspension, application X will not be held abandoned.
- (E) No other submission by applicant is necessary because application X is still pending. The examiner is required to act on the request for continued examination after expiration of the three month period of suspension.

5. Which of the following practices or procedures may be properly employed in accordance with the USPTO rules and the procedures set forth in the MPEP 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).

6. In accordance with the USPTO rules and the procedures of the MPEP, which of the following is true?

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

7. In accordance with the USPTO rules and the procedures set forth in the MPEP, for a nonprovisional application to receive a filing date in the USPTO under 37 CFR 1.53(b), all of the following must be filed except:

- (A) An oath or declaration under 37 CFR 1.51(b)(2).
- (B) A specification as prescribed by the first paragraph of 35 USC 112.
- (C) A description pursuant to 37 CFR 1.71.
- (D) At least one claim pursuant to 37 CFR 1.75.
- (E) Any drawing required by 37 CFR 1.81(a).

8. A complete continuation application by the same inventors as those named in the prior application may be filed under 35 USC 111(a) using the procedures of 37 CFR 1.53(b) by providing, in accordance with the USPTO rules and the procedures set forth in the MPEP:

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

9. Inventors B and C are employed by Corporation D, which authorized registered practitioner E to prepare and file a patent application claiming subject matter invented by B and C. Inventor B signed the oath, an assignment to Corporation D, and a power of attorney authorizing practitioner E to prosecute the application. Inventor C refused to sign the oath and any assignment documents for the application. The employment contract between inventor C and Corporation D contains no language obligating C to assign any invention to Corporation D. A patent application was properly filed in the USPTO under 37 CFR 1.47 naming B and C as inventors, but without inventor C signing the oath. C has now started his own company competing with Corporation D producing a product with the invention in the application. Inventor B is a friend of inventor C and wants C to have continued access to the application. Which of the following statements is in accordance with the USPTO rules and the procedures set forth in the MPEP?

- (A) Inventor C, who has not signed the oath or declaration, may revoke the power of attorney to practitioner E and appoint practitioner F to prosecute the application.
- (B) Inventor C cannot be excluded from access to the application because inventor B has not agreed to exclude inventor C. In order to exclude a co-inventor from access to an application, all the remaining inventors must agree to exclude that co-inventor.
- (C) Inasmuch as one of the named joint inventors has not assigned his or her rights to Corporation D, the corporation is not an assignee of the entire right and interest, and therefore cannot exclude inventor C from access to the application.
- (D) An inventor who did not sign the oath or declaration filed in an application can always be excluded from access to an application.
- (E) An assignee filing an application can control access to an application and exclude inventors who have not assigned their rights and other assignees from inspecting the application.

10. In accordance with the USPTO rules and the procedures set forth in the MPEP, 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. A registered practitioner properly recorded an assignment document for application A identifying XYZ Company as the assignee. The document assigns to XYZ Company the “subject matter claimed in Application A.” A proper restriction requirement was made by a primary examiner in application A between two distinct inventions, and the practitioner elected to prosecute one of the inventions. Application A was prosecuted, and later became abandoned. Before the abandonment date of application A, the practitioner filed a complete application B as a proper divisional application of application A. Application B claimed the nonelected invention of Application A, and was published as a U.S. application publication. XYZ Company remains the assignee of application A. What must the practitioner do in accordance with the USPTO rules and the procedures set forth in the MPEP to ensure that XYZ Company is listed as the assignee on the face of any patent issuing from application B?

- (A) File a proper assignment document in application B identifying XYZ Company as the assignee.
- (B) File a proper assignment document in application B identifying XYZ Company as the assignee, and confirm that USPTO’s bibliographic data for application B identifies XYZ Company as the assignee by checking the filing receipt for application B, the U.S. application publication of application B, or the USPTO’s Patent Application Information Retrieval (PAIR) system data for application B, depending on when the practitioner filed the assignment document in application B.
- (C) Confirm that XYZ Company is identified as the assignee on the U.S. application publication of application B.
- (D) File a proper assignment document in application B identifying XYZ Company as the assignee, and confirm that XYZ Company is identified as the assignee on the U.S. application publication of application B.
- (E) Upon allowance of application B, the practitioner must identify XYZ Company as the assignee in the appropriate space on the Issue Fee Transmittal form for specifying the assignee for application B.

12. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following is true?

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

13. Prior to filing a patent application for a client, a registered practitioner determined that the client was entitled to claim small entity status under 37 CFR 1.27. The practitioner filed a patent application for the client on November 1, 2002 together with a claim for small entity status under 37 CFR 1.27. On December 2, 2002, a Notice to File Missing Parts was mailed setting a two month period for reply and requiring the basic filing fee and the surcharge under 37 CFR 1.16(e). The practitioner timely submitted the small entity fees for the basic filing fee and the surcharge as required in the Notice. Shortly thereafter, the practitioner discovered that on October 31, 2002, the day before the application was filed, the client, without advising the practitioner, had assigned all rights in the invention that is the subject of the application to an entity that would not qualify for small entity status under 37 CFR 1.27. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following actions would be the best action for the practitioner to take?

- (A) File a continuing application under 37 CFR 1.53(b) with the large entity filing fee and then file a letter of express abandonment under 37 CFR 1.138 in the original application after the continuing application has been accorded a filing date.
- (B) Promptly file a notification of loss of small entity status under 37 CFR 1.27(g) and, thereafter, pay large entity fees whenever any subsequent fees are required.
- (C) Wait until a Notice of Allowance is received and then timely submit the large entity issue fee along with a notification of loss of small entity status under 37 CFR 1.27(g).
- (D) File a paper under 37 CFR 1.28(c) requesting that the good faith error in claiming small entity status be excused and complying with the separate submission and itemization requirements of 37 CFR 1.28(c) and including payment of the deficiency owed.
- (E) Pay the difference between the large entity filing fee and small entity filing fee and the difference between the large entity surcharge and small entity surcharge within two months from the mail date of the Notice to File Missing Parts.

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

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

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

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

16. Claim 1 of an application recites “[a]n article comprising: (a) a copper substrate; and (b) a electrically insulating layer on said substrate.” The specification defines the term “copper” as being elemental copper or copper alloys. In accordance with USPTO rules and procedures set forth in the MPEP, for purposes of searching and examining the claim, the examiner should interpret the term “copper” in the claim as reading on:

- (A) Elemental copper only, based on the plain meaning of “copper.”
- (B) Copper alloys only, based on the special definition in the specification.
- (C) Elemental copper and copper alloys, based on the special definition in the specification.
- (D) Any material that contains copper, including copper compounds.
- (E) None of the above.

17. Rolland files a U.S. patent application fourteen months after he perfects an invention in Europe. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following would establish a statutory bar against the granting of a U.S. patent to Rolland?

- (A) A foreign patent issued to Rolland 11 months prior to the filing date of Rolland’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 Rolland’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.

18. In accordance with the USPTO rules and the procedures set forth in the MPEP, in which of the following cases is the date of actual receipt by the USPTO not accorded as the application filing date?

- (A) Provisional application filed without claims.
- (B) Non-provisional application filed containing an error in inventorship.
- (C) Non-provisional application filed which fails to identify the inventor(s).
- (D) Non-provisional application with executed oath filed without any claim(s).
- (E) Non-provisional application filed using a certificate of mailing in accordance with 37 CFR 1.8.

19. In connection with the utility of an invention described in a patent application, which of the following conforms to the USPTO rules and the procedure set forth in the MPEP?

- (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. Inventor Joe is anxious to get a patent with the broadest claim coverage possible for the invention. Joe retained a registered practitioner, Jane, to obtain the advantage of legal counsel in obtaining broad protection. Jane filed a patent application for the invention. The inventor heard that, although patent prosecution is conducted in writing, it is possible to get interviews with examiners. Joe believes an interview might hasten the grant of a patent by providing the examiner a better understanding of the true novelty of the invention. Which of the following are consistent with the USPTO rules and the procedures set forth in the MPEP regarding usage of interviews?

- (A) Prior to the first Office action being mailed the inventor calls the examiner to whom the application is docketed to offer help in understanding the specification.
- (B) After receiving the first Office action Jane calls the examiner for an interview for the purpose of clarifying the structure and operation of the invention as claimed and disclosed, because the examiner's analysis regarding patentability in the rejection is novel and suggests that the examiner is interpreting the claimed invention in a manner very different from the inventor's intent.
- (C) Jane has Larry, a registered practitioner in the Washington D.C. area, who is more familiar with interview practice to call the examiner. Jane gives Larry a copy of the first Office action, which suggests that the primary examiner's analysis is incorrect, and offers to explain why. Jane instructs Larry that because Larry is unfamiliar with the inventor, Larry should not agree to possible ways in which the claims could be modified, or at least indicate to the examiner that Jane would have to approve of any such agreement.
- (D) Jane calls the primary examiner after receiving the final rejection, demanding that the examiner withdraw the finality of the final action. When the examiner states that the final rejection is proper, Jane demands an interview as a matter of right to explain the arguments.
- (E) (B) and (D).

21. In accordance with the USPTO rules and the procedures set forth in the MPEP, a petition to make a patent application special may be filed without fee in which of the following cases?

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

22. The Potter patent application was filed on June 6, 2002, claiming subject matter invented by Potter. The Potter application properly claims priority to a German application filed on June 6, 2001. In a first Office action all the claims of the Potter application are rejected under 35 USC 102(e) based on a U.S. patent application publication to Smith et al ("Smith"). A registered practitioner prosecuting the Potter application ascertains that the relevant subject matter in Smith's published application and Potter's claimed invention were, at the time Potter's invention was made, owned by ABC Company or subject to an obligation of assignment to ABC Company. The practitioner ascertains that the Smith application was filed on April 10, 2001 and that the Smith application was published on December 5, 2002. Smith and Potter do not claim the same patentable invention. To overcome the rejection without amending the claims which of the following replies would not comply with the USPTO rules and the procedures set forth in the MPEP to be an effective reply for overcoming the rejection?

- (A) A reply that only contains arguments that Smith fails to teach all the elements in the only independent claim, and which specifically points out the claimed element that Smith lacks.
- (B) A reply that consists of an affidavit or declaration under 37 CFR 1.131 properly proving invention of the claimed subject matter of the Potter application prior to April 10, 2001.
- (C) A reply that consists of an affidavit or declaration under 37 CFR 1.132 properly showing that Smith's invention is not by "another."
- (D) A reply that properly states that the invention of the Potter application and the Smith application were commonly owned by ABC Company at the time of the invention of the Potter application.
- (E) All of the above.

23. The claims in a patent application having been twice or finally rejected, the applicant files a timely Notice of Appeal on January 2, 2003. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following situations should the USPTO not notify the applicant that the Appeal Brief is defective and allow him an opportunity to correct the deficiency?

- (A) The Appeal Brief is filed on July 10, 2003, without a request for extension of time under 37 CFR 1.136.
- (B) The Appeal Brief is submitted unsigned.
- (C) The Appeal Brief states that the claims do not stand or fall together, and presents argument as to why the claims are separately patentable, but the primary examiner does not agree with the applicant's argument.
- (D) The Appeal Brief does not state whether the claims stand or fall together, but presents arguments why the claims subject to the same rejection are separately patentable.
- (E) The Appeal Brief does not address one of the grounds of rejection stated by the primary examiner.

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

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

25. The specification in a patent application has been objected to for lack of enablement. To overcome this objection in accordance with the USPTO rules and the procedures set forth in the MPEP, a registered practitioner 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.

26. Co-inventors Smith and Jones filed an application for a patent on a cell phone, on May 15, 2002. They received a first Office action from a primary examiner rejecting the claims under 35 USC 102(a) over a publication by Bell and Watson, published on April 5, 2002, describing a cell phone having all the same features as is claimed in the patent application. In reply, the co-inventors each submitted a declaration under 37 CFR 1.131 stating that they had actually reduced the invention to practice no later than March 13, 2002. However, the declarations failed to include two claimed features. Neither the particular antenna needed to enable the cell phone could receive transmissions from the local cellular transmitting tower, nor a detachable carrying strap was included in the declarations. As evidence of their prior reduction to practice, Smith and Jones submitted their co-authored journal article. The journal article contained a figure of the cell phone as described in the declarations. That is, the cell phone shown in the figure of the article lacked an antenna and a detachable strap. The article was received by the journal on March 13, 2002, and was published on April 30, 2002. The cell phones shown in the figure in the Bell and Watson publication, and in the Smith and Jones patent application have the particular antenna and a detachable strap. Which of the following actions, if taken by the examiner, would be the most proper in accordance with USPTO rules and the procedures set forth in the MPEP?

- (A) The examiner should maintain the rejection of the claims under 35 USC 102(a) and make the rejection final.
- (B) The examiner should withdraw the rejection and look for references which have a publication date prior to May 15, 2001.
- (C) The examiner should withdraw the rejection and notify Smith and Jones that their application is in condition for allowance.
- (D) The examiner should maintain the rejection, but indicate that the claims would be allowable if Smith and Jones provided an original copy of the figure published in their journal article as factual support for their declarations.
- (E) The examiner should maintain the rejection and inform Smith and Jones that the declarations are insufficient because they cannot “swear behind” a reference which is a statutory bar.

27. On January 2, 2001, a registered practitioner filed a patent application with the USPTO for inventor Bock. The application includes a specification and a single claim to the invention, which reads as follows:

1. A new string consisting only of material Z that has the ability to stretch to beyond its initial unstretched length.

On June 2, 2001, the practitioner received an Office action from the primary examiner rejecting the claim. The claim is solely rejected under 35 USC 102 in view of Patent A, which discloses a string consisting only of material Z. The Office action states, "Patent A discloses a string consisting only of material Z. Patent A does not expressly teach the stretchability property of the string. Nevertheless, the recited stretchability is inherent in the string of patent A. Accordingly, patent A anticipates the claimed string." Mr. Bock believes he is entitled to a patent to his new string and authorizes the practitioner to reply to the Office action by arguing that his string stretches to ten times its initial unstretched length, something that patent A does not teach. Since this is not expressly taught in Patent A, the practitioner argues, Patent A cannot anticipate the claimed string. In accordance with USPTO rules and procedures set forth in the MPEP, is the practitioner's reply persuasive as to error in the rejection?

- (A) Yes.
- (B) Yes, but the claim should now be rejected again, this time under 35 USC 103 as obvious over Patent A.
- (C) Yes, because the stretchability property is expressly taught by Patent A.
- (D) Yes, examiner nowhere addresses the claimed limitation of stretching the string beyond its initial unstretched length.
- (E) No.

28. Ben hires a registered practitioner to prosecute his patent application. The practitioner drafted an application having fifteen claims. Claim 1 is independent, and each of claims 2-15 are singularly dependent upon claim 1. A proper non-final Office action is mailed to the practitioner. Following consultation with Ben, the practitioner timely prepared, signed, and filed a reply to the Office action containing an amendment that does not add new matter, but does add claims 16-27. Each of claims 16-27 is directed to the same invention sought to be patented through claims 1-15. The dependency of each of claims 16-27 reads "any of claims 5-15." For purposes of fee calculation in accordance with the USPTO rules and the procedures set forth in the MPEP, how many total claims are contained in the application after the amendment is entered?

- (A) One hundred thirty-six.
- (B) One hundred thirty-five.
- (C) Twenty-seven.
- (D) One hundred forty-seven.
- (E) Fifteen.

29. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following statements regarding operability or enablement of a prior art reference is the most correct?

- (A) The level of disclosure required for a reference to be enabling prior art is no less if the reference is a United States patent than if it is a foreign patent.
- (B) A reference is not presumed to be operable merely because it expressly anticipates or makes obvious all limitations of an applicant's claimed apparatus.
- (C) A non-enabling reference may not qualify as prior art for the purpose of determining anticipation or obviousness of the claimed invention.
- (D) A reference does not provide an enabling disclosure merely by showing that the public was in possession of the claimed invention before the date of the applicant's invention.
- (E) All of the above are correct.

30. Joan goes to a registered practitioner wanting to know the status of the applications of her competitor Pete. During Joan's previous relationship with Pete she believes she may have been a coinventor on one of the applications filed by Pete. Pete owns Applications A, B, C and D. Application B is a continuation of Application A and a redacted copy of Application A has been published under 35 USC 122(b). Joan is listed as a coinventor on Application C. Pete has an issued patent that claims priority to Application D. Assume only the last six digits of the numerical identifier are available for Application D and Application D is abandoned. Which of the following, in accordance with the USPTO rules and the procedures set forth in the MPEP, is not true?

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

31. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following is true?

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

32. On January 2, 2001, a registered practitioner filed a patent application with the USPTO for inventor Bloc. The application includes a specification and a single claim to the invention which reads as follows:

1. Compound Y.

In the specification, Bloc explains that compound Y is an intermediate in the chemical manufacture of synthetic Z. With respect to synthetic Z, the specification discloses its structural formula and further states that synthetic Z is modeled on the natural form of Z to give it the same therapeutic ability to alleviate pain. The specification goes on to state that synthetic Z is also a cure for cancer. On June 2, 2001, the practitioner received an Office action from the primary examiner rejecting the claim. The claim is rejected under 35 USC 101 as being inoperative; that is, the synthetic Z does not operate to produce a cure for cancer (*i.e.*, incredible utility). Bloc believes he is entitled to a patent to his compound Y. In accordance with USPTO rules and procedures set forth in the MPEP, how best should the practitioner reply to the rejection of the claim?

- (A) Advise Bloc that he should give up because a cure for cancer is indeed incredible and is unproven.
- (B) File a reply arguing that a cure for cancer is not incredible and he can prove it if given the chance.
- (C) File a reply arguing that whether or not a cure for cancer is incredible is superfluous since Bloc has disclosed another utility – alleviating pain, which is not incredible.
- (D) File a reply arguing that the claim is directed to compound Y, not synthetic Z.
- (E) File a reply arguing that synthetic Z is modeled on the natural form of Z.

33. Application No. A was published as U.S. Patent Application Publication No. B. A member of the public reviewed the listing of the file contents of the application on the Patent Application Information Retrieval system and determined that the application was still pending, that a final Office action was mailed, and that the application file is in the Technology Center where it is being examined. The member of the public does not have a power to inspect, but would like a copy of the final Office action as well as the other papers in the patent application. In accordance with the USPTO rules and the procedures set forth in the MPEP, can a copy of these papers be obtained by the member of the public, and if so, how can the copy be obtained?

- (A) No, a copy cannot be obtained because patent applications are maintained in confidence pursuant to 35 USC 122(a).
- (B) No, a copy cannot be obtained because the patent application is still pending.
- (C) Yes, a member of the public can go to the Technology Center and ask for the file for copying at a public photocopier.
- (D) Yes, the member of the public can complete a “Request for Access to an Application Under 37 CFR 1.14(e)” and, without payment of a fee, order the file from the File Information Unit. Upon the Unit’s receipt of the application, the member of the public can use a public photocopier to make a copy.
- (E) Yes, the member of the public can order a copy from the Office of Public Records, with a written request and payment of the appropriate fee.

34. A first Office action on the merits rejecting Claim 1 under 35 USC 103 as being obvious in view of reference A set a three month shortened statutory period for reply. A registered practitioner files a timely response (without an extension of time) to the first Office action amending Claim 1 to include a limitation not found in reference A or any other prior art of record. However, the limitation also lacks support in applicant’s original disclosure, *i.e.*, it is new matter. Which of the following courses of action, if taken by the primary examiner, would be in accord with the USPTO rules and the procedures set forth in the MPEP?

- (A) Hold the application abandoned after expiration of the three month shortened statutory period for reply because an amendment adding new matter to the claims is not a *bona fide* response.
- (B) Consider the new matter and reject Claim 1 under 35 USC 101 because a claim that recites new matter lacks utility.
- (C) Consider the new matter and treat Claim 1, determining whether the invention as claimed with the new matter, would have been obvious in view of reference A, and reject Claim 1 under 35 USC 112, first paragraph, for lack of support in the original disclosure for new matter.
- (D) Ignore the new matter and reject Claim 1 again under § 103 in view of reference A.
- (E) All of the above.

35. Which of the following is a proper basis for establishing a substantial new question of patentability to obtain reexamination in accordance with proper USPTO rules and the procedures set forth in the MPEP?

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

36. Which of the following is not a policy underlying the public use bar of 35 USC 102(b)?

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

37. In accordance with the USPTO rules and the procedures set forth in the MPEP, a grant of small entity status entitles an applicant to which of the following?

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

38. In accordance with USPTO rules and the procedures set forth in the MPEP, an amendment filed with or after a notice of appeal under 37 CFR 1.191(a), but before jurisdiction has passed to the Board of Patent Appeals and Interferences, should be entered by the primary examiner where the amendment:

- (A) requests unofficial consideration by the examiner.
- (B) is less than six pages long.
- (C) removes issues from appeal.
- (D) presents more specific claims, because it is believed that they may have a better chance of being allowable even though the claims do not adopt the examiner's suggestions.
- (E) introduces new issues, allowing the examiner to rethink his position.

39. 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 in accordance with the USPTO rules and the procedures set forth in the MPEP 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.

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

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

41. Evidence that a claim may not comply with the second paragraph of 35 USC 112 occurs in accordance with the USPTO rules and the procedure set forth in the MPEP where:

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

42. Paprika is a known product. A patent application discloses a composition which is made by subjecting paprika to processing steps X, Y and Z. The composition is disclosed to be useful in treating cancer. The application was filed June 1, 2002. A reference published May 1, 2001 discloses a food product made by subjecting paprika to processing steps X, Y and Z. The reference does not disclose that the resulting composition has any properties that would make it useful for treating cancer. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following claims is not anticipated by the reference?

- (A) A composition made by the process of subjecting paprika to processing steps X, Y and Z, wherein the composition is effective for treating cancer.
- (B) A composition for treating cancer, made by the process of subjecting paprika to processing steps X, Y and Z.
- (C) A method of making a cancer-treating composition, comprising subjecting paprika to processing steps X, Y and Z.
- (D) A method of treating cancer, comprising administering an effective amount of a composition made by subjecting paprika to processing steps X, Y and Z.
- (E) All of the above.

43. Which of the following definitions does not accord with proper USPTO rules and the procedures set forth in the MPEP relating to drawings in patent applications?

- (A) Original drawings are drawings submitted with the application when filed, and may be either formal or informal.
- (B) Formal drawings are stamped “approved” by the Draftsperson.
- (C) Drawings may be informal for reasons such as the size of reference elements.
- (D) A substitute drawing is usually submitted to replace an original formal drawing.
- (E) A drawing may be declared as informal by the applicant when filed.

44. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following, if any, is true?

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

45. AI files an application for a patent. After the Notice of Allowance is mailed and the issue fee has been paid AI discovers a prior art reference which is material to patentability. What should AI do in accordance with the USPTO rules and the procedures set forth in the MPEP?

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

46. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following is not a “printed publication” under 35 USC 102(b), with respect to a patent application filed June 1, 2002?

- (A) A paper that was orally presented at a meeting held May 1, 2001, where the meeting was open to all interested persons and the paper was distributed in written form to six people without restriction.
- (B) A doctoral thesis that was indexed, cataloged, and shelved May 1, 2001, in a single, university library.
- (C) A research report distributed May 1, 2001, in numerous copies but only internally within an organization and intended to remain confidential.
- (D) A reference available only in electronic form on the Internet, which states that it was publicly posted May 1, 2001.
- (E) A technical manual that was shelved and cataloged in a public library as of May 1, 2001, where there is no evidence that anyone ever actually looked at the manual.

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

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

48. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following statements regarding a proper prior art reference is true?

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

49. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following statements regarding claim interpretation during patent prosecution is incorrect?

- (A) A claim is to be given its broadest reasonable interpretation in light of the supporting disclosure in the specification.
- (B) Because a claim is read in light of the specification, the claim may properly be narrowed by interpreting it as including elements or steps disclosed in the specification but not recited in the claim.
- (C) If an applicant does not define a claim term in the specification, that term is given its ordinary meaning in the art.
- (D) When an explicit definition of a claim term is provided in an applicant's specification, that definition controls the interpretation of the term as it is used in the claims.
- (E) Means plus function language in claims which defines the characteristics of a machine or manufacture includes only the corresponding structures or materials disclosed in the specification and equivalents thereof.

50. A registered practitioner files a nonprovisional utility application in 2000. In 2002, the practitioner files a continuation-in-part application and claims benefit of the filing date of the 2000 application for the 2002 application. Thereafter, the practitioner amends the 2002 application to include claims that were not present in either the originally filed 2000 application or the originally filed 2002 application. The primary examiner properly concludes that the added claims are not supported by the original disclosure in either application. Which of the following is in accord with the USPTO rules and the procedures set forth in the MPEP?

- (A) The added claims are rejected for lack of written description under 35 USC 112, first paragraph.
- (B) The added claims are rejected as new matter under 35 USC 132.
- (C) The added claims are denied benefit of the filing date of the 2000 application.
- (D) (A) and (B).
- (E) (A) and (C).

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

OCTOBER 15, 2003

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. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the patent laws, rules and procedures as related in the Manual of Patent Examining Procedure (MPEP). 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.**

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1. Assuming that a rejection has been properly made final, which of the following statements is not in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) An objection and requirement to delete new matter from the specification is subject to supervisory review by petition under 37 CFR 1.181.
- (B) A rejection of claims for lack of support by the specification (new matter) is reviewable by appeal to the Board of Patent Appeals and Interferences.
- (C) If both the claims and the specification contain the same new matter, and there has been both a rejection and objection by the primary examiner, the new matter issue should be decided by petition, and is not appealable.
- (D) If both the claims and the specification contain the same new matter, and there has been both a rejection and objection by the examiner, the new matter issue is appealable, and should not be decided by petition.
- (E) None of the above.

2. A claim in a pending patent application stands rejected under 35 USC 103(a) as being obvious over Kim in view of Lance. The Kim and Lance references are both U.S. Patents issued on respective applications filed before the date of the application in question. In the rejection, the primary examiner asserted that no determination of the level of ordinary skill in the art was necessary because the subject matter of the application and of Kim and Lance were so easily understandable; and that the Kim reference relates to the applicant's endeavor. The examiner properly found motive in Kim and Lance for combining the references, but the motive would produce a benefit different from that offered by applicant's invention. Neither reference teaches or suggests the ambiguous limitation. In the rejection under 36 USC 103(a), the examiner did not address an ambiguous limitation in the claim. However, the examiner separately rejected under 35 USC 112, second paragraph as indefinite due to the ambiguity. According to the patent laws, rules and procedures as related in the MPEP, which of the following arguments, if true, would overcome the rejection?

- (A) The examiner asserted that because the subject matter of the application and of Kim and Lance were so easily understandable, a factual determination of the level of skill in the art was unnecessary.
- (B) The Kim reference is nonanalogous art because, although it relates to the field of the applicant's endeavor, it is not pertinent to the particular problem with which the applicant was concerned.
- (C) The reason given by the examiner to combine Kim and Lance is to obtain a benefit different from that offered by the applicant's invention.
- (D) Neither the Kim nor Lance references teaches or suggests the ambiguous claimed limitation that the examiner separately rejected as indefinite.
- (E) All of the above.

3. Inventor Joe is anxious to get a patent with the broadest claim coverage possible for the invention. Joe retained a registered practitioner, Jane, to obtain the advantage of legal counsel in obtaining broad protection. Jane filed a patent application for the invention. The inventor heard that, although patent prosecution is conducted in writing, it is possible to get interviews with examiners. Joe believes an interview might hasten the grant of a patent by providing the examiner a better understanding of the true novelty of the invention. Which of the following are consistent with the patent law, rules and procedures as related by the MPEP regarding usage of interviews?

- (A) Prior to the first Office action being mailed the inventor calls the examiner to whom the application is docketed to offer help in understanding the specification.
- (B) After receiving the first Office action Jane calls the examiner for an interview for the purpose of clarifying the structure and operation of the invention as claimed and disclosed, because the examiner's analysis regarding patentability in the rejection is novel and suggests that the examiner is interpreting the claimed invention in a manner very different from the inventor's intent.
- (C) Jane has Larry, a registered practitioner in the Washington D.C. area, who is more familiar with interview practice to call the examiner. Jane gives Larry a copy of the first Office action, which suggests that the primary examiner's analysis is incorrect, and offers to explain why. Jane instructs Larry that because Larry is unfamiliar with the inventor, Larry should not agree to possible ways in which the claims could be modified, or at least indicate to the examiner that Jane would have to approve of any such agreement.
- (D) Jane calls the primary examiner after receiving the final rejection, demanding that the examiner withdraw the finality of the final action. When the examiner states that the final rejection is proper, Jane demands an interview as a matter of right to explain the arguments.
- (E) (B) and (D).

4. Claim 1 of an application recites “[a]n article comprising: (a) a copper substrate; and (b) a electrically insulating layer on said substrate.” The specification defines the term “copper” as being elemental copper or copper alloys. In accordance with the patent laws, rules and procedures as related in the MPEP, for purposes of searching and examining the claim, the examiner should interpret the term “copper” in the claim as reading on:

- (A) Elemental copper only, based on the plain meaning of “copper.”
- (B) Copper alloys only, based on the special definition in the specification.
- (C) Elemental copper and copper alloys, based on the special definition in the specification.
- (D) Any material that contains copper, including copper compounds.
- (E) None of the above.

5. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following does not constitute prior art upon which a primary examiner could properly rely upon in making an obviousness rejection under 35 USC 103?

- (A) A U.S. patent in the applicant's field of endeavor which was issued two years before the filing date of applicant's patent application.
- (B) A non-patent printed publication in a field unrelated to the applicant's field of endeavor but relevant to the particular problem with which the inventor-applicant was concerned, which was published the day after the filing date of applicant's application.
- (C) A printed publication published more than 1 year before the filing date of applicant's patent application, which publication comes from a field outside the applicant's field of endeavor but concerns the same problem with which the applicant-inventor was concerned.
- (D) A printed publication in the applicant's field of endeavor published 3 years before the filing date of applicant's patent application.
- (E) A U.S. patent which issued more than 1 year before the filing date of applicant's patent application, which the Office placed in a different class than the applicant's patent application, but which concerns the same problem with which the applicant-inventor was concerned, and which shows the same structure and function as in the applicant's patent application.

6. In a reexamination proceeding a non-final Office action dated November 8, 2001 set a shortened statutory period of 2 months to reply. The patent owner, represented by a registered practitioner, filed a response on March 7, 2002, which included an amendment of the claims. No request for an extension of time was received. As of May 8, 2002, which of the following actions would be in accord with the patent laws, rules and procedures as related in the MPEP?

- (A) The registered practitioner should file a request and fee for an extension of time of two months.
- (B) The registered practitioner should file a petition for revival of a terminated reexamination proceeding showing the delay was unavoidable or unintentional, and the appropriate petition fee for entry of late papers.
- (C) The primary examiner responsible for the reexamination should mail a Notice of Allowance and grant a new patent. The patent owner's failure to timely respond to the outstanding Office action does not affect the allowability of the claims in the patent.
- (D) The examiner should provide an Office action based upon the claims in existence prior to the patent owner's late amendment, and mail a Final Office action.
- (E) The registered practitioner should request an extension of time of four months, and file a Notice of Appeal.

7. On January 2, 2001, a registered practitioner filed a patent application with the USPTO for inventor Bloc. The application includes a specification and a single claim to the invention which reads as follows:

1. Compound Y.

In the specification, Bloc explains that compound Y is an intermediate in the chemical manufacture of synthetic Z. With respect to synthetic Z, the specification discloses its structural formula and further states that synthetic Z is modeled on the natural form of Z to give it the same therapeutic ability to alleviate pain. The specification goes on to state that synthetic Z is also a cure for cancer. On June 2, 2001, the practitioner received an Office action from the primary examiner rejecting the claim. The claim is rejected under 35 U.S.C. 101 as being inoperative; that is, the synthetic Z does not operate to produce a cure for cancer (i.e., incredible utility). Bloc believes he is entitled to a patent to his compound Y. In accordance with the patent laws, rules and procedures as related in the MPEP, how best should the practitioner reply to the rejection of the claim?

- (A) Advise Bloc that he should give up because a cure for cancer is indeed incredible and is unproven.
- (B) File a reply arguing that a cure for cancer is not incredible and he can prove it if given the chance.
- (C) File a reply arguing that whether or not a cure for cancer is incredible is superfluous since Bloc has disclosed another utility – alleviating pain, which is not incredible.
- (D) File a reply arguing that the claim is directed to compound Y, not synthetic Z.
- (E) File a reply arguing that synthetic Z is modeled on the natural form of Z.

8. 35 USC 102(d) establishes four conditions which, if all are present, establish a bar against the granting of a patent in this country. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following is not one of the four conditions established by 35 USC 102(d)?

- (A) The foreign application must be filed more than 12 months before the effective U.S. filing date.
- (B) The foreign application must have been filed by the same applicant as in the United States or by his or her legal representatives or assigns.
- (C) The foreign patent or inventor's certificate must be actually granted before the U.S. filing date.
- (D) The foreign patent or inventor's certificate must be actually granted and published before the U.S. filing date.
- (E) The same invention must be involved.

9. Smith's first invention is a new method of fabricating a semiconductor capacitor in a dynamic random access memory (DRAM) cell. Smith filed a first patent application on December 13, 2001 disclosing and claiming the first invention. Smith's later, second invention, is an improved semiconductor capacitor in a DRAM cell and a method of making it. Smith filed a second application on December 16, 2002, claiming the benefit of the filing date of the copending first application. The second application contains claims 1-20, and a specification that provides support for the claimed subject matter in compliance with 35 USC 112, first paragraph. In the second application, claims 1-10 are drawn to Smith's first invention, and claims 11-20 are drawn to Smith's second invention. The primary examiner found a non-patent printed publication authored by Jones published on February 4, 2002. The article discloses the both of Smith's inventions. Which of the following courses of action by the examiner would be in accord with the patent laws, rules and procedures as related in the MPEP?

- (A) The examiner can reject claims 1-20 in the second application using the article because the publication date of the article is earlier than the filing date of the second application.
- (B) The examiner cannot reject any of the claims in the second application using the article because the second application claims the benefit of the filing date of the first application.
- (C) The examiner can reject claims 1-20 in the second application using the article because the second application is not entitled to the benefit of the filing date of the first application since the second application was filed more than one year from the filing date of the first application.
- (D) The examiner can reject claims 1-10, but cannot reject claims 11-20 in the second application because the first application did not disclose the improved capacitor set forth in claims 11-20.
- (E) The examiner cannot reject claims 1-10, but can reject claims 11-20 in the second application because the first application did not disclose an improved capacitor set forth in claims 11-20.

10. In accordance with the patent laws, rules and procedures as related in the MPEP, definiteness of claim language under 35 U.S.C. 112, second paragraph must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure.
- (B) The teachings of the prior art.
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.
- (D) The claim interpretation that would be given by one possessing expert skill in the pertinent art at the time the invention was made
- (E) (A), (B) and (C).

11. Application A was filed after November 29, 2000. Reference X and application A were commonly owned at the time the invention of application A was made. In accordance with the patent laws, rules and procedures as related in the MPEP the prior art exclusion of 35 USC 103(c) can be properly invoked to obviate which of the following rejections?

- (A) A rejection under 35 USC 102(e) based on reference X, if reference X is prior art only under 35 USC 102(e).
- (B) A double patenting rejection based on reference X, if reference X is available as prior art only under 35 USC 102(e).
- (C) A rejection under 35 USC 103(a) based on reference X, if reference X is available as prior art only under 35 USC 102(e).
- (D) (B) and (C).
- (E) All of the above.

12. Inventors B and C are employed by Corporation D, which authorized registered practitioner E to prepare and file a patent application claiming subject matter invented by B and C. Inventor B signed the oath, an assignment to Corporation D, and a power of attorney authorizing practitioner E to prosecute the application. Inventor C refused to sign the oath and any assignment documents for the application. The employment contract between inventor C and Corporation D contains no language obligating C to assign any invention to Corporation D. A patent application was properly filed in the USPTO under 37 CFR 1.47 naming B and C as inventors, but without inventor C signing the oath. C has now started his own company competing with Corporation D producing a product with the invention in the application. Inventor B is a friend of inventor C and wants C to have continued access to the application. Which of the following statements is in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) Inventor C, who has not signed the oath or declaration, may revoke the power of attorney to practitioner E and appoint practitioner F to prosecute the application.
- (B) Inventor C cannot be excluded from access to the application because inventor B has not agreed to exclude inventor C. In order to exclude a co-inventor from access to an application, all the remaining inventors must agree to exclude that co-inventor.
- (C) Inasmuch as one of the named joint inventors has not assigned his or her rights to Corporation D, the corporation is not an assignee of the entire right and interest, and therefore cannot exclude inventor C from access to the application.
- (D) An inventor who did not sign the oath or declaration filed in an application can always be excluded from access to an application.
- (E) An assignee filing an application can control access to an application and exclude inventors who have not assigned their rights and other assignees from inspecting the application.

13. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following fees may not be reduced by 50 percent for “small entities”?

- (A) The basic filing fee for a design patent application.
- (B) The fee for a disclaimer.
- (C) The fee for a petition for an extension of time.
- (D) The fee for recording a document affecting title.
- (E) The maintenance fee due at 3 years and six months after grant.

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

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

15. A utility application filed in May 2001 has been prosecuted through a second action final rejection. In the final rejection some claims were allowed and other claims were finally rejected. Which of the following accords with the patent laws, rules and the procedures as related in the MPEP for a proper reply to a second action final rejection in the utility application?

- (A) An amendment canceling all rejected claims and complying with 37 CFR 1.116.
- (B) Only a Notice of Appeal.
- (C) The appropriate fee for a request for continued examination (RCE).
- (D) A continued prosecution application (CPA) under 37 CFR 1.53(d).
- (E) All of the above.

16. Tribell files a patent application for her aroma therapy kit on November 29, 1999, which issues as a patent on August 7, 2001. She tries to market her kit but all of her prospects are concerned that her patent claims are not sufficiently broad. On September 5, 2001, Tribell asks a registered practitioner for advice on what to do to improve her ability to market her aroma therapy kit. At the consultation the practitioner learns that in the original patent application, Tribell had a number of claims which were subjected to a restriction requirement, but were nonelected and withdrawn from further consideration. The practitioner also determines that the claims in the patent obtained by Tribell were narrower than the broader invention disclosed in the specification, and the cited references may not preclude patentability of the broader invention. Which of the following is the best course of action to pursue in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) Tribell should file a reissue application under 35 USC 251 within two years of the issuance of the patent, broadening the scope of the claims of the issued patent.
- (B) Tribell should file a reissue application under 35 USC 251 any time during the period of enforceability of the patent to broaden the scope of the claims of the issued patent, and then file a divisional reissue application of the first reissue application on the nonelected claims that were subjected to a restriction requirement in the nonprovisional application which issued as a patent.
- (C) Tribell should simultaneously file two separate reissue applications under 35 USC 251, one including an amendment of broadening the claims in the original patent, and the other including the nonelected claims that were subjected to a restriction requirement in the nonprovisional application which issued as a patent.
- (D) Tribell 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 original application.
- (E) Tribell should immediately file a reissue application under 35 USC 251, including the nonelected claims that were subjected to a restriction requirement in the original application.

17. Inventor files an application containing the following original Claim 1:

1. A widget comprising element A, and element B.

In a first Office action on the merits, a primary examiner rejects claim 1 under 35 USC 103 as being obvious over reference X. Reference X explicitly discloses a widget having element A, but it does not disclose element B. The examiner, however, takes official notice of the fact that element B is commonly associated with element A in the art and on that basis concludes that it would have been obvious to provide element B in the reference X widget. In reply to the Office action, the registered practitioner representing the applicant makes no amendments, but instead requests reconsideration of the rejection by demanding that examiner show proof that element B is commonly associated with element A in the art. Which of the following actions, if taken by the examiner in the next Office action would be in accord with the patent laws, rules and procedures as related in the MPEP?

- I. Vacate the rejection and allow the claim.
 - II. Cite a reference that teaches element B is commonly associated with element A in the art and make the rejection final.
 - III. Deny entry of applicant's request for reconsideration on the ground that it is not responsive to the rejection and allow applicant time to submit a responsive amendment.
- (A) I and II only.
 - (B) II only.
 - (C) II and III only.
 - (D) I, II, and III.
 - (E) I and III only.

18. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following statements regarding operability or enablement of a prior art reference is the most correct?

- (A) The level of disclosure required for a reference to be enabling prior art is no less if the reference is a United States patent than if it is a foreign patent.
- (B) A reference is not presumed to be operable merely because it expressly anticipates or makes obvious all limitations of an applicant's claimed apparatus.
- (C) A non-enabling reference may not qualify as prior art for the purpose of determining anticipation or obviousness of the claimed invention.
- (D) A reference does not provide an enabling disclosure merely by showing that the public was in possession of the claimed invention before the date of the applicant's invention.
- (E) All of the above are correct.

19. In accordance with patent laws, rules and procedures as related in the MPEP, a rejection under 35 USC 102 can be overcome by demonstrating:

- (A) the reference is nonanalogous art.
- (B) the reference teaches away from the claimed invention.
- (C) the reference disparages the claimed invention.
- (D) (A), (B) and (C).
- (E) None of the above.

20. On January 3, 2003, a registered practitioner filed a continuation application that includes a benefit claim to a prior-filed application. The practitioner simultaneously filed in the prior-filed application an express abandonment in favor of a continuing application. The prior application contained five drawing figures described in the specification. However, the continuation application contains only four of the five drawing figures. The specification of the continuation application did not include a complete description of the missing drawing figure. A postcard from the USPTO, listing the contents of the continuation application, contains a note that only four drawing figures were received. The practitioner inadvertently omitted one of the drawing figures mentioned in the specification when he filed the continuation application. The missing drawing figure shows a claimed feature of the invention. On February 10, 2003, the practitioner received a Notice of Omitted Item(s) properly according a filing date of January 3, 2003 for the continuation application without the missing drawing figure and notifying the applicant that the drawing is missing. Which of the following procedures for filing the missing drawing would comply with the patent laws, rules and procedures as related in the MPEP for according the continuation application a January 3, 2003 filing date with the five drawing figures that were present in the application?

- (A) The practitioner files the missing drawing figure in response to the Notice of Omitted Item(s) within the time period set forth in the notice.
- (B) The practitioner files the missing drawing figure and an amendment to the specification to add a complete description of the missing drawing figure in response to the Notice of Omitted Item(s) within the time period set forth in the notice.
- (C) The practitioner files an amendment to cancel the description of the missing drawing figure from the specification of the continuation application.
- (D) If the continuation application as originally filed includes an incorporation by reference of the prior-filed application to which the benefit is claimed, the practitioner can file the missing drawing figure any time prior to the first Office action.
- (E) The practitioner files the missing drawing figure accompanied by a petition under 37 CFR 1.53(e) with the petition fee set forth in 37 CFR 1.17(h) only alleging that the drawing figure indicated as omitted was in fact deposited with the USPTO with the application papers.

21. Patent application A was filed on January 12, 1995, containing claims 1-10. A primary examiner rejects the claims under 35 USC 102(b) as being anticipated by a U.S. patent issued on June 2, 1992. The rejection also relies on a technical paper published March 12, 1993 to show that a characteristic is inherent in the patent, although not expressed in its disclosure. According to the patent laws, rules and procedures as related in the MPEP, which of the following actions is most likely to overcome the rejection?

- (A) Filing a declaration and exhibits under 37 CFR 1.131 to antedate the reference U.S. patent.
- (B) Filing evidence under 37 CFR 1.132 tending to show commercial success of the invention.
- (C) Filing evidence under 37 CFR 1.132 tending to show unexpected results of the invention.
- (D) Amending the specification of application A to claim priority under 35 USC 120 by a specific reference to a prior copending application B that was filed before June 2, 1992 by the same inventor and discloses the invention claimed in at least one claim of application A in the manner provided by the first paragraph of 35 USC 112.
- (E) Submitting arguments pointing out that the rejection under 35 USC 102(b) relies on more than one reference.

22. Application Number A was published as U.S. Patent Application Publication Number B. A member of the public reviewed the listing of the file contents of the application on the Patent Application Information Retrieval system and determined that the application was still pending, that a final Office action was mailed, and that the application file is in the Technology Center where it is being examined. The member of the public does not have a power to inspect, but would like a copy of the final Office action as well as the other papers in the patent application. In accordance with the patent laws, rules and procedures as related in the MPEP, can a copy of these papers be obtained by the member of the public, and if so, how can the copy be obtained?

- (A) No, a copy cannot be obtained because patent applications are maintained in confidence pursuant to 35 USC 122(a).
- (B) No, a copy cannot be obtained because the patent application is still pending.
- (C) Yes, a member of the public can go to the Technology Center and ask for the file for copying at a public photocopier.
- (D) Yes, the member of the public can complete a "Request for Access to an Application Under 37 CFR 1.14(e)" and, without payment of a fee, order the file from the File Information Unit. Upon the Unit's receipt of the application, the member of the public can use a public photocopier to make a copy.
- (E) Yes, the member of the public can order a copy from the Office of Public Records, with a written request and payment of the appropriate fee.

23. Applicant files a claim which includes the following limitation: “a step for crossing the road.” The specification recites the following acts: “(1) go to the curb, (2) look both ways, (3) if the road appears safe, walk across the road, (4) step up onto the far curb, (5) continue walking.” The primary examiner properly construes the step limitation to cover the foregoing acts. A prior art reference, published two years before the application was filed, expressly describes acts (1)-(4), but not (5). This same reference also discloses the remaining limitations recited in applicant’s claim, i.e., those other than the step plus function limitation. The examiner rejects the claim under 35 USC 102(b) as being anticipated by the prior art reference. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following is the most complete reply to overcome the rejection under these circumstances?

- (A) An argument explaining that since act (5) is not disclosed in the reference, it does not anticipate the claim.
- (B) An amendment to the specification deleting act (5) – continue walking.
- (C) An argument showing that neither the equivalent of act (5) nor act (5) is disclosed in the reference, which therefore does not anticipate the claim.
- (D) An amendment to the claim by adding a negative limitation to expressly exclude act (5) from crossing the road.
- (E) (B) and (D).

24. A registered practitioner filed an application for an applicant claiming a “a means for pulling the door open.” The specification describes a handle and a knob as being used together as a corresponding structure for pulling the door open. A prior art patent discloses a door opened by pulling on an attached bar. The primary examiner issued an Office action rejecting the claim under 35 USC 102 as being anticipated. In the action, the examiner properly identified the corresponding structure described in applicant’s specification as the means for pulling the door open, and properly explained why the prior art attached bar is the equivalent of the structure described in applicant’s specification. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following is the most correct reply to overcome the rejection under these circumstances?

- (A) An amendment to the claim changing the pulling means to expressly include an attached bar.
- (B) Only argue that the claimed pulling means is not found in the prior art relied-upon reference and therefore the claim is patentable.
- (C) An amendment to the specification that adds an attached bar to correspond to the prior art.
- (D) An amendment to the claim substituting for the term “means for pulling the door open” the structure of a handle and a knob.
- (E) An amendment to the specification that excludes an attached bar as a pulling means.

25. A registered practitioner filed a utility patent application on May 15, 2000 pursuant to 35 USC 111(a) claiming a detergent composition. On May 15, 2002 the Office mailed a non-final Office action setting a 3-month period for reply. A proper reply was mailed on August 15, 2002 by first-class mail with sufficient postage to the USPTO. The reply was received by the USPTO on September 15, 2002. On September 30, 2002, the Office mailed a final Office action. On October 15, 2002, the Office received a Request for Continued Examination (RCE) meeting all of the requirements of 37 CFR 1.114. On October 30, 2002, the USPTO mailed a Notice of Allowance in view of the RCE and amendment. The utility application issued on February 11, 2003. Which of the following statements is in accord with the patent laws, rules and procedures as related in the MPEP concerning the amount of additional term applicant X would receive because of Patent Term Adjustment (PTA)?

- (A) The patentee would earn PTA because the Office failed to mail at least one notification under 35 USC 132 or notice of allowance under 35 USC 151 no later than fourteen months after the date the application was filed under 35 USC 111(a) but would lose some earned PTA because applicant did not file a response to the non-final rejection within three months.
- (B) The patentee would earn PTA because the Office failed to mail at least one notification under 35 USC 132 or notice of allowance under 35 USC 151 no later than fourteen months after the date the application was filed under 35 USC 111(a) and would not lose any earned PTA because applicant filed a response to the non-final rejection within three months.
- (C) The patentee would not earn any additional time under the provisions of PTA because the application is utility application, not a design application.
- (D) The patentee would not earn any additional time because the application was filed prior to May 29, 2000 and the filing of the RCE would not make the application eligible for PTA.
- (E) The patentee would earn PTA because the filing of the RCE on October 15, 2002 makes the application eligible for PTA and the Office did not mail at least one notification under 35 USC or notice of allowance under 35 USC 151 within 14 months of the date the application was filed under 35 USC 111(a).

26. When, in accordance with the patent laws, rules and procedures as related in the MPEP, is a supplemental oath or declaration treated as an amendment under 37 CFR 1.312?

- (A) When filed in a nonprovisional application after the Notice of Allowance has been mailed.
- (B) When filed in a reissue application at any point during the prosecution.
- (C) When filed in a nonprovisional application after the payment of the Issue Fee.
- (D) When filed in a reissue application after the Notice of Allowance has been mailed.
- (E) (A) and (D).

27. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following is patentable subject matter under 35 USC 101?

- (A) A novel and unobvious abstract idea.
- (B) A previously undiscovered law of nature.
- (C) A billing process containing mathematical algorithms producing a written invoice.
- (D) A novel and unobvious discovery of a physical phenomenon.
- (E) All of the above.

28. A registered practitioner files a patent application with the following claim:

1. A plastic insert for the bottom of a shopping cart comprising circular receptacles to receive wine bottles and to maintain them in an upright and stable position even while the shopping cart is moved about a store so that they do not fall and break.

Patent A discloses a plastic insert for the bottom of a shopping cart comprising rectangular receptacles to receive cereal boxes and to maintain them in an upright and stable position even while the shopping cart is moved about a store in order to keep them organized in the cart. Patent A also discloses that the receptacles could be any circular diameter to receive complementary shaped bottles or jars such as to securely hold 2-liter soft drink bottles or mayonnaise jars. A primary examiner rejected the claim as being obvious under 35 USC 103 over Patent A reasoning that Patent A suggests to one of ordinary skill in the art an insert for a shopping cart with circular receptacles for the purpose of stably maintaining any bottle, including wine bottles, while pushing the cart about a store so that the cart remains organized. Assume the examiner has made a sufficient *prima facie* case of obviousness. Following receipt of the rejection, the practitioner filed a timely reply. The practitioner argued that Patent A does not render obvious the claimed subject matter because there is no suggestion of a plastic insert to keep a wine bottle from falling and breaking in a shopping cart. Which of the following best explains why, in accordance with the patent laws, rules and the procedures as related in the MPEP, the examiner should or should not be persuaded by the practitioner's argument?

- (A) No, because Patent A suggests circular receptacles for any complementary bottle, albeit for a different purpose.
- (B) Yes, because there is no suggestion in Patent A that the plastic insert can hold a wine bottle.
- (C) Yes, because the claim uses the insert to keep the bottles from falling and breaking while Patent A uses the insert to keep the cart organized.
- (D) Yes, because Patent A is more interested in organizing boxes than holding bottles.
- (E) Yes, because the prevention from breakage is an unexpected property of the plastic insert.

29. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following statements regarding publications as references is incorrect?

- (A) A doctoral thesis indexed and shelved in a library can be sufficiently accessible to the public to constitute prior art as a printed publication.
- (B) Evidence showing routine business practices is never sufficient to establish the date on which a publication became accessible to the public.
- (C) A paper which is orally presented in a forum open to all interested persons can constitute a “printed publication” if written copies are disseminated without restriction.
- (D) Documents distributed only internally within an organization, which has an existing policy of confidentiality or agreement to remain confidential are not “printed publications” even if many copies are distributed.
- (E) A publication disseminated by mail is not available as prior art until it is received by at least one member of the public.

30. A registered practitioner receives an Office action for Application X, a patent application filed after November 29, 1999. The action contains a rejection of all the claims as being obvious under 35 USC 103(a) over Patent A in view of Patent B. Patent A is only available as prior art under 35 USC 102(e). Patent B is available under 35 USC 102(b). The practitioner seeks to disqualify Patent A as prior art under 35 USC 103(c). Which of the following would be sufficient evidence to disqualify Patent A as prior art in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) A declaration signed by an employee of Corporation K, who is not empowered to act on behalf of Corporation K, stating that at the time the invention claimed in Application X was made, the claimed invention and Patent A were commonly owned by Corporation K.
- (B) A declaration signed by the inventor of Patent A stating that at the time the invention claimed in Application X was made, the invention claimed in Application X and the invention claimed in Patent A were both subject to an obligation of assignment to the same person.
- (C) A statement by the inventor Jones, the sole inventor of Application X, saying that at the present time, Application X and Patent A are commonly owned.
- (D) A statement by the practitioner stating that Application X and Patent A were, at the time the invention claimed in Application X was made, commonly owned by the same person.
- (E) A statement by inventor Jones, the sole inventor of Application X, saying that at the time the invention claimed in Application X was made, Jones owned a majority interest in Patent A.

31. Reexamination has been ordered following receipt of a request for reexamination of U.S. Patent X, filed by the patentee. Patent X contains independent claims 1 through 4, each directed to a hydrocyclone separator apparatus. They are the only claims that were ever presented during prosecution of the application that matured into Patent X. In the first Office action during reexamination, claims 1 through 4 are rejected as being obvious under 35 USC 103 over U.S. Patent Z. The apparatus is used for separating material, including fibers suspended in a liquid suspension, into a light fraction containing the fibers, and a heavy fraction containing rejects. Assume there are no issues under 35 USC 102, 103, or 112, and that any dependent claim is properly dependent. Recommend which of the following claims, if any, would be subject to rejection under 35 USC 305 for improperly enlarging the scope of the original claim in accordance with the patent laws, rules and procedures as related in the MPEP.

- (A) Claim 5. A hydrocyclone separator apparatus according to claim 4, wherein said blades are configured in the form of generally plane surfaces curved in one plane only.
- (B) Claim 5. A hydrocyclone separator apparatus according to claim 4, wherein the outlet duct is in the form of two frusto-conical portions joined at their narrow ends.
- (C) Claim 5. A method of separating material including fibers suspended in a liquid suspension comprising the steps of separating the material into a light fraction containing the fibers and a heavy fraction containing rejects, and converting the light fraction into a pulp and paper stock suspension.
- (D) Claim 5. A hydrocyclone separator apparatus according to claim 4, wherein the separator chamber is conical in shape having at the narrow end an outlet for the heavy fraction and at its wide end an outlet for the light fraction.
- (E) None of the above.

32. With respect to the examiner's burden in making an enablement rejection under 35 USC 112, first paragraph, which of the following statements is or are in accordance with the patent laws, rules and procedures as related in the MPEP?

- (1) The examiner may properly make an enablement rejection before construing the claims.
 - (2) The examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention.
 - (3) The examiner need not give reasons for the uncertainty of the enablement when there is no evidence of operability beyond the disclosed embodiments.
- (A) Statement (1) only
 - (B) Statement (2) only
 - (C) Statement (3) only
 - (D) Statements (1) and (2)
 - (E) Statements (1) and (3)

33. Which of the following phrases taken from an independent claim has an antecedent basis problem according to the patent laws, rules and the procedures as related in the MPEP?

- (A) “the center of the circle having ...,” where the claim does not previously recite that the circle has a “center.”
- (B) “the major diameter of the ellipse being ...,” where the claim does not previously recite that the ellipse has a “major diameter.”
- (C) “the outer surface of the sphere being ...,” where the claim does not previously recite that the sphere has an “outer surface.”
- (D) “the lever of the machine being located ...,” where the claim does not previously recite a “lever.”
- (E) “the area of the rectangle being ...,” where the claim does not previously define an “area.”

34. A registered practitioner filed a utility application on February 11, 2002. On April 4, 2002, the practitioner filed an information disclosure statement (IDS) in the application. The practitioner received a notice of allowance dated January 3, 2003 soon after it was mailed. When discussing the application with the practitioner on January 21, 2003, and before paying the issue fee, the client notices for the first time that a reference, which is one of many patents obtained by the client’s competitor, was inadvertently omitted from the IDS. The client has been aware of this reference since before the application was filed. The client is anxious to have this reference appear on the face of the patent as having been considered by the USPTO. Which of the following actions, if taken by the practitioner, would not be in accord with the patent law, rules and procedures as related by the MPEP?

- (A) Before paying the issue fee, timely file an IDS citing the reference, along with the certification specified in 37 CFR 1.97(e), and any necessary fees.
- (B) Within three months of the mail date of the notice of allowance, without paying the issue fee, timely file a Request for Continued Examination (RCE) under 37 CFR 1.114, accompanied by the fee for filing an RCE, and an IDS citing the reference.
- (C) Within three months of the mail date of the notice of allowance, without paying the issue fee, timely file a continuing application under 37 CFR 1.53(b), an IDS citing the reference, and any necessary fees.
- (D) After paying the issue fee, timely file a petition to withdraw the application from issue to permit the express abandonment of the application in favor of a continuing application, a continuation application under 37 CFR 1.53(b), an IDS citing the reference, and any necessary fees.
- (E) After paying the issue fee, timely file a petition to withdraw the application from issue to permit consideration of a Request for Continued Examination (RCE) under 37 CFR 1.114, the fee for filing an RCE, and an IDS citing the reference.

35. A registered practitioner files an amendment to the client's claim which inserts language into the claim. The primary examiner improperly rejects the claim under 35 USC 112, first paragraph, description requirement. The examiner's rejection states that the amendment inserted new matter which does not have descriptive support in the original specification. The examiner correctly points out that there is no literal support for the amendatory claim language in the original specification, but erroneously concludes that it constitutes new matter. Assume that there is support for the amendment in the original disclosure. In accordance with the patent laws, rules and procedures as related in the MPEP, a proper reply would include which of the following argument(s) to show the examiner is in error?

- (A) The original specification would enable one of ordinary skill in the art to practice the invention as now claimed.
- (B) Literal support for new claim language is not required.
- (C) The original specification reasonably conveys to one of ordinary skill in the art that the inventor had the claimed invention in his/her possession as of the filing date of the application.
- (D) The new claim language is described in a related application filed by the inventor that is now a U.S. patent.
- (E) (B) and (C).

36. A registered practitioner filed a patent application in the Office in 1999. Following examination and a final rejection, the practitioner timely filed a proper notice of appeal and a proper appeal brief in the application wherein claims 1-3 stand rejected, claims 4 and 5, which depend from claim 1, stand objected to as depending from a rejected claim but are otherwise allowable, and claims 6-10 stand allowed. The appeal involves claims 1-3. After the brief was filed but prior to a decision by the Board of Patent Appeals and Interferences, the practitioner filed a request for continued examination (RCE) with a submission in accordance with 37 CFR 1.114 without paying the fee set forth in 37 CFR 1.17(e). In accordance with the patent laws, rules and procedures as related in the MPEP, what effect does the filing of the RCE without the fee set forth in Rule 1.17(e) have on the application under appeal?

- (A) The application is abandoned.
- (B) The application is still pending and under appeal awaiting a decision by the Board of Patent Appeals and Interferences, because the RCE was improper.
- (C) The application is still pending; the appeal is considered withdrawn and the application will be passed to issue with claims 1-3 canceled and claims 4-10 allowed.
- (D) The application is still pending; the appeal is considered withdrawn and the application will be passed to issue with claims 1-5 canceled and claims 6-10 allowed.
- (E) The appeal is withdrawn; the application is returned to the primary examiner and prosecution is reopened as to claims 1-10.

37. Applicant filed an application containing a claim directed to a polishing wheel coated with diamond grit particles. The application discloses, but does not claim, a diamond grit particle size of 5-7 microns. The examiner rejected the claim under 35 USC 102(b) as being anticipated by a U.S. patent which disclosed as its invention a polishing wheel in accordance with the claim of the application but coated with glass grit particles instead of diamond grit particles. The applied patent, which issued more than 1 year prior to the effective filing date of the application, also disclosed that diamond grit particles were known for coating on polishing wheels but were inferior to glass grit particles because they were more expensive and did not adhere as well to the polishing wheel. The applied patent disclosed a grit particle size of 50-100 microns. Which of the following timely taken courses of action would comply with the patent laws, rules and procedures as related in the MPEP for overcoming the rejection?

- (A) Argue that the patent teaches away from the use of a diamond grit particle coating on a polishing wheel and thus does not teach the claimed invention.
- (B) File a declaration under 37 CFR 1.132 showing unexpected results using diamond grit rather than glass grit.
- (C) Antedate the applied patent by filing a declaration under 37 CFR 1.131 showing that applicant invented the claimed subject matter prior to the effective date of the applied patent.
- (D) Argue the applied patent is nonanalogous art.
- (E) Amend the claim by adding a limitation that the diamond grit particle size is 5-7 microns, and arguing that the claimed invention differs from applied patent by limited the diamond grit particle size to 5-7 microns.

38. Prosecution before the primary examiner results in the rejection of claim 1. Claim 2 was objected to as being allowable except for its dependency from claim 1. Independent claim 3 has been allowed. The rejection of claim 1 is properly appealed to the Board of Patent Appeals and Interferences. The Board properly affirms the rejection of claim 1. Appellant has filed no response to the decision of the Board, the appellant has taken no action, and the time for filing an appeal to the court or a civil action has expired. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following actions is the most appropriate response by the examiner?

- (A) The examiner should hold the application abandoned.
- (B) The examiner should cancel claim 1, convert dependent claim 2 into independent form by examiner's amendment, and allow the application.
- (C) The examiner should set a 1-month time limit in which appellant may rewrite the dependent claim in independent form.
- (D) The examiner should cancel claims 1 and 2 and allow the application with claim 3 only.
- (E) None of the above.

39. On May 1, 2001, a complete patent application was filed with the USPTO naming H as the sole inventor. A primary examiner rejected all the claims in the application under 35 USC 102(e) as being anticipated by a U.S. Patent granted to inventors H and S. The patent was granted on September 25, 2001 on an application filed on December 7, 2000. The claims of the patent application and U.S. patent define the same patentable invention as defined in 37 CFR 1.601(n). The U.S. patent and the application have common ownership. Which of the following, if properly submitted by applicant, would overcome the rejection in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) File a terminal disclaimer in accordance with 37 CFR 1.321(c).
- (B) File a declaration under 37 CFR 1.131 to establish the inventor invented the subject matter of the rejected claim prior to the effective date of the reference X.
- (C) File a declaration stating that the application and patent are currently owned by the same party, and that the inventor named in the application is the prior inventor under 35 USC 104.
- (D) (A) and (C).
- (E) All of the above.

40. In accordance with patent laws, rules and procedures as related in the MPEP, which of the following transitional phrases exclude additional, unrecited elements or method steps from the scope of a claim?

- (A) Comprising;
- (B) Containing;
- (C) Characterized by;
- (D) Including; or
- (E) None of the above.

41. Assume that each claim 5 is in a different patent application. Recommend which, if any, of the following wording is in accord with the patent laws, rules and procedures as related in the MPEP for a multiple dependent claim.

- (A) Claim 5. A gadget according to claims 1-3, in which ...
- (B) Claim 5. A gadget as in claims 1, 2, 3, and/or 4, in which ...
- (C) Claim 5. A gadget as in claim 1 or 2, made by the process of claim 3 or 4, in which ...
- (D) Claim 5. A gadget as in either claim 6 or claim 8, in which ...
- (E) None of the above are proper multiple dependent claims.

42. A registered practitioner filed a first patent application wherein claims 1-10 claims are directed to a widget and claims 11-20 are directed to a method of making a widget. Following a proper restriction requirement, claims 1-10 were elected for prosecution. The primary examiner rejected claims 1-10. The practitioner filed a reply that only consisted of argument. The examiner was unpersuaded by the argument, and entered a final rejection of claims 1-10. In reply, the practitioner filed a continuing application containing claims 1-10 directed to a widget, and claims 11-20 directed to a method of using a widget. In the continuing application, the examiner enters a new written restriction requirement requiring a provisional election between claims 1-10 and claims 11-20. The practitioner believes the new restriction requirement is improper and would like the rejection in the parent application reviewed as well. The new restriction requirement has not been made final. Which of the following best describes whether and why, in accordance with the patent laws, rules, and procedures as related by the MPEP, the reply to the restriction requirement may be by appeal to the Board of Patent Appeals and Interferences?

- (A) Yes. An immediate appeal to the Board can be filed to review the restriction requirement if any claims have been twice rejected.
- (B) No. An immediate appeal cannot be filed to the Board because the new claims directed to a method of using a widget have not been twice rejected.
- (C) Yes. An immediate appeal can be filed for any claims that have been twice rejected because the Board can also review any second restriction requirement made against the same claims.
- (D) No. An immediate appeal to the Board cannot be lodged because a provisional election has not been made of either the claims to a widget or claims to a method of use of the widget.
- (E) No. An immediate appeal cannot be taken because no claims are currently under rejection. Review of a final restriction requirement is only possible as a petitionable matter before a Technology Center Director. It is not an appealable matter to the Board.

43. In accordance with the patent laws, rules and procedures as related in the MPEP, where the independent claim in an application is to an article of manufacture, then a dependent claim to the article of manufacture does not comply with 35 USC 112, fourth paragraph, if:

- (A) the further limitation changes the scope of the dependent claim from that of the claim from which it depends.
- (B) the further limitation of the dependent claim is not significant.
- (C) it does not refer back to and further limit the claim from which it depends.
- (D) it relates to a separate invention.
- (E) it is separately classified from the claim from which it depends.

44. A registered practitioner filed in the USPTO a client's utility patent application on December 30, 2002. The application was filed with a request for nonpublication, certifying that the invention disclosed in the U.S. application has not and will not be the subject of an application in another country, or under a multilateral international agreement, that requires eighteen month publication. Subsequently, the client files an application in Japan on the invention and some recent improvements to the invention. The improvements are not disclosed or supported in the utility application. Japan is a country that requires eighteen month publication. Two months after filing the application in Japan, and before filing any other papers in the USPTO, the client remembers that a nonpublication request was filed and informs the practitioner about the application that was filed in Japan. Which of the following courses of action is in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) The application is abandoned because the practitioner did not rescind the nonpublication request and provide notice of foreign filing within 45 days of having filed the application in Japan. The applicant must now file a petition and fee to revive under 37 CFR 1.137(b).
- (B) The application is abandoned because the applicant did not rescind the nonpublication request before filing the application in Japan. The applicant must now file a petition and fee to revive under 37 CFR 1.137(b).
- (C) The applicant should file an amendment to the specification of the U.S. application, adding the recent improvements to the disclosure in the specification.
- (D) The application is abandoned because the applicant did not rescind the nonpublication request by notifying the Office under 37 CFR 1.213(c) within the appropriate time. The applicant must now file a petition and fee to revive under 37 CFR 1.137(b).
- (E) The applicant could today notify the USPTO of the foreign filing. It is not necessary to file a petition and fee to revive for the application to continue to be examined in the USPTO.

45. In accordance with patent laws, rules and procedures as related in the MPEP, an abandoned U.S. patent application:

- (A) is never available as evidence of prior art.
- (B) may become prior art only when it is properly incorporated by reference in the disclosure of a U.S. patent.
- (C) may become prior art as of its filing date, but only if it is properly incorporated by reference in the disclosure of a U.S. patent.
- (D) may become evidence of prior art as of its filing date, but only if it is properly incorporated by reference in the disclosure of a U.S. patent or U.S. application publication.
- (E) may become prior art when it is properly incorporated by reference in the disclosure of a U.S. application publication.

46. In accordance with the patent law, rules and procedures as related by the MPEP, which of the following is not a “printed publication” under 35 USC 102(b), with respect to a patent application filed June 1, 2002?

- (A) A paper that was orally presented at a meeting held May 1, 2001, where the meeting was open to all interested persons and the paper was distributed in written form to six people without restriction.
- (B) A doctoral thesis that was indexed, cataloged, and shelved May 1, 2001, in a single, university library.
- (C) A research report distributed May 1, 2001, in numerous copies but only internally within an organization to persons who understood the organization’s unwritten policy of confidentiality regarding such reports.
- (D) A reference available only in electronic form on the Internet, which states that it was publicly posted May 1, 2001.
- (E) A technical manual that was shelved and cataloged in a public library as of May 1, 2001, where there is no evidence that anyone ever actually looked at the manual.

47. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following statements regarding claim interpretation during patent prosecution is incorrect?

- (A) A claim is to be given its broadest reasonable interpretation in light of the supporting disclosure in the specification.
- (B) Because a claim is read in light of the specification, the claim may properly be narrowed by interpreting it as including elements or steps disclosed in the specification but not recited in the claim.
- (C) If an applicant does not define a claim term in the specification, that term is given its ordinary meaning in the art.
- (D) When an explicit definition of a claim term is provided in an applicant’s specification, that definition controls the interpretation of the term as it is used in the claims.
- (E) Means plus function language in claims which defines the characteristics of a machine or manufacture includes only the corresponding structures or materials disclosed in the specification and equivalents thereof.

48. Buddy is a recent father and a machinist at a local machine shop. One day while driving to work, Buddy conceived an idea for an improved baby stroller. He quickly worked out many of the details of how to build such an improved stroller, but he still had questions. Buddy later explained his idea to his employer and showed the employer detailed preliminary drawings of the stroller without any agreement as to confidentiality. Buddy wanted use of his employer's machine shop to build a model. Buddy's employer was also excited about the stroller idea and its commercial potential, and the two quickly reached an oral agreement. Buddy would have free use of the machine shop equipment and supplies after regular business hours to work on his model. In exchange, Buddy agreed to assign any patent rights in his invention to the employer for \$1,000.00. Only Buddy and, occasionally, his employer were ever present in the shop when Buddy was working on the stroller. Buddy finalized the design just over a year later, and a nonprovisional patent application was on file within a month of finalization along with a recently executed written assignment of the rights in the invention to Buddy's employer. During prosecution of the patent application, the examiner learned of the oral agreement between Buddy and his employer, and rejected the claims on the basis that the invention was on sale more than one year before the application filing date. Determine which of the following would provide the most reasonable basis for traversing the rejection in accordance with the patent laws, rules and procedures as related in the MPEP.

- (A) The examiner cannot properly make the rejection because it is not based on prior art patents or printed publications.
- (B) The oral agreement was a private transaction between Buddy and his employer and no private transaction can provide a basis for an on-sale bar.
- (C) An assignment or sale of the rights in an invention and potential patent rights is not a sale of "the invention" that would operate as a bar to patentability under 35 USC 102(b).
- (D) There can be no on-sale bar even though there was no express requirement of confidentiality because no one other than Buddy's employer was present in the shop when Buddy was working on the stroller and the oral agreement was not public.
- (E) Although the oral agreement to assign the patent to Buddy's employer was made more than a year before the filing date, the written assignment was less than a year before the filing date, and under the Statute of Frauds, sales for more than \$500.00 require a written agreement. A rejection based on the on-sale bar can never be made unless there is an actual sale.

49. Inventor files an application for a non-theoretical metal alloy. The application as originally filed contains the following Claim 1:

1. A metal alloy comprising at least 20% by volume of iron; at least 10% by volume of gallium, and at least 10% by volume of copper.

In accordance with the patent law, rules and procedures as related by the MPEP, which of the following claims would be properly held indefinite under 35 USC 112(2)?

- (A) Claim 2: The alloy of claim 1 containing 66% by volume of gallium and 14% by volume of copper.
- (B) Claim 2: The alloy of claim 1 containing at least 21% by volume of iron, 11% by volume of gallium, and 10.01% by volume of copper.
- (C) Claim 2: The alloy of claim 1 containing 20% by volume of iron, 10% by volume of gallium, and 10% by volume of copper.
- (D) Claim 2: The alloy of claim 1 containing 54% by volume of copper and 27% by volume of gallium.
- (E) Claim 2: The alloy of claim 1 containing at least 1% by volume of silver.

50. Ben hires a registered practitioner to prosecute his patent application. The practitioner drafted an application having fifteen claims. Claim 1 is independent, and each of claims 2-15 are singularly dependent upon claim 1. A proper non-final Office action is mailed to the practitioner. Following consultation with Ben, the practitioner timely prepared, signed, and filed a reply to the Office action containing an amendment that does not add new matter, but does add claims 16-27. Each of claims 16-27 is directed to the same invention sought to be patented through claims 1-15. The dependency of each of claims 16-27 reads “any of claims 5-15.” For purposes of fee calculation in accordance with the patent laws, rules and procedures as related in the MPEP, how many total claims are contained in the application after the amendment is entered?

- (A) One hundred thirty-six.
- (B) One hundred thirty-five.
- (C) Twenty-seven.
- (D) One hundred forty-seven.
- (E) Fifteen.

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

OCTOBER 15, 2003

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. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the patent laws, rules and procedures as related in the Manual of Patent Examining Procedure (MPEP). 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.**

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1. In accordance with the patent laws, rules and procedures as related in the MPEP, for a nonprovisional application to receive a filing date in the USPTO under 37 CFR 1.53(b), all of the following must be filed except:

- (A) The basic filing fee required by 37 CFR 1.16(a).
- (B) A specification as prescribed by the first paragraph of 35 USC 112.
- (C) A description pursuant to 37 CFR 1.71.
- (D) At least one claim pursuant to 37 CFR 1.75.
- (E) Any drawing required by 37 CFR 1.81(a).

2. A U.S. patent was granted on May 8, 2001. The sole independent claim in the patent is directed to a combination of elements ABCD. A registered practitioner filed a reissue application on April 11, 2003 to narrow sole independent claim. In the reissue application, the independent claim is amended to a combination to elements ABCDE. The reissue application is accompanied by a transmittal letter stating that the application was filed to narrow a claim, that all inventors could not be located to sign the reissue oath or declaration at that time, and that a declaration would be submitted in due course. No other amendments to the claims were filed on April 11, 2003. On May 8, 2003, a declaration signed by all inventors is filed declaring that they had claimed less than they had a right to claim, and that the error arose without deceptive intent. The inventors also filed on May 8, 2003 a preliminary amendment deleting element A from the sole independent claim leaving elements BCDE. The amendment and declaration are filed using the provisions of 37 CFR 1.10. The practitioner included an authorization to charge the practitioner's deposit account for any necessary fees. Which of the following actions by the primary the examiner in the first Office action is in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) Reject all the claims based upon a broadening reissue outside the two year statutory period authorized by 35 USC 251 since applicant did not file a broadened reissue claim at the time of filing.
- (B) Reject all the claims based upon a broadening reissue outside the two year statutory period authorized by 35 USC 251 since applicant did not file a claim to a broadened reissue claim within the two year period set by 35 USC 251.
- (C) Reject all the claims based upon a broadening reissue outside the two year statutory period authorized by 35 USC 251 since applicant's indication in the transmittal letter indicated that the filing of the reissue application was a narrowing reissue and that the broadening amendment was not permissible even if filed within the two-years from the grant of the original patent.
- (D) Determine that the application is a proper broadening reissue and perform an examination and issue an Office action in due course.
- (E) Determine that the application is a proper broadening reissue and reject the claims under the recapture doctrine since the claims are broader than the issued claims.

3. An applicant submits a product-by-process claim to a shoe made by a series of specific process steps. The claim is rejected over a publication under 35 USC 102(b) and 103. Assume for this question that the publication reasonably appears to show the identical shoe, but describes a different method of making the shoe. What is the proper procedure to try to overcome the rejection in accordance with the patent laws, rules and the procedures as related in the MPEP?

- (A) Argue that all limitations in the claim must be given weight and that rejection must be withdrawn because the reference does not disclose the claimed method of making steps.
- (B) Argue that the examiner has not carried the burden of proving that the shoes are identical.
- (C) Present evidence why the steps of the claimed process produce a patentably different structure.
- (D) Submit a declaration under 37 CFR 1.132 by the author of the publication describing in more detail how the shoe in the publication was made by a different method.
- (E) Argue that the inventor was not aware of the publication when the invention was made.

4. A registered practitioner files an international application submission that includes a description, claims and drawings in the United States Receiving Office (RO/US) on Wednesday, January 8, 2003. The submission did not include the required request, international and search fees, or the designation of a PCT contracting State. The RO/US mails an "Invitation to Correct the Purported International Application," dated January 10, 2003, to the practitioner indicating that the designation of at least one Contracting State, as required by PCT Article 11(1)(iii)(b), was not included. A one-month period for response is set in the Invitation. On Monday, February 10, 2003, the practitioner submits by facsimile a designation sheet of the Request Form designating every available Contracting State, and authorization to charge all required fees. In accordance with the patent laws, rules and procedures as related in the MPEP, will the application be accorded an international filing date?

- (A) Yes. The application will be accorded a filing date of January 8, 2003.
- (B) Yes. The application will be accorded an international filing date of February 10, 2003.
- (C) No. The application will not be accorded an international filing date because the failure to designate at least one contracting State cannot be cured by a facsimile transmission.
- (D) No. The application was given a one-month period for response. The practitioner would have had to have filed the response on Friday, February 7, 2003 in order to have been timely.
- (E) None of the above.

5. In accordance with the patent laws, rules and procedures as related in the MPEP, satisfaction of the written description requirement may not be demonstrated by:

- (A) including in the specification a description of an actual reduction to practice.
- (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) describing during prosecution of a new or amended claim an element or limitation (omitted from the original disclosure in the specification) as an essential or critical feature of the invention.
- (D) including in the specification a description of distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention at the time of filing.
- (E) including in the patent application disclosure of drawings or structural chemical formulas showing that the invention is complete.

6. Inventor Tip, a scientist in a pencil research laboratory, theorized that, based on the abrasive properties of moon dust, a highly efficient erasure can be made by adding a trace amount of moon dust to a normal pencil erasure formulation. Point, in the Sales department, determined that this would be perfect for a high end product. A U.S. patent application has been filed claiming a pencil erasure formulation with a trace amount of moon dust. An example of how to make the formulation with specified percentages of moon dust is presented therein. Thereafter, Tip learns about the duty to disclose information and he recalls signing a declaration under 37 CFR 1.63 stating that he had reviewed and understood the contents of the specification including the claims. Tip becomes concerned that the use of moon dust was only a theory and that to obtain patent would mislead the public to conclude that moon dust was actually used and found to be effective. The application has been allowed, but the issue fee has not yet been paid. Which of the following is most in accord with patent laws, rules and procedures as related in the MPEP?

- (A) Point is under a duty to disclose material information to the USPTO.
- (B) Tip is under a duty to disclose his concern regarding the moon rock information to the USPTO.
- (C) Both Point and Tip are under a duty to disclose material information to the UPSTO.
- (D) There is no duty to disclose information regarding how the moon rock formulation was developed to the USPTO.
- (E) Inasmuch as the application is allowed, an appropriate Request for Continued Prosecution pursuant to 37 CFR 1.114 needs to be filed accompanied by a information disclosure regarding the possibility of rejections under 35 USC 101, and 112, first paragraph.

7. The claimed invention in a patent application is directed to an explosive composition “comprising 60-90% solid ammonium nitrate, and 10-40% water-in-oil in which sufficient aeration is entrapped to enhance sensitivity to a substantial degree.” The application discloses that the explosive requires both fuel (the ammonium nitrate), and oxygen to “sensitize the composition.” A prior art reference, published more than two years before the effective filing date of the application, discloses explosive compositions containing water-in-oil emulsions having identical ingredients to those claimed, in ranges overlapping with the claimed composition. The only element of the claim not recited in the reference is “sufficient aeration entrapped to enhance sensitivity to a substantial degree.” The reference does not recognize that sufficient aeration sensitizes the fuel to a substantial degree. In addition to the prior art reference, a printed publication contains test data demonstrating that “sufficient aeration” is necessarily an inherent element in the prior art blasting composition under the circumstances. In accordance with the patent laws, rules and the procedures as related in the MPEP, the prior art reference:

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

8. With respect to establishing “reasonable diligence” for under 35 USC 102(g), which of the following statements is or are in accordance with the patent laws, rules and procedures as related in the MPEP?

- (1) The inventor and his attorney must drop all other work and concentrate on the particular invention involved.
 - (2) The entire period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses.
 - (3) Work relied upon to show reasonable diligence must be directly related to the reduction to practice.
- (A) Statement (1) only
 - (B) Statement (2) only
 - (C) Statement (3) only
 - (D) Statements (1) and (3)
 - (E) Statements (2) and (3)

9. Which one of the following statements is in accord with the patent laws, rules and procedures as related in the MPEP regarding double patenting rejections?

- (A) A rejection of application claims for obviousness-type double patenting over the claims of a patent which names a different inventive entity (where one inventor is in common with the inventive entity in the application) and was not commonly owned at the time applicant made his or her invention can be overcome with an affidavit or declaration under 37 CFR 1.131 showing that the applicant made the invention in the United States prior to the effective filing date of the patent.
- (B) A rejection for obviousness-type double patenting of application claims over patent claims can properly rely on an embodiment which is disclosed in the patent and provides support for the patent claims on which the rejection is based.
- (C) The filing of a terminal disclaimer to overcome an obviousness-type double patenting rejection constitutes a binding admission that the rejection is proper.
- (D) Application claims are properly rejected for obviousness-type double patenting over claims of a patent having an effective filing date earlier than the effective filing date of the application only if both of the following two conditions are satisfied: (a) the rejected application claims recite an obvious variation of the subject matter recited in the patent claims on which the rejection is based; and (b) the patent claims on which the rejection is based recite an obvious variation of the subject matter recited in the rejected application claims.
- (E) None of statements (A) through (D) is correct.

10. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following can a third party submit in a pending published application within two months from the publication date where the submission identifies the application to which it is directed by application number and includes the appropriate fee?

- (A) A list referencing a videotape and copy of the tape showing that the process claimed in the application was in use more than one year before the filing date of the application.
- (B) A U.S. patent issued more than one year before the filing date of the application and a written explanation of the patent made by the third party on the patent.
- (C) A publication with a publication date more than one year before the filing date of the application and including underlining made by the third party on the publication.
- (D) A protest raising fraud and inequitable conduct issues.
- (E) A list of the sole Japanese language publication submitted for consideration, including the publication date of the publication, a copy of the Japanese language publication and a written English language translation of the pertinent parts of the publication.

11. A U.S. patent was granted on May 8, 2001 to five inventors. The five inventors assigned their entire patent rights to Q Company. Q Company needs to file a reissue application to broaden the claims of the patent. The registered practitioner preparing the application has been unable to locate any of the five inventors to sign the reissue oath or declaration. Today is May 8, 2003. Which of the following should the practitioner do to enable the applicant to broaden the patent claims in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) Wait to file the reissue application until the first day the signatures of all five inventors can be obtained. At that time, pay the filing fee and file a petition seeking May 8, 2003 as the filing date. File with the petition a showing of the unavailability of all inventors until the filing of the application.
- (B) Wait to file the reissue application until the signatures of at least three inventors can be obtained. At that time, file a petition seeking May 7, 2003 as the filing date accompanied by a showing of the unavailability of all inventors on May 8th. Payment of the filing fees may be postponed until receipt of a decision on the petition.
- (C) File the reissue application on May 8, 2003, presenting only the claims in the patent, and include a listing of inventors, but not pay the filing fee at the time of filing.
- (D) Wait to file the reissue application until the signature of one of the inventors has been obtained since at least one inventor is needed to show a lack of deceptive intent on the part of the applicants.
- (E) File the complete reissue application complying with 37 CFR 1.173(a) and 1.53(b) with an unexecuted reissue declaration listing the names of all the inventors with at least one broadening claim on May 8, 2003.

12. Which of the following is patentable subject matter under 35 USC 101 in accordance with the patent laws, rules, and procedures as set forth in the MPEP?

- (A) A claim to a new mineral discovered in the earth or a new plant found in the wild.
- (B) A claim to a method of using a computer to select a set of arbitrary measurement point values. (The selected values are not to be transformed outside of the computer into computer data).
- (C) A claim to a method of controlling a mechanical robot which relies upon storing data in a computer that represents various types of mechanical movements of the robot.
- (D) A claim to a method of updating alarm limits by changing the number value of a variable to represent the result of the calculation.
- (E) A claim to a data structure *per se*. (The claim does not specify any location where the data structure is stored).

13. On January 2, 2001, a registered practitioner filed a patent application with the USPTO for inventor Beck. The application includes a specification and a single claim to the invention which reads as follows:

1. Mixture Y made by the process Q1.

In the specification, Mr. Beck discloses that mixture Y has a melting point of 150° F. On June 2, 2001, the practitioner received an Office action from the primary examiner rejecting the claim. The claim is rejected under 35 USC 102/103 as being clearly anticipated by or obvious over Patent A. The examiner states “Patent A teaches mixture Y but made by a different process Q2.” Beck believes he is entitled to a patent to mixture Y. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following would be the best reply to the rejection of his claim?

- (A) An argument that the claimed product has an unexpectedly low melting point of 150° F, supported by an affidavit showing that the mixture Y made by process Q2 exhibits a melting point of 300° F.
- (B) An argument that the processes used by applicant and patent A are different, supported by a third-party declaration stating only that the processes are different.
- (C) An argument that the claimed product has an unexpectedly low melting point of 150° F, supported by a third-party declaration stating only that the products are different.
- (D) An argument that the processes used by applicant and patent A are different, supported by an affidavit showing that the mixture Y made by process Q2 exhibits a melting point of 300° F.
- (E) An argument that the claimed product has an unexpectedly low melting point of 150° F because the claimed mixture Y has a melting point of 150° F and the mixture Y of patent A has a melting point of 300° F.

14. Inventor Jones files an application under 35 USC 111(a) on March 27, 2002. The application is a continuation of an international application, which was filed on December 1, 2000. The international application claims priority to a U.S. provisional application filed December 2, 1999. The international application designated the United States, and was published in English under PCT Article 21(2). All applications contained the exact same disclosure. In accordance with the patent laws, rules and procedures as related in the MPEP, what, if any, is the earliest prior art date under 35 USC 102(e) for the publication of the 35 U.S.C. 111(a) application under 35 USC 122(b)?

- (A) None, the publication has no prior art date under 35 U.S.C. 102(e)
- (B) March 27, 2002
- (C) December 11, 2001
- (D) December 1, 2000
- (E) December 2, 1999

15. Applicant filed an international patent application under the Patent Cooperation Treaty (PCT) designating the United States. A copy of the international application has not been submitted to the USPTO by the International Bureau. The deadline for entering the national stage under 35 USC 371(c) was August 15, 2002. Applicant submitted all of the national stage items required by 35 USC 371(c) by facsimile transmission on August 15, 2002. The facsimile transmission was successfully received by the USPTO on August 15, 2002. The submission included an authorization to charge any required fees to the valid deposit account of the registered practitioner representing applicant. The account contained sufficient funds. Assuming that applicant has made no other national stage submissions under 35 USC 371(c), which of the following statements is most correctly describes why the national stage submission in accordance with the patent laws, rules and the procedures as related in the MPEP is proper or improper?

- (A) The national stage submission was proper because facsimile transmission is a valid method of correspondence in the USPTO.
- (B) The national stage submission was proper because a copy of an originally executed oath or declaration is acceptable, but the original oath or declaration should be retained as evidence of authenticity.
- (C) The national stage submission was improper because a copy of the international application and the basic national fee necessary to enter the national stage as required by 35 USC 371(c) may not be submitted by facsimile transmission.
- (D) The national stage submission was improper because the USPTO does not accept fee payments via facsimile transmission.
- (E) The national stage submission was improper because facsimile transmission may never be used for PCT applications.

16. Which of the following statements is or are in accord with the patent laws, rules and procedures as related in the MPEP?

- (1) In a 35 USC 103 obviousness analysis, the proper question is whether the differences between the prior art and the claims would have been obvious to one of ordinary skill in the art.
 - (2) In a 35 USC 103 obviousness analysis, an inventor's assertion the he has discovered the source or cause of an identified problem should never be considered.
 - (3) A 35 USC 103 obviousness analysis requires consideration not just of what is literally recited in the claims, but also of any properties inherent in the claimed subject matter that are disclosed in the specification.
- (A) Statement 1
 - (B) Statement 2
 - (C) Statement 3
 - (D) Statements 1 & 2
 - (E) Statements 1 & 3

17. A patent application was filed on November 1, 2000 for the invention of J.J. Smithy. The application has no priority or benefit claims to any other application. Claims in the application are separately rejected under 35 USC 102 as being anticipated by each of the following references. Which reference can be properly applied under 35 U.S.C. 102(e) in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) A WIPO publication of an international application under PCT Article 21(2), which has an international filing date of October 3, 2000, was published in English and designated the United States.
- (B) A U.S. patent by J.J. Smithy that has a filing date of September 5, 2000.
- (C) A U.S. application publication under 35 U.S.C. 122(b) by inventor Jones that was filed on August 8, 2000.
- (D) A journal article by Marks published on October 11, 2000.
- (E) All of the above.

18. A registered practitioner filed a design patent application on December 30, 2003. The application was filed with an inventor-executed declaration naming Jon Jones as the sole inventor, who has not assigned the invention and is not under an obligation to assign his invention. The filing receipt was recently received, indicating that the application will be published on Thursday, July 1, 2004. In reviewing the filing receipt the practitioner realizes that the typed name of the inventor contained a typographical error (an “h” was missing) and that the correct spelling was John Jones. Which of the following would be the course of action at the least expense to correct the error in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) The practitioner should file a request under 37 CFR 1.48 to correct the inventorship of the application with a new declaration under 37 CFR 1.63 signed by John Jones (with the correct spelling of this name), a statement by Mr. Jones as to how the error occurred and that the error was without deceptive intention, and the processing fee set forth in 37 CFR 1.17(q).
- (B) The practitioner should file a petition under 37 CFR 1.182 and the petition fee set forth in 37 CFR 1.17(h), requesting correction of the spelling of the inventor’s name.
- (C) The practitioner should file a request for a corrected filing receipt and a separate letter to the Office explaining that the declaration contains a typographical error, that the correct spelling of the inventor’s name is John Jones, and requesting correction of the Office records.
- (D) The practitioner should expressly abandon the application, and file a continuation with a new declaration with the correct spelling.
- (E) The practitioner should call the examiner and tell the examiner that the inventor’s name is wrong, and ask for the examiner to change the name on the declaration.

19. The claims in an application are rejected under 35 USC 103 as obvious over prior art reference A in view of prior art reference B. All of the following statements are in accord with the patent laws, rules and procedures as related in the MPEP except:

- (A) Where the combination of prior art references provides motivation to make the claimed invention to achieve the same advantage or result discovered by the applicant, the references do not have to expressly suggest the combination of references.
- (B) The rationale to modify or combine the prior art references may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law.
- (C) In considering the disclosure of the prior art references, it is proper to take into account the specific teachings of the references, as well as the inferences that one skilled in the art could reasonably draw from the specific teachings.
- (D) An examiner may take official notice of facts outside the record that are capable of instant and unquestionable demonstration as being “well known” prior art or common knowledge in the art.
- (E) To rely on equivalence as a rationale supporting an obviousness rejection under 35 USC 103 an examiner may base the rejection on the mere fact that the components at issue are functional or mechanical equivalents.

20. Recommend which of the following rejections under 35 USC 102 in a reexamination proceeding is in accordance with the patent laws, rules and procedures as related in the MPEP.

- (A) A rejection under 35 USC 102(a) based on an affidavit that the invention was known or used by others before the invention thereof by the applicant for patent.
- (B) A rejection under 35 USC 102(b) based on an affidavit that the invention was in the public use in this country more than one year prior to the date of the application for a patent in the United States.
- (C) A rejection under 35 USC 102(e) that the invention was described in a patent by another filed in the United States before the invention thereof by the patent applicant.
- (D) A rejection under 35 USC 102(f) based on an affidavit that the applicant did not himself invent the subject matter sought to be patented.
- (E) A rejection under 35 USC 102(b) that 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.

21. Which of the following would comply with the patent laws, rules and procedures as related in the MPEP and would be a fully responsive reply to a non-final Office action on the merits rejecting all the claims in the application as being unpatentable under 35 USC 102 and/or 103 over prior art references?

- (A) A timely filed and properly signed written reply which does not include an amendment to the claims, but includes a request for the examiner's rejections to be reconsidered supported by arguments replying to every ground of rejection and distinctly and specifically points out the supposed errors in every rejection. and pointing out the specific distinctions believed to render the claims patentable over any applied references.
- (B) A timely filed and properly signed written reply which includes an amendment canceling all the claims in the application and adding new claims, and a request for the examiner's rejections to be reconsidered in view of the newly presented claims.
- (C) A timely filed and properly signed written reply which does not include an amendment to the claims, but does generally alleges that the claims define a patentable invention.
- (D) A timely filed and properly signed written request for continued examination (RCE).
- (E) All of the above.

22. Which, if any, of the following statements is in accord with the patent laws, rules and procedures as related in the MPEP?

- (A) Where an inventor's residence is stated correctly in the 37 CFR 1.76 application data sheet and incorrectly in the inventor's 37 CFR 1.63 oath or declaration, the discrepancy must be corrected by filing a supplemental 37 CFR 1.67 oath or declaration giving the correct residence.
- (B) Where two inventors file separate 37 CFR 1.63 oaths or declarations which do not identify both inventors, the USPTO will presume they are joint inventors and will not require new oaths or declarations.
- (C) A dependent claim which merely repeats a limitation that appears in the claim on which it depends is properly rejected under the fourth paragraph of 35 USC 112.
- (D) In a statement under 37 CFR 1.97(e)(1) specifying that "each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the statement," the three-month period begins on the date the communication was first received by either a foreign associate or a U.S. registered practitioner.
- (E) None of statements (A) to (D) is correct.

23. A patent application is filed having one claim (claim 1). The most relevant prior art uncovered by the primary examiner, after searching the claimed subject matter, is a published abstract summarizing the disclosure of a foreign patent document. The abstract is in English, the foreign document is in German. Both the published abstract and the foreign document are prior art under 35 USC 102(b). The published abstract provides an adequate basis for concluding that claim 1 is *prima facie* obvious under 35 USC 103. Which of the following actions is in accord with the patent laws, rules and procedures as related in the MPEP?

- (A) Reject claim 1 under 35 USC 103, based on the abstract, because it is a publication in its own right and provides sufficient basis for a *prima facie* case of obviousness.
- (B) Reject claim 1 under 35 USC 103, based on the abstract, because disclosures that are not in English cannot form the basis of a prior art rejection.
- (C) Reject claim 1 under 35 USC 103, based on the German-language patent document, as evidenced by the abstract.
- (D) Do not reject claim 1 based on the abstract; instead, obtain a translation of the German-language document and determine whether its full disclosure supports a rejection under 35 USC 102(b) or 103.
- (E) Do not reject the claims based on the abstract because an abstract can never provide sufficient disclosure to be enabling.

24. Applicant filed a provisional patent application in the USPTO under 35 USC 111(b) on Tuesday, November 30, 1999. On Tuesday, November 28, 2000, applicant filed a nonprovisional application in the USPTO under 35 USC 111(a) that properly claimed priority under 35 USC 119(e) to the filing date of the provisional application. On Wednesday, November 29, 2000, applicant filed an international application for patent in the USPTO under the Patent Cooperation Treaty that designated the United States and properly claimed priority to both the provisional and the nonprovisional applications. On Friday, July 28, 2001, applicant filed a national stage application in the USPTO under 35 USC 371, providing all of the requirements under 35 USC 371 and properly claiming benefit to the filing date of the provisional application under 35 USC 119(e) and the nonprovisional application under 35 USC 120. The national stage application was published on Tuesday, January 30, 2002 and issued as a patent on Tuesday, February 4, 2003. Assuming no patent term extension or adjustment, the patent term ends on the date that is 20 years from which of the following dates in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) Tuesday, November 30, 1999
- (B) Tuesday, November 28, 2000
- (C) Wednesday, November 29, 2000
- (D) Friday, July 28, 2001
- (E) Tuesday, February 4, 2003

25. A registered practitioner files a nonprovisional utility application in 2000. In 2002, the practitioner files a continuation-in-part application and claims benefit of the filing date of the 2000 application for the 2002 application. Thereafter, the practitioner amends the 2002 application to include claims that were not present in either the originally filed 2000 application or the originally filed 2002 application. The primary examiner properly concludes that the added claims are not supported by the original disclosure in either application. Which of the following is in accord with the patent laws, rules and procedures as related in the MPEP?

- (A) The added claims are rejected for lack of written description under 35 USC 112, first paragraph.
- (B) The added claims are rejected as new matter under 35 USC 132.
- (C) The added claims are denied benefit of the filing date of the 2000 application.
- (D) (A) and (B).
- (E) (A) and (C).

26. Which of the following best describes a situation for which a reply to the examiner's Office action including both an affidavit filed under 37 CFR 1.131 and an affidavit filed under 37 CFR 1.132 may be in accord with the patent laws, rules and procedures as related in the MPEP?

- (A) In a timely reply to a non-final Office action, where the examiner's sole rejection of appellant's claims is based on an alleged violation of the enablement requirement of 35 USC 112.
- (B) In a timely reply to non-final Office action, where the examiner's sole rejection of appellant's claims is a rejection under 35 USC 103(a) employing a non-patent document that was published less than one year prior to the filing date of appellant's patent application.
- (C) In a timely reply to a non-final Office action, where the examiner's sole rejection of appellant's claims is a rejection under 35 USC 103(a) employing a non-commonly owned U.S. patent as prior art under 35 USC 102 (e) that claims the same invention as applicant.
- (D) In a timely reply to an examiner's answer presenting the affidavits for the first time, where in the examiner's first Office action and final rejection, the examiner maintains the same rejection under 35 USC 103(a) of all of appellant's claims based in part on a non-patent document that was published less than one year prior to the filing date of appellant's patent application.
- (E) In a timely reply to a final Office action presenting the affidavits for the first time, where in the examiner's first Office action, the examiner's sole rejection of appellant's claims is a rejection under 35 USC 103(a) employing a non-patent document that was published less than one year prior to the filing date of appellant's patent application.

27. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following is not within the scope of the term “on sale” as it is used in 35 USC 102(b)?

- (A) A sale conditioned on buyer satisfaction.
- (B) A sale that did not result in a profit.
- (C) A single sale of the claimed subject matter.
- (D) A commercial offer to sale the claimed subject matter.
- (E) An offer to sale the patent rights in the claimed subject matter.

28. A patent application is filed disclosing and claiming a system for detecting expired parking meters. The specification fully supports the original, sole claim. The application discloses that the “electronics control unit” contains a comparator and an alarm. The application includes several drawings. One of the drawings shows a block diagram of the system, illustrating the electronics control unit as a box, labeled “electronics control unit.” The sole claim of the application is as follows:

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

A final Office action, dated February 3, 2004, indicates that the sole claim contains allowable subject matter, but includes an objection to the specification, on the grounds that the subject matter of the electronics control unit, though described in a sufficiently specific and detailed manner in the original specification, was required to be shown in the drawings under 37 CFR 1.83. The Office action did not set a period for reply. Determine which of the following actions, if any, comports with the patent laws, rules and procedures as related in the MPEP for overcoming the objection.

- (A) On April 1, 2004, a Notice of Appeal is filed together with appropriate fees, and a brief pointing out that a patent should issue since the subject matter of the electronics control unit was adequately described in the original specification.
- (B) On April 1, 2004, a drawing is filed in the USPTO illustrating only the comparator and alarm of the electronics control unit that was described in the original specification.
- (C) On April 1, 2004, a Notice of Appeal of appeal is filed together with appropriate fees, and a brief pointing out that the addition of a drawing showing the electronics control unit would not constitute addition of new matter since the electronics control unit was adequately described in the original specification.
- (D) On September 1, 2004, a petition is filed urging that no further drawing should be required because the subject matter of the electronics control unit, for purposes of the application, was adequately disclosed in the block diagram drawing.
- (E) None of the above.

29. On Thursday, February 6, 2003, applicant files an application for a design patent in Country X, which issues the patent on the filing date. In accordance with the patent laws, rules and the procedures as related in the MPEP, what is the last date applicant can file a U.S. design application to avoid any loss of patent rights?

- (A) Friday, February 6, 2004 (assume not a Federal holiday).
- (B) Thursday, February 5, 2004 (assume not a Federal holiday).
- (C) Wednesday, August 6, 2003.
- (D) Wednesday, May 6, 2003.
- (E) None of the above are correct.

30. Co-inventors Smith and Jones filed an application for a patent on a cell phone, on May 15, 2002. They received a first Office action from a primary examiner rejecting the claims under 35 USC 102(a) over a publication by Bell and Watson, published on April 5, 2002, describing a cell phone having all the same features as is claimed in the patent application. In reply, the co-inventors each submitted a declaration under 37 CFR 1.131 stating that they had actually reduced the invention to practice no later than March 13, 2002. However, the declarations failed to include two claimed features. Neither the particular antenna needed to enable the cell phone could receive transmissions from the local cellular transmitting tower, nor a detachable carrying strap was included in the declarations. As evidence of their prior reduction to practice, Smith and Jones submitted their co-authored journal article. The journal article contained a figure of the cell phone as described in the declarations. That is, the cell phone shown in the figure of the article lacked an antenna and a detachable strap. The article was received by the journal on March 13, 2002, and was published on April 30, 2002. The cell phones shown in the figure in the Bell and Watson publication, and in the Smith and Jones patent application have the particular antenna and a detachable strap. Which of the following actions, if taken by the examiner, would be the most proper in accordance with the patent laws, rules and the procedures as related in the MPEP?

- (A) The examiner should maintain the rejection of the claims under 35 USC 102(a) and make the rejection final.
- (B) The examiner should withdraw the rejection and look for references which have a publication date prior to May 15, 2001.
- (C) The examiner should withdraw the rejection and notify Smith and Jones that their application is in condition for allowance.
- (D) The examiner should maintain the rejection, but indicate that the claims would be allowable if Smith and Jones provided an original copy of the figure published in their journal article as factual support for their declarations.
- (E) The examiner should maintain the rejection and inform Smith and Jones that the declarations are insufficient because they cannot “swear behind” a reference which is a statutory bar.

31. In accordance with the patent laws, rules and procedures as related in the MPEP, for a nonprovisional application to receive a filing date in the USPTO under 37 CFR 1.53(b), all of the following must be filed except:

- (A) An oath or declaration executed by applicant pursuant to 37 CFR 1.63.
- (B) A specification as prescribed by the first paragraph of 35 USC 112.
- (C) A description pursuant to 37 CFR 1.71.
- (D) At least one claim pursuant to 37 CFR 1.75.
- (E) A drawing when required by 37 CFR 1.81(a).

32. Determine which of the following documents, if any, must also contain a separate verification statement in accordance with the patent laws, rules and procedures as related in the MPEP.

- (A) A request to correct inventorship in a pending application.
- (B) A petition to make an application special.
- (C) A claim for foreign priority.
- (D) A substitute specification.
- (E) None of the above.

33. A registered practitioner files an application on the client's discovery that adding silica to a known plastic composition containing the flame retardant, X, results in increased flame retardance. The application claims a composition comprising the known plastic composition containing X and also silica. The primary examiner rejects the claim on the basis that applicant admits that X was a known flame retardant and that there is no evidence of improved flame retardance. In accordance with the patent laws, rules and procedures as related in the MPEP, a proper reply could include which of the following argument(s) to rebut and overcome the rejection?

- (A) The examiner cannot rely on admitted prior art.
- (B) The examiner has not shown that the prior art appreciated applicant's discovery of silica to be a flame retardant.
- (C) The examiner has not made out a prima facie case of obviousness due to lack of motivation in the prior art or in the knowledge generally available to one of ordinary skill in the art for adding silica to the known plastic composition.
- (D) The applicant does not have to show an improved or unexpected result for the claimed invention.
- (E) (C) and (D).

34. In accordance with the patent laws, rules and procedures as related in the MPEP , which of the following paper is precluded from receiving the benefit of a certificate of mailing or transmission under 37 CFR 1.8?

- (A) An amendment, replying to an Office action setting a period for reply, transmitted by mail with a certificate of mailing to the USPTO from a foreign country.
- (B) An amendment, replying to an Office action setting a period for reply, transmitted by facsimile with a certificate of transmission to the USPTO from a foreign country.
- (C) An information disclosure statement (IDS) under 37 CFR 1.97 and 1.98 transmitted after the first Office action.
- (D) A request for continued examination (RCE) under 37 CFR 1.114.
- (E) An appeal brief.

35. The sole claim in an application filed by A and having an effective filing date of June 5, 2002, recites an electrical signal amplifier comprising a plurality of germanium transistors connected together in a particular configuration. The claim is rejected under 35 USC 103(a) as being obviousness over a primary nonpatent reference publication (Reference P) in view of a secondary nonpatent reference publication (Reference S). Reference P has an effective date of April 3, 2002, and names A and B as the authors. Reference S has an effective date of December 10, 2001, and names C as the sole author. Reference P discloses an electrical signal amplifier including a plurality of silicon transistors connected together in the same configuration as that set forth in the claim. Reference S discloses a signal amplifier employing germanium transistors connected in a configuration different from the claimed configuration. The applicant does not deny that the references render the claimed subject matter *prima facie* obvious. Which, if any, of the declarations under 37 CFR 1.132 set forth below should be sufficient under the patent laws, rules and procedures as related in the MPEP to overcome the rejection?

- (A) An uncontradicted declaration by A asserting that the subject matter relied on by the examiner in reference P constitutes A's sole invention, with the result that Reference P is not available as prior art against the claim.
- (B) A declaration by A asserting that "the claimed amplifier has satisfied a long-felt need in the art."
- (C) A declaration by A and accompanying copies of competitors' advertisements which conclusively show that those competitors have exactly copied appellant's commercial embodiment of the claimed amplifier.
- (D) A declaration by A and supporting documentation establishing that ever since the filing date of A's application, sales of the commercial embodiment of A's claimed amplifier have consistently constituted ninety percent or more of the relevant signal amplifier market in the United States.
- (E) None of the above.

36. An application naming X and Y as joint inventors, filed on April 3, 2002, has a single pending claim, and does not claim the benefit of any earlier application. Which, if any, of the following items of prior art that have been relied on in various rejections of the claim may be overcome by a suitable affidavit under 37 CFR 1.131 in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) A U.S. patent to G that issued on March 27, 2001, has an effective U.S. filing date of January 4, 2000, and does not claim the “same patentable invention” (as defined in 37 CFR 1.601(n)) as the rejected claim.
- (B) A U.S. patent to P that issued on June 5, 2001, has an effective U.S. filing date of February 1, 2000, and includes a claim that is identical to the rejected claim.
- (C) A journal article to H published on December 10, 2001, and characterized in the application as “describ[ing] the prior art.”
- (D) A foreign patent issued to X and Y on November 7, 2001, which claims the same subject matter as the rejected claim and is based on an application filed on January 3, 2001.
- (E) None of the above.

37. The specification of an application does not disclose the utility of the claimed composition. In fact, the claimed invention is useful for shrinking a specific class of tumors. In a first Office action, the primary examiner has properly determined that the claims lack utility, and has rejected all of the composition claims under the first paragraph of 35 USC 112 as lacking utility. Which of the following responses is in accord with the USPTO rules and the procedures of the MPEP for persuading the examiner that the rejection is improper?

- (A) Explain that the rejection is statutorily improper because the first paragraph of section 112 is concerned with enablement and written description issues and therefore does not support a rejection for lack of utility.
- (B) Point out that the rejection is based on an erroneous finding by the examiner because the specification, in fact, clearly discloses that the composition in question possesses “useful biological” properties.
- (C) Show that the rejection is improper by filing probative evidence that the claimed composition has unambiguously proven to be useful for shrinking a specific class of tumors.
- (D) File declarations by persons with ordinary skill in the art stating that they would immediately appreciate that the claimed composition is useful for shrinking a specific class of tumors due to the fact that similar compositions having the same characteristics as applicant’s claimed composition were known to be effective for this purpose.
- (E) Argue that the rejection is improper because the examiner has failed to present evidence in support of his position that the claimed composition has no utility.

38. A registered practitioner properly recorded an assignment document for application A identifying XYZ Company as the assignee. The document assigns to XYZ Company the “subject matter claimed in Application A.” A proper restriction requirement was made by a primary examiner in application A between two distinct inventions, and the practitioner elected to prosecute one of the inventions. Application A was prosecuted, and later became abandoned. Before the abandonment date of application A, the practitioner filed a complete application B as a proper divisional application of application A. Application B claimed the nonelected invention of Application A, and was published as a U.S. application publication. XYZ Company remains the assignee of application A. What must the practitioner do in accordance with the patent laws, rules and procedures as related in the MPEP to ensure that XYZ Company is listed as the assignee on the face of any patent issuing from application B?

- (A) File a proper assignment document in application B identifying XYZ Company as the assignee.
- (B) File a proper assignment document in application B identifying XYZ Company as the assignee, and confirm that USPTO’s bibliographic data for application B identifies XYZ Company as the assignee by checking the filing receipt for application B, the U.S. application publication of application B, or the USPTO’s Patent Application Information Retrieval (PAIR) system data for application B, depending on when the practitioner filed the assignment document in application B.
- (C) Confirm that XYZ Company is identified as the assignee on the U.S. application publication of application B.
- (D) File a proper assignment document in application B identifying XYZ Company as the assignee, and confirm that XYZ Company is identified as the assignee on the U.S. application publication of application B.
- (E) Upon allowance of application B, the practitioner must identify XYZ Company as the assignee in the appropriate space on the Issue Fee Transmittal form for specifying the assignee for application B.

39. An international application is filed in the United States Receiving Office on September 18, 2002. In accordance with the PCT and USPTO rules and the procedures set forth in the MPEP, which of the following will result in the application not being accorded an international filing date of September 18, 2002?

- (A) The description and claims are in German.
- (B) The Request is signed by a registered attorney rather than the applicant.
- (C) The sole applicant is a Canadian resident and national.
- (D) The application does not contain a claim.
- (E) The application is not accompanied by any fees.

40. Applicant files a patent application in Japan on January 5, 2000. Applicant files a PCT international application designating the United States on January 5, 2001, based on the Japanese application. The international application is published in English on July 5, 2001. The international application enters the national stage in the United States on September 5, 2001. The USPTO publishes the application on June 6, 2002. The application issues as a United States patent on December 3, 2002. What is its earliest possible 35 USC 102(e) prior art date for the application published by the United States, in view of the amendment to Title 35 by the American Inventors Protection Act of 1999 and the Intellectual Property and High Technology Technical Amendments Act of 2002?

- (A) January 5, 2000.
- (B) January 5, 2001.
- (C) July 5, 2001.
- (D) June 6, 2002.
- (E) December 3, 2002.

41. A non-final Office action contains, among other things, a restriction requirement between two groups of claims (Group 1 and Group 2). Determine which of the following, if included in a timely reply under 37 CFR 1.111, preserves applicant's right to petition the Commissioner to review the restriction requirement in accordance with the patent laws, rules and procedures as related in the MPEP.

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

42. The primary examiner has rejected claims 1-10 under 35 USC 103(a) as being unpatentable over the Smith patent in view of the Jones reference. Appellant properly argues that there is no motivation to combine the teachings of Smith and Jones. The examiner repeats the rejection of claims 1-10 as being “unpatentable over Smith in view of Jones.” The examiner additionally cites a patent to Brown that was necessary to provide motivation for combining the teachings of Smith and Jones. The examiner does not list Brown in the statement of the rejection. Appellant timely appeals to the Board of Patent Appeals and Interferences, and files a proper appeal brief. The examiner files an examiner’s answer addressing the rejection of claims 1-10 under 35 USC 103(a) as being unpatentable over Smith in view of Jones, and cites Brown in the argument as providing motivation to combine Smith and Jones. In accordance with the patent laws, rules and procedures as related in the MPEP, what will be the most proper decision of the Board?

- (A) The Board will affirm the rejection based on Smith and Jones only.
- (B) The Board will affirm the rejection based on Smith, Jones and Brown.
- (C) The Board will reverse the rejection based on Smith and Jones only.
- (D) The Board will reverse the rejection based on Smith, Jones and Brown.
- (E) None of the above.

43. Which of the following statement(s) is in accordance with patent laws, rules and procedures as related in the MPEP regarding filing of an Application Data Sheet (ADS) in the USPTO?

- (A) All non-provisional applications must include an ADS when the application is originally filed.
- (B) If an ADS is filed at the same time as an oath or declaration under 37 CFR 1.63 or 1.67 and the information supplied in the two documents is inconsistent, the information provided in the ADS will always govern.
- (C) If an ADS is filed at the same time as an oath or declaration under 37 CFR 1.63 or 1.67 and the information supplied in the two documents is inconsistent, the oath or declaration will govern any inconsistency related the claiming of benefit under 35 USC 119(e), 120, 121 or 365(c).
- (D) If an ADS is filed after an oath or declaration under 37 CFR 1.63 or 1.67 is filed, and the information supplied in the two documents is inconsistent, the information provided in the ADS will always govern.
- (E) The oath or declaration under 37 CFR 1.63 or 1.67 governs inconsistencies with the ADS when the inconsistency concerns setting forth the citizenship of the inventor(s) under 35 USC 115.

44. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following statements regarding claim interpretation is the most correct?

- (A) A claim having the transition term “comprising” is limited to only the limitations, elements or steps recited in the claim, and is not inclusive or open-ended of other unrecited elements or steps.
- (B) The transition term “consisting essentially of” limits the claim to the limitations recited in the claim and additional elements or steps which do not materially affect the basic and novel characteristics of the claimed invention.
- (C) A claim having the transition term “consisting of” is not limited to the elements or steps recited in the claim, but can include elements or steps other than those recited in addition to any impurities ordinarily associated therewith.
- (D) A claim which depends from a claim which claims an invention “consisting of” the recited elements or steps can add an element or step to further limit the claimed invention.
- (E) All of the above.

45. A patent application has claims 1-10 pending. Claims 1 and 7 are independent claims. Claims 2-6 depend directly from claim 1 while claims 8-10 depend directly from claim 7. Claims 1-10 have been twice rejected by the primary examiner under 35 USC 103(a) as being unpatentable over Smith patent in view of Jones patent. The applicant has appealed the rejection to the Board of Patent Appeals and Interferences. In the brief under the “grouping of claims” section, appellant states that each of the claims is separately patentable. In the arguments section of the brief, appellant separately argues only claims 1, 4 and 6. In the examiner’s answer, the examiner disagrees with appellant’s claim grouping because all the claims present a similar issue of patentability. The examiner states that the claims all stand or fall together as a single group. In accordance with the patent laws, rules and procedures as related in the MPEP, which claim(s) must the Board consider separately on the merits?

- (A) The Board must consider each of claims 1-10 separately on the merits.
- (B) The Board must only consider claims 1, 4 and 6 separately on the merits.
- (C) The Board must only consider claim 1 separately on the merits.
- (D) The Board must consider claim 1 and claim 7 separately on the merits as representative of all the claims on appeal.
- (E) The Board must determine which claim is representative of all the claims on appeal and consider only that claim separately on the merits.

46. A primary examiner is examining a patent application. The application includes a specification and a single claim to the invention that reads as follows:

1. A building material to be used as an alternative to brick in the construction of a house, said building material comprising compressed refuse, the majority of which is wood.

In the specification, the inventor explains that the wood to be used in the inventive building material should be balsa wood. According to the specification, balsa-containing building material has the advantage of being lighter than brick. In a first Office action mailed to the registered practitioner representing the inventor the single claim was rejected as anticipated under 35 U.S.C. § 102 over Patent A. Patent A issued more than one year before the effective filing date of the application, and teaches a building material to be used as an alternative to brick in the construction of a house comprising compressed refuse, the majority of which is pine. The practitioner replies to the first Office action by arguing that the invention is different from that of Patent A. According to the practitioner, the inventor uses balsa wood, not pine. The claim has not been amended. Which of the following describes how the examiner should proceed in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) The examiner should allow the claim.
- (B) The examiner should allow the claim only after including a Reasons for Allowance pointing out that the inventor argues that her invention is directed to using balsa wood, not pine.
- (C) The examiner should issue a Final Rejection again rejecting the claim as anticipated under 35 USC102 over Patent A.
- (D) The examiner should reopen prosecution and begin anew, this time searching for a reference that shows a building material containing balsa wood.
- (E) The examiner should withdraw the rejection but issue a new Office action this time rejecting the claim under 35 USC 112, second paragraph, because the claim is broad enough to encompass using pine.

47. To rely in a rejection under 35 USC 102(a) on an invention that is known or publicly used in accordance with patent laws, rules and procedures as related in the MPEP, the invention:

- (A) must be known or used in NAFTA or WTO member countries.
- (B) must be known or used in a NAFTA member country, but only if the filing date of the application is after the effective date of the North American Free Trade Agreement Implementation Act.
- (C) must be known or used in this country.
- (D) can be known or used in any country.
- (E) must be known or used in a WTO member country, but only if the filing date of the application is after the effective date of the implementation of the Uruguay Round (WTO) Agreements Act.

48. A registered practitioner timely files a petition under 37 CFR 1.181 while the application is pending before the primary examiner to challenge the prematureness of the final rejection that set a shortened statutory period for reply. Assume the petition is filed within two months of the date on the final rejection. What is the next response that should be docketed by the practitioner in accordance with the patent laws, rules and the procedures as related in the MPEP to avoid a penalty or payment of fees?

- (A) A reply to the final rejection within 6 months.
- (B) A status inquiry 6 months after filing the petition.
- (C) A reply to the final rejection within the shortened statutory time period set for reply in the final rejection.
- (D) No reply is necessary until a decision is received on the petition.
- (E) All of the above.

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

9. A personal computer comprising a microprocessor and a random access memory that includes at least 1 gigabyte of storage.

10. The personal computer of Claim 9, wherein the microprocessor has a clock speed of 100-200 megahertz.

11. The personal computer of Claim 10, wherein the random access memory is greater than ½ gigabyte of storage.

Which of the following statements is or are in accord with the patent laws, rules and procedures as related in the MPEP regarding the respective claims under the fourth paragraph of 35 USC 112?

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

50. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following facts are required for 35 USC 102(g) to form the basis for an *ex parte* rejection:

- (1) The subject matter at issue has been actually reduced to practice by another before the applicant's invention.
- (2) There has been no abandonment, suppression or concealment.
- (3) A U.S. patent application for the subject matter at issue has been filed by another prior to the filing of the applicant's application.
- (4) A U.S. patent has been granted for the subject matter at issue prior to the filing of the applicant's application.

- (A) Fact (1) only
- (B) Fact (2) only
- (C) Facts (1) and (2)
- (D) Facts (1), (2) and (3)
- (E) Facts (1), (2), (3) and (4)

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