

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

AUGUST 26, 1998

Morning Section (100 Points)

Time: 3 Hours

DIRECTIONS

This section 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 section 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 (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 section of the examination consists of fifty (50) multiple choice questions, each worth two (2) points. Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

You may write anywhere on this examination booklet. However, do not remove any pages from the booklet. Only answers recorded in SECTION 1 of your Answer Sheet will be graded. **YOU MUST SCORE AT LEAST 70 POINTS TO PASS THIS SECTION OF THE REGISTRATION EXAMINATION.**

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO

1. As patent counsel for the National Pharmaceutical Company (NPC), you prepared and filed in the PTO a patent application for an improved medication for treating osteomyelitis, an infectious inflammatory bone disease. The application listed John Jones, an NPC research biochemist who is obligated by an employment contract to assign all inventions to NPC, as the sole inventor. The specification referenced a prior art medication containing an effective amount of an organic compound having a cyclopentadiene ring structure containing a metal ion held by coordination bonds used in the treatment of osteomyelitis, and noted that its use was often accompanied by nausea and muscle cramps. Comparative test data set forth in the specification revealed that the negative side effects of the use of the prior art medication could be essentially avoided by limiting the metal ion to a metal ion selected from the group consisting of osmium (atomic number 76), iridium (atomic number 77), platinum (atomic number 78), and gold (atomic number 79). Following several years of prosecution, the application issued as a patent on February 24, 1998, with the following single claim:

A medication for treating osteomyelitis containing an effective amount of an organic compound having a cyclopentadiene ring structure containing a metal ion held by coordination bonds, said metal ion being selected from the group consisting of osmium, iridium, platinum, and gold.

On February 10, 1998, Jones submitted an invention disclosure to you containing test data demonstrating that when iridium, platinum, or gold, as contrasted with osmium, is selected for the metal ion of the aforementioned organic compound, half as much organic compound is required to be effective in the medication for treating osteomyelitis. You then prepared and filed on February 23, 1998, a continuation-in-part application in the PTO on this discovery. In the first Office Action the primary examiner rejected the following claim on the ground of "statutory type" double patenting over the Jones patent based on 35 U.S.C. § 101:

A medication for treating osteomyelitis containing an effective amount of an organic compound having a cyclopentadiene ring structure containing a metal ion held by coordination bonds, said metal ion being selected from the group consisting of iridium, platinum, and gold.

Which of the following actions should overcome the examiner's rejection in accordance with proper PTO practice and procedure?

- (A) File a reply traversing the rejection and arguing that the same invention is not being claimed because the patent claim is broader than the rejected claim. Therefore, the patent claim can be infringed without infringing the rejected claim.
- (B) File an amendment rewriting the claim in accordance with 37 CFR § 1.121, and adding the corresponding atomic number immediately following the recitation of each metal ion.
- (C) File a terminal disclaimer under 37 CFR § 1.321.
- (D) File a declaration of prior invention under 37 CFR § 1.131.

- (E) File a reply traversing the rejection and arguing that 35 U.S.C. § 103(c), does not preclude patentability because “the subject matter and the claimed invention, were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

2. Your client, Mr. Jones, asked you to prepare a patent application for his new pasta maker. The key features of the invention are the different types of dough which can be used and the shapes of the pasta which can be made. The completed application was filed on Monday, May 18, 1998. After filing the application, you conducted a prior art search and found a published article by another which was published on May 16, 1997. The published article discusses a pasta maker very similar to your client’s pasta maker. In the course of your search, you also found a few patents, but none as pertinent as the article. You file all of the prior art in an Information Disclosure Statement on June 8, 1998. In your opinion, the article is the best available prior art. Assuming that this is true, under which of the following sections of Title 35 U.S.C., if any, would Mr. Jones not be entitled to a U.S. patent?

- (A) 102(a)
- (B) 102(b)
- (C) 102(d)
- (D) 102(e)
- (E) None of the above.

3. In which of the following situations, if any, can you assist John in obtaining a patent under the Plant Patent Act?

- (A) While weeding his garden, John noticed a number of unusual plants growing in his vegetable garden. In autumn, John dug up the strange plants and discovered tubers which appeared to be a distinct and new variety of Jerusalem artichoke. The next spring, John planted the tubers and succeeded in starting a new crop.
- (B) While touring the rain forest in South America, John discovered a distinct and new variety of orchid growing in an uncultivated state on the banks of the Amazon river.
- (C) While experimenting with a number of different plants in his flower garden, John was able to sexually reproduce a distinct and new variety of a plant. Unable to think of a suitable name, he decided to call it “A Rose by Any Other Name.”
- (D) While experimenting with different techniques for extruding plastic, John succeeded in making a new, original and ornamental design for a bouquet utilizing an extrusion technique common in the plastics industry.
- (E) None of the above.

4. As patent counsel for the Apex Biotechnology Corporation, you filed a patent application in the PTO on January 2, 1998, naming Smith as inventor, with claims directed to a method for recovering a purified eucaryotic growth hormone or an analog thereof from a bacterial cell. The growth hormone or analog thereof is produced in the bacterial cell via expression of a DNA sequence encoding the hormone or analog. A primary patent examiner initially rejected all the claims as obvious under 35 U.S.C. §§ 102(e)/103 in view of a commonly assigned application Serial No. 0X/XXX,XXX (the 'XXX application), filed December 29, 1995 naming Jones as inventor. The rejection was "provisional" in the sense that the 'XXX application had not yet issued as a patent. After consultations with Smith and Apex management, you filed a terminal disclaimer complying with 37 CFR § 1.321(c) disclaiming that part of the term of the Smith application which would extend beyond the expiration date of the commonly assigned, copending 'XXX application. Upon the 'XXX application becoming abandoned, in favor of a Continued Prosecution Application (CPA), filed June 4, 1998, the examiner withdrew the rejection and substituted the following two rejections in the Smith application:

(1) A rejection of all the claims under 35 U.S.C. §§ 102(e)/103 as obvious over commonly-assigned U.S. Patent No. A,AAA,AAA to Able in view of U.S. Patent No. B,BBB,BBB to Baker; and

(2) A "provisional" rejection of all the claims under 35 U.S.C. §§ 102(e)/103 as obvious over of the CPA application in view U.S. Patent No. B,BBB,BBB to Baker.

The examiner correctly noted that both the Able patent and the CPA application disclose, but do not claim, the subject matter of the abandoned 'XXX application, and that the application which matured into the Able patent was assigned to Apex and was filed in the PTO on December 29, 1995. The invention claimed in the Smith application is patentably distinct from the inventions claimed in the Able patent and the CPA application.

Which of the following actions and/or arguments is most likely to overcome the examiner's rejections?

- (A) File a reply arguing (1) that the terminal disclaimer should be effective to overcome the 35 U.S.C. §§ 102(e)/103 rejection based on the public policy implicit in 35 U.S.C. § 103(c), which precludes citation as prior art of commonly-owned subject matter developed by another person, and (2) that Smith, Able, and Jones are "other persons."
- (B) File a declaration under 37 CFR § 1.132 by Smith unequivocally declaring that he conceived or invented the subject matter disclosed but not claimed in the references.
- (C) File a reply arguing that the terminal disclaimer should be effective to overcome the 35 U.S.C. §§ 102(e)/103 rejection based on the

analogy of such rejection to a double patenting situation, citing *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed.Cir. 1985), wherein the court characterized an obviousness-type double patenting rejection as "analogous" to a 35 U.S.C. § 103 rejection.

- (D) File an affidavit under 37 CFR § 1.131 by Smith including facts that Smith conceived the claimed invention in a NAFTA member country in August 1993, that Smith moved to Hawaii in 1994 and began working on his conception in earnest during the period December 1994 until December 1, 1995, when he moved to a WTO member country other than a NAFTA country, where he successfully reduced his invention to practice on December 28, 1995. Accompany the affidavit with the argument that the affidavit effectively "swears back" of such references.
- (E) File a declaration under 37 CFR § 1.130 to disqualify the commonly owned references, accompanied by the argument that a prior art reference that renders claimed subject matter obvious under 35 U.S.C. § 103 necessarily creates an obviousness-type double patenting situation, which is obviated by the filing of the terminal disclaimer.

5. Reginald, a registered patent agent, filed a nonprovisional patent application in the PTO on December 4, 1997, naming Able, Baker, and Charlie as joint inventors. The application properly identified all the inventors, a specification and one independent claim and four dependent claims. No drawings, declaration, or filing fees were filed with the application. Subsequently, the PTO correctly informed Reginald that drawings, specifically three figures, were necessary for the understanding of the subject matter sought to be patented. At the same time, the PTO informed Reginald that the declaration and filing fee were missing. On February 13, 1998, Reginald filed in the PTO drawings of the three figures. On February 17, 1998, the Official Draftsman required new drawings on the ground that the submitted drawings were not in compliance with the standards of 37 CFR § 1.84, although he regarded them as suitable for reproduction and admitted them for examination purposes. On February 19, 1998, Reginald filed in the PTO a declaration signed by all the inventors. On February 20, 1998, Reginald filed in the PTO a written authorization to charge the filing fee of the application and all surcharges to his established deposit account which contained sufficient funds. On March 6, 1998, Reginald filed in the PTO a set of new drawings in compliance with the standards of 37 CFR § 1.84. In accordance with proper PTO practice and procedure, what filing date should the PTO assign to Reginald's patent application?

- (A) December 4, 1997
- (B) February 13, 1998
- (C) February 19, 1998
- (D) February 20, 1998
- (E) March 6, 1998

6. Johnson invented an improved hose clamp for use on automobile radiator hoses and retained the services of a registered patent agent to obtain patent protection for his invention. The agent prepared the application and filed it in the PTO on June 20, 1994. On October 23, 1996, the patent agent filed a continuation application claiming the benefit of priority under 35 U.S.C. § 120, and thereafter permitted the parent application to become abandoned. During prosecution of the continuation application, the primary examiner rejected all the claims under 35 U.S.C. § 103 as unpatentable over Johnson's issued patents, specifically, Johnson '012 in view of Johnson '004. The Johnson '012 patent issued on November 12, 1991, on an application filed on April 18, 1990. The Johnson '004 patent issued on January 10, 1995, on an application filed on December 3, 1992. Following the filing of a reply traversing the examiner's rejection of the claims, the examiner issued a final rejection. Johnson has now learned that his patent agent has suffered a stroke and is unable to continue representing him, and asks you for your opinion as to whether there is a reasonable chance of overcoming the examiner's rejection.

Based on the following opinions, which do you believe is the best answer and most consistent with PTO practice and procedure?

- (A) There is little likelihood of overcoming the primary examiner's rejection because both references issued more than a year prior to the filing date of the continuation application. This is supported by 35 U.S.C. § 102, which states, "A person shall be entitled to a patent unless - . . . (b) the invention was patented . . . in this . . . country . . . more than one year prior to the date of the application for patent in the United States"
- (B) There is little likelihood of overcoming the primary examiner's rejection because the primary reference, i.e., Johnson '012 patent, issued more than a year prior to the filing date of the parent application, and the secondary reference, i.e., Johnson '004, was filed more than a year prior to the filing date of the parent application. This is supported by 35 U.S.C. § 102, which states, "A person shall be entitled to a patent unless - . . . (b) the invention was patented . . . in this . . . country . . . more than one year prior to the date of the application for patent in the United States . . . or . . . (e) the invention was described in a patent granted on an application for patent . . . filed in the United States before the invention thereof by the applicant for patent"
- (C) There is a reasonable chance of overcoming the primary examiner's rejection because the secondary reference, i.e., Johnson '004 patent, is Johnson's own patent and does not qualify as prior art under 35 U.S.C. §§ 102(a) or (e). Also, since the Johnson '004 patent issued after the filing date of the parent application, and since the continuation application is simply a continuation of the parent application, the Johnson '004 patent does not constitute prior art under 35 U.S.C. § 102(b). Accordingly, the Johnson '004 patent does not qualify as prior art to support a rejection under 35 U.S.C. § 103.
- (D) There is a reasonable chance of overcoming the primary examiner's rejection

because the secondary reference, i.e., Johnson '004 patent, was first patented prior to the filing date of the continuation application for patent in the United States on an application for patent filed more than twelve months before the filing date of the continuation application for patent in the United States. This is supported by 35 U.S.C. § 102, which states, "A person shall be entitled to a patent unless - . . . (d) the invention was first patented . . . by the applicant . . . in a foreign country prior to the date of the application for patent in this country on an application for patent . . . filed more than twelve months before the filing of the application in the United States"

- (E) There is a reasonable chance of overcoming the primary examiner's rejection because both references issued more than a year prior to the filing date of the continuation application, and therefore the invention was made in the United States by Johnson, who had not abandoned, suppressed, or concealed it, before his continuation application. This is supported by 35 U.S.C. § 102, which states, "A person shall be entitled to a patent unless - . . . (g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it," and 35 U.S.C. § 103(c), which states, "Subject matter . . . which qualifies as prior art only under subsection . . . (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person"

7. Which of the following statements regarding a Continued Prosecution Application (CPA) is not correct?

- (A) The request for a CPA can be filed by facsimile and processed entirely in the examining group.
- (B) The CPA will use the same file jacket as the prior application.
- (C) The application number of the CPA remains the same as the prior application.
- (D) No continuation-in-part CPA is permitted.
- (E) Priority to the parent application is granted only if there is reference to the parent application in the first paragraph of the specification of the CPA.

8. Trade Winds, Ltd., is a British company which processes and packages bulk herbs and spices. It sells these goods to distributors, who resell them under a variety of brand names. In February of 1997, Smith, an employee of Trade Winds, conceived the idea, new at that time, of using a container made of clear plastic rather than the traditional tin spice package or an opaque plastic container. In due course, Smith came forward with a large, clear container in the basic shape of a tall box with an oval depression in each side that serves as a hand grip. The container also has a plastic screw-on lid which has a flip-up opening for spooning or shaking out the contents of the container. On March 11, 1997, Trade Winds filed a utility patent application in Great Britain which fully disclosed their new spice container and its unique design, and shortly thereafter, on April 10, 1997, the new container was displayed at a packaging trade show in Yorkshire, England. The container was such a success at the trade show that Trade Winds, on May 6, 1997, entered into a 3 month contract with Professor Yak, a renowned business consultant and Dean of the School of Economics at a university in the United States, to develop a long-range business plan for Trade Winds. In order to get feedback from people who might actually use the container, Professor Yak set up a study at his university in which he selected ten students who were dietetics majors at his university, and tasked them to test the functional features of the new container, the prior art tin container, and the prior art opaque plastic container. The study occurred between June 1, and August 1, 1997. A study guide outlined the methodology, wherein: (1) the students were to pick up the containers and describe how they felt (e.g., comfortable, awkward, easy to grip, balanced, etc.); (2) the students were asked which container they liked best, and why; and (3) the students were asked how the containers felt when shaking out their contents. On March 6, 1998, Trade Winds filed an application for a design patent on the new container in the United States claiming the benefit of the earlier filing date of the British patent application under 35 U.S.C. § 119. Which of the following statements accords with proper PTO practice and procedure?

- (A) The U.S. design patent application is entitled to the benefit of the filing date of the copending British application under 35 U.S.C. § 119. Since this date is earlier than the date of the trade show, the display of the container at the show is not a public use bar under 35 U.S.C. § 102(b).
- (B) The U.S. design patent application is not entitled to the benefit of the filing date of the copending British application under 35 U.S.C. § 119. Therefore, the display of the container at the show is a public use bar under 35 U.S.C. § 102(b).
- (C) The U.S. design patent application is not entitled to the benefit of the filing date of the copending British application under 35 U.S.C. § 119. Therefore, Professor Yak's study activity in the United States constitutes a public use bar under 35 U.S.C. § 102(b).
- (D) The U.S. design patent application is not entitled to the benefit of the filing date of the copending British application under 35 U.S.C. § 119. The U.S. design patent application is barred by Professor Yak's study activity in the United States because the study activity involved the display of the cannister design to a group of students who were not subject to a confidentiality agreement, the activity occurred "in this country," and the activity occurred "more than one year prior to the date of

the application for patent in the United States.”

- (E) The U.S. design patent application is not entitled to the benefit of the filing date of the copending British application under 35 U.S.C. § 119. The U.S. design patent application is not barred by Professor Yak’s study activity in the United States because it occurred less than one year before the application was filed.

9. Able, a researcher with the Royal Fruit Co. (hereinafter “Royal”), discovered a distinct and new variety of peach tree which he successfully succeeded in asexually reproducing. Royal then obtained an assignment from Able, and filed a plant patent application with the PTO claiming the asexually reproduced peach tree. Subsequently, Baker, a researcher with the Georgia Peach Co. (hereinafter “Georgia”), unaware of Able’s discovery, discovered a similar though independent and patentably distinct variety of peach tree. Baker succeeded in asexually reproducing his discovery. Georgia then obtained an assignment from Baker and filed a utility patent application with the PTO claiming the fruit and propagating material of the Baker peach tree. Subsequently, Georgia merged with Royal, which acquired title to all of Georgia’s assets, including the Baker utility patent application. In the course of prosecution of the Baker patent application, the primary examiner “provisionally” rejected all of the claims in the Baker application on the ground of obviousness-type double patenting with the claims in Able’s application. On the basis of the present factual scenario and proper PTO practice and procedure, which of the following statements is true?

- (A) The rejection is improper because while there is a common relationship of ownership, a common relationship of inventorship is lacking.
- (B) The rejection is improper because the Able and Baker inventions are independent and patentably distinct from each other.
- (C) The rejection is improper because there was no common relationship of ownership at the time of Baker’s invention.
- (D) The rejection is proper because the issue of double patenting can be addressed without violating the confidential status of the applications as required by 35 U.S.C. § 122.
- (E) The rejection is improper because a provisional double patenting rejection cannot be based on copending utility and plant patent applications.

10. Sam Smart, a cabinet maker employed by Star Furniture Company, designed a unique armoire blending the ascetic style of Shakerism with the flamboyant style of Victorianism. Star officials were so impressed that they asked Patent Counsel to take immediate steps to obtain patent protection on the armoire. Patent Counsel filed a provisional utility application in the PTO on September 16, 1997, naming Sam Smart as the sole inventor. On March 20, 1998, Patent Counsel filed nonprovisional utility and design applications in the PTO, each application claiming priority from the provisional utility application under 35 U.S.C. § 119(e)(1). In the first Office action in the design application, the examiner rejected the sole claim as unpatentable under 35 U.S.C. § 103 over a photograph of a gun cabinet appearing in a department store catalog published in October 1997. Which of the following actions accords with proper practice and procedure and is most likely to overcome the rejection?

- (A) Traverse the rejection on the ground that the photograph is not available as a reference because the inventors named in the provisional and nonprovisional applications are the same, the nonprovisional application was filed within 12 months of the provisional application, the nonprovisional application refers to the copending provisional application, and the provisional application antedates the publication date of the reference catalog.
- (B) Traverse the rejection on the ground that the photograph is not available as a reference because while the photograph depicts a gun cabinet of substantially the same appearance as the claimed design, the gun cabinet and the armoire are not from analogous arts.
- (C) Traverse the rejection on the ground that the design of the armoire is not obvious from the reference because an armoire functions essentially to hold clothes, whereas a gun cabinet functions essentially to hold rifles.
- (D) Traverse the rejection on the ground that the ornamentation of the armoire is not obvious from the reference since the ornamentation of the armoire is embossed on the armoire surface, whereas the ornamentation of the gun cabinet is impressed in the gun cabinet surface.
- (E) Traverse the rejection by submitting evidence of commercial success of the claimed design and arguing that the overall appearance and design, characteristics of the gun cabinet are basically different from the claimed design.

11. Jack developed a unique safety valve for use in combination with a standard boiler. The safety valve comprises a piezoelectric element which functions to adjust the opening of the valve in response to pressure build-up. His patent agent prepared and filed a proper patent application in the PTO with the following sole original claim:

The combination of a standard boiler with a safety valve, said safety valve comprising a piezoelectric element which functions to adjust the opening of the valve in reply to pressure build-up.

In the first Office action, the primary examiner properly rejected the claim over a combination of references as being unpatentable under 35 U.S.C. § 103. Thereafter, the patent agent responded by filing an amendment which substituted a new claim for the sole original claim. The new claim is also drawn to the combination of a standard boiler with a safety valve. The examiner finally rejected the new claim on same grounds as the original claim was rejected, and stating that the new claim was a substantial duplicate of all the essential features of the canceled claim. Which of the following accords with PTO practice and procedure for responding to the rejection?

- (A) File a response having an amendment which adds a single claim limited to the safety valve, accompanied by argument clearly demonstrating that the claim to the safety valve has limitations not shown in the prior art references.
- (B) File a response clearly and correctly pointing out that the new claim has limitations to particular structure not disclosed or suggested by the prior art references whether considered individually or in combination.
- (C) File a response accompanied by an affidavit under 37 CFR § 1.132 setting forth test data demonstrating the technical superiority of Jack's safety valve over the safety valves in the prior art when used in conjunction pneumatic tire inflation devices.
- (D) File a petition to the Commissioner under 37 CFR § 1.81 and the proper petition fee requesting that the examiner be directed to withdraw the finality of the rejection as being premature because the new claim presented limitations not disclosed or suggested by the prior art references, and the examiner did not address those limitations in the rejection.
- (E) File a petition to the Commission under 37 CFR § 1.183 and the proper petition fee requesting that the examiner be directed to withdraw the finality of the rejection on the ground that the finality of the rejection was premature inasmuch as the new claim contained limitations not disclosed or suggested by the references, and the examiner did not address those limitations in the rejection.

12. When an application filed under 37 CFR § 1.47(a) has been accepted at the PTO, is in pending or abandoned status, and has not been referred to by application number and date in a United States or foreign patent or published application, which of the following may not, as a matter of right, receive information regarding the status of whether the application is pending or abandoned?

- (A) The applicant(s).
- (B) The assignee of record in the Patent and Trademark Office.
- (C) The attorney or agent of record in the application.
- (D) A non-signing inventor.
- (E) None of the above.

13. Jenkins is principal attorney of record in a patent application assigned to the Titan Pharmaceutical Co. in Sacramento, California. The application is directed to one of Titan's most important discoveries, i.e., an improved method of synthesizing quinoline consisting of the steps (a), (b), (c), and (d). After receiving a first Office action objecting to all the claims because of improper form, Jenkins filed an associate power of attorney in the PTO on January 21, 1998, naming Harris as an associate with full power. On February 10, 1998, Harris filed an amendment canceling all the claims and adding new claims 11 and 12, accompanied by appropriate argument. The new claims related to the synthesis of quinoline and consisted of the steps, (a), (b), and (c). On April 6, 1998, the examiner considered the Harris amendment in light of the argument and rejected the two claims as clearly anticipated under 35 U.S.C. § 102 as unpatentable over a 1953 publication by Skraup. Harris forwarded the Office action rejecting the claims along with a copy of the Skraup publication to Jenkins for his review. Jenkins determined that Harris had inadvertently omitted (d), the fourth step of the process. This step was neither disclosed by nor obvious in light of Skraup's teaching. Assuming Jenkins is correct in his determination, which of the following is the best action designed to (1) accord with proper PTO practice and procedure, (2) to overcome the rejection, and (3) be conducive to expeditious prosecution?

- (A) Jenkins should file an amendment adding step (d) to Claims 11 and 12, and offering appropriate argument.
- (B) Jenkins should file an amendment adding Claim 13, which depends from Claim 12. Claim 13 is directed to only step (d), and is accompanied by appropriate argument for patentability.
- (C) The assignee should file a revocation of Jenkins' power of attorney, and concurrently, Harris should file an amendment adding step (d) to the claims and offering appropriate argument.
- (D) The assignee should file a revocation of Jenkins' power of attorney, and after acceptance of the revocation by the PTO, Harris should file an amendment adding step (d) to the claims and offering appropriate argument.
- (E) Harris should file an amendment adding Claim 13, which would depend from Claim 11. Claim 13 would be directed to only step (d). Harris would offer appropriate argument for patentability.

14. You are the only attorney of record in a patent application that you have filed for your client, Jones. The primary examiner set a three month shortened statutory period for reply which requires that an amendment/reply be filed on September 8, 1998. You are away on vacation and will not be back until the end of September. You were planning on filing the reply when you returned. However, while you were away, the client calls your office and informs your secretary that he does not want to pay the additional fees required for an extension of time and wants the reply filed on or before September 8, 1998. Your secretary relays this information to you today, August 26, 1998. Since you were not planning to file the reply until you returned, you do not have Jones' file with you. With Jones' consent, you previously disclosed his invention to your brother, Mike, who is also your partner and a registered practitioner. You call Mike, and ask him

prepare and file a reply. Mike is familiar with the application, and calls Jones to tell him that he prepare, and file the amendment before the expiration of the three month period to avoid the payment of an extension fee. Can Mike properly prepare and file the reply at the PTO without a power of attorney from Jones?

- (A) Yes, because you and Mike are brothers in the same firm.
- (B) No, because you have not authorized Mike to act on your behalf.
- (C) No, because Mike is not listed as one of the attorneys of record.
- (D) Yes, because Mike is a registered practitioner and his signature and registration number on the reply constitutes a representation that he is authorized to represent Jones.
- (E) No, because Mike would be violating the PTO Code of Professional Responsibility.

You have filed a patent application on behalf of your client, Smith, on October 7, 1997. On July 15, 1998, the examiner sent a second Office action containing a final rejection. You mailed a reply to the PTO on July 10, 1998. Yesterday, you received an *Ex parte Quayle* action. Today, August 26, 1998, Smith brought to your attention prior art that he discovered last week. After reviewing the prior art, you determine that the prior art should be submitted to the PTO for consideration by the examiner. What will need to be filed with an Information Disclosure Statement (IDS) in order for the IDS to be considered by the examiner?

- (A) No additional papers are required to be filed with the IDS.
- (B) A petition requesting consideration of the IDS, and the appropriate fee.
- (C) A certificate of mailing, and the appropriate fee.
- (D) A certification that no information contained in the Information Disclosure Statement (IDS) was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the person signing the certification after making reasonable inquiry, was known to any individual designated in § 1.56(c) more than three months prior to the filing of the statement, a petition requesting consideration of the IDS and the appropriate fee.
- (E) A certification and statement stating that no item of information contained in the IDS was known to any individual designated in § 1.56(c) more than three months prior to the filing of the statement and petition requesting consideration of the IDS.

16. An application you filed for your client, Sam, received a final rejection dated January 12, 1998. The primary examiner set a three month shortened statutory period for reply. As you have been working closely with Sam, you were ready with an immediate reply and filed it with a certificate of mailing dated February 10, 1998. Unfortunately, the primary examiner was not persuaded by your reply, and mailed you an advisory action dated March 2, 1998. After discussing the matter with your client, you have decided that the best route to go is to the Board of Patent Appeals and Interferences. On March 6, 1998, you prepare a Notice of Appeal, and a certificate of mailing dated March 6, 1998. Inadvertently, the Notice of Appeal was not deposited with the U.S. Postal Service. The Notice of Appeal and Certificate of Mailing are hand carried by your intern and delivered to the mail room in the PTO on March 9, 1998. What would be the very last date on which an appeal brief could be filed if a proper petition and fee for the maximum extension of time is filed with the brief?

- (A) May 9, 1998
- (B) June 12, 1998
- (C) September 9, 1998
- (D) October 6, 1998
- (E) October 9, 1998

17. You have filed an application containing three claims drawn to two properly divisible inventions, Claims 1 and 3, linked by Claim 2. Claim 1 is directed to an injection molding process for a thermoplastic, Claim 2 is directed to a molding process for making a synthetic heat exchanger, and Claim 3 is directed to a synthetic heat exchanger. The primary examiner makes a restriction requirement stating that "Claim 2 links the injection molding process and the heat exchanger" and requires you to elect between the inventions defined by Claims 1 and 3. Which of the following would be the most appropriate reply to the restriction requirement?

- (A) Traverse the requirement, ask for reconsideration and withdrawal of the requirement because Claim 2 links both Claims 1 and 3 together.
- (B) Traverse the requirement, and amend Claim 1 to limit the claim to an injection molding process for making a heat exchanger.
- (C) Elect the invention defined by Claim 1 or Claim 3, and urge that since Claim 2 is a linking claim, it should be examined with the claims of the elected invention.
- (D) Elect the invention defined by Claim 2, and argue that you want the choice of using an injection process for making a heat exchanger so that the restriction would be moot since all the claims would be included.
- (E) File a petition requesting review of the requirement for restriction because the inventions defined by Claims 1 and 3 are not properly divisible where a proper linking claim exists.

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

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

2. Which PTO official will decide a petition requesting reopening of prosecution of a patent application after a final decision by the Board of Patent Appeals and Interferences under 37 CFR 1.198, where no court action has been filed?

- (A) The Solicitor.
- (B) The primary examiner to whom the application was originally assigned.
- (C) The Administrative Patent Judge who wrote decision.
- (D) The Group Director for the group where the application originated.
- (E) The Director of the Office of National Application Review.

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

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

21. You have filed a patent application on behalf of your client, Jane Smith. Since then, Jane has married and legally changed her name to Jane Jones. Which of the following would be the most appropriate procedure to make the corresponding name change in Jane's patent application?

- (A) File a petition with the appropriate fee directed to the Office of the Assistant Commissioner for Patents requesting the name change, and include an affidavit signed with both names setting forth the procedure whereby the change of name was effected.
- (B) File an amendment in the application requesting the examiner to change the applicant's name on the application to Jane Jones.
- (C) Expressly abandon the application, and file a continuation application naming Jane Jones as the inventor.
- (D) File a Certificate of Correction with the appropriate fee while the application is pending requesting that Jane Smith be changed to Jane Jones.
- (E) File a petition in the Application Processing Division of the PTO requesting that Jane Smith be changed to Jane Jones.

22. Prior art references may be combined to show obviousness of the claimed invention under 35 U.S.C. § 103. Which of the following most correctly completes the statement: "In establishing obviousness, _____"

- (A) a suggestion to modify the art must be expressly stated in one of the references used to show obviousness."
- (B) a suggestion to modify the art must be expressly stated in all the references used to show obviousness."
- (C) a suggestion to modify the art may be inherently or implicitly taught in one of the references used to show obviousness."
- (D) a suggestion to modify the art is unnecessary unless the patent applicant presents evidence or argument tending to show unobviousness."
- (E) A suggestion to modify the art can come from recent nonanalogous prior art references."

23. Claimed subject matter has been properly rejected under 35 U.S.C. § 103 over a combination of prior art references which render the claimed subject matter *prima facie* obvious. Which of the following actions by a practitioner in accordance with proper PTO procedure is most likely to be sufficient to overcome the *prima facie* case of obviousness?

- (A) Filing a declaration under 37 CFR § 1.132 containing evidence that the claimed subject matter possesses unexpected results, disclosed in the application, which are not described in the prior art, and arguing that the evidence rebuts the *prima facie* case.
- (B) Filing a reply arguing and giving your opinion that the claimed apparatus provides unexpectedly superior productivity.

- (C) Filing a declaration under 37 CFR § 1.132 presenting evidence of superior properties for iron-containing compositions, disclosed in the application where the broad rejected claim is drawn to a “metal-containing” composition. The prior art reference discloses and describes an aluminum composition which satisfies the broad claim, and the practitioner argues that the evidence rebuts the *prima facie* case of obviousness.
- (D) Filing a declaration under 37 CFR § 1.132 which demonstrates that a “metallic” apparatus of Claim 1 has superior properties to a plastic apparatus having all the structural limitations recited in the claim, and arguing that the evidence, which relies on properties disclosed in the application, rebuts the *prima facie* case of obviousness, where Claim 1 was rejected under 35 U.S.C. § 103 over references disclosing metallic apparatuses, and the references made out a *prima facie* case of obviousness.
- (E) Filing a declaration under 37 CFR § 1.132 demonstrating commercial success of a telephone apparatus having all the structural limitations recited in the rejected claim except that the commercially successful apparatus is plastic and is disclosed in the application, whereas the rejected claim is limited to a “metallic” telephone apparatus, and arguing that the evidence rebuts the *prima facie* case of obviousness, where the claim was rejected under 35 U.S.C. § 103 over references disclosing metallic telephone apparatuses, and the references made out a *prima facie* case of obviousness.

Assuming that each claim given below is from a different application, which of the following claims contain improper multiple dependent claim wording?

- (A) Claim 6. A ceramic camshaft as in either Claim 1 or Claim 2, further comprising
- (B) Claim 4. An intake valve as in any of the preceding claims, in which
- (C) Claim 3. A fuel injector according to Claims 1 or 2, further comprising
- (D) Claim 7. A turbocharger as in one of Claims 3-5, in which
- (E) Claim 10. A rotary engine as in Claims 2 or 4 and 8 or 9, which

25. Claimed subject matter has been rejected under 35 U.S.C. § 103 over a combination of prior art references, which purport to render the claimed subject matter *prima facie* obvious. Which of the following rebuttals properly demonstrates in the given circumstances that the references could not render the claimed subject matter *prima facie* obvious, and thereby overcome the rejection?

- (A) Where the primary reference is a Russian patent certificate, the secondary reference is a U.S. patent, and a registered practitioner argues that *prima facie* obviousness has not been demonstrated because the assumption that the person of ordinary skill in the art would be familiar with all prior art references pertaining to a given art is in conflict with reality.
- (B) Where the claimed subject matter is a method for detecting and measuring minute quantities of nitrogen compounds, the primary reference teaches a method for detecting and measuring minute quantities of sulfur having - in addition to all the limitations of the claimed method - a solvent to collect the sample and stating that the presence of nitrogen in the sample will interfere with measuring sulfur quantities, a secondary reference teaching a method of detecting minute quantities of nitrogen in the atmosphere, and a registered practitioner argues that the references may not be properly combined to formulate a rejection of *prima facie* obviousness because there is nothing to suggest that they be combined since the primary reference seeks to avoid nitrogen.
- (C) Where neither the primary nor secondary reference explicitly states that its teachings may be combined with the teachings of the other reference, a registered practitioner should argue that the references may not be properly combined to formulate a rejection of *prima facie* obviousness absent an express suggestion in one prior art reference to look to another specific reference.
- (D) Where the claimed detergent uses sugar to enhance the compatibility of softeners with other components of the detergent, the primary reference teaches a detergent having all the claimed limitations except for the presence of sugar, and the secondary reference teaches using sugar as a filler or weighting agent in detergents having softeners, a registered practitioner should argue that the claimed detergent cannot be *prima facie* obvious unless one reference teaches using sugar for the same purpose it is used in the claimed detergent.
- (E) Where the claimed food additive uses YXY to sweeten food, the primary reference teaches food additive having all the claimed limitations except for using XY as a preservative, and the secondary reference teaches the equivalence of XY and YXY as preservatives in food, a registered practitioner should argue that to establish a *prima facie* case of obviousness there must be a suggestion from the prior art that the claimed invention will have the same or similar utility as the one newly discovered by applicant.

26. The claimed invention in inventor Jones' application is a digital transmission system which communicates a plurality of separate digital streams over a common channel. It includes a transmitter portion (block encoding arrangements and multiplexer), and receiver portion (a demultiplexer and block decoding arrangements). The receiver portion includes a phase comparator having four inputs and one output and a divider having two inputs and one output. The functions of the phase comparator and divider are adequately disclosed in the specification. However, the specification does not describe how to make and use the phase comparator and divider. The examiner correctly and reasonably asserting that the comparator was not a typical two input phase comparator, and the divider was not a typical one input divider, properly rejected the claims under 35 U.S.C. § 112, first paragraph, for lack of enabling disclosure because the structural details of the phase comparator and divider were not disclosed. Which of the following declarations would be minimally legally sufficient to overcome this rejection in accordance with proper PTO practice and procedure?

- (A) A declaration of a professor stating that "the elements referred to in the application as the divider and the phase comparator were well-known to those of skill in the art as of June 17, 1997," the filing date of the Jones application.
- (B) A declaration of a professor stating that "the elements referred to in the application as the divider and the phase comparator were well-known to those of skill in the art as of June 17, 1997," the filing date of the Jones application, and that these elements were "routinely built."
- (C) A declaration of a professor stating that "the elements referred to in the application as the divider and the phase comparator were well-known to those of skill in the art as of June 17, 1997," the filing date of the Jones application, that these elements were "routinely built," and the professor provides details in the declaration concerning the structure and function of the elements.
- (D) A declaration of a professor stating that "the elements referred to in the application as the divider and the phase comparator were well-known to those of skill in the art as of June 17, 1997," the filing date of the Jones application, that these elements were "routinely built and sold to the public by [two identified corporations] before June 17, 1997, and were used in constructing a digital transmission system at the university."
- (E) A declaration of a professor stating that "the elements referred to in the application as the divider and the phase comparator were well-known to those of skill in the art as of June 17, 1997," the filing date of the Jones application, that these elements were "routinely built and sold to the public by [two identified corporations] before June 17, 1997, and were used in constructing a digital transmission system at the university." The professor was involved with the construction of the digital transmission system.

27. X invented a bending machine. On June 18, 1996, the practitioner filed a first patent application in the PTO for X disclosing and claiming the bending machine. The disclosure, drawings, and claims in the first application complied with all regulations for obtaining a filing date. Claims in the first application were given a final rejection in an Office action dated March 2, 1998, setting a three month shortened statutory period for reply. The claims were rejected under 35 U.S.C. § 103 over two U.S. patents issued before 1995. On August 1, 1998, the practitioner became aware of a foreign patent published on July 1, 1997, which discloses a bending machine invented by Y that is identical to the bending machine described and claimed in the first application. X informed the practitioner on August 2, 1998, that X will need an additional two months to complete tests to demonstrate that X's invention provides unexpected results. The practitioner decides to file a continuation application. Which of the following courses of action preclude the foreign patent from possibly being prior art under 35 U.S.C. § 102(b), and complies with the provisions for filing a continuation application in the PTO?

- (A) On September 2, 1998, file in the PTO a document wherein the practitioner requests a continuation application under 37 CFR § 1.53(d), identify and expressly abandon the first application, identify X as the inventor, retain the same claims as were finally rejected, request utilization of the file jacket of the first application, petition for a three month extension of time, and pay the appropriate extension of time and filing fees.
- (B) On September 2, 1998, file in the PTO a document wherein the practitioner requests a continuation application under 37 CFR § 1.53(d), identify and expressly abandon the first application, identify X as the inventor, retain the same claims as were finally rejected, request utilization of the file jacket of the first application, and pay the appropriate filing fee.
- (C) The foreign patent never could be prior art under 35 U.S.C. § 102(b) against X because the first application was filed more than one year before the publication date of the foreign patent. File in the PTO, on October 5, 1998, a duplicate of the first application together with X's affidavit under 37 CFR § 1.132 showing the results of X's tests, an appropriate filing fee, and a preliminary amendment amending the first sentence of the specification to refer to the first application.
- (D) The foreign patent never could be prior art under 35 U.S.C. § 102(b) against X because the first application was filed more than one year before the publication date of the foreign patent. File in the PTO, on October 5, 1998, a duplicate of the first application, X's affidavit under 37 CFR § 1.132 showing the results of X's tests, a petition for a five month extension of time, and appropriate filing and five month extension of time fees.
- (E) On August 26, 1998, file in the PTO a duplicate of the specification (wherein X is identified as the inventor), claims, and drawings of the first application, a letter requesting that the duplicate be treated as continuation application under 37 CFR § 1.53(d), and the appropriate filing fee.

28. Inventor Smith prepared and filed on February 11, 1997, a provisional application regarding a machine Smith invented in the United States on November 5, 1996. A Notice to File Missing Parts dated March 6, 1997, informed Smith that the filing fee was omitted, and that the filing fee along with the surcharge are required. The Notice set a period for reply which was two months from the filing date. Smith failed to pay the filing fee and the required surcharge. The provisional application became abandoned. A Notice of Abandonment, dated May 11, 1997, was sent to Smith. Smith engaged practitioner P to prepare and file a patent application, and informed P that Smith had filed a provisional application on February 11, 1997. On February 11, 1998, P filed a complete nonprovisional patent application for Smith, claiming benefits under 35 U.S.C. 119(e) of the filing date of the provisional application. On March 4, 1998, Smith furnished P with a copy of a publication by Allon, dated February 2, 1997, fully describing the machine and a manner of making and using the machine. Also on March 4, 1998, Smith gave P copies of the two notices. P, upon asking Smith why no reply had been filed to either notice, learned that Smith had been hospitalized for a heart attack and ensuing complications from March 5 through May 4, 1997, and Smith's significant other put the notices away without opening or showing them to Smith so as not to disturb Smith, and then forgot about the notices. Smith first learned of the notices on March 3, 1998, while sorting through papers to prepare Smith's 1997 income tax return. To properly protect Smith's patent rights, the most appropriate course of action for P to take is

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- (A) to do nothing inasmuch as the regulations no longer provide for revival of an abandoned provisional application after a nonprovisional application has been filed.
 - (B) to promptly file a request to withdraw the holding of abandonment explaining that abandonment was improper inasmuch as Smith's significant other had withheld the notices from Smith, and Smith had not received the notices. Also, with the request file the filing fee, a copy of the Allon publication, and an explanation of the relevance of the Allon publication.
 - (C) to promptly file a petition requesting the Commissioner to exercise his supervisory authority to withdraw the holding of abandonment as improvident inasmuch as Smith's significant other had withheld the notices from Smith, and Smith had not received the notices.
 - (D) promptly file a petition and fee to revive the provisional application as being unintentionally abandoned, the appropriate surcharge, the filing fee, and a statement that the entire delay was unintentional. Also file in the nonprovisional application an IDS listing the Allon publication along with a copy of the Allon publication, and an explanation of the relevance of the Allon publication to the claims in the patent application.
 - (E) promptly file a petition and fee for a two month extension of time, a petition and fee to revive the provisional application as being unintentionally abandoned, the filing fee, and a statement that the entire delay was unintentional.

29. On September 10, 1997, Smith invented a process for implanting processing chips in human heads. The chips permit the human to control replies when angered. Smith filed a *pro se* patent application in the PTO on the process on November 17, 1997. Shortly afterwards, Smith was hired by EZ Corporation, a processor and distributor of chips. During the pendency of the Smith patent application, on January 3, 1998, Smith invented an improvement to the process, and pursuant to Smith's employment agreement, Smith executed an assignment of the improved process invention to EZ Corporation. You are patent counsel for EZ Corporation. Pursuant to instructions, you prepared a patent application on the improved process invention. On February 3, 1998, you filed a complete patent application together with the executed assignment in the PTO. The application filed on February 3, 1998, in addition to disclosing the process disclosed in the *pro se* application, also disclosed and claimed only the improved process. The first sentence of the specification in the application filed on February 3, 1998, stated that the application was a CIP of the copending *pro se* Smith patent application, which was adequately identified therein. On May 11, 1998, the *pro se* Smith patent application became abandoned. On June 4, 1998, all the claims to the improved process in the application filed on February 3, 1998, were rejected by the primary examiner as unpatentable under 35 U.S.C. § 103 over a U.S. patent that issued on March 3, 1998, on an application that was filed on December 11, 1995. Which of the following actions accords with proper PTO practice and procedure, and represents the most appropriate action for overcoming the examiner's rejection?

- (A) File a reply which argues that the claims of the present application are nonobvious over the U.S. Patent issued on March 3, 1998.
- (B) File a reply which argues that since Smith is the same inventor named in the previously filed *pro se* application, and since the CIP application contains a specific reference to the earlier filed application, the CIP application is entitled to the benefit of the earlier filing date in accordance with 35 U.S.C. § 120 for purposes of the improvement process claims.
- (C) File an affidavit under 37 CFR § 1.132 presenting test data showing that the process in the CIP application is significantly superior to the process in the *pro se* application.
- (D) File a reply which argues that the reference patent cannot be the basis of a rejection because its issue date postdates the filing date of the CIP application.
- (E) File an affidavit under 37 CFR § 1.131 swearing back of the reference filing date.

30. Inventor X, a citizen of Germany, invented a tape dispenser in Germany on May 5, 1996. On January 22, 1997, X filed a patent application for the tape dispenser in the German Patent Office. On January 22, 1998, you filed a complete U.S. patent application in the PTO claiming a tape dispenser on behalf of X. The U.S. application was filed with a declaration under 37 CFR § 1.63 signed by X claiming foreign priority of the German patent application. In an Office action dated June 17, 1998, and setting a three month shortened statutory period for reply, a primary patent

examiner properly rejected all the claims in the U.S. patent application as being anticipated under 35 U.S.C. § 102(a) by the disclosure in magazine articles describing how to make and use an identical tape dispenser. The articles were published in the United States in February 1997, and in Great Britain in March 1997. Which of the following actions accords with proper PTO practice and procedure, and represents the most appropriate action for overcoming the rejection?

- (A) On or before September 17, 1998, file a certified copy of the German application, and an English translation of the German application.
- (B) On or before September 17, 1998, file a certified copy of the German application, an English translation of the German application, and point out that the reference is no longer available as prior art.
- (C) File a reply on or before September 17, 1998, which argues that the reference cannot be used because the application inventor X filed in the German Patent Office antedates the article.
- (D) File an affidavit under 37 CFR § 1.132 signed by you stating that the reference cannot be used because the application which inventor X filed in the German Patent Office antedates the articles.
- (E) File a petition to have the Commissioner exercise his supervisory authority and withdraw the rejection stating that the reference cannot be properly used inasmuch as the declaration under 37 CFR § 1.63 makes clear that the application inventor X filed in the German Patent Office antedates the articles.

31. Which of the following utility statements, which correspond in scope to the subject matter sought to be patented, is sufficient to meet the requirements of 35 U.S.C. §§ 101 and 112, first paragraph?

- (A) The invention is a novel process for making certain steroids which, in turn, are known to be useful in the formation of A-nor steroids. There is nothing in the record of the application file showing that any "A-nor steroid" which might ultimately be produced from the claimed compounds would itself be a useful product.
- (B) The invention is a composition which is the cure for all cancer.
- (C) The invention is a novel composition using a new source of stannous tin for incorporation in dentifrices by which term is meant mouth washes, tooth pastes, tooth powders and chewing gums, i.e., compositions for introduction into the oral cavity as cleansing compositions.
- (D) The invention is a composition which prevents the process of aging.
- (E) The invention is a device that increases the efficiency of an engine from 35% to 110%.

32. In connection with an appeal to the Board of Patent Appeals and Interference's, which of the following rejections would be a new ground of rejection?

- (A) In a final Office action, Claim 1 is rejected under 35 U.S.C. § 103 over A in view of B. On appeal, in the examiner's answer, the primary examiner again states that Claim 1 is rejected under 35 U.S.C. § 103 over A in view of B, but the actual argument or rationale supporting the rejection, while having the same basic thrust as the argument or rationale advanced in the final rejection differs therefrom.
- (B) In a final Office action, Claim 6 is rejected under 35 U.S.C. § 103 over A in view of B, and Claim 8 is rejected under 35 U.S.C. § 103 over A in view of C. No claim was rejected under 35 U.S.C. § 103 over A in view of B and C. In reply, an amendment proposes to combine the limitations of Claims 6 and 8 together in a new claim, Claim 9, and canceling Claims 6 and 8. In an advisory action, the primary examiner permits entry of the amendment as reducing issues on appeal. On appeal, in the examiner's answer, the primary examiner rejects Claim 9 under 35 U.S.C. § 103 over A in view of B and C, supported by the argument advanced in the rejections of Claims 6 and 8.
- (C) In a final Office action, Claims 1 and 2, where Claim 2 depends on Claim 1, are rejected under 35 U.S.C. § 103 over A in view of B. In reply, an amendment proposes to rewrite Claim 2 in independent form and cancel Claim 1. In an advisory action, the primary examiner advises that the proposed amendment will be entered as reducing issues on appeal, and that the final rejection would be used to reject Claim 2 as amended. On appeal, in the examiner's answer, the primary examiner rejects Claim 2 under 35 U.S.C. § 103 over A in view of B, supported not only by the argument advanced in the rejections of Claims 1 and 2, but also by rationale not advanced in the final rejection, though the rationale has the same thrust as the rationale in the final Office action.
- (D) In a final Office action, Claims 2 and 3 are rejected under 35 U.S.C. § 103 over A in view of B. In reply, an amendment proposes to cancel Claims 2 and 3, and add Claim 4, which incorporates the limitations of Claims 2 and 3. In an advisory action, the primary examiner advises that the proposed amendment will be entered, and that the final rejection would be used to reject the added Claim 4. On appeal, in the examiner's answer, the primary examiner rejects Claim 4 under 35 U.S.C. § 103 over A in view of B, supported by the argument advanced in the rejections of Claims 2 and 3.
- (E) In a final Office action, Claim 3 is rejected under 35 U.S.C. § 103 over A in view of B, and Claim 4 is rejected under 35 U.S.C. § 103 over A in view of C. In reply, an amendment proposes to combine the limitations of Claims 3 and 4 together in a new claim, Claim 5, and canceling Claims 3 and 4. In an advisory action, the primary examiner denies entry of the proposed amendment as not reducing issues on appeal. On appeal, in the examiner's answer, the primary examiner states that Claim 3 has been rejected under 35 U.S.C. § 103 over A in view of B, and claim 4 has been rejected under 35 U.S.C. § 103 over A in view of C, and supports the

rejections by expanding upon the arguments advanced in the final Office action.

33. The practitioner timely files an appeal brief together with an Information Disclosure Statement (IDS) disclosing references X and Y, an appropriate certification, a petition requesting consideration of the IDS, and the appropriate petition fee. References X and Y were not previously of record in the application. The primary examiner properly concludes that new rejections must be made of Claim 1 under 35 U.S.C. § 102(b) over X, and Claims 1 and 2 under 35 U.S.C. § 103 over X in view of Y. With the approval of a supervisory patent examiner, the primary examiner reopens prosecution, and enters the rejections in an Office action. Which of the following actions accords with proper PTO practice and procedure, and represents the most appropriate action for overcoming the primary examiner's rejections?

- (A) The practitioner files a reply under 37 CFR § 1.111 together with an amendment rewriting Claim 1 to incorporate the limitations of Claim 2, and canceling Claim 2; a declaration under 37 CFR § 1.132 showing that the invention set out in amended Claim 1 produces unexpected results; and arguments in the reply pointing out the supposed errors in the examiner's rejection, and replying to each ground of rejection.
- (B) The practitioner may timely file a reply brief arguing that Claim 1 is not anticipated by reference X, and file an affidavit under 37 CFR § 1.132 in support of an argument that the invention set out in Claim 2 provides unexpected results not suggested by references X and Y.
- (C) The practitioner requests reinstatement of the appeal, and files a supplemental appeal brief accompanied by an amendment canceling Claim 1, and amending Claim 2. In the supplemental appeal brief, the practitioner argues that the rejections of Claims 1 and 2 are overcome by the amendment to the claims. The practitioner does not argue that Claims 1 and 2 are patentable independent of the amendment.
- (D) The practitioner requests reinstatement of the appeal, and files a supplemental appeal brief accompanied by an amendment canceling Claim 1, and a declaration under 37 CFR § 1.132 showing that the invention set out in Claim 2 produces unexpected results. In the supplemental appeal brief, the practitioner argues that the rejections have been overcome. The amendment and declaration are necessary to overcome the rejection.
- (E) The practitioner files a reply brief arguing that the examiner is not permitted to reopen prosecution and reject the claims, and arguing that the rejections are in error based on the practitioner's statement that the invention provides unexpected results. The practitioner's statement is otherwise unsubstantiated by evidence in the record.

34. On November 6, 1997, the practitioner filed a complete patent application, filing fee, and declaration under 37 CFR § 1.63 identifying inventors A and B by their full names, and providing their residence, post office addresses, and citizenship. Inventors A and B did not assign, and were under no obligation to assign their rights in the invention to any other party. A primary examiner required restriction between the invention of Claims 1-5, and the invention of Claims 6-10. The practitioner elected the invention of Claims 1-5. The examiner withdrew Claims 6-10 from consideration. On July 15, 1998, the practitioner filed a reply to a first Office action dated May 8, 1998, which did not set a period for reply. In the reply, Claims 6-10 were canceled, and Claims 1 and 3 were amended by adding limitations supported by information disclosed, but unclaimed in the application. The limitations were substantially embraced by the statement of invention in the application. Claim 1 is an independent claim, and Claims 2-5 depend directly or indirectly from Claim 1. On August 1, 1998, inventors A and B then provided the practitioner with information clearly showing that Claims 1-5, as amended, were not the joint invention of A and B, and that such error arose without deceptive intent. Which of the following actions fulfills proper PTO practice and procedure for correcting inventorship?

- (A) Where the information shows that A is the sole inventor of Claims 1-5, as amended, the practitioner should file an amendment to name only A as the sole inventor of the invention set forth in Claims 1-5, together with a statement by the practitioner to correct the inventorship. The foregoing should be filed promptly, and preferably before the next Office action.
- (B) Where the information shows that A and C are joint inventors of Claims 1-5, as amended, the practitioner should file an amendment deleting B as an inventor, and adding C as a joint inventor. The amendment should be accompanied by a petition including a statement by B and C that the error in inventorship occurred without deceptive intent on their part, a statement identifying B as the named inventor who is being deleted and acknowledging that B's invention is no longer being claimed, and a statement by C that the amendment is necessitated by the amendment of the claims. An oath or declaration under 37 CFR § 1.63 by A and C should also accompany the amendment. The foregoing should be filed promptly, and preferably before the next Office action.
- (C) Where the information shows that A is the sole inventor of Claims 1-5, as amended, the practitioner should file a properly completed request on a separate paper for a continuation application as a continued prosecution application. The request names as inventor only A, and is accompanied by the proper filing fee, and a statement by the practitioner requesting the deletion of B as inventor inasmuch as B is not an inventor of the invention being claimed in the new application. The foregoing should be filed before an issue fee is paid in the prior application, or before the prior application is abandoned.
- (D) Where the information shows that A and C are joint inventors of Claims 1-5, as amended, the practitioner should file a properly completed request on a separate paper for a continuation application as a continued prosecution application. The request names as inventors A and C, and is accompanied by the proper filing fee,

and a statement by the practitioner requesting the deletion of B as inventor inasmuch as B is not an inventor of the invention being claimed in the new application, and addition of C as an inventor. The request is accompanied by a new declaration under 37 CFR § 1.63 naming A and C as the inventors. The foregoing should be filed before an issue fee is paid in the prior application, or before the prior application is abandoned.

- (E) All of the above.

35. During the pendency of inventor Smith's first patent application, he filed a request for a Continued Prosecution Application (CPA). On February 4, 1998, a primary examiner again rejected Claims 1-4 in the CPA application under 35 U.S.C. § 103 over references X and Y, and again rejected Claim 5 under 35 U.S.C. § 103 over references X, Y, and Z. The examiner did not set a shortened statutory period for reply. On August 4, 1998, the practitioner filed a notice of appeal to the Board of the Patent Appeals and Interferences from the examiner's decision rejecting Claims 1-5. Claims 6-10 in the CPA application stand allowed. Which of the following actions was not in accord with proper PTO practice and procedure regarding the appeal and Smith's CPA application?

- (A) The practitioner timely filed the notice of appeal containing an authorization to charge fees to a deposit account, which is signed by the practitioner.
- (B) The practitioner timely filed the notice of appeal containing an authorization to charge the appeal fee to a deposit account which is signed by the practitioner and does not specify which claims are appealed.
- (C) The practitioner timely filed the notice of appeal containing an unsigned authorization to charge the appeal fee to a deposit account; the notice of appeal specifies which claims are appealed.
- (D) The practitioner timely filed an unsigned notice of appeal; the notice of appeal specifies which claims are appealed; a proper authorization to charge fees to a deposit account accompanied the notice of appeal.
- (E) The practitioner timely filed the notice of appeal which was signed by the practitioner; the notice of appeal specifies which claims are appealed; the appropriate fee accompanies the notice of appeal. An appeal brief was filed with a request for extension of time and the requisite fee seven months after the notice of appeal was filed.

36. Which of the following statements regarding a CPA application is correct?

- (A) A proper CPA division application is filed on August 17, 1998, where, on February 20, 1998, a final Office action setting a three month shortened statutory period for reply was mailed in a prior application; and on August 17, 1998, a request is filed by facsimile for a CPA division application of the prior application; the request, signed by the practitioner, includes an authorization to charge small entity fees under 37 CFR § 1.16 to a deposit account, identifies the correct application number of the prior application; and refers to and is accompanied by a preliminary amendment causing the CPA application to have two independent claims, and 12 dependent claims.
- (B) A CPA continuation application stands abandoned where, before the abandonment of a prior application wherein there was a final rejection, a request was filed in the PTO on December 8, 1997, for a CPA continuation application of the prior application; the request was filed without a filing fee; the PTO sent to the practitioner a Notice To File Missing Parts of Application dated December 17, 1997, requiring payment of the \$790.00 filing fee, and \$130.00 surcharge on or before February 17, 1998; and on July 17, 1998, the practitioner files a petition and check covering the fees for a five month extension of time, the filing fee, and surcharge.
- (C) An improper, as opposed to a proper CPA division application, has been filed where a Notice of Allowance and Issue Fee Due setting a three month statutory period for reply was mailed in a prior application on February 4, 1998; the issue fee was never paid; a completed request for a CPA division application was filed in the PTO on May 6, 1998, with a certificate of mailing by first class mail under 37 CFR § 1.8; the certificate is dated May 4, 1998; and the request correctly identifies the application number of the prior application and is signed by the practitioner.
- (D) A proper CPA continuation application has been filed where a provisional application was filed in the PTO on August 12, 1997; a completed request for a CPA continuation application was filed by hand delivery in the PTO on August 11, 1998; and the request correctly identifies the application number of the prior provisional application and is signed by the practitioner.
- (E) A design application may be properly filed as CPA divisional application of a prior utility application by filing, during the pendency of the prior utility application, a completed request, signed by the practitioner, which correctly identifies the application number of the prior application, together with a preliminary amendment canceling the original specification and substituting a design specification.

37. In an original patent application having Claims 1 through 10, where Claims 1 and 4 are independent claims, a primary examiner properly rejected Claims 1-5 under 35 U.S.C. § 112, second paragraph, and Claims 4-10 under 35 U.S.C. § 103 over a combination of prior art references. The Office action set a three month shortened statutory period for reply. A patent practitioner's reply (both amendment and arguments) addressed the rejections of Claims 4-10 under 35 U.S.C. § 103 and of Claims 4 and 5 under 35 U.S.C. § 112, but failed to reply to the rejection of Claims 1-3 under 35 U.S.C. § 112, second paragraph. Which of the following does not comply with PTO practice and procedure regarding the reply?

- (A) If the Office action was a non-final Office action on the merits dated January 12, 1998, and the reply was filed on Monday, April 13, 1998; then the examiner, in a communication dated April 17, 1998, may properly call attention to the omission of a reply to the rejection of Claims 1-3, and set a one month shortened statutory period to complete the reply, and the practitioner may properly avoid abandonment of the application by filing on Tuesday, October 17, 1998, a request and fee for a five month extension of time, and a reply to the rejection of Claims 1-3 under 35 U.S.C. § 112, second paragraph.
- (B) If the Office action was a final Office action dated January 12, 1998, and the reply was filed on Monday, April 13, 1998, and in an Advisory action dated April 20, 1998, the examiner informed the practitioner that the amendment in the reply did not *prima facie* place the application in condition for allowance; then the practitioner may properly avoid abandonment of the application by filing, on July 10, 1998, a notice of appeal and appeal fee.
- (C) If the Office action was a non-final Office action on the merits dated January 12, 1998, and the reply was filed on Monday, April 13, 1998; then the primary examiner, in a communication dated April 17, 1998, may properly call attention to the omission of a reply to the rejection of Claims 1-3 and set a one month shortened statutory period to complete the reply, and the practitioner can properly achieve copendency between the application and a continuing application by filing a request and filing fee for a continued prosecution application on or before May 13, 1998, all without completing the reply.
- (D) If the Office action was a second, final Office action on the merits dated September 9, 1997, and the reply was filed on March 9, 1998, together with a request and fee for a three month extension of time; and if the examiner informed the practitioner in the second, final Office action that the same rejection of Claims 1-3 under 35 U.S.C. § 112, second paragraph, had been made in the first, non-final Office action and that there was an omission of a reply to the rejection of Claims 1-3 in the practitioner's reply to the first, non-final Office action; then the examiner may properly determine that the omission in the reply filed on March 9, 1998, was not inadvertent, so inform the practitioner in an Advisory action, and the application becomes abandoned for an incomplete reply.
- (E) All of the above.

38. Inventor A, with the assistance of a registered patent practitioner P, filed a patent application. The PTO mailed to P an Office action. P, a sole practitioner, received the Office action. The application became abandoned for failure to respond within the three month shortened statutory period for reply specified in the Office action. A asked P every three months about the status of the application. P always advised A that the application was pending. P did not revive the application. Using letters, and billing A for work not performed in the application, P mislead A into believing that the application was pending. Inventor A first learned of the abandoned status of the application in a telephone conversation with the primary examiner on June 12, 1998. On June 14, 1998, A engaged another practitioner, X, to assist in reviving and prosecuting the application. Since June 12, 1998, P has refused to respond to letters he received from A and X by certified mail, or to telephone calls from A and X, wherein A and X have requested P to provide a factual statement explaining what occurred. Inventor A, with the assistance of practitioner X, filed a petition to revive the application on August 25, 1998. Which of the following complies with PTO practice and procedure for a petition to revive an application for unavoidable delay in replying to an Office action?

- (A) Where the application was filed on May 9, 1995, and became abandoned on March 5, 1997, for no reply to an Office action dated December 4, 1996, file a petition, accompanied by the petition fee, a terminal disclaimer for 17 months which is proper in all formal respects, the disclaimer fee, the required reply, and a showing, corroborated by supporting documents and affidavits from A and X, demonstrating that P failed to inform A of the Office action, A had sought status information from P every three months since November 1996, P misled A regarding the status of the application, and P has failed to respond to communications requesting P's assistance in reviving the application, and the entire delay was unavoidable.
- (B) Where the application was filed on June 10, 1996, and became abandoned on March 21, 1997, for no reply to an Office action dated December 20, 1996, file a petition, accompanied by the petition fee, a terminal disclaimer for 17 months which is proper in all formal respects, the disclaimer fee, the required reply, and an affidavit signed by X stating that P failed to inform A of the Office action, A had sought status information from P every three months since November 1996, P misled A regarding the status of the application, and P has failed to respond to communications requesting P's assistance in reviving the application, and the entire delay was unavoidable.
- (C) Where the application was filed on April 10, 1997, and became abandoned on May 6, 1998, for no reply to an Office action dated November 5, 1997, file a petition, accompanied by the petition fee, the required reply, and an affidavit signed by X stating that P failed to inform A of the action, P misled A regarding the status of the application, and P has failed to respond to communications from A and X requesting P's assistance in reviving the application.
- (D) Where the application was filed on April 10, 1997, and became abandoned on February 6, 1998, for no reply to an Office action dated November 5, 1997, file a petition to revive accompanied by a terminal disclaimer for 3 months which is

proper in all formal respects, an authorization to charge any required fees to a designated account, the required reply, and an affidavit signed by A stating that P failed to inform A of the action, and that A was damaged by P's conduct at least to the extent that A had incurred additional fees and expenses for the petition, and the entire delay was unavoidable.

(E) None of the above.

39. The Jones patent application was filed in the PTO in January 1998. Jones conceived and reduced the claimed invention to practice in the United States. A claim in the application has been rejected under 35 U.S.C. § 102 as being unpatentable over a U.S. patent to Smith. Smith did not derive anything from Jones, or visa versa, and at no time were Smith and Jones obligated to assign their inventions to the same employer. In which of the following situations should a declaration by Jones under 37 CFR § 1.131 overcome the rejection in accordance with proper PTO practice and procedure?

- (A) The rejected claim is drawn to a genus. The Smith patent issued in March 1997, on an application filed in June 1993. The patent discloses, but does not claim, a single species of the genus claimed by Jones. The declaration shows completion in April 1993, of the same species disclosed by Smith.
- (B) The rejected claim is drawn to a species. The Smith patent issued in March 1997, on an application filed in June 1993. The patent discloses, but does not claim, the species claimed by Jones. The declaration shows completion in April 1993, of a different species.
- (C) The rejected claim is drawn to a genus. The Smith patent issued in March 1997, on an application filed in June 1993. The patent discloses, but does not claim, several species within the genus claimed by Jones. The declaration shows completion in April 1993, of a species different from the reference's species and the species within the scope of the claimed genus.
- (D) The rejected claim is drawn to a genus. The Smith patent issued in March 1996, on an application filed in June 1993. The patent discloses, but does not claim, several species within the genus claimed by Jones. The declaration shows completion in April 1993, of one or more of the species disclosed in the patent.
- (E) The rejected claim is drawn to a genus. The Smith patent issued in November 1997, on an application filed in June 1993, and the patent discloses and claims several species within the genus claimed by Jones. The declaration shows completion in April 1993, of each species claimed in the Smith patent.

40. On August 12, 1998, reexamination was ordered of the Smith patent based on a proper substantial new question of patentability. The Smith patent was granted on September 12, 1995, on a patent application filed on July 2, 1992. Considering each of the following situations separately from the other, which of the situations complies with PTO practice and procedure regarding a rejection of Claims 1-5 in the Smith patent?

- (A) Claims 1-5 are rejected as being obvious under 35 U.S.C. § 103 over Jones in view of Winslow. The Jones patent issued in 1990, and the Winslow patent issued in 1989. In the application filed on July 2, 1992, Claims 1-5 were rejected under 35 U.S.C. § 103 over Jones in view of Winslow on the same rationale, and the same claimed subject matter was in Claims 1-5 in the application and patent.
- (B) Claims 1-5 are rejected as being anticipated under 35 U.S.C. § 102 (b) over Jiles, a British patent specification published on April 16, 1991. Claims 1-5 are drawn to irradiating a broad genus of "fungus material" first disclosed in the application filed July 2, 1992. The Smith application filed on July 2, 1992, was a continuation-in-part application of an application filed on March 21, 1990, and claims the benefit of the filing date of the application filed on March 21, 1990. The application filed on March 21, 1990, did not disclose or support treating a broad genus of "fungus material," but disclosed irradiating only a fungus species.
- (C) Claims 1-5 are rejected as being anticipated under 35 U.S.C. § 102 (b) over Janes, a British trade journal published on April 16, 1991. Claims 1-5 are drawn to electrolytically etching a metal. The British trade journal describes a species with the broad scope of Claims 1-5. The rejection can be overcome by antedating the reference by filing Smith's declaration under 37 CFR § 1.131 showing that Smith reduced the claimed invention to practice prior to April 16, 1991 in the United States.
- (D) Claims 1-5 are rejected as constituting obviousness type double patenting with Claims 6 and 7 of the U.S. patent to Johns, which issued on August 5, 1997. Claims 1-5 in the Smith patent have not been amended as of the date of the rejection. The U.S. patent to Johns formed the basis of a provisional obviousness type double patenting rejection during the initial prosecution of the Smith application.
- (E) Claims 1-5 are rejected under 35 U.S.C. § 102(f) over an unpublished transcript of testimony given by Smith. The testimony clearly establishes that Smith is not the inventor of the subject matter of Claims 1-5. Smith neither suggested the claimed subject matter, nor participated in any manner in the reduction to practice of the invention. Smith merely funded the research by Jones, who conceived and invented the claimed subject matter.

41. In regard to the Jones application, a complete Office action dated January 20, 1998, and setting a three month shortened statutory period for reply was mailed to the office of the attorney of record. The Office action contains rejections under 35 U.S.C. §§ 112 and 102. Considering separately the following different circumstances regarding the Office action, which course of action by the attorney complies with proper PTO practice and procedure and will correct the problem?

- (A) The Office action is in an envelope postmarked January 20, 1998, and was received in the attorney's office on Friday, January 30, 1998, due to delays in the U.S. Postal Service. The attorney should file and the PTO should grant a petition to restart the previously set reply period to run from the date of receipt of the Office action if the petition is filed on or before Friday, February 13, 1998, and the petition includes evidence showing the date of receipt, and the attorney's statement setting forth the date of receipt.
- (B) The Office action is in an envelope postmarked January 22, 1998, and was received in the attorney's office on Friday, January 30, 1998. The attorney should file and the PTO should grant a petition to restart the previously set reply period to run from the date of receipt of the Office action if the petition is filed on or before Friday, February 13, 1998, and the petition includes evidence showing the address on the Office action, a copy of the envelope which contained the Office action showing the postmark date, and the attorney's statement setting forth the date the Office action was received at the attorney's office and that the Office action was received in the postmarked envelope.
- (C) The Office action is in an envelope postmarked January 22, 1998, and was received in the attorney's office on Friday, January 30, 1998. The attorney should file and the PTO should grant a petition to restart the previously set reply period to run from the postmark date on the envelope if the petition is filed on April 30, 1998, with a reply to the Office action, and the petition includes evidence showing the address on the Office action, a copy of the envelope which contained the Office action showing the postmark date, and the attorney's statement setting forth the date the Office action was received at the attorney's office and that the Office action was received in the postmarked envelope.
- (D) A Notice of Abandonment dated August 19, 1998, is received in the attorney's office. The attorney should file and the PTO should grant a petition to revive the application as unavoidably abandoned where the petition is filed on September 24, 1998, contains the attorney's statement that the Office action was not received by the attorney, and is accompanied by the appropriate petition fee and a proposed reply is not included.
- (E) None of the above.

42. Which of the following, published before the effective filing date of an application, is not an enabling prior art reference when used as anticipatory prior art under 35 U.S.C. § 102?

- (A) A picture of a chair in a magazine. The magazine is published monthly in England. The picture shows all of the structural features recited in the application claims, and how they are put together.
- (B) Disclosure in a magazine article of the compound claimed in the application wherein only the compound is claimed. The magazine is published monthly in the United States. The article discloses a manner of making the compound which differs from the manner disclosed in the application. No utility for the compound is disclosed in the article.
- (C) Disclosure in a magazine article of a liquid named "Rejuvenator Juice." The magazine is published monthly in the United States. The article discloses that the liquid restores youth when ingested. The article does not disclose the composition or manner of making the liquid. The application has claims directed to a liquid composition which is described in the specification as restoring youth when ingested.
- (D) The drawings in a U.S. design patent disclose all the structural features recited in the claims of the application. The drawings also show how the features are combined.
- (E) Disclosure of a table in a magazine published in the United States. The disclosure, including a picture, describes and shows how all of the claimed features are united in the table.

43. Five different situations are presented below wherein the attorney of record calls an error to the attention of the examiner. Which request (or lack of request) by the attorney, and reply by the examiner is not in accord with proper PTO practice and procedure?

- (A) An Office action dated February 11, 1998, and setting a three month shortened statutory period for reply was accompanied by a citation of references wherein a prior art patent was identified with an incorrect patent number. The attorney of record, on April 6, 1998, called the error to the attention of the examiner and requested that the examiner restart the reply period. The attorney should receive from the examiner a new citation of references correcting the error, a copy of the Office action redated, and a communication restarting the three month shortened statutory period for reply to run from the date the error is corrected.
- (B) A page of rejections is omitted from an Office action dated April 21, 1998, which set a three month shortened statutory period for reply. The attorney of record, on May 25, 1998, called the error to the attention of the examiner and requested that the examiner set a new reply period. The attorney should receive from the examiner a complete, redated Office action setting a three month shortened statutory period for reply to run from the date the error is corrected.
- (C) A copy of a patent reference is omitted from an Office action dated April 21, 1998,

which set a three month shortened statutory period for reply. The attorney of record, on May 25, 1998, called the error to the attention of the examiner and requested that the reply period be reset. The attorney should receive from the examiner a copy of the omitted patent reference, and a communication resetting the reply period to be a two month shortened statutory period running from the date the error is corrected.

- (D) A copy of a patent reference was omitted from an Office action dated April 16, 1998, which set a three month shortened statutory period for reply. The attorney of record, on May 19, 1998, called the error to the attention of the examiner, but did not request that the examiner set a new reply period. The attorney should receive from the examiner a copy of the omitted patent reference with a letter noting that the time period set for reply remains as set forth in the Office action dated April 16, 1998.
- (E) A copy of a patent reference was omitted from an Office action dated March 9, 1998, which set a three month shortened statutory period for reply. The attorney of record, on July 14, 1998, called the error to the attention of the examiner and requested that the reply period be reset. The attorney should receive from the examiner a copy of the omitted patent reference with a letter noting that the time period set for reply remains as set forth in the Office action dated March 9, 1998.

44. Your client, the Happy Co., has come to you and requested that you file an international application under the Patent Cooperation Treaty (PCT) which designates Canada, Mexico, and the European Patent Office. Since today, August 26, 1998, is the last day of the Paris Convention priority year, you are rushing to prepare an application which will be granted an international filing date. Given the following elements, which combination is necessary to have an international filing date granted?

- I. The designation of at least one PCT contracting state.
- II. The payment of the international fee.
- III. A part of the application which appears to be a claim.
- IV. The name(s) of the inventor(s).
- V. An application in a language prescribed by the receiving office.

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

45. The practitioner filed a patent application for inventor Jones on February 7, 1996. An Office action dated September 10, 1997, was a second action, final rejection of all the claims in the Jones application, and set a three month shortened statutory period for reply. On March 4, 1998, the practitioner filed a reply, containing an amendment and arguments which the practitioner and Jones believed would place the application in condition for allowance, a request for a three month extension of time, and the appropriate extension of time fee. In the ensuing different factual scenarios presented below, which course of action by the practitioner is in accord with proper PTO practice and procedure?

- (A) The practitioner did not file a notice of appeal and appeal fee on or before March 10, 1998. An Advisory action dated March 24, 1998, informed the practitioner that the amendment was not entered, and a Notice of Abandonment dated April 11, 1998, informed the practitioner that the application was abandoned. Thereafter, the practitioner should file, on or before Monday, July 13, 1998, a petition to revive the application as unintentionally abandoned, together with the appropriate petition fee, a notice of appeal and appeal fee, and a statement that the entire delay in filing the notice of appeal and fee from the due date for the reply until the filing of a grantable petition was unintentional.
- (B) The practitioner did not file a notice of appeal and appeal fee on or before March 10, 1998. An Advisory action dated March 24, 1998, informed the practitioner that the amendment was not entered. A Notice of Abandonment dated April 11, 1998, informed the practitioner that the application was abandoned. Thereafter, the practitioner should file, on or before Monday, July 13, 1998, a petition to revive the application as unavoidably abandoned, together with the appropriate petition fee, a notice of appeal and appeal fee, and a statement that the entire delay in filing the notice of appeal and fee from the due date for the reply until the filing of a grantable petition was unavoidable since it was believed that the reply placed the case in condition for allowance, and notice to the contrary was not given until after expiration of the reply period and any available extension thereof.
- (C) The practitioner did not receive a Notice of Allowance and Issue Fee Due dated March 24, 1998, mailed to him. However, the practitioner did receive a Notice of Abandonment dated July 11, 1998, informing him of the application's abandonment for nonpayment of the issue fee. Thereafter, the practitioner should file, on or before October 11, 1998, a petition to revive the application as unavoidably abandoned, together with the appropriate petition fee, a continuing application, and a statement that the entire delay in filing the continuing application from the due date for filing an issue fee until the filing of a grantable petition was unavoidable.
- (D) The practitioner, after receiving a Notice of Allowance and Issue Fee Due dated March 24, 1998, was informed by Jones not to pay the issue fee until the industry or a competitor showed interest in the invention. The practitioner received a Notice of Abandonment dated July 11, 1998, advising of the application's abandonment for nonpayment of the issue fee. Jones advised the practitioner on

August 24, 1998, that such interest was expressed to Jones on the preceding day. Thereafter, the practitioner should file, on or before Monday, November 9, 1998, a petition to revive the application as unavoidably abandoned, together with the appropriate petition fee, and issue fee, and a statement that the entire delay in filing the issue fee from the due date for the fee until the filing of a grantable petition was unavoidable.

- (E) All of the above.

46. John Doe, an employee of the National Radio Company (NRC), while serving his two week summer reserve duty obligation with the U.S. Air Force, and while working in the research labs at Wright-Patterson Air Force Base, jointly with Jane Roe, an Air Force civil service employee, conceived and actually reduced to practice a unique transponder. As patent counsel for the Air Force, you reviewed the submitted invention disclosure and prepared a patent application therefrom naming John Doe as sole inventor. You then had John Doe execute an assignment to the Air Force as well as the necessary oath, petition, and power of attorney naming you attorney of record, and filed the complete application and assignment with the PTO. In the course of prosecution, the examiner issued an Office action provisionally rejecting all the claims in the application as unpatentable under 35 U.S.C. §§ 102(e)/103 based on a copending application assigned to the Air Force. Which of the following actions, if taken by you, would not accord with proper PTO practice and procedure?

- (A) File a reply to the Office action traversing the rejection accompanied by an assignment executed by John Doe to the Air Force along with (1) a petition for correction of inventorship including a statement of facts verified by John Doe establishing when the error without deceptive intention was discovered and how it occurred, (2) an oath or declaration by John Doe and Jane Roe, and (3) the appropriate fee.
- (B) File a reply to the Office action traversing the rejection accompanied by an assignment executed by John Doe to the Air Force along with an affidavit of common ownership of the two inventions claimed in the copending applications signed by you.
- (C) File a reply to the Office action traversing the rejection accompanied by an assignment executed by John Doe to the Air Force along with a certificate of mailing under 37 CFR § 1.8.
- (D) (A) and (B)
- (E) (B) and (C)

47. Smith, an electrical engineer working as an independent contractor, entered into a contract to install an emergency generator at the research facilities of the Wesson Cellular Phone Company. The contract contained no patent rights clause. While so employed, Smith had an opportunity to observe the research work being done and to chat with the Wesson research staff. Smith soon developed an interest in the research work being done, and realized that he could improve on the operation of the Wesson cellular phone. Soon afterwards, Smith designed a unique link scanning switching control mechanism which significantly improved the operation of the Wesson cellular phone. Wesson quickly recognized the importance of using Smith's invention in its business, and retained the services of Mr. I. M. Goody, a registered patent agent who is not an attorney. Which of the following actions by Mr. Goody would (1) best serve his client's business interests, (2) accord with proper PTO practice and procedure, and (3) be consistent with the PTO Code of Professional Responsibility?

- (A) Negotiate with Mr. Smith for an assignment of his invention to Wesson, draft an assignment agreement and have the same executed by Smith and Wesson, and record the original executed assignment with the assignment branch of the PTO.
- (B) Negotiate with Mr. Smith for an assignment and disclosure of his invention to Wesson, draft an assignment agreement and a patent application on the Smith invention, have both the assignment agreement and a combined oath, and power of attorney for the patent application executed by Smith, and file the documents with the PTO accompanied by the appropriate fees.
- (C) Request that Wesson obtain an assignment or license of the Smith invention and thereafter prepare a patent application on the Smith invention and file the same in the PTO in the name of Smith as sole inventor.
- (D) Negotiate with Mr. Smith to license his invention to Wesson, draft the license agreement and have same executed by Smith and Wesson, and record the original executed assignment with the assignment branch of the PTO.
- (E) Advise Wesson that it may use the Smith invention in its business because the circumstances giving rise to the invention give it a "shop right."

48. Jack loved to tinker with electrical gadgets in his youth, but adulthood and the responsibilities of a job and a family forced him to spend his time with other pursuits. Retirement, however, opened the door to renew his passion for tinkering, and soon he began to spend so much time at his pastime that he developed a reputation as an eccentric among his friends and neighbors. One day, while Jack was tinkering in his homemade shop and his wife, Jill, was entertaining relatives, Bruce, a visiting relative and a registered patent attorney, wandered into Jack's shop, and soon became entranced with one of the gadgets that Jack had invented. Bruce informed Jack that his invention appeared to be patentable and that he, Bruce, would be delighted to obtain patent protection for Jack for no more than the expenses involved, and that he, Bruce, could probably arrange to market the invention for little more than the effort involved in making a few phone calls. After very little persuasion, Jack retained Bruce to patent the invention, insisting, however, that he be permitted to review the final draft of the application, that he be consulted at every step of the prosecution, and that no prosecution decision be made without his concurrence. Bruce agreed, and thereupon prepared and filed a patent application naming Jack as sole inventor. Subsequently, Bruce succeeded in negotiating the sale of Jack's entire interest in the invention to the Star Financial Group, which in turn conveyed an exclusive license in the invention to the Omega Electrical Corporation. Both the assignment to Star and the license to Omega were properly executed and recorded in the PTO. According to proper PTO practice and procedure, which of the following statements is true?

- (A) Omega may intervene in the prosecution of Jack's patent application and appoint a patent attorney other than Bruce without Jack's consent.
- (B) Omega may intervene in the prosecution of Jack's patent application and appoint a patent attorney other than Bruce, and specifically request that Jack be excluded from access to his patent application file.
- (C) Star may intervene in the prosecution of Jack's patent application and appoint a patent attorney other than Bruce, and specifically request that Jack be excluded from access to his patent application file.
- (D) Omega may intervene in the prosecution of Jack's patent application and appoint a patent attorney other than Bruce, and specifically request that Jack be excluded from access to his patent application file, but Jack may be permitted to inspect the file on sufficient showing why the inspection is necessary to conserve his rights.
- (E) Star may intervene in the prosecution of Jack's patent application and appoint a patent attorney other than Bruce, and specifically request that Omega be excluded from access to his patent application file.

49. An international application under the Patent Cooperation Treaty (PCT), which designated the United States, was filed on January 3, 1995. The application claimed priority of a prior French national application filed on February 7, 1994. A copy of the international application was communicated to the United States as a designated office on August 19, 1995. A demand for international preliminary examination, in which the United States was elected, was filed on September 5, 1995. Accordingly, the thirty month period of PCT Article 39(1)(a) expired at midnight on August 7, 1996. The applicant submitted the basic national fee to enter the United States national stage on August 2, 1996. On October 2, 1996, the applicant timely submitted a translation of the international application and a declaration of the inventors in compliance with PCT regulations in response to a Notice of Missing Requirements. Also, on October 8, 1996, the applicant timely submitted a translation of amendments under Article 19 of the PCT in response to the Notice of Missing Requirements. On October 30, 1996, a Notice of Acceptance was mailed to the applicant. The national stage application issued as a U.S. patent on December 6, 1997. What is the effective date of the U.S. patent as a reference under 35 U.S.C. 102(e)?

- (A) January 3, 1995
- (B) August 7, 1996
- (C) October 2, 1996
- (D) October 8, 1996
- (E) December 6, 1997

50. Which of the following is not a requirement of 35 U.S.C. § 102(d) to bar the granting of a patent in this country?

- (A) The foreign application must have been filed more than 12 months before the effective filing of the application in the United States.
- (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 have been published prior to the date of the application for patent in the United States.
- (E) The same invention must be involved.

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

AUGUST 26, 1998

Afternoon Section (100 Points)

Time: 3 Hours

DIRECTIONS

This section 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 section 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 (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 section of the examination consists of fifty (50) multiple choice questions, each worth two (2) points. Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

You may write anywhere on this examination booklet. However, do not remove any pages from the booklet. Only answers recorded in SECTION 1 of your Answer Sheet will be graded. YOU MUST SCORE AT LEAST 70 POINTS TO PASS THIS SECTION OF THE REGISTRATION EXAMINATION.

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO

1. Dr. John Doe, an electrical engineer, was employed by the General Automotive Company, (GAC), to do research on ignition distribution systems for internal combustion engines. In the course of such research, Dr. Doe took a number of samples of rigid metallic manifold casings, and filled them with a variety of yieldable, non-moldable unitary solids having various dielectric properties. After testing many materials including the reaction products of polymerized walnut-shell oil and formaldehyde, and comparing their radio shielding properties, none of which worked, Dr. Doe concentrated his research on what theoretically appeared to be the most promising materials, specifically, the reaction products of polymerized nut-shell oil and formaldehyde. Included in Dr. Doe's subsequent tests were the polymerized oils from the shells of walnuts, peanuts, chestnuts, almonds, and cashews only. In the case of the cashews, Dr. Doe discovered that the dielectric property of the resulting reaction products were such that when utilized in harnesses designed for ignition distribution systems of internal combustion engines the radio shielding property proved outstanding. As patent counsel for GAC, you prepared and filed in the PTO a patent application disclosing the results of Dr. Doe's research including his test data. The application as filed includes a single claim which begins with the following language:

A radio-shielding harness for the ignition distribution system of an internal combustion engine, comprising a rigid metallic manifold casing for enclosing and shielding a plurality of ignition conductors, and

Which of the following phrases, each of which is described by the specification, when added to the end of the recited claim language is least likely to be rejected under 35 U.S.C. § 112?

- (A) a solid yieldable dielectric material consisting of polymerized nutshell oil substantially filling said casing around said conductors, said material being in a non-moldable state and capable of holding said conductors against movement relative to each other and to the casing.
- (B) a solid yieldable dielectric material consisting of the reaction products of polymerized nut-shell oil and formaldehyde substantially filling said casing around said conductors, said oil selected from the group comprising shells of walnuts, peanuts, chestnuts, almonds, and cashews, and said material being in a non-moldable state and capable of holding said conductors against movement relative to each other and to the casing.
- (C) a solid yieldable dielectric material consisting of the reaction products of polymerized nut-shell oil and formaldehyde substantially filling said casing around said conductors, said oil selected from the group consisting of shells of walnuts, peanuts, chestnuts, almonds, and cashews, and said material being in a non-moldable state and capable of holding said conductors against movement relative to each other and to the casing.
- (D) a solid yieldable dielectric material consisting of the reaction products of polymerized cashew-shell oil and formaldehyde substantially filling said casing around said conductors, said material being in a non-moldable state and capable of holding said conductors against movement relative to each other and to the casing.

- (E) a solid yieldable dielectric material selected from the group comprising the reaction products of polymerized chestnut-shell oil and formaldehyde substantially filling said casing around said conductors, said material being in a non-moldable state and capable of holding said conductors against movement relative to each other and to the casing.

2. Your client has invented a miniature vacuum tube comprising a capacitor having a capacitance of 0.003 to 0.012 μf , preferably 0.006 μf . You draft a patent application directed to your client's invention and satisfying the requirements of 35 U.S.C. § 112. You draft the following independent claim:

1. A miniature vacuum tube comprising a capacitor having a capacitance of 0.003 to 0.012 μf .

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

- (A) 2. The miniature vacuum tube of Claim 1 wherein the capacitor has a capacitance of 0.006 μf .
(B) 2. A miniature vacuum tube as in Claim 1 wherein the capacitor has a capacitance of 0.006 to 0.012 μf .
(C) 2. A miniature vacuum tube as in Claim 1 wherein the capacitor has a capacitance of about 0.003 to 0.011 μf .
(D) 2. The miniature vacuum tube of Claim 1 wherein the capacitor has a capacitance of between 0.005 and 0.012 μf .
(E) (C) and (D)

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

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

4. Star Chemical Corporation retains you to obtain patent protection for their invention relating to improved production of ethylene oxide. You prepare and file a patent application in the PTO having a specification satisfying the requirements of 35 U.S.C. § 112 and the following two claims, which are fully supported by the specification:

1. A process for preparing a silver-supported catalyst for the improved production of ethylene oxide, said process comprising the steps of:

- (a) forming an aqueous solution of silver salt;
- (b) immersing completely in said solution a carrier of inert, porous particles, characterized by an average diameter not larger than 3/16 inch, an average pore diameter of 10 to 70 microns, and a surface area less than one square meter per gram;
- (c) impregnating said particles with said solution;
- (d) separating the impregnated particles from the remainder of said solution;
- (e) drying the separated particles, whereby said silver salt is deposited uniformly throughout the pores of said particles; and
- (f) activating the dried particles by heating them in air at a temperature sufficient to decompose the deposited silver salt.

2. An oxygen-activated catalyst for use in the controlled catalytic oxidation of ethylene to ethylene oxide, said catalyst comprising 5 to 25% by weight of silver, said silver being the thermal decomposition product of a pore solution-deposited silver salt uniformly distributed throughout the pores of inert, porous particles.

Claim 1 is rejected in the first Office Action under 35 U.S.C. § 103 as unpatentable over Able in view of Baker. Claim 2 is rejected under 35 U.S.C. § 103 as unpatentable over Baker. Able discloses a process for producing a catalyst for oxidation of ethylene to ethylene oxide by impregnating a porous carrier with a solution of a silver salt of an organic acid, separating the excess liquid, drying the impregnated carrier, and decomposing the silver salt by direct heat in an inert gas. Baker discloses a method of making an oxygen activated catalyst by coating a carrier with a silver catalyst using a paste or slurry. The silver compound paste is coated on the support, dried and then activated by treating the catalyst in large trays for several hours in a forced draft hot air oven at about 400°C. Baker discloses the physical characteristics of the oxygen-activated catalyst. The physical characteristics of the claimed catalyst are indistinguishable from Baker's catalyst.

Which of the following represents the best course of action to overcome the rejection and obtain a Notice of Allowance in the application?

- (A) Cancel Claim 1 and argue that the inventive catalyst has both high selectivity, i.e., a measure of the ability of a catalyst to prefer the partial oxidation reaction of ethylene over the total oxidation reaction of ethylene to carbon dioxide, and high productivity, i.e., a measure of the amount of ethylene oxide produced per unit of catalyst and per unit of time.
- (B) Cancel Claim 2 and argue that the combination of references is improper because it would not have been obvious to one of ordinary skill in the art to substitute the activation step of Baker for the activation step of Able.
- (C) Amend Claim 1 to recite that an oxidizing agent is added to the solution to prevent premature reduction of the silver salt.
- (D) Cancel Claim 1 and amend Claim 2 to recite that the inert, porous particles contain silica-alumina, and argue that such recitation is not disclosed by the references.
- (E) Cancel Claim 1 and argue that the combination of references is improper because it would not have been obvious to one of ordinary skill in the art to substitute the activation step of Baker for the activation step of Able.

5. X invented a laminate containing a transparent protective layer and a light-sensitive layer, without an intermediate layer. The prior art included a laminate containing a transparent protective layer and a light-sensitive layer held together by an intermediate adhesive layer. Which of the following is a proper claim that would overcome a 35 USC § 102 rejection based on the prior art?

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

6. Egghead filed a patent application on subject matter pertaining to a method of producing a completely hardened metal structural element, such as a roller bearing race. The invention is directed to separating one bearing race from another in the production process. The specification discloses that the method consists essentially of the steps of (1) subjecting the surface of the element along an intended course of fracture to direct high energy radiation, such as a laser beam, to selectively embrittle the metal, and (2) then splitting the element along the intended course of fracture, e.g., by a chilling process, such as quenching, or putting the surface subjected to radiation under tensile stress by applying a force to the structural element to generate the fracture, thereby forming separate bearing races. The specification does not include a definition of the language "completely hardened metal structural element," and notes that the surface of the structural element may be provided with a groove along at least a portion of the intended course of the fracture, but that the groove is not provided to influence the course of the fracture, and hence, in contrast to known methods, it is unnecessary to form the groove as a sharp-edged notch.

In the course of prosecution, the examiner issued an Office Action rejecting claims 6 and 10, the remaining claims in the case, as anticipated by Highbrow under 35 U.S.C. § 102(b). The Highbrow patent teaches a method of producing a metal structural element by irradiating the surface of such element with high energy radiation along an intended course of fracture which has been provided with a sharp-edged notch, and then splitting the element along the intended course of fracture by quenching.

The claims are as follows:

6. A method of fracturing a completely hardened metal structural element, said method consisting essentially of subjecting the surface of the completely hardened structural element at least along a portion of an intended course of fracture and in transverse limitation thereto to a high energy radiation to selectively embrittle the metal, and then splitting the element along the intended course of fracture by a chilling process.

10. The method of Claim 6 comprising providing the surface of the completely hardened metal structural element along at least a portion of the intended course of fracture with a groove, and subjecting said element to said high energy radiation.

Which of the following actions should Egghead take that accords with proper PTO practice and procedure and stands the best chance of overcoming the examiner's rejection?

- (A) Traverse the rejection and argue that Highbrow does not teach the application of "direct" high energy radiation as taught by Egghead.
- (B) Traverse the rejection and argue that the language "consisting essentially of" recited in Claim 6 excludes the "notching" step taught by Highbrow.

- (C) Amend Claim 6 by deleting the language "by a chilling process" at the end of the claim and traverse the rejection by arguing that Claim 6 no longer reads on Highbrow's "quenching" step.
- (D) Traverse the rejection and argue that the language "a completely hardened metal structural element" recited in Claim 6 would be interpreted by one of ordinary skill in the art as defining a metal element which is completely crystalline throughout its structure and that the metal element disclosed by Highbrow does not possess this crystalline structure.
- (E) Amend Claim 6 by deleting the language "a chilling process" of the claim and, after "fracture by" in line 5, inserting the language "putting the surface subjected to radiation under tensile stress by applying a force to the structural element to generate the fracture." Traverse the rejection on the ground that Highbrow does not teach this step and that his quenching step is not equivalent thereto.

7. Inventor Jones received a patent that, through error and without deceptive intent, failed to describe an embodiment of her invention. Eighteen months after the patent was issued, you filed a complete reissue application adding a claim directed to the omitted embodiment, together with Jones' declaration explaining the error, and the other required papers. In accordance with PTO practice and procedure,

- (A) The claim is subject to a rejection under 35 U.S.C. § 132.
- (B) The specification is subject to an objection as failing to provide proper antecedent basis for the claimed subject matter and require correction.
- (C) The claim is subject to a rejection under 35 U.S.C. § 251 and a rejection under 35 U.S.C. § 112, first paragraph.
- (D) The claim is allowable.
- (E) (B) and (D).

8. A patent application describes an improved cat litter tray, preferably rectangular in shape, and includes drawings depicting such a tray having a major axis and a minor axis and adapted to hold a layer of cat litter. The specification describes and the drawings depict a removable igloo-like cover mated with at least two sides of the tray in a friction fit manner and containing an opening at each end of the cover parallel to the minor axis of the tray adapted for ingress and egress of a cat. The essential feature described in the specification and depicted in the drawings resided in a screen, pivotally affixed to opposing sides of the tray parallel to the major axis of the tray at points above the cat litter. In operation, as described in the specification, a cat would enter the device through one of the openings in the igloo-like cover stepping upon the screen, preferably wire mesh. The weight of the cat would cause the screen to pivot downward until it contacted the layer of cat litter. Following urination, the cat would egress from the device through a cover opening, the urine having passed through the wire mesh screen to be absorbed by the cat litter, and the cat having egressed without carrying any litter to be tracked into the surrounding area. During the day, ingress and egress from the opposing cover openings would result in the pivotally affixed wire mesh screen being subjected to a see-saw action, essential to break up and disintegrate dried fecal matter, thus permitting the matter to pass through the screen to the litter below. Reference numerals assigned to the elements and shown in the drawings were as follows: tray 10, screen 15, cover 20

Which of the following claim phrases accord(s) with PTO practice and procedure regarding the form of claims?

- (A) An improved cat litter tray comprising a tray 10, a screen 15, a cover 20
- (B) An improved cat litter tray comprising a tray (10), a screen (15), a cover (20)
- (C) An improved cat litter tray comprising a tray, a screen, a cover, ...
- (D) A and B
- (E) B and C

9. In the course of prosecuting a patent application before the PTO, you receive a non-final Office action allowing Claim 1, and rejecting Claims 2 through 6, the remaining claims in the case.

Claim 1 reads as follows:

1. A ship propeller exhibiting excellent corrosion resistance, said ship propeller consisting essentially of a copper base alloy consisting of 2 to 10 percent tin, 0.1 to 0.9 percent zinc, and copper.

The specification of the application teaches that the copper base alloy made with the addition of 2 to 10 percent aluminum increases the alloy's wear resistance without detracting from its corrosion resistance. However, adding aluminum to the surface of the propeller does not increase wear resistance. Which of the following claims, if any, if added by amendment would accord with proper PTO practice and procedure?

- (A) 7. A copper base alloy according to Claim 1 wherein said alloy includes 2 to 10 percent aluminum.
- (B) 7. A ship propeller according to Claim 1 including the step of adding 2 to 10 percent aluminum to the copper base alloy.
- (C) 7. A ship propeller according to Claim 1 including 2 to 10 percent aluminum.
- (D) 7. A ship propeller according to Claim 1 wherein said alloy includes 2 to 10 percent aluminum.
- (E) None of the above.

10. Applicant claims the following container lid combination:

- 1. A dispensing top for passing only several candy pieces at a time from an open ended container filled with candy, having a generally conical shape and an opening at each end, the opening at the reduced end allows several pieces of candy to pass through at the same time, and means at the enlarged end of the top embrace the open end of the container, the taper of the top being such that only a few pieces of candy are dispensed when the top is mounted on the container and the container is turned over.

The prior art reference X teaches a conically shaped funnel that can be secured on top of a can containing motor oil, such that the contents are dispensed when the can is turned on its side. X also mentions that it can be used for solid materials. The claim was rejected as anticipated by X under 35 U.S.C. § 102. Which of the following replies to the rejection would be most likely to result in issuance of Claim 1?

- (A) Traversing the rejection on the ground that X is nonanalogous art, and therefore cannot be used for anticipation purposes against Claim 1.
- (B) Traversing the rejection on the ground that X does not specifically teach dispensing of candy pieces like Claim 1.
- (C) Amending Claim 1 to add specific limitations to the dimensions of the dispensing top.
- (D) All of the above.
- (E) None of the above.

11. While researching heart disease, Dr. Able developed a process for preparing compounds which exert "strongly saluretic [sodium expelling] and diuretic [water expelling] effects." Dr. Able found that these compounds were useful also in the treatment of heart conditions and hypertension. Dr. Able's compounds are substituted dihydrobenzothiadiazines having an "R" group at position 3 of the benzothiadiazine nucleus wherein R is selected from the group consisting of phenyl, benzyl, and phenethyl. You prepare a patent application on Dr. Able's invention and file the application in the PTO on August 5, 1996. The sole original claim is as follows:

A substituted dihydrobenzothiadiazine compound wherein the only variable is an "R" group at position 3 of the benzothiadiazine nucleus, said "R" group being selected from the group consisting of phenyl, benzyl, and phenethyl, and said compound exerting strong saluretic and diuretic effects and being useful in the treatment of heart conditions and hypertension.

In the first Office action, the claim is rejected under 35 U.S.C. § 102(e) as unpatentable over the Baker patent, which issued June 25, 1998 on an application filed May 13, 1996. The Baker specification states that it is "a continuation-in-part application of my application Serial No. 123,456, filed September 29, 1995 (now abandoned)." The Baker patent relates to processes for preparing compounds having a generic formula which includes within its scope substituted dihydrobenzothiadiazine compounds, and a list of appropriate substituents disclosed by the Baker patent includes the compounds of Dr. Able's claim. One of the processes disclosed by Baker in the patent and in application '456 for preparing the compounds is identical to Dr. Able's process in all material respects. The '456 application discloses several closely related processes for preparing compounds having a generic formula identical to that disclosed in the issued patent. But the '456 application contained an even broader disclosure. Comparison of the generic disclosure and the nature of the substituents on the benzothiadiazine nucleus as disclosed in the Baker patent and the '456 application reveals that they both disclose the "R" group as including hydrogen, trifluoromethyl, benzyl, or phenethyl. In rejecting Dr. Able's claim, the examiner placed emphasis on Example 2 of the '456 application, particularly, the last paragraph, which stated that other reagents may be used in the preparation process employed in Example 2, and identified specific reagents, which if used would result in each of the compounds of Dr. Able's claim, i.e., compounds wherein the "R" group was phenyl, benzyl, or phenethyl. In reply to the Office action, you file an amendment limiting the variable of Dr. Able's claim to one of the following "R" groups. Which one is most likely to overcome the rejection?

- (A) phenyl
- (B) benzyl
- (C) phenethyl
- (D) trifluoromethyl
- (E) None of the above

12. Jones, a graduate student at ABC University, while engaged in a research project funded by a grant from a Fortune 500 company, conceived an invention for creating a smooth waveform display in a digital oscilloscope. After building and successfully testing the invention, Jones, pursuant to the grant instrument, assigned the invention rights to the Fortune 500 company. As patent counsel for the company, you prepared and filed a patent application directed to the invention. The application contains the following claim which is the sole claim in the application:

A rasterizer for converting vector list data representing sample magnitudes of an input waveform into anti-aliased pixel illumination intensity data to be displayed on a display means comprising:

- (a) means for determining the vertical distance between the endpoints of each of the vectors in the data list;
- (b) means for determining the elevation of a row of pixels spanned by the vector;
- (c) means for normalizing the vertical distance and elevation; and
- (d) means for outputting illumination intensity data as a predetermined function of the normalized vertical distance and elevation.

The specification in the application describes specific structure corresponding to each of the means for performing a specified function recited in the claim.

Which of the following statements best characterizes the claim?

- (A) The claim reads on a digital computer means to perform the various steps under program control. Thus, it is proper to treat the claim as if it is drawn to a method.
- (B) The claim as a whole is directed to a mathematical algorithm.
- (C) The claim is directed to nonstatutory subject matter because during examination the means clauses are given their broadest interpretation and limitations in the specification are not imputed into the claim.
- (D) The claim as a whole is directed to a machine.
- (E) The claim is directed to nonstatutory subject matter because it is written completely using means clauses which are read broadly in the PTO to encompass each and every means for performing the recited functions. Thus, the claim is a process claim wherein each means clause represents a step reciting a mathematical operation, which steps combine to form a mathematical algorithm for computing pixel information. When the claim is viewed without the steps of this mathematical algorithm, no other elements or steps are found.

13. A's patent specification discloses a personal computer comprising a microprocessor and a random access memory. There is no disclosure on the specification of a minimum amount of storage for the random access memory. In the preferred embodiment the microprocessor has a clock speed of 100-200 megahertz. The application originally included the following Claims 11 and 12 (among others), and Claim 13 was added by amendment after an office action:

11. A personal computer comprising a microprocessor and a random access memory including at least ½ gigabyte of storage.

12. The personal computer of Claim 11, in which the microprocessor has a clock speed of 170-200 megahertz.

13. The personal computer of Claim 12, in which the random access memory is greater than 1 gigabyte of storage.

Which of the following statements is or are true about the claims with respect to 35 U.S.C. § 112, fourth paragraph?

- (A) Claim 11 is a proper independent claim.
- (B) Claim 12 is a proper dependent claim.
- (C) Claim 13 is a proper dependent claim.
- (D) Claim 13 is an improper dependent claim.
- (E) (A), (B), and (C).

14. X received a patent on a satellite communications system, and has engaged you to advise her on seeking reissue with the following amended Claim 1:

1. A low orbit satellite communications system [for mobile terminals], wherein the communications antenna system of each satellite provides isoflux coverage made up of a plurality of [elongated] fan beams that are elongated in the travel direction of the satellite.

The amended claim is supported by the original disclosure in X's patent. X is concerned about the applicability of reference A. During the original prosecution, the examiner rejected original Claim 1 as anticipated by A, but then the examiner changed her mind and allowed original Claim 1 over A. X is concerned that infringers of the patent will contend, as a defense to patent infringement, that original Claim 1 is in fact anticipated by A. X is also concerned that amended Claim 1, above, also is arguably anticipated by A.

Which of the following statements is (are) true?

- (A) X may properly present amended Claim 1 in a reissue application filed at any time during the patent term.
- (B) As long as X files her reissue application within two years of the issuance of X's patent, X may properly present amended Claim 1 at any time during the prosecution of the reissue application or any continued prosecution applications arising from the reissue application, and no intent to broaden the claims was indicated in the oath or declaration within the two year period.
- (C) As long as X files her reissue application within two years of the issuance of X's patent, X may properly present amended Claim 1 at any time during the prosecution of the reissue application, but X may not properly present amended Claim 1 for the first time in a continued prosecution application arising from the reissue application unless X also filed that application within two years of the issuance of X's patent, and no intent to broaden the claims was indicated in the oath or declaration within the two year period.
- (D) Since the examiner considered reference A during the original prosecution of X's patent, but then allowed Claim 1, the examiner cannot apply reference A during the reissue proceeding to reject any claim that is narrower than original Claim 1.
- (E) None of the above.

15. You have filed a complete plant patent application claiming a distinct and new plant variety, and claiming a method for obtaining the plant variety. Which, if any, of the following statements are false?

- (A) You may not amend the application to add additional description of the plant variety not contained in the original application, even if consistent and related to the original description and photograph of the plant.
- (B) The examiner may properly require you to deposit an adequate sample of the plant variety with an acceptable depository, and reject the claims under 35 U.S.C. § 112 pending the deposit.
- (C) The examiner may properly require you to elect which of the claims you want examined for ultimate issuance as the single claim to which you are entitled.
- (D) All of the above.
- (E) None of the above.

16. An original claim in a patent application to a mechanical arts invention recites the limitation of "a screw" which is shown in an original application drawing. However, "a screw" does not appear in the original written description part of the application. Which of the following is correct?

- (A) The written description may not be properly amended to include "a screw."
- (B) The claim is indefinite with respect to "a screw."
- (C) The application lacks an enabling disclosure as to "a screw."
- (D) The claim is definite with respect to "a screw."
- (E) The application fails to set forth the best mode for "a screw."

17. For a certain chemical composition, the original written description sets forth a range of "35% - 80%" and specific examples of "40%" and "65%." A corresponding claim includes the limitation, added by amendment, of "at least 42%." There is no other range or specific example disclosed in the application. Which of the following is correct?

- (A) The claim limitation is indefinite.
- (B) The claim limitation is not supported by the written description.
- (C) The disclosure is enabling with respect to the claim limitation.
- (D) The claim limitation is within the scope of "35%- 80%" in the written description.
- (E) The inventor has concealed the best mode.

18. The claims of an application limit a scanning device as having a specific angular view. A patent issues. One year after the patent issued, the patentee filed a reissue application with all required papers. As filed, the claims in the reissue application are amended to remove the limitations directed to the specific angular view. Which of the following is correct?

- (A) The patentee may not broaden his claims through reissue by removing the limitations directed to the specific angular view.
- (B) Since the patentee is removing a limitation, the claim is being narrowed.
- (C) The patent may not be modified after issuance.
- (D) The patentee may broaden claims through reissue by removing the limitation directed to the specific angular view.
- (E) The Patent and Trademark Office may not allow broader claims during reissue.

19. A claim limitation reads "a pH range between 7 and 12, preferably between 9 and 10." Which of the following is correct?

- (A) Since the limitation properly sets forth outer limits, it is definite.
- (B) As long as the limitation is supported in the written description, it is proper.
- (C) The limitation is indefinite.
- (D) Since the limitation sets forth a preferred range, it is definite.

- (E) An applicant is precluded from expanding the claim coverage beyond a pH range of 7-12 under the doctrine of equivalents.

20. With regard to an art or technology that is considered to be unpredictable, which of the following is correct?

- (A) A patent cannot issue because the art is unpredictable.
- (B) Claims in an application need more detail than usual in order to be definite.
- (C) An applicant has an option as to which mode of the invention to set forth.
- (D) An applicant must pay a higher filing fee.
- (E) A written description needs more detail as to how to make and use the invention in order to be enabling.

21. Which of the following claim phrases may be used 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.

22. Which of the following claims is (are) not in proper format?

- (A) A device for cooking small pieces of food comprising a basket including a mesh made of a material suitable for cooking small pieces of food, said mesh comprising a bottom, a rear wall, a front wall, and two side walls, wherein the two side walls are joined to the front and rear walls and the rear wall is higher than the front wall such that the entire device fits completely within conventional covered outdoor barbecue grills and such that the higher rear wall facilitates turning over the small pieces of food when the device is shaken.
- (B) A mesh basket for cooking food comprising a bottom, a rear wall, a front wall, and two side walls, wherein the side walls are joined to the front and rear walls and the rear wall is higher than the front wall such that the entire basket fits completely within conventional covered outdoor barbecue grills.
- (C) A device for grilling small pieces of food comprising a bottom, a rear wall, a front wall, and two side walls, wherein the two side walls are joined to the front and rear walls and the rear wall is higher than the front wall, and wherein the walls are made of a mesh material suitable for cooking or grilling small pieces of food.
- (D) (A) and (B).
- (E) None of the above.

23. Which of the following statements is (are) true?

- (A) A claim may not be dependent on any claim which is itself a dependent claim.
- (B) A dependent claim may not contain means-plus-function limitations.
- (C) A dependent claim will always be infringed by any device that would also infringe the base claim from which it depends.
- (D) Any dependent claim may be re-drafted as an independent claim.
- (E) All of the above statements are true.

24. Which of the following is not a PTO recommendation or requirement?

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

25. Which of the following is false?

- (A) The meaning of terms in a claim should be ascertainable by reference to the description in the specification.
- (B) While a term used in a claim may be given a special meaning in the description, no term may be given a meaning repugnant to the usual meaning of the term.
- (C) Trademarks may be used in claims only if each letter in the trademark is capitalized.
- (D) Claims may not contain tables or chemical or mathematical formulas.
- (E) Figures may be incorporated by reference in the claims.

26. The claim below is incomplete because it is missing limitation (iii).

A seating device comprising:

- (i) a base member having four parallel edges, and opposing first and second sides;
- (ii) a back member connected to one of the edges of the base member forming a right angle with said first side;
- (iii) _____

- (iv) a pair of arm members connected to said back member and said first and second leg members, wherein said arm members are capable of supporting the arms of a person sitting in the seating device.

Of the following choices, which would be the best to complete the claim by providing the missing limitation (iii)?

- (A) a set of leg members connected to the second side of said base member;
- (B) a first pair of leg members connected to the second side of said base member at the same edge as the back member, and a second pair of leg members connected to the opposite edge of said support member;
- (C) first, second, third, and fourth leg members connected to said underside of said base member;
- (D) first, second, third, and fourth leg members connected to said second side of said base member, each edge having a leg member adjacent to said edge, wherein said leg members are parallel to each other;
- (E) first, second, third, and fourth leg members connected to said corners of said second side of said base member;

27. Applicant filed a patent application claiming a polyester. The application discloses that the claimed polyester having structural formula R-R' is used to form a stain resistant fabric. The examiner properly rejected the claims as unpatentable over prior art disclosing the claimed polyester having structural formula R-R' and its use to form various fabrics. Given the fact that applicant's specification discloses that the polyester may be produced by a process comprising steps A, B, C, and D, and such process is novel and unobvious, which of the following claims, if introduced by amendment, would overcome the rejection?

- (A) A polyester having structural formula R-R' used to form a stain resistant fabric, the polyester being produced by the process comprising the steps A, B, C, and D.
- (B) A polyester-producing process comprising steps A, B, C, and D, said process resulting in a polyester having structural formula R-R' capable of forming a stain resistant fabric.
- (C) A polyester produced by the process comprising the steps A, B, C, and D.
- (D) A polyester comprising the resultant product of steps A, B, C, and D.
- (E) A polyester produced by the process comprising the steps A, B, C, and D, said polyester used to form a stain resistant fabric and having structural formula R-R'.

The following two questions are related:

28. Your client comes to you with a new ornamental design for a bowling pin. Which of the following would be proper claim language for your client's design?

- (A) "The ornamental design for a bowling pin."
- (B) "The ornamental design for a bowling pin as shown and described."
- (C) "The ornamental design for sports equipment as shown."
- (D) "A unique configuration and surface ornamentation for a bowling pin."
- (E) None of the above because bowling pins are functional and not ornamental.

29. Your client's bowling pin includes both a unique functional structure and unique surface ornamentation. You decide that it would be beneficial to protect the unique structure and the unique surface ornamentation separate and apart from one another. Which of the following would be an appropriate action for separately protecting the unique functional structure of the bowling pin?

- (A) Draft a dependent claim covering the unique functional structure and file it in the same design application as the claim covering the entire design of the bowling pin.
- (B) File a separate utility application claiming only the unique functional structure of the bowling pin.
- (C) File a separate design application claiming only the unique surface ornamentation of the bowling pin.
- (D) File a separate utility application claiming a unique method for making a wooden bowling pin having the unique functional structure.
- (E) None of the above.

30. Which of the following requirements of 35 U.S.C. § 112 do NOT apply to design patent claims?

- (A) The written description requirement of the first paragraph.
- (B) The best mode requirement of the first paragraph.
- (C) The requirement in the second paragraph to distinctly claim the subject matter which the applicant regards as his invention.
- (D) The requirement in the third paragraph for an independent claim.
- (E) None of the above.

31. Which of the following is not required in a provisional application?

- (A) The written description of the invention.
- (B) The best mode contemplated by the inventor for carrying out his or her invention.
- (C) One or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- (D) The manner and process of making and using the invention.
- (E) None of the above.

32. Applicant's patent application is directed to a light sensitive dental reconstruction compound comprising a polymer and non-reactive metal blend having a set point activated by ultraviolet light. The polymer is made from at least 60% by weight monomer X, and at least 0.1% by weight monomer Y. 74%, 79%, and 85% are exemplary weight percentages of monomer X, with the respective weight percentage balances of the polymer being monomer Y. Set point is defined as the phase change when the amorphous polymer transforms to a hard, rigid, enamel-like state from a soft, flexible, rubbery state. The set point is directly related to the types of monomer selected and monomer proportions selected. A prior art reference properly cited against the application discloses a dental reconstruction compound comprised of polymer and non-reactive metal blends made from the same monomers, and the same proportions as that disclosed by applicant. The prior art reference does not disclose the method of inducing a set point by exposing the compound to ultra-violet light. The reference compositions are disclosed as being used in veterinary dentistry. Which of the following claims, if any, is (are) patentable over the reference?

- (A) A light sensitive dental reconstruction compound comprising a polymer and non-reactive metal blend, said polymer comprising at least 60% by weight monomer X, and at least 0.1% by weight monomer Y, wherein a set point is induced using ultra-violet light.
- (B) A light sensitive dental reconstruction compound comprising a polymer and non-reactive metal blend, said polymer comprising 74% by weight monomer X, and the balance monomer Y, wherein a set point is induced using ultra-violet light.
- (C) A dental reconstruction compound comprising a polymer and non-reactive metal blend, said polymer comprising 79% by weight monomer X, and the balance monomer Y, wherein a set point is induced using ultra-violet light.
- (D) (A) and (B).
- (E) None of the above.

33. Which, if any, of the following claims is (are) improper?

- (A) A gadget as in any one of the preceding claims, in which
- (B) A gadget according to Claims 3 and 4, further comprising
- (C) A gadget according to Claims 1-3, in which
- (D) A gadget according to Claim 3 or 4, further comprising
- (E) (B) and (C)

34. A multiple dependent claim may not properly depend upon:

- (A) an independent claim.
- (B) claim dependent on a single claim.
- (C) a claim which is dependent from a multiple dependent claim.
- (D) a claim containing Markush language.
- (E) (C) and (D).

35. Given the following information regarding three claims:

- (i) A claim refers to "said lever" where the claim contains no earlier recitation or limitation of a lever;
- (ii) A claim initially refers to "an aluminum lever," and "a plastic lever" and thereafter refers to "said lever"; and
- (iii) A claim initially refers to a "controlled stream of fluid" and thereafter refers to "the controlled fluid,"

which of the following statements is correct?

- (A) The claims in (i), (ii) and (iii) are all definite.
- (B) The claims in (i) and (ii) are definite; and the claim in (iii) is indefinite.
- (C) The claim in (i) is indefinite; and the claims in (ii) and (iii) are definite.
- (D) The claims (i) and (ii) are indefinite; and the claim in (iii) is definite.
- (E) The claims in (i), (ii) and (iii) are all indefinite.

36. Which of the following statements is true?

- (i) An applicant cannot use a patent to prove the state of the art for the purpose of the enablement requirement if the patent has an issue date later than the effective filing date of the application.
- (ii) A publication dated after the effective filing date of an application may be properly used to demonstrate that an application is nonenabling if the publication provides evidence of what one skilled in the art would have known on or before the application's effective filing date.
- (iii) The state of the art existing at the issue date of the patent is used to determine whether a particular disclosure in the patent is enabling.

- (A) (i), (ii) and (iii) are all true.
- (B) (i) and (ii) are true; (iii) is false.

- (C) (i) is false; (ii) and (iii) are true.
- (D) (i) is true; (ii) and (iii) are false.
- (E) (i), (ii) and (iii) are all false.

37. Which of the following expressions, when found in a claim, comply with the provisions of the second paragraph of 35 U.S.C. § 112?

- (A) containing A, B, and optionally C
- (B) material such as rock, wool or asbestos
- (C) lighter hydrocarbons, such, for example, as the vapors or gas produced
- (D) normal operating conditions such as while in the container of a proportioner
- (E) such material as wood and the like

38. Which of the following is not a correct statement regarding the consideration of asserted therapeutic or pharmacological utility?

- (A) Evidence of pharmacological or other biological activity of a compound will be relevant to an asserted therapeutic use if there is reasonable correlation between the activity in question and the asserted utility.
- (B) An applicant can establish a correlation by relying on statistically relevant data documenting the activity of a compound or composition which is claimed.
- (C) The applicant does not have to prove that a correlation exists between a particular activity and an asserted therapeutic use of a compound as a matter of statistical certainty.
- (D) An applicant must provide evidence of success in treating humans where such a utility is disclosed.
- (E) An applicant need not provide evidence that an animal model for the human disease condition had been established prior to the filing date of the application.

39. Which one of the following statements regarding establishment of a *prima facie* case of obviousness is not correct?

- (A) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
- (B) There must be a reasonable expectation of success.
- (C) The prior art reference (or references when combined) must teach or would have suggested all the limitations in the claim.
- (D) The teaching or suggestion to make the claimed combination that is found in the applicant's disclosure may be used by the examiner.
- (E) The prior art references when combined, cannot render the prior art unsatisfactory for its intended purpose.

40. In which of the following situations may an affidavit or declaration under 37 CFR § 1.131 be properly used?

- (A) Where the reference publication date is more than one year before applicant's or patent owner's effective filing date.
- (B) Where the reference, a U.S. Patent, with a patent date less than one year prior to applicant's effective filing date, shows but does not claim the same patentable invention.
- (C) Where the subject matter relied upon is evidence under 35 U.S.C. § 102(f).
- (D) Where the reference is a prior U.S. patent to the same inventive entity claiming the same invention.
- (E) Where the applicant has clearly admitted on the record that the prior art invention was prior to his invention.

41. Claim 1 in a patent application is directed to a method for whitening teeth. Claims 1 through 5 read as follows:

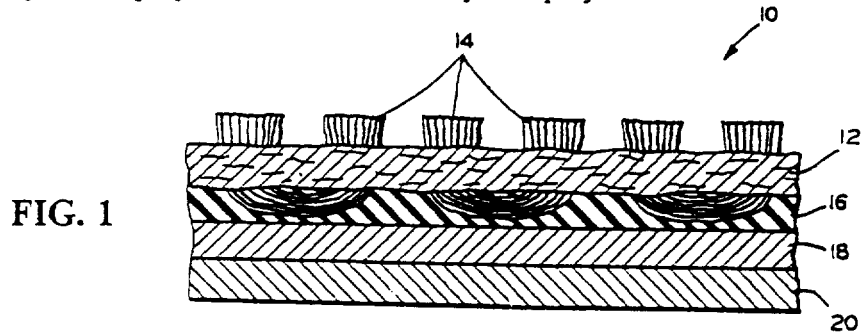
1. A method for whitening teeth comprising isolating the teeth to be treated; preparing a bleaching composition comprising an oxygen-radical generating agent; applying said composition to said isolated teeth; and exposing each of said isolated teeth to laser light from an argon laser for a selected time to accelerate whitening.
2. The method of Claim 1, wherein said bleaching composition further comprises a booster selected from the group consisting of ammonium persulfate and sodium persulfate, and a buffer selected from the group consisting of sodium carbonate and sodium bicarbonate.
3. The oxygen radical-generating agent of Claim 1, where said generator is selected from the group consisting of hydrogen peroxide and sodium carbonate peroxide.
4. The buffer agent according to Claim 2, wherein said buffering agent is any other buffering agent which maintains a pH of said composition between 7 and 10.
5. A method according to Claim 4, wherein said argon laser has a wavelength range in the visible spectrum between 410 and 522 nanometers.

Which of the following is (are) proper dependent claim(s) in accordance with 37 CFR § 1.75?

- (A) Claim 2.
- (B) Claim 3.
- (C) Claim 4.
- (D) Claim 5.
- (E) Claims 2 through 5.

42. A patent application is under preparation to be filed in the PTO. The application discloses and describes a tufted carpet shown in the drawing below (Figure 1) having several components. The following independent claim has been drafted:

1. A tufted carpet (10) comprising:
 - a primary backing (12) having loops of yarn (14) forming a tufted structure projecting outwardly from said primary backing;
 - a layer of latex (16) affixed to the primary backing;
 - a layer of polyolefin (18) affixed to the layer of latex; and
 - a secondary backing (20) consisting of a woven synthetic polyolefin affixed to the layer of polyolefin.



In the absence of issues of supporting disclosure, which of the following would not be a proper dependent claim when the application is filed in the PTO?

- (A) 2. The tufted carpet according to Claim 1, wherein the primary backing is jute, cotton, or a synthetic fiber.
- (B) 2. The tufted carpet according to Claim 1, wherein the secondary backing is woven cotton, or a woven synthetic polyolefin.
- (C) 2. The tufted carpet according to Claim 1, wherein the loops of yarn are selected from the group consisting of polyester, polyamide, nylon, and polyolefin.
- (D) 2. The tufted carpet according to Claim 1, wherein the polyolefin layer is selected from the group consisting of polyethylene, and polypropylene.
- (E) All are proper dependent claims.

43. Patent practitioner Smith filed a patent application for adhesive compositions having a paste-like consistency and comprising filler admixed with liquid monomer, the filler being water-insoluble solid filler which forms a paste with the liquid monomer, and is essentially inert with respect to the monomer and is insoluble in the monomer. The specification states, "The compositions of this invention must contain, as essential ingredients, at least one monomer of a class of alpha-cyanoacrylic acid esters and at least one filler." The compositions are characterized as being capable of being applied to a substrate submerged in water. Which of the following claims properly sets forth the composition?

- (A) An adhesive composition comprising a filler admixed with a liquid monomer of a class known as alpha-cyanoacrylic acid esters, the filler being water-insoluble solid filler which forms a paste with the liquid monomer, and is essentially inert with respect to the monomer and is insoluble in the monomer.
- (B) An adhesive composition comprising means to admix a filler with a liquid monomer of a class known as alpha-cyanoacrylic acid esters, the filler being water-insoluble solid filler which forms a paste with the liquid monomer, and is essentially inert with respect to the monomer and is insoluble in the monomer.
- (C) An adhesive composition comprising a filler for admixture with a liquid monomer of a class known as alpha-cyanoacrylic acid esters, the filler being water-insoluble solid filler which forms a paste with the liquid monomer, and is essentially inert with respect to the monomer and is insoluble in the monomer.
- (D) An adhesive composition having a filler adapted to be admixed with a liquid monomer of a class known as alpha-cyanoacrylic acid esters, the filler being water-insoluble solid filler which forms a paste with the liquid monomer, and is essentially inert with respect to the monomer and is insoluble in the monomer.
- (E) An adhesive composition assembly having a paste-like consistency capable of being applied to a substrate submerged in water.

44. Summer discovered that by adhering cotton swabs on opposing ends of a cylindrical rod, he could use the device to clean hair and dust particles caught in screens at the rear end of a hair dryer by causing a swab to contact a surface of the screen and rotating the swab to collect the hair and dust. Summer provides patent practitioner Smith with reliable test data establishing this fact. Preliminary to preparing a patent application, Smith conducted a search of the prior art, and found that cotton swabs adhering to opposing ends of a cylindrical rod, and the method of preparing such devices were disclosed in patents issued more than one year ago. Smith also found patents published five or more years ago disclosing hair dryers having a screen at an end of the hair dryer to catch hair and dust, and prevent the same from reaching the heating element in the hair dryer. Notwithstanding, Summer wants to file a patent application on his invention. In the absence of issues of supporting disclosure, which of the following is the best claim for Summer's invention?

- (A) A method of preparing a cotton swab device, said device being characterized by being useful for removing hair and dust from hair dryers.

- (B) A cotton swab device consisting of a cylindrical rod having first and second opposing ends, a first cotton swab adhering to said first opposing end, and a second cotton swab adhering to said second opposing end.
- (C) A method of removing hair and dust particles from a screen in an end of a hair dryer comprising bringing a cotton swab of a cotton swab device into contact with a surface of a screen of a hair dryer, and rotating the swab to collect the hair and dust.
- (D) A process for using a cotton swab device to remove materials selected from the group consisting of hair and dust particles from an end of a hair dryer.
- (E) A hair dryer having a screen at an end of the hair dryer, and a cotton swab device for removing hair and dust from said screen.

45. Presented below are five separate portions of five different claims. Assuming that there are no issues of support or lack of antecedent basis, which portion does not contain a means-or-step-plus function which invokes the sixth paragraph of 35 U.S.C. § 112?

- (A) 1. In a pressure responsive instrument having a pressure responsive chamber including a wall portion movable in reply to change in fluid pressure thereon, the improvement comprising a plate means and a leaf spring; wing means on said plate means
- (B) 1. A process for recovering molybdenum values in usable form from ferruginous, molybdenum - bearing slags comprising . . . raising the pH of the resulting pulp to about 5.0 to precipitate dissolved molybdenum trihydroxide
- (C) 1. A boring device for deep boring an object rotating about an axis, comprising . . force generating means adapted to provide a force acting on the cutting head to cause radial displacement of said cutting head
- (D) 1. In an aircraft having a bladed rotor adapted under at least one translational flight condition to provide both lift and propulsive thrust, a jet driving device so constructed and located on the rotor as to drive the rotor
- (E) 1. An air filter assembly for filtering air laden with particulate matter, said assembly comprising . . said portion having means, responsive to pressure increases in said chamber caused by said cleaning means, for moving particulate matter in a downward direction

46. On January 15, 1996, Winter filed a patent application disclosing and claiming a process for promoting growth of a ruminant by administering a pharmacologically acceptable salt of lysocellin to said ruminant. In the application, physiologically acceptable salts of lysocellin are identified as sodium lysocellin, zinc lysocellin, and manganese lysocellin. The claims in the application are as follows:

1. A process for promoting growth of a ruminant by administering to said ruminant a growth-promoting amount of a pharmaceutically acceptable salt of lysocellin selected from the group consisting of manganese lysocellin, sodium lysocellin and zinc lysocellin.
2. The process of Claim 1 wherein the pharmaceutically acceptable salt of lysocellin is manganese lysocellin.
3. The process of Claim 1 wherein the pharmaceutically acceptable salt of lysocellin is sodium lysocellin.
4. The process of Claim 1 wherein the pharmaceutically acceptable salt of lysocellin is zinc lysocellin.

Claims 1-4 in Winter's application have been twice rejected under 35 U.S.C. § 103 over a U.S. patent granted to Spring on April 15, 1997, on an application filed March 12, 1996; which, in turn is a continuation-in-part application of an application filed December 12, 1994, now abandoned. The second rejection is a final rejection. As filed on December 12, 1994, Spring's application disclosed and claimed a "process for promoting growth of ruminants by administering to ruminants a growth promoting amount of manganese lysocellin," as well as how to make and use the invention, and the best mode for carrying out the invention. As filed on March 12, 1996, Spring's CIP application disclosed and claimed a "process for promoting growth of ruminants by administering to ruminants a growth promoting amount of a member selected from the group consisting of manganese lysocellin, sodium lysocellin, and zinc lysocellin." The CIP application also discloses how to make and use the invention, and the best mode for carrying out the invention. Claim 1 in Spring's patent claims a "process for promoting growth of a ruminant by

administering to the ruminant a growth promoting amount of a lysocellin material selected from the group consisting of manganese lysocellin, sodium lysocellin, and zinc lysocellin." The rejection may be properly obviated by:

- (A) A timely appeal of the rejection of Claims 1-4 to the Board of Patent Appeals and Interferences, a timely filed brief stating that the claims stand or fall together, and arguing that Spring's parent application only discloses administering the manganese lysocellin, and Spring's patent does not present a claim confined to administering a manganese lysocellin, and timely payment of all appropriate fees.
- (B) A timely appeal of the rejection of Claims 1-4 to the Board of Patent Appeals and Interferences, a timely filed brief stating that the claims stand or fall together, and arguing that Spring's patent claims are unsupported by the disclosure in the parent application because the description of one species, the manganese lysocellin, in Spring's parent application does not amount to a written description of the class of materials or genus set forth in Spring's patent claims, and timely payment of all appropriate fees.
- (C) A timely filed reply arguing that Spring's patent claim is unsupported by the disclosure in the parent application because the description of one species, the manganese lysocellin, in Spring's parent application does not amount to a written description of the class of materials or genus set forth in Spring's patent claims.
- (D) A timely filed reply containing an amendment canceling "manganese lysocellin," in Claim 1, and arguing that Spring's patent claim does not describe the invention now claimed in Winter's application, and that there is nothing in Spring's parent application disclosing or motivating one of ordinary skill in the art to promote growth of ruminants with sodium lysocellin or zinc lysocellin.
- (E) A timely filed reply containing an amendment cancelling "manganese lysocellin," in Claim 1, and cancelling Claim 2, and arguing that there is nothing in Spring's parent application disclosing or motivating one of ordinary skill in the art to promote growth of ruminants with sodium lysocellin or zinc lysocellin.

Answer Questions 47 and 48 based upon the following information. You have drafted and filed a patent application which includes the following disclosure and drawings:

The invention comprises a blinking-light LED device 10, a pair of which are shown adhered to the outer surface of a sports shoe 11. LED device 10 is formed by a heart-shaped casing 12 molded of synthetic plastic material, such as polyethylene or polypropylene. The device may also be formed in a different shape such as a star or animal. The invention consists of an interior cavity having an LED 15 provided with leads 15A and 15B. Lead 15A has a right angle bend to define the fixed contact of a make and break switch mechanism 14 having a movable contact 16. Movable contact 16 is formed by a cantilevered flat metal spring having a weight 17 attached to its free end. The other end of the movable contact 16 is connected to the positive terminal of a 1.5V battery cell 18 whose negative terminal is connected to the positive terminal of an identical cell 19. The negative terminal of cell 19 is connected through a current limiting resistor 20 to lead 15B of the LED, thereby, completing the circuit. The weighted movable contact 16 of the make and break switch mechanism 14 is acceleration-sensitive, which means that when shoe 11 is worn by a jogger, the foot movement of the jogger gives rise to changes in velocity which are sensed by movable contact 16, causing the contact to flex momentarily, and engage fixed contact defined by lead 15A, closing the switch to provide power to LED 15. When LED 15 is activated, it emits a flash of light. A strobe effect is created because current flowing through resistor 20 causes a voltage drop developed across the resistor which abruptly inactivates the LED. Therefore, the LED is briefly activated to produce an intense flash of light, very much in the manner of a strobe flashtube.

FIG. 1

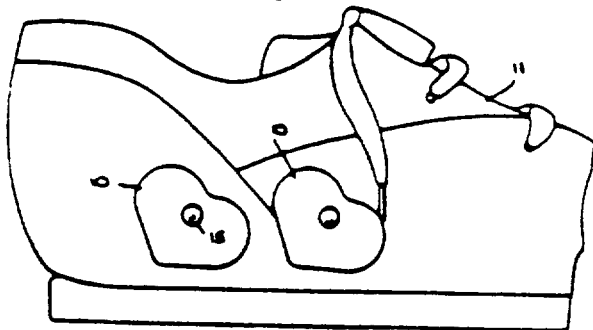
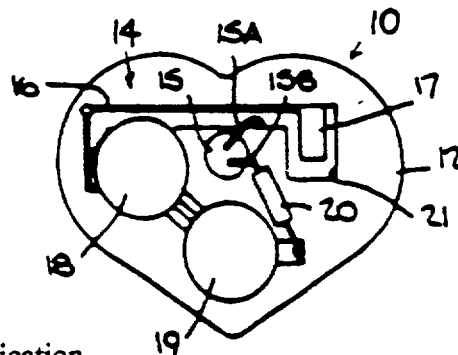


FIG. 2



The following independent claim is included in the application.

1. A blinking light LED device comprising:
 - (a) A casing (12) attachable to a shoe (11), an LED (15) mounted on the casing, said LED (15) having a first lead (15B) and a second lead (15A);
 - (b) A power source comprising batteries (18 & 19) connected in series, said power source having a positive terminal and a negative terminal, said negative terminal being connected to said first lead (15B);
 - (c) Said second lead defining a fixed contact;
 - (d) A make and break switch mechanism (14) having a movable contact defined by a

cantilevered flat spring (16) having a fixed end and a free end, said fixed end is connected to said positive terminal and said free end having a weight (17) attached thereto;

(e) Whereby movement of said movable contact causes said spring to flex and engage said fixed contact thereby causing said make and break switch mechanism to momentarily close and complete a circuit and briefly activate the LED (15).

Answer the following two questions based upon the foregoing disclosure and independent claim.

47. Which of the following claims would be a proper dependent claim?

- (A) 2. A blinking light LED device as set forth in Claim 1, further including a current-limiting resistor interposed between a lead and a terminal.
- (B) 2. A blinking light LED device according to Claim 1, wherein the invention further comprises a current-limiting resistor interposed between said first power source and said second power source.
- (C) 2. A jogger wearing a shoe as set forth in Claim 1, further including a current-limiting resistor interposed between a lead and a power source.
- (D) 2. A blinking light LED device as set forth in Claim 1, further comprising a current-limiting resistor interposed between said first lead and said negative terminal of the power source.
- (E) 2. A blinking LED shoe as set forth in Claim 1, the invention further consisting of a current-limiting resistor which causes a voltage drop to inactivate the LED.

48. You submitted the following dependent claim in the application:

- 3. A blinking light device as set forth in Claim 3, wherein the casing comprises molded synthetic plastic material.

The examiner issued a rejection under 35 U.S.C. § 112, second paragraph, citing the improper dependency of the claim. Which of the following proposed amendments will overcome the rejection?

- (A) 3. A blinking light device as set forth in Claims 1 or 2, wherein the casing comprises molded synthetic material.
- (B) 3. (Amended) A blinking light device as set forth in Claim [3] 1, wherein the casing comprises molded synthetic plastic material.
- (C) 3. (Amended) A blinking light device as set forth in [Claim] Claims 1 and 2, wherein the casing comprises molded synthetic plastic material.
- (D) 3. A blinking light device as set forth in the preceding claims [Claim 3], wherein the casing comprises molded synthetic plastic material such as polyethylene.
- (E) 3. (Amended) A blinking light device as set forth in Claim [3] 1, wherein the casing is made of synthetic plastic material.

49. A patent application is being prepared. The application discloses and describes a construction device shown in the drawing below (Figure 1) having several components. Certain "means" are not illustrated Figure 1, but are shown in other drawings not presented below or they are described elsewhere in the application. The following independent claim has been drafted:

1. A construction device comprising:
 - a frame (12);
 - a plate (20) having a front surface and a back surface,
said plate being disposed in said frame;
 - a glass tube (18) supported by said back surface of said
plate, and having a visually
perceptible indicia and being filled with inert gas;
 - means for illuminating said glass tube; and
 - a reflective panel (22), for reflecting light transmitted from the
glass tube, disposed in said frame at a spaced distance
from said plate and glass tube.

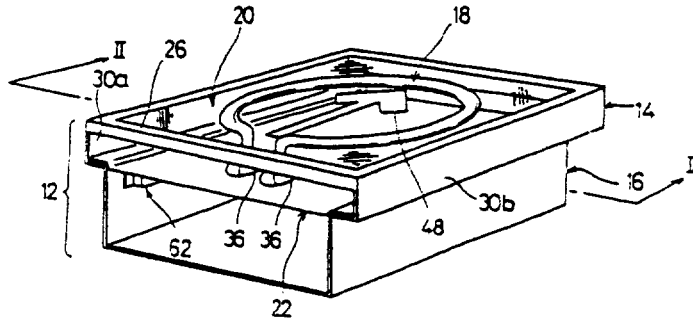


FIG. 1

In the absence of issues of supporting or enabling disclosure in the description portion of the specification, which of the following dependent claims lacks proper antecedent basis when the application is filed in the PTO?

- (A) 2. The construction device according to Claim 1, wherein said plate is made of a glass material.
- (B) 3. The construction device according to Claim 2, further comprising means to secure the glass tube to said back surface of said plate.
- (C) 4. The construction device according to Claim 1, wherein said means to secure the glass tube to said back surface of said plate is an optically transparent thermosetting resin.
- (D) 5. The construction device according to Claim 1, wherein a protection layer consisting of an optically transparent thermoplastic resin is disposed on the entirety of said back surface of said plate in such a manner that said protection layer covers at least a portion of said glass tube.
- (E) 6. The construction device according to Claim 1, wherein said inert gas is helium.

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

An automatic processor for processing a silver halid photographic light-sensitive material with a processing solution, the processor comprising:
a processing solution tank containing a processing solution for processing the material;
a circulating path for circulating the processing solution, and
a supply means for supplying a solid composition to the processing tank or the path wherein the following expression is satisfied:

$$V <$$

where V represents an amount of the processing in the processing tank, and Vf represents the amount of processing solution in the path.

Which of the following is in accord with proper PTO amendment practice and procedure?

- (A) In Claim 1, line 1, delete "halid" and insert in its place --halide--.
- (B) In Claim 1, line 4, add --the circulating path connect the processing tank--.
- (C) In Claim 1, line 7, after "<" insert --Vf--.
- (D) In Claim 1, line 8, after "processing" insert --solution--.
- (E) All of the above.

NAME _____

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

APRIL 21, 1999

Morning Session (50 Points)

Time: 3 Hours

DIRECTIONS

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

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

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

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

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO

1. P, a registered patent practitioner, filed a reply to a first Office action which rejected all claims under 35 U.S.C. § 102(a) based on an earlier patent granted to Z. The Office Action was dated September 15, 1998 and set a three month shortened statutory period for reply. P's unsigned reply, filed February 3, 1999, did not include a petition for an extension of time and contained only the following paragraph:

Applicant respectfully spits on the ludicrous position taken by the Examiner in rejecting all claims under 35 U.S.C. § 102(a) based on an invalid patent granted to Z. Applicant may be willing to overlook the Examiner's stupidity in making this rejection since it is possible that the Examiner was unaware that Z is a bum and a thief who stole Applicant's invention. Applicant has renumbered the claims and has attached a copy of Z's patent with notations made thereon. Applicant respectfully requests that the Examiner "WAKE UP" and take another look at Applicant's claims in light of these remarks. Please charge my deposit account number 99-1234 to cover the cost of any required fees.

P should not be surprised when the amendment is not entered because:

- (A) The reply was not signed.
- (B) An amendatory paper determined to contain objectionable remarks will be returned to the sender.
- (C) P did not file a petition for an extension of time.
- (D) (A) and (B) are correct.
- (E) (A),(B), and (C) are correct.

2. On August 20, 1998, you filed in the PTO a patent application which claims a new pharmaceutical compound and a method of using the pharmaceutical compound to treat obesity. On January 29, 1999, you received a restriction requirement from the examiner requiring election between the following groups of claims: group (I), directed to the product; and group (II), directed to the method of use. Which of the following statements, if any, is not a proper reply to the restriction requirement?

- (A) You file a written reply provisionally electing the claims of group I, with traverse, and set forth the reasons why you believe the restriction requirement is improper.
- (B) You file a written reply electing the claims of group I for prosecution on the merits, and an amendment canceling the method claims of group II.
- (C) You file a written reply traversing the restriction requirement, and setting forth specific reasons why you believe the restriction requirement is improper.

- (D) You file a written reply electing the claims of group I for prosecution on the merits, without traverse of the restriction requirement.
- (E) None of the above.

3. Which of the following statements regarding design patents are **not** true?

- (A) A design patent and a trademark may be obtained on the same subject matter.
- (B) A design patent claim for type fonts will be rejected for failure to comply with the "article of manufacture" requirement.
- (C) A computer-generated icon must be embodied in a computer screen, monitor, or other display panel to satisfy 35 U.S.C. § 171.
- (D) The claimed design is shown by solid lines in the drawing. It is not permissible to show any portion of the claimed design in broken lines.
- (E) Novelty and obviousness of a design claim must generally be determined by a search in the pertinent design classes. It is mandatory that the search be extended to the mechanical classes encompassing inventions of the same general type.

4. During a reexamination proceeding, the patent owner seeks to amend Claim 1 as follows:

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

All changes in the claim are fully supported by the original patent disclosure. Should the claim, as amended, be rejected?

- (A) Yes, because the amendment broadens the scope of the claim of the patent.
- (B) No, because the claim is fully supported by the original patent disclosure.
- (C) No, because the amendment does not add new matter into the claim.
- (D) No, because the amendment narrows the scope of the patent.
- (E) Yes, because the claim has not been amended in accordance with PTO rules for amending patent claims.

5. On February 13, 1998, practitioner Wally filed a complete nonprovisional application for patent, filing fee, and an executed oath under 37 CFR § 1.63 in the PTO identifying inventors A and B by their full names, and providing their residence, post office addresses, and citizenship. A and B have assigned their application to XYZ Corporation who Wally represents. Two weeks after the filing of the patent application, XYZ sends Wally a letter informing him that due to an oversight, a third inventor, C, should be added to the joint inventorship. Which of the following is the most proper procedure for correcting the inventorship of the patent application?

- (A) File a new oath signed by C, and file an amendment adding C as an inventor along with a statement of facts by C noting that the omission of him as an inventor was without deceptive intent and establishing when the error was discovered and how it occurred.
- (B) File a new oath signed by A, B, and C, and file an amendment adding C as an inventor along with a verified statement of facts by C noting that the omission of him as an inventor was without deceptive intent and establishing when the error was discovered and how it occurred.
- (C) File a new oath signed by A and B, and file an amendment adding C as an inventor along with the written consent of the assignee and a statement of facts verified by A and B noting that the omission of C as an inventor was without deceptive intent and establishing when the error was discovered and how it occurred.
- (D) File a new oath signed by A and B, and file an amendment adding C as an inventor along with the written consent of the assignee and a petition with the appropriate fee giving a verified statement of facts by A and B noting that the omission of C as an inventor was without deceptive intent and establishing when the error was discovered and whether they had reviewed and understood the contents of the specification including the claims as amended by any amendment specifically referred to in the oath or declaration and whether they had reviewed the oath or declaration prior to its execution and if so, how the error had occurred in view of such reviews.
- (E) File a new oath signed by A, B, and C, and file an amendment adding C as an inventor along with the written consent of the assignee, a petition, the appropriate fee, and a statement from C that the inventorship error occurred without deceptive intention.

6. On January 7, 1998, your client published an article containing a complete and enabling disclosure of a new pharmaceutical compound she developed. On February 6, 1998, you prepared and filed in the PTO a provisional application for the client containing an enabling disclosure of the pharmaceutical compound disclosed in the publication. The provisional patent application was filed by depositing it directly with the United States Postal Service via "Express Mail Post Office to Addressee." On Saturday, February 6, 1999, you deposit a complete, nonprovisional U.S. patent application directly with the U.S. Postal Service via "Express Mail Post Office to Addressee." The nonprovisional application claims the new pharmaceutical compound and claims priority to the filing date of the provisional application under 35 U.S.C. § 119(e). The nonprovisional application is received in the PTO mailroom on Tuesday, February 9, 1999. The claims to the pharmaceutical compound are:

- (A) Patentable over your client's article. The effective filing date of the complete nonprovisional application is February 6, 1998.
- (B) Unpatentable. The effective filing date of the complete nonprovisional application is February 9, 1999, and thus the claims to the compound are barred by the publication of your client's article more than one year before the complete nonprovisional application's effective filing date.
- (C) Unpatentable over your client's article because the article is prior art under 35 U.S.C. § 102(a).
- (D) Patentable over your client's article. The effective filing date of the complete nonprovisional application is Monday, February 8, 1999. However, because the article was written by the inventor, the inventor can swear behind the article's publication date.
- (E) Unpatentable. The effective filing date of the complete nonprovisional application is February 9, 1999, and thus the claims to the compound are barred by the publication of your client's article more than one year before the complete application's effective filing date.

7. A patent application claims a chemical composition and discloses in the application that the composition has a cleansing property in addition to being able to remove ink stains. The examiner rejected the claims in the application under 35 U.S.C. § 103 as being obvious over Parker in view of Cross. Each reference discloses chemical compositions which can be used to remove ink stains. The proposed combination of references includes all the limitations of the composition claimed in the application. However, neither reference shows nor suggests the cleansing property newly discovered by applicant. Does the combination of Parker and Cross support a *prima facie* case of obviousness?

- (A) Yes, even though neither reference shows or suggests the newly discovered property of the claimed composition.
- (B) Yes, because after reading applicant's specification, it would be obvious that both references can be combined to achieve the cleansing property claimed by applicant.
- (C) No, unless in addition to structural similarity between the claimed and prior art compositions, the references contain a suggestion that the compositions will have the newly discovered cleansing property.
- (D) No, because the discovery of a new property of a previously known composition imparts patentability to the known composition.
- (E) No, because the burden of proof cannot be shifted to the applicant to show that the prior art compositions lacked the newly discovered property asserted for claimed composition unless one of the references discloses the property.

8. An original application was prosecuted through final rejection. All of the claims in the original application were properly rejected by the examiner as being obvious over two patent references. The applicant allows the application to go abandoned without replying to the final rejection. Two years after the abandonment, the applicant files a substitute application in which all of the claims are identical to those in the original application. The examiner _____ make a final rejection in the substitute application in the first Office action on the merits _____.

- (A) can ... provided any assignment in the original application has been applied to the substitute application
- (B) can ... because the claims would have been properly finally rejected in the next Office action on the grounds of rejection and the same art of record in the original patent application
- (C) can ... because the substitute application is entitled to the filing date of the original application

- (D) cannot ... because applicant is entitled to a new search and further consideration of the claims presented in the substitute application
- (E) cannot ... because the substitute application does not identify and make reference to the original application

9. In a first Office action dated March 18, 1999, the examiner rejected Claim 1 under 35 U.S.C. § 103 and objected to Claim 2 as being dependent upon a rejected claim. The examiner stated that Claim 2 would be allowable if the subject matter of Claim 2 was rewritten in independent form to include all the limitations of Claim 1. On April 6, 1999, after consulting with your client, you filed an amendment canceling Claim 2 and incorporating the subject matter of Claim 2 into Claim 1. Two weeks later, your client has changed his mind and now desires to traverse the rejection of Claim 1 without incorporating the subject matter of Claim 2 into Claim 1. Which of the following would be the most appropriate procedure to take under the circumstances?

- (A) Advise your client that there is nothing you can do until a reply is due for the next Office action.
- (B) Immediately file a supplemental amendment traversing the rejection of Claim 1 and requesting that Claim 2 be reinstated.
- (C) Immediately file a supplemental amendment adding a claim identical to canceled Claim 2. The new claim should be underlined in its entirety with the parenthetical expression (amended) following the original claim number 2.
- (D) Immediately file a supplemental amendment adding a new Claim 3 which is identical to original Claim 2, amend Claim 1 to delete the subject matter added by the April 6, 1999, amendment, and traverse the rejection of Claim 1.
- (E) Immediately file a supplemental amendment adding a new Claim 3 which is identical to original Claim 2, adding a new Claim 4 which is identical to original Claim 1, cancel amended Claim 1, and traverse the rejection of Claim 1.

10. Your client informs you that he has filed an international application in the United States Receiving Office and timely elected and designated the United States. Your client now wishes you to file the necessary documents to enter the U.S. national stage prior to April 27, 1999, the 30 month deadline for entering the national stage. Which of the following actions should you take to obtain the benefit of the international filing date prior to April 27, 1999?

- (A) File only the oath or declaration since that is all that is required for entry into the U.S. national stage.
- (B) File a copy of the international application in the PTO if a copy has not been provided by the International Bureau, and a cover letter instructing that the U.S. national filing fee be deducted from your deposit account.
- (C) File a request to enter the national stage with the PTO identifying the international application.
- (D) File a paper with the PTO identifying the international application, and asking that the PTO send you a bill for the U.S. national filing fee.
- (E) File a request that the International Bureau send all the necessary papers and the fee to the PTO, and send a new oath or declaration signed by your client.

11. Newly registered patent practitioner, Andy, is working at a large patent law firm. Supervising patent attorney, Pat, asks Andy to prepare a short memo which addresses the manner in which an issued patent may be corrected and/or amended. To fully respond to Pat's request, which of the subjects set forth below should Andy include in the following sentence: "An issued patent may be corrected by _____."

- (I) filing for reissue
- (II) filing a disclaimer
- (III) filing a Continued Prosecution Application
- (IV) filing a request for reexamination
- (V) filing a certificate of correction

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

12. Inventor X, a citizen of Germany, invented a new stapler in Germany on July 25, 1997. On January 22, 1998, X filed a patent application for the stapler in the German Patent Office. On January 22, 1999, you filed a complete U.S. patent application in the PTO claiming a stapler on behalf of X. The U.S. application was filed with a declaration under 37 CFR § 1.63 signed by X claiming foreign priority of the German patent application. In an Office action dated April 16, 1999, and setting a three month shortened statutory period for reply, the primary patent examiner properly rejected all the claims in the U.S. patent application as being anticipated under 35 U.S.C. § 102(a) by the disclosure in magazine articles describing how to make and use an identical stapler. The articles were published in the United States in February 1998, and in Great Britain in March 1998. Which of the following actions are in accord with proper PTO practice and procedure, and represent the most appropriate actions for overcoming the rejection?

- (A) File a petition to have the Commissioner exercise his supervisory authority and withdraw the rejection stating that the references cannot be properly used inasmuch as the declaration under 37 CFR § 1.63 makes clear that the application inventor X filed in the German Patent Office antedates the articles.
- (B) File a reply on or before July 16, 1999, which argues that the references cannot be used because the application inventor X filed in the German Patent Office antedates the articles.
- (C) On or before July 16, 1999, file a certified copy of the German application, an English translation of the German application, and point out that the references are no longer available as prior art.
- (D) File an affidavit under 37 CFR § 1.132 signed by you stating that the references cannot be used because the application which inventor X filed in the German Patent Office antedates the articles.
- (E) On or before July 16, 1999, file a certified copy of the German application, and an English translation of the German application.

13. All of the following portions of an application can be used for interpreting the scope of the claims except the _____

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

The answer to each of Questions 14 and 15 is based upon the facts set forth in the paragraphs below. Answer each question independently of the other.

Smith discovered that a tungsten carbide insert for a metal cutting tool may be bonded (with a far superior bond strength over other known methods of attachment) to a steel tool holder. Smith filed a patent application on his invention which contained the following two claims:

- (1) A method of bonding a carbide insert to a steel tool holder comprising the steps of providing a layer of polystick at the interface of the holder and insert, heating the holder, insert, and polystick to a temperature of 250°F. and thereafter cooling the holder, insert, and polystick at a rate of between 12 and 13°F. per hour until a temperature of 120°F. is reached.
- (2) A carbide insert bonded to a steel holder by the method of Claim 1.

The examiner rejected Claim 1 under 35 U.S.C. § 103 as being unpatentable over a U.S. patent to Y in view of a British patent to Z. The examiner rejected Claim 2 under 35 U.S.C. § 102(b) as being anticipated by the patent to Y. The patent to Y teaches that a tungsten carbide insert is bonded to a steel tool holder by utilizing a layer of polystick at the interface of the insert and holder, but makes no mention of any particular temperatures. The patent to Z teaches that in a grinding tool, diamond chips may be "securely fastened" to a ceramic holder by applying a layer of polystick at the interface of the diamonds and holder, heating the holder, chips, and polystick to a temperature of 150°F. and thereafter "slowly" cooling the holder.

14. Which of the following, if any, if submitted with the reply to the Office action, would most likely overcome the examiner's rejection of Claim 1?

- (A) Evidence that a gear cutting machine which includes a carbide insert bonded to a steel tool holder by the method set forth in Claim 1 is outselling all other such machines by a two-to-one margin.
- (B) An affidavit by Smith that, in his opinion, the patent to Y is inoperative.
- (C) Evidence that heavy advertising resulted in increased sales of Smith's invention.
- (D) An affidavit by Smith showing that the claimed method of bonding a carbide insert to a steel tool holder results in a bond which is 50 times greater than that of the invention disclosed in the patent to Y.
- (E) None of the above.

15. Which of the following, if any, if submitted with a reply to the Office action, would be most persuasive and most likely overcome the examiner's rejection of Claim 2?

- (A) Evidence that a gear cutting machine which includes a carbide insert bonded to a steel tool holder as set forth in Claim 1 is outselling all other such machines by a two-to-one margin.
- (B) An affidavit by Smith that, in his opinion, the patent to Z is inoperative.
- (C) Evidence that heavy advertising resulted in increased sales of Smith's invention.
- (D) An affidavit by Smith showing that there is a long felt need in the industry for Smith's carbide insert to a steel tool holder.
- (E) None of the above.

16. Pete the patent practitioner is preparing a patent application for his client, Perry. The invention is disclosed in the specification as a pickle machine comprising A, B, and means C for performing a function. The specification discloses two specific embodiments for performing the function defined by means C, namely C' and C". The specification also discloses that components D or E may be combined with A, B, and means C to form A, B, means C, and D, or to form A, B, means C and E. The specification further discloses that component G may be used with only means C', and then only if components D and E are not present.

The first three claims in the application are as follows:

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

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

- (A) A pickle machine consisting essentially of A, B, means C' for performing a function, D, and G.
- (B) A pickle machine as claimed in Claim 2, further comprising E.
- (C) A pickle machine as claimed in Claim 1, further comprising D.
- (D) A pickle machine as claimed in Claim 2 or 3, wherein means C is C", and further comprising G.
- (E) A pickle machine as claimed in Claims 1, 2 or 3, further comprising G.

17. You are a sole patent practitioner. You have just finished reading the opinion of the Court of Appeals for the Federal Circuit in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, wherein the Federal Circuit held that patent claims directed to “a data processing system for managing a financial services configuration of a portfolio . . .” were directed to statutory subject matter under 35 U.S.C. § 101. Convinced that your background as a computer programmer and electrical engineer will now be more in demand as a result of the *State Street Bank* decision, you decide to place an advertisement in *PC Magazine*. Your advertisement reads as follows:

INVENTOR NEWSFLASH!!! The highest patent court in the land has just ruled that computer programs can be patented. Don’t miss this opportunity to make millions on your invention. To obtain a patent at a reasonable cost, call 1-888-DO IT NOW! Free initial consultation.

Would your advertisement violate the PTO Code of Professional Responsibility?

- (A) Yes. Free consultations are not permitted.
- (B) No. You have not given anything of value to *PC Magazine* for recommending your services.
- (C) No. The PTO Code of Professional Responsibility permits advertising in magazines.
- (D) Yes. The advertisement does not indicate that you are a registered patent agent.
- (E) Yes. The advertisement does not include your name.

18. Inventors Beavis and Barbara mailed their complete provisional patent application to the PTO via first class mail on Tuesday, January 13, 1998, with a certificate of mailing. The application was received in the PTO on Friday, January 16, 1998. In late December 1998, Beavis and Barbara acquired financing for their invention. Encouraged by their good fortune, Beavis and Barbara hire a patent attorney to file a patent application for them. It is Monday, January 4, 1999, and you are the patent attorney hired by Beavis and Barbara. What is the latest date that a nonprovisional patent application can be filed claiming the benefit of Beavis and Barbara’s earlier filed provisional patent application?

- (A) Saturday, January 16, 1999, via “Express Mail” date stamped as such in accordance with 37 CFR § 1.10.
- (B) Tuesday, January 13, 1999, via “Express Mail” date stamped as such in accordance with 37 CFR § 1.10.
- (C) Tuesday, January 13, 1999, via hand delivery to the PTO.
- (D) Friday, January 15, 1999, via facsimile transmission.
- (E) Friday, January 15, 1999, with a certificate of mailing.

19. Which of the following statements, if any, are *true* regarding representations to the Patent and Trademark Office under 37 CFR § 10.18 and 37 CFR § 1.4(d)(2)?

(I) Practitioners are required to advise clients regarding the sanctions which apply for knowingly and willfully concealing a material fact in papers submitted to the PTO.

(II) Every paper filed by a practitioner must be personally signed by the practitioner, except those required to be signed by the applicant or party.

(III) Applicant has a duty to conduct a prior art search as a prerequisite to filing an application for patent.

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

20. A parent application A was filed on September 9, 1988, and became abandoned on October 19, 1993. Application B was filed on October 21, 1993, and referred to application A as well as claimed the benefit of the filing date of application A. Application B issued as a patent on June 17, 1997. Application C was filed on October 29, 1993, and referred to application B as well as claimed the benefit of the filing date of application B. Application D was filed on December 20, 1996. Application D referred to application B and claimed the benefit of the filing date of application B. Both applications C and D were abandoned on July 22, 1998. Application E was filed on July 22, 1998 and is drawn to the same invention as claimed in applications C and D. Application E claims the benefit of the filing dates of applications A, B, C, and D, and makes reference to all preceding applications. The earliest effective filing date of application E with respect to any common subject matter in the prior applications is:

- (A) October 21, 1993
- (B) December 20, 1996
- (C) October 29, 1993
- (D) September 9, 1988
- (E) July 22, 1998

21. Mike, an avid cyclist, has developed an invention relating to a bicycle having a “shaped handlebar” which provides improved aerodynamic properties for the bicycle. The invention is described in Mike’s pending U.S. patent application. The “shaped handlebar” is disclosed as being “Y” shaped. The application as filed, however, contained only a single claim (Claim 1) to the bicycle having a “shaped handlebar”. Claim 1 was properly rejected under 35 U.S.C. § 102(b) as anticipated by a U.S. patent to Lois which discloses a “V” shaped handlebar on a bicycle. Claim 1 was amended to add a bicycle wheel structure not disclosed or suggested by the Lois patent. Dependent Claims 2 and 3 were added to add further limitations to the invention. Claim 2 is dependent from Claim 1 and further defined the handlebar as being “Y” shaped. Claim 3 is also dependent from Claim 1 and further defined the handlebar as being “U” shaped. Which of the following statements is true?

- (A) Claim 3 would be unpatentable under the second paragraph of 35 U.S.C. § 112 as being indefinite.
- (B) Claim 2 would be unpatentable under the fourth paragraph of 35 U.S.C. § 112 because it does not further limit the subject matter of independent Claim 1.
- (C) Claim 3 would be unpatentable under the first paragraph of 35 U.S.C. § 112 since the description requirement is not satisfied.
- (D) Claim 2 would be unpatentable under 35 U.S.C. § 132 as being drawn to new matter.
- (E) Claims 2 and 3 would be unpatentable under 35 U.S.C. § 102(b) as being anticipated by the Lois patent.

22. Which of the following does **not** have to be included as part of a request for reexamination of a patent filed by the patent owner?

- (A) The entire specification, claims, and drawings of the patent for which reexamination is requested in cut-up form.
- (B) Proposed amendments to the patent claims for which reexamination is requested.
- (C) A copy of every patent or printed publication relied upon as raising a substantial new question of patentability.
- (D) A statement pointing out each substantial new question of patentability based on prior patents and printed publications.
- (E) An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested.

23. Grish, Dersh, and you are registered practitioners and partners in a law firm. You prepared and filed in the PTO a patent application for Inahurry, your client. Inahurry has successfully marketed the claimed invention. Financial success of the invention is a real possibility. The application was filed with a combined Declaration and Power of Attorney signed by Inahurry appointing you, Grish, and Dersh as Inahurry's attorneys to prosecute the application. All of the claims in the application were rejected in the first Office action. After you filed a timely reply to the first Office action, the examiner issued a second Office action dated January 13, 1999, in which he made a final rejection of the claims, and set a three month shortened statutory period for reply. Promptly after receipt of the second Office action, you notified Inahurry of the action and possible replies. Inahurry, who is not well versed in patent practice and procedure, but who is dissatisfied with the course of prosecution with the application, sends you a letter dated April 5, 1999, discharging you, Grish, and Dersh. What are your ethical obligations as a result of Inahurry's letter?

- (A) You must file with the Commissioner by July 13, 1999, a request to withdraw signed by you on behalf of yourself, Grish, and Dersh; and take reasonable steps to avoid foreseeable prejudice to Inahurry's rights, including giving due notice to Inahurry of the request, the period for reply, the availability of extensions of time to reply and fees for the same, and delivery to Inahurry of all papers and property to which Inahurry is entitled, and refund any unearned fees.
- (B) You must obtain from the Commissioner approval to withdraw at least thirty days before the expiration of the statutory period for reply, give due notice to Inahurry of the request, and deliver to Inahurry all papers and property to which Inahurry is entitled, and refund any unearned fees.
- (C) You must continue to prosecute the application until Inahurry files a revocation of the power of attorney in the PTO and it is approved by the Commissioner.
- (D) You have an ethical obligation to talk to Inahurry and find out why he is dissatisfied with your firm and to persuade him to let your firm continue to represent him before the PTO.
- (E) You have an ethical obligation to continue to prosecute the application because Inahurry is not well versed in patent practice and procedure, and Inahurry's financial success will depend on securing a patent.

24. The first three claims in a pending patent application read as follows:

1. A widget comprising A, B, and C.
2. A widget as claimed in Claim 1, further comprising D.
3. A widget as claimed in Claims 1 or 2, further comprising E.

The application further discloses element G which can be combined with any combination of elements A, B, C, D, and E to form the widget. Which of the following claims would be a correct form for Claim 4?

- (A) A widget as claimed in Claims 1, 2, and 3, further comprising G.
- (B) A widget as claimed in Claim 2, further comprising D.
- (C) A widget as claimed in Claim 3, further comprising D.
- (D) A widget as claimed in Claims 1 or 2, further comprising G.
- (E) A widget as claimed in Claims 1, 2, or 3, further comprising G.

25. Bert and Ernie are joint inventors of a widget that automatically adjusts television volume levels during commercial breaks. A nonprovisional patent application was filed on October 15, 1998, and a first Office action on the merits was mailed on January 11, 1999. A reply was filed on January 28, 1999, and a Notice of Allowance was mailed on February 26, 1999. The Issue Fee has not been paid. What is the last day that Bert and Ernie can file a properly drafted Information Disclosure Statement (IDS) without having to pay a fee and to ensure that the information submitted in the IDS would be considered by the examiner?

- (A) Friday, January 15, 1999, via facsimile with a Certificate of Transmission
- (B) Sunday, January 10, 1999, via facsimile with a Certificate of Transmission
- (C) Thursday, January 28, 1999, via first class mail with no Certificate of Transmission
- (D) Friday, January 15, 1999, via "Express Mail Post Office to Post Office" with a Certificate of Express Mailing
- (E) Thursday, February 25, 1999, via facsimile with a Certificate of Transmission but without a statement that each item cited in the IDS was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to submission of the IDS

26. A double patenting issue can be raised _____

- I. between two or more pending applications.
- II. in a reexamination proceeding.
- III. between a pending international application which has not yet entered the national stage in the United States and a patent.
- IV. between three pending applications and a patent.

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

27. On April 3, 1997, Priscilla discovered a process for making a new composition by heating an aqueous mixture of a resin and a metal salt. Priscilla filed a patent application on July 28, 1997, which issued as a patent on January 19, 1999. The patent claims were directed only to the process for making the composition. Priscilla's patent discloses, but does not claim, the composition. On September 19, 1998, Bruce discovered that Priscilla's composition could be made by a different process comprising the steps of reacting a resin, a metal oxide, and an acid in a nitrogen atmosphere. On January 11, 1999, Bruce filed an application in the PTO which claims the composition and his method of making the composition. All work by Priscilla and Bruce was done in this country. Bruce's work is independent of and not derived from Priscilla. Bruce and Priscilla have never been employed by the same employer. The examiner rejected Bruce's composition claims over Priscilla's patent under 35 U.S.C. § 102. The rejection is:

- (A) improper because Priscilla discloses a process which is different from the process used by Bruce to make the composition.
- (B) proper because Priscilla's composition was known by others in this country before the invention thereof by Bruce.
- (C) improper because Bruce filed his application before Priscilla's patent issued.
- (D) proper because Priscilla discloses, but does not claim the composition, and has an earlier filing date than Bruce.
- (E) (B) and (D).

28. Inventor Dan invented Y in the United States on February 5, 1998, and hired practitioner P to prepare and file a provisional application. On March 6, 1998, P filed a provisional patent application in the PTO. P received a Notice to File Missing Parts dated June 5, 1998, because the appropriate filing fee was not filed. The Notice set a period for reply which was two months from the date of the Notice. The filing fee and required surcharge were not filed in the PTO. The provisional patent application became abandoned. A Notice of Abandonment, dated August 10, 1998, was duly received by P's secretary in P's office, and P's secretary placed the notice in Dan's file. On March 3, 1999, Dan furnished P with a copy of a publication by Smith dated March 1, 1998, fully describing Y, and its method of manufacture. On March 4, 1999, P reviewed Dan's file and found the two notices. To properly protect Dan's patent rights, the most appropriate course of action for P to take is to _____

- (A) file in the PTO on Friday, March 5, 1999, a nonprovisional application claiming Y, and file a copy of the Smith publication, and an explanation of the relevance of the Smith publication.
- (B) deposit with the U.S. Postal Service as "Express Mail" in accordance with 37 CFR § 1.10, on Saturday, March 6, 1999, a nonprovisional application which claims Y, a copy of the Smith publication, and an explanation of the relevance of the Smith publication.
- (C) file in the PTO on Friday, March 5, 1999, another provisional application claiming the benefit of the filing date of the March 6, 1998, provisional application. For the March 6, 1998, provisional application, file the filing fee and surcharge, the appropriate petition and fee to revive the provisional application, a statement by P that the abandonment of the provisional application was unintentional, a copy of the Smith publication, and an explanation of the relevance of the Smith publication.
- (D) deposit in the U.S. Postal Service as "Express Mail" in accordance with 37 CFR § 1.10 on Saturday, March 6, 1999, a nonprovisional application claiming Y, and claiming the benefit of the filing date of the provisional application under 35 U.S.C § 119(e) along with a copy of the Smith publication, and an explanation of the relevance of the Smith publication. Also, in the provisional application, file the filing fee and surcharge for the provisional application along with the appropriate petition and fee to revive the provisional application as unintentionally abandoned, and a statement by P that the abandonment of the provisional application was unintentional.

- (E) file in the PTO on Monday, March 8, 1999, a nonprovisional application claiming Y and claiming benefit of the filing date of the provisional application under 35 U.S.C. § 119(e), and also file the filing fee and surcharge for the provisional application along with the appropriate petition and fee to revive the provisional application as unintentionally abandoned, a statement by P that the abandonment of the provisional application was unintentional, a copy of the Smith publication, and an explanation of the relevance of the Smith publication.

29. On April 1, 1999, Inventor Dave filed a patent application claiming a pancake flipper. To fully describe the pancake flipper, Dave refers to a February 1999 issue of a cooking magazine. The examiner objected to the specification on the ground that it improperly incorporated the material of the publication by reference. Which of the following actions would accord with proper PTO practice and procedure in overcoming the objection?

- (A) Amend the specification to include the material incorporated by reference.
- (B) File a declaration executed by Dave containing the essential material and stating that the material consists of the same material incorporated by reference.
- (C) Abandon the application and file a new application incorporating by reference Dave's prior application.
- (D) File an amendment which amends the specification to include the material incorporated by reference and file a petition to the Commissioner stating that the incorporation by reference was inadvertent with the proper fee.
- (E) File an amendment to the specification to include the material incorporated by reference, and accompany it with an affidavit executed by Dave stating that the amendatory material consists of the same material incorporated by reference.

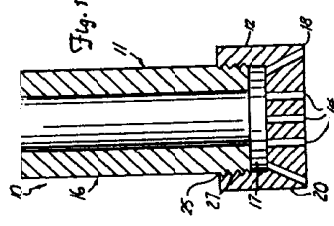
Answer Questions 30 and 31 independently of each other and based upon the following information. You have drafted and filed a patent application for JoJo Industries directed to a device for mechanically flushing food storage containers with gases which includes the following disclosure and drawings:

The gas flushing device of the present invention, illustrated generally at 10 in FIG. 1, includes a main body 11 having a piston portion 12 with holes 14 that is securely attached to a piston rod 16. The piston rod 16 is in communication with a source of a flushing gas such as carbon dioxide. The piston rod 16 conveys flushing gas to a chamber 17 in which the flushing gas under pressure exits through holes 14.

In one preferred embodiment, the piston portion 12 of the gas flushing device 10 includes a bottom surface 18 that is substantially circular. The bottom surface 18 of the piston portion 12 is preferably made of a non-stick material such as nylon or teflon. The piston portion 12 also includes a cylindrical side surface 20 that meets the bottom surface 18 at the circumference of the bottom surface 18. For a flat bottom surface 18, the cylindrical surface 20 is substantially perpendicular to the bottom surface 18.

The piston portion 12 also includes at least one hole 14. In one embodiment, the hole 14 is positioned in the bottom surface 18 of the piston portion 12. In another embodiment, the piston portion 12 includes a plurality of holes that are located on the bottom surface 18. In another embodiment, the piston portion 12 includes a plurality of holes that are located on each of the bottom surface 18 and the cylindrical surface 20. The piston portion 12 is securely attached to the hollow rod portion 16 by a threaded section 25 on the piston rod portion 16 that engages a threaded section 27 on the piston portion 12. The piston rod portion 16 may be detached from the piston portion 12 by disengaging the threaded sections, thereby facilitating cleaning of the flushing device 10.

The piston rod portion 16 of the main body 11 shown in FIG. 1 is a hollow rod. The piston rod portion 16 is threadably attachable to and detachable to a source of flushing gas. In one embodiment, the piston rod portion 16 and piston portion 12 are parts of a single substantially hollow main body 11.



The following independent claim is included in the application:

1. A gas flushing device for flushing a container enclosing food comprising a main body (11) that includes a piston portion (12) with at least one hole (14) providing direct contact between the gas and the food, a piston rod portion (16) which is threadably attachable to and detachable to a source of flushing gas and which is securely attached to the piston portion (12), the piston portion (12) having a nonstick surface (18).

30. Which of the following claims, if any, comply with 35 U.S.C. § 112 based upon Jolo's disclosure and independent claim?

- (A) 2. The gas flushing device of Claim 1 wherein said piston portion (16) is attached to said piston rod portion (12) by a threaded section (25) on said piston rod portion (12) that engages a threaded section (27) on said piston rod portion (12).
- (B) 2. The gas flushing device according to Claim 1 wherein said piston portion is made of nylon.
- (C) 2. The gas flushing device of Claim 1 wherein the piston portion includes a bottom surface and a cylindrical side surface bounding the bottom surface.
- (D) 2. The gas flushing device of Claim 1 wherein said hole is positioned in said bottom surface of said piston portion.
- (E) None of the above.

31. Which of the following dependent claims, if any, cover the embodiment described in lines 15-16 of the disclosure?

- (A) 2. A gas flushing device as set forth in Claim 1 wherein the piston portion includes a plurality of holes located on each of said bottom surface and said cylindrical surface.
- (B) 3. A gas flushing device of Claim 2 wherein the piston portion includes a plurality of holes located on each of said bottom surface and said cylindrical surface.
- (C) 2. The gas flushing device of Claim 1 wherein the piston portion includes a cylindrical surface perpendicular to a bottom surface and said piston portion includes a plurality of holes located on each of said bottom surface and said cylindrical surface.
- (D) (A), (B), and (C).
- (E) (A) and (C).

32. XYZ Corporation has hired you to draft and file a patent application relating to a steel alloy. You diligently prepare the application and file it in the PTO on June 23, 1998, naming Baker as the inventor. On February 5, 1999, you receive a first Office action rejecting all the claims under 35 U.S.C. § 102(g)/103 over a patent assigned to XYZ Corporation. Able is the inventor named in the patent. The Able patent was granted on an application filed on June 25, 1996, and issued on January 13, 1998. You can overcome this rejection by _____

- (A) filing an affidavit signed by an officer of the XYZ Corporation averring that both Able and Baker were subject to an obligation of assignment on the date the later invention was made, and stating facts which explain the officer's belief of ownership.
- (B) filing an affidavit by Baker averring common ownership on the date of filing the Able patent application with the necessary fee.
- (C) filing a terminal disclaimer so as not to extend the term of the Baker application beyond that of the Able patent if the Baker application matures into a patent.
- (D) filing a request to suspend the prosecution of the Baker patent application, and petition the Commissioner for a corrected filing receipt dated January 13, 1998, because of common ownership.
- (E) filing a request for reexamination of the Able patent based on prior art references not disclosed by Baker.

33. Inventor Cal files a provisional application in the PTO on June 5, 1997. On June 2, 1998, Cal asks you to prepare and file a nonprovisional utility patent application. On June 3, 1998, you file the nonprovisional utility patent application. On June 5, 1997, you file the nonprovisional utility application with a specific reference to Cal's June 5, 1997, provisional application. A Notice of Allowance is sent on February 3, 1999, and the Issue fee is timely paid on April 1, 1999. The patent will issue on June 1, 1999. When will Cal's patent term begin and end?

- (A) The term will begin on June 1, 1999, and end on June 5, 2017.
- (B) The term will begin on February 3, 1999, and will end on June 5, 2017.
- (C) The term will begin on April 1, 1999, and will end May 1, 2018.
- (D) The term will begin on June 1, 1999, and will end on June 3, 2018.
- (E) The term will begin on February 3, 1999, and will end on June 3, 2018.

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

A steam cooking device comprising:

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

Which of the following is in accord with proper PTO amendment practice and procedure?

- (A) In Claim 1, line 4, after "steam" insert --generator--.
- (B) In Claim 1, line 7, after "inner" insert --panel--.
- (C) In Claim 1, line 6, delete [one], insert --two--, and amend "zone" to read --zones--.
- (D) In Claim 1, lines 3-4, after "chamber" (second occurrence) delete [for receiving] and insert --to produce sufficient quantities of gas and --.
- (E) In Claim 1, line 4, delete "secured within" and insert --attached to--.

35. A Notice of Allowance is dated and mailed on September 25, 1998, to the applicant. In which of the following situations would the issue fee not be considered as timely paid?

- (A) The issue fee is filed in the PTO on Monday, December 28, 1998.
- (B) The issue fee is filed in the PTO on Wednesday, November 25, 1998.
- (C) The issue fee is filed in the PTO on Thursday, March 25, 1999, and is accompanied by a petition to the Commissioner for a three month extension of time, as well as the late payment fee.
- (D) The issue fee is received in the PTO on December 29, 1998, and is accompanied with a certificate of mailing dated Monday, December 28, 1998.
- (E) (A) and (D).

36. Whenever a claim of a patent is held invalid:

- (A) the claim must be disclaimed by the patent owner to avoid invalidity of the remaining claims in the patent.
- (B) a portion of the claim can be disclaimed provided the remaining portion of the claim adequately defines the invention.
- (C) any disclaimer of the claim shall be in writing, but need not be recorded in the PTO.
- (D) and the invalid claim is to a composition of matter, the claims to a biotechnological process which result in that composition of matter will also be held invalid.
- (E) None of the above.

37. Which of the following statements, if any, regarding amendments to claims in a reexamination proceeding are true?

- (A) If copies of the printed patent are used to amend the claims, additions to the claims are indicated by carets.
- (B) Brackets may not be used in amending claims if more than 5 words are being inserted into the claim.
- (C) Additions to amended claims are indicated by underlining, and new claims may be added, if and only if, an equal number of existing claims are canceled.
- (D) A patent claim should be canceled by a statement canceling the patent claim and renumbering any new claim to have the number of the canceled claim.
- (E) A previously proposed new claim should be canceled by a statement canceling the proposed new claim without presentation of the text of the previously proposed new claim.

38. You are a registered patent agent representing a corporate client. An appeal is taken from the examiner's final rejection of Claims 1-8 of your client's nonprovisional patent application. Independent Claim 1 and its dependent Claims 2-4 stand rejected under 35 U.S.C. § 102(b) based on a U.S. patent to X. Independent Claim 5, independent Claim 6 and its dependent Claims 7-8 stand rejected under 35 U.S.C. § 103 based on a U.S. patent to Y in view of a U.S. patent to Z. None of the dependent claims are multiple dependent claims. The subject matter of Claims 1, 2, 3, 5, 6, and 8 is very important to

your client and you consider each of these claims to be separately patentable over the art applied by the examiner in rejecting these claims. In your Appeal Brief, which of the following courses of action, if any, would be the most appropriate to follow on behalf of your client?

- (A) Specify that dependent Claims 2-4 and 7-8 stand or fall together with their respective independent Claims 1 and 6, and present reasons as to why independent Claims 1, 5, and 6 are considered separately patentable.
 - (B) Point out the errors in the examiner's rejection of Claims 1-3 and how the specific limitations of Claims 1-3 are not shown in X's patent. Point out the errors in the examiner's rejection of Claims 5, 6, and 8 and how Y and Z, taken as a whole, do not suggest the claimed subject matter of Claims 5, 6, and 8.
 - (C) Point out that dependent Claims 4 and 7 stand or fall with their respective independent Claims 1 and 6, and present arguments as to the separate patentability of each of Claims 1, 2, 3, 5, 6, and 8.
 - (D) Argue the importance of each claim to your client, emphasizing the differences in what independent Claims 1, 5, and 6 cover, and state how the examiner erred in relying on X, Y, and Z's patents.
 - (E) All of the above.
39. You are prosecuting a patent application in which there are two named inventors. You received a notice of allowance in the patent application. However, before the Issue fee became due, one of the named inventors died. Which of the following statements is **true** with respect to the application as a consequence of the death of the inventor?
- (A) A new power of attorney must be submitted so that you can continue to represent the remaining inventor.
 - (B) The application is automatically abandoned upon the death of the inventor.
 - (C) A new application must be filed naming the heirs of the deceased inventor and the remaining inventor.
 - (D) The executor or administrator of the deceased inventor must intervene to prevent the application from being withdrawn from issue.
 - (E) The application matures to a patent after timely payment of the required fees.

40. You are a registered practitioner and you have filed a patent application in the PTO on behalf of your client, Wannaberich, on January 7, 1998. In the first Office action, the examiner made a restriction requirement. Although your client disagrees with the restriction, you have made a provisional election with traverse and vehemently argue the restriction requirement. In the next Office action, the restriction is made final and an action on the merits follows. The application is eventually allowed. The client now wants to pursue the non-elected invention. You file a divisional application directed to the non-elected invention before the parent application issues as a patent. In the first Office action in the divisional application, the examiner rejects the claims on the grounds of obviousness-type double patenting over the patent which issued from the parent application. What should be the most appropriate reply to the rejection?

- (A) File a terminal disclaimer to obviate the double patenting rejection.
- (B) Amend the claims in the pending application to overcome the rejection.
- (C) File a 37 CFR § 1.132 antedating affidavit.
- (D) Request reconsideration and point out that it is improper to use the parent patent in an obviousness-type double patenting rejection when a restriction requirement has been made by the examiner in the parent application.
- (E) File a petition under 37 CFR § 1.183 to the Commissioner.

41. Petitions under 37 CFR § 1.48 are generally decided by the primary examiner except:

- (A) When the application is involved in an interference.
- (B) When the application is a national stage application filed under 35 U.S.C. § 371.
- (C) When accompanied by a petition under 37 CFR § 1.183 requesting waiver of a requirement under 37 CFR § 1.48(a) or (c), e.g., waiver of the statement of lack of deceptive intent by an inventor to be added or deleted, or waiver of the reexecution of the declaration by all of the inventors.
- (D) When a second conversion under 37 CFR § 1.48(a) is attempted.
- (E) All of the above.

42. The examiner determined that amended Claim 1 contains new matter and rejected amended Claim 1. The claim was added by an amendment which was filed after the filing date of the application. Which of the following identifies the proper basis for the rejection of amended Claim 1 and the action which should be taken by the applicant to overcome the rejection?

- (I) Claim 1 is rejected under 35 U.S.C. § 112, first paragraph. Applicant should amend the specification to include the new matter therein so as to provide antecedent support for the claim.
- (II) Claim 1 is rejected under 35 U.S.C. § 132. Applicant should cancel the claim.
- (III) Claim 1 is rejected under 35 U.S.C. § 112, first paragraph. Applicant should cancel the claim.
- (IV) Claim 1 is rejected under 35 U.S.C. § 132. Applicant should file a declaration in accordance with 37 CFR § 1.63.

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

43. Which of the following phrases, when appearing in a claim, would render the claim indefinite?

- (A) A claim to a bicycle that recited "said front and rear wheels so spaced as to give a wheelbase that is between 58 percent and 75 percent of the height of the rider that the bicycle was designed for."
- (B) A claim limitation specifying that a certain part of a pediatric wheelchair be "so dimensional as to be insertable through the space between the doorframe of an automobile and one of the seats."
- (C) A claim limitation defining the stretch rate of a plastic as "exceeding about 10% per second."
- (D) (A) and (B).
- (E) (A), (B), and (C).

Both questions 44 and 45 are based on the following fact pattern:

B filed a patent application on March 31, 1997, for an ice cream machine. Discovering an added feature that improved productivity, B filed a CIP application on May 14, 1997. Thereafter, B abandoned the application filed on March 31, 1997. On June 30, 1998, a patent was granted to B for his invention in the CIP application. On March 1, 1999, B realizes that he is claiming less than he is entitled to in view of the added feature in the CIP application. B is worried that this will hurt his upcoming negotiations to assign his patent rights to Mega Corporation. B comes to you, a registered patent practitioner, on March 2, 1999, for advice regarding how to file an application for reissue.

44. What is the latest date that B can file an application for reissue and be entitled to seek enlargement of the scope of the claims of the original patent?

- (A) June 29, 2000
- (B) May 14, 1999
- (C) March 31, 1999
- (D) June 30, 2000
- (E) None of the above

45. What documents must be filed as part of B's application for reissue in order to be granted a filing date?

- (I) Reissue Oath or Declaration
- (II) An offer to surrender
- (III) Filing fee
- (IV) Written Consent of Mega Corp.
- (V) A specification, claims and any required drawings.

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

46. The claims in an application filed on behalf of McTeal were rejected as being unpatentable under 35 U.S.C. § 103 over Gage in view of Nell. McTeal gave you, a registered practitioner, power of attorney to prosecute her application. Which one of the following items of information available to you would be relevant to overcoming the rejection of the claims without modifying or amending the claims?

- (A) Gage and Nell do not teach or suggest feature A of McTeal's invention which is set forth in each of the drawings and in the working examples in McTeal's application, but which is not recited in any of the rejected claims.
- (B) In the opinion of Billy, a noted expert in the field, McTeal's invention is patentable because it has revitalized the industry and Billy has nominated McTeal to receive the prestigious Phrog Foundation Award for Excellence.
- (C) McTeal's invention can be shown to possess unexpected superior properties over the prior art.
- (D) Gage was published 50 years before Nell and therefore contains no specific reference to Nell suggesting that his invention can be modified in the manner suggested by the Examiner.
- (E) The teachings of Gage and Nell, taken singularly or combined, would not be followed by one of ordinary skill in the art because it would be cost prohibitive to do so.

47. Which of the following must be filed to obtain a filing date for a Continued Prosecution Application?

- (I) A copy of the originally filed specification, claims and drawings.
- (II) A newly executed oath or declaration signed by all the originally named inventors.
- (III) The filing fee.
- (IV) A request, on a separate paper, for an application under 37 CFR § 1.53(d) in compliance with that paragraph.

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

48. Patent practitioner Luke filed a patent application in the PTO on behalf of his client Vader which contained three original claims directed to Vader's invention and which were fully supported by the specification. The three original claims read as follows:

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

The examiner issued a rejection of Claim 3 under 35 U.S.C. § 112, second paragraph, citing the improper dependency of the claim. In the absence of issues of supporting disclosure, which of the following proposed amendments will overcome the rejection?

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

49. You are a registered practitioner and Henry has come to you to determine whether he has a patentable invention. He discloses to you that he has developed a composition that can be used as bait for a conventional mousetrap. He explains to you that his composition is so effective that one need only wait minutes to lure mice to the trap. You explain to Henry that you cannot give a patentability opinion until after a preliminary search has been made of the prior art. You have a search made and find that Henry's composition is a well known pork barrel lubricant that has been in public use for over 20 years. What should be your advice to Henry?

- (A) File a U.S. patent application claiming the composition as mouse bait.
- (B) File a U.S. patent application with claims directed to a method of using the composition as bait.
- (C) Explain that it would be impossible for any claims to the process of using the composition as mouse bait to be allowed under the current guidelines of the PTO.

- (D) File a provisional patent application directed only to the composition in order to gain a competitive advantage for one year. Within one year of filing the provisional application, recommend that Henry file a nonprovisional application claiming the composition.
- (E) None of the above.

50. Your client has invented a widget consisting essentially of an amplifier having a voltage of 100 to 300 amps, preferably 250 amps, and a woofer having a wattage of 400 to 450 watts, preferably 425 watts. You draft a patent application directed to your client's invention and satisfying the requirements of 35 U.S.C. § 112. You draft the following independent claim:

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

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

- (A) 2. The widget of Claim 1 wherein the amplifier has a voltage of up to 300 amps.
- (B) 2. The widget of Claim 1 wherein the woofer has a wattage of 425 to 450 watts.
- (C) 2. The widget of Claim 1 wherein the amplifier has a voltage of 300 amps and the woofer has a wattage between 430 and 450 watts.
- (D) 2. A widget of Claim 1 further comprising an amplifier having a voltage of at least 250 amps and a woofer having a wattage of at least 425 amps.
- (E) (A) and (D).

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

APRIL 21, 1999

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

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

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

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO

Answer questions 1 and 2 based on the following facts:

Registered patent attorneys, Will, Able and Fleet, are partners in their own California law firm specializing in patent law. As luck would have it, a PTO filing deadline falls due for each partner on Friday, February 12, 1999. Having to forego their weekly Friday afternoon discussion of the MPEP, all three partners are scrambling to finish their papers. Will is drafting a Continued Prosecution Application (CPA) under 37 CFR § 1.53(d) which must be filed by Friday, February 12, 1999. Having just received the client's instructions that morning, Able is replying to a Final Office action dated August 12, 1998, which set a three month shortened statutory period for reply. Fleet, working hard to satisfy a forgetful, new client, is putting the finishing touches on a nonprovisional patent application based on a provisional application his new client had filed on February 12, 1998. Finishing their work at 8:30 p.m. Pacific time, all three partners head to the mailroom. There is only one facsimile machine. With their deadline fast approaching, Will and Able begin to argue about who should use the facsimile machine first to send their papers to the PTO. A complete transmission of Able's amendment would take fifteen minutes. A complete transmission of Will's CPA would take ten minutes. Thankful that they had been studying their MPEP, Will and Able come to an agreement. At exactly 8:40 p.m. Pacific time, a first facsimile transmission is sent to the PTO from Will and Able's firm.

1. Which one of the following choices outlines the best course of action taken by Will and Able so that both Will and Able's documents received a Friday, February 12, 1999, filing date?

- (A) Will files his CPA via facsimile at 8:40 p.m. Pacific time with all the necessary papers including a Certificate of Transmission. The CPA is received in the PTO exactly ten minutes later. Able files his amendment via facsimile at 8:50 p.m. Pacific time with all the necessary papers including a Certificate of Transmission which states the date of transmission. Able's amendment is received in the PTO exactly fifteen minutes after he sent it.
- (B) Able files his amendment via facsimile at 8:40 p.m. Pacific time with all the necessary papers including a Certificate of Transmission. The amendment is received in the PTO exactly fifteen minutes later. Will files his CPA via facsimile at 8:55 p.m. Pacific time with all the necessary papers including a Certificate of Transmission which states the date of transmission. Will's CPA is received in the PTO exactly ten minutes after he sent it.

- (C) Will files his CPA via facsimile at 8:40 p.m. Pacific time with all the necessary papers including a Certificate of Transmission. The CPA is received in the PTO exactly ten minutes later. After a quick conference call with his client about the amendment, Able files the amendment via facsimile at 9:10 p.m. Pacific time with all the necessary papers but fails to include a Certificate of Transmission. Able's CPA is received in the PTO exactly fifteen minutes after he sent it.
- (D) (A) and (B).
- (E) None of the above.

2. At 8:45 p.m. Pacific time that same day, Fleet rushes to the nearest United States Post Office (USPS) down the street to send his nonprovisional patent application with all the necessary papers to the PTO. What is the best action for Fleet to take to receive a Friday, February 12, 1999, filing date?

- (A) Send the application with a Certificate of Mailing via first class mail no later than 11:59 p.m. Pacific time on Friday.
- (B) Deposit the application directly with an employee of the U.S. Postal Service by "Express Mail Post Office to Post Office" at 8:59 p.m. Pacific time.
- (C) Deposit the application directly with an employee of the U.S. Postal Service by "Express Mail Post Office to Addressee" no later than 11:59 p.m. Pacific time.
- (D) Send the application via "Federal Express" before 11:59 p.m. Pacific time.
- (E) (B) and (C).

3. In addition to complying with 37 CFR § 1.4(d)(2), which of the following documents, if any, must also contain a separate verification statement?

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

4. In early 1997, Goforgold, a company based in Australia, developed a widget with increased reflective properties. Goforgold filed a patent application in the Australian Patent Office on January 8, 1997, and filed a corresponding application in the USPTO on January 5, 1998. All research activities for the inventions disclosed and claimed in the U.S. and Australian applications took place in Australia. The U.S. patent application contains five claims:

1. A widget comprising elements A and B.
2. A widget according to Claim 1 wherein the widget further includes element D.
3. A widget comprising elements A and C.
4. A widget according to Claim 3 wherein the widget further includes element E.
5. A widget comprising elements A, B, and C.

The Australian application only supports claims 1, 2, and 5 of the U.S. application. During the course of prosecution of the U.S. application, the examiner properly rejected all of the claims under 35 U.S.C. § 102(e) as being anticipated by a U.S. patent assigned to Gotthesilver. The Gotthesilver patent was granted on October 6, 1998, on a U.S. application filed on June 15, 1997. The Gotthesilver patent specifically describes, but does not claim, the widget in claims 1-5 of the U.S. application filed by Goforgold. The subject matter of the Gotthesilver patent was reduced to practice in Flushing, New York as of February 12, 1997. Which of the following proposed arguments or actions would properly overcome the examiner's § 102(e) rejection with respect to all the claims?

- (A) File an affidavit under 37 CFR § 1.132 swearing behind the claims of the Gotthesilver patent by relying on the 1997 research activities of Goforgold in Australia.
- (B) File a claim for a right of priority based on the application filed in Australia along with a certified copy of the Australian patent application and canceling Claims 3 and 4.
- (C) File a claim for a right of priority based on the application filed in Australia along with a certified copy of the Australian patent application.
- (D) File an affidavit under 37 CFR § 1.132 swearing behind the February 12, 1997, reduction to practice date of the Gotthesilver patent.
- (E) File a terminal disclaimer.

5. In which of the following situations would a petition to make special **not** be granted?

- (A) The applicant files a petition with the petition fee requesting special status and stating that small entity status has been established; that the subject of the biotechnology patent application is a major asset of the small entity; and that the development of the technology will be significantly impaired if examination of the application is delayed, including an explanation of the basis for making the statement.
- (B) Applicant's invention materially enhances the quality of the environment. Applicant files a petition that the application be accorded special status and includes a statement explaining how the invention contributes to the restoration of a basic life-sustaining element. No fee is included.
- (C) Applicants have filed a request that their application which is directed to an invention for a superconductive material be accorded special status. Applicants' request is accompanied by a statement that the invention involves superconductivity. No fee is included.
- (D) Applicant's invention is directed to a system for detecting explosives. Applicant files a petition for special status which is accompanied by a statement explaining how the invention contributes to countering terrorism. No fee is included.
- (E) None of the above.

6. Which of the following fees are reduced for small entities?

- I. Patent application filing fees
- II. Petition for an extension of time fees
- III. Petition to suspend the rules fees
- IV. Patent Issue fees
- V. Certificate of Correction fees

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

The answer to each of questions 7-11 is based upon the facts set forth in the paragraph below. Answer each question independently of the others.

You are a registered patent agent with an office in Buffalo, New York. On January 13, 1998, Murphy, a resident of Canada, came to your office for purpose of obtaining a U.S. patent on her invention. She tells you that she first conceived her invention at her home in Ontario on December 18, 1996, and that she reduced it to practice on January 10, 1997, at her home. On January 13, 1998, Murphy provided you with a detailed written description fully disclosing her invention. You diligently proceeded to prepare the application. You filed the application in the PTO on February 12, 1998. Consider each of the situations presented in the questions below in light of the facts presented above and determine which paragraph of 35 U.S.C. § 102, if any, would prevent Murphy from obtaining a U.S. patent.

7. Murphy's invention is described and claimed in a U.S. patent to O'Malley granted on February 9, 1999, on a national stage application filed in the United States on February 17, 1998, based on a PCT international application filed in France on November 13, 1997. O'Malley satisfied the requirements of 35 U.S.C. § 371(c)(1), (2), and (4) on February 17, 1998.

- (A) 35 U.S.C. § 102(b).
- (B) 35 U.S.C. § 102(c).
- (C) 35 U.S.C. § 102(e).
- (D) 35 U.S.C. § 102(f).
- (E) None of the above.

8. Murphy patented her invention in Canada on December 30, 1997 on a Canadian patent application filed on February 10, 1997.

- (A) 35 U.S.C. § 102(a).
- (B) 35 U.S.C. § 102(b).
- (C) 35 U.S.C. § 102(d).
- (D) 35 U.S.C. § 102(e).
- (E) None of the above.

9. In January of 1997, Murphy sold prototypes of her invention in Canada.

- (A) 35 U.S.C. § 102(a).
- (B) 35 U.S.C. § 102(b).
- (C) 35 U.S.C. § 102(f).
- (D) 35 U.S.C. § 102(g).
- (E) None of the above.

10. After the application was filed in the U.S., Murphy admitted that in order to make the claimed invention operative, the mechanic who built the prototype of Murphy's invention added a novel feature without consulting Murphy which is included in all the claims of the application.

- (A) 35 U.S.C. § 102(a).
- (B) 35 U.S.C. § 102(b).
- (C) 35 U.S.C. § 102(f).
- (D) 35 U.S.C. § 102(g).
- (E) None of the above.

11. Murphy's invention is described and claimed in a German Gebrauchsmuster petty patent granted on February 11, 1998, based on an application filed by Murphy on February 2, 1997. The German Gebrauchsmuster patent was published on February 14, 1998.

- (A) 35 U.S.C. § 102(b).
- (B) 35 U.S.C. § 102(c).
- (C) 35 U.S.C. § 102(d).
- (D) 35 U.S.C. § 102(e).
- (E) None of the above.

12. Which of the following statements, if any, regarding Secrecy Orders are false?

- (A) A Secrecy Order remains in effect for a period of one year from its date of issuance.
- (B) If the Secrecy Order is applied to an international application, the application will not be forwarded to the International Bureau as long as the Secrecy Order remains in effect.
- (C) If, prior to or after the issuance of the Secrecy Order, any significant part of the subject matter or material information relevant to the application has been or is revealed to any person in a foreign country, the principals must promptly inform such person of the Secrecy Order and the penalties for improper disclosure.
- (D) Use of facsimile transmissions to file correspondence in a Secrecy Order case is permitted so long as it is transmitted to the Office in a manner that would preclude disclosure to unauthorized individuals and is properly addressed.
- (E) (C) and (D).

13. On January 19, 1999, inventor B filed a patent application in the PTO claiming invention X. Inventor B did not claim priority based on a foreign application filed by inventor B on April 3, 1998, in the Patent Office in Japan. In the foreign application, inventor B disclosed and claimed invention X, which inventor B had conceived on August 11, 1997, and reduced to practice on November 5, 1997, all in Japan. The U.S. patent examiner issued an Office action where all the claims in the patent application were properly rejected under 35 U.S.C. § 102(a) and (e) as being anticipated by a U.S. patent granted to inventor Z on September 1, 1998, on a patent application filed in the PTO on December 5, 1997. There is no common assignee between Z and B, and they are not obligated to assign their invention to a common assignee. Moreover, inventors Z and B, independently of each other, invented invention X, and did not derive anything from the other. The U.S. patent to Z discloses, but does not claim, invention X. Which of the following is/are appropriate reply(ies) which could overcome the rejections under §§ 102(a) and (e) when timely filed?

- (A) File an antedating affidavit or declaration under 37 CFR § 1.131 showing conception on August 11, 1997, and actual reduction to practice on November 5, 1997, all in Japan.
 - (B) File a claim for the right and benefit of foreign priority wherein the Japanese application is correctly identified, file a certified copy of the original Japanese patent application, and argue that as a result of the benefit of foreign priority, the U.S. patent is no longer available as a prior art reference against the claims.
 - (C) Amend the claims to require particular limitations disclosed in inventor B's application, but not disclosed or suggested in inventor Z's patent, and argue that the limitations patentably distinguish the claimed invention over the prior art.
 - (D) (A) and (C).
 - (E) (B) and (C).
14. A Certificate of Correction **cannot** be used to correct:
- (A) the failure to make reference to a prior copending application.
 - (B) an incorrect reference to a prior copending application.
 - (C) the omission of an inventor's name from an issued patent through error and without deceptive intent.
 - (D) the omission of a preferred embodiment in the original disclosure overlooked by the inventor which would materially affect the scope of the patent.
 - (E) (A), (B), and (D).

15. In responding to a final rejection of Claims 1 to 5 as being obvious, applicant's patent agent argued that the references applied in the rejection neither taught nor suggested the claimed invention. The examiner issued a Notice of Allowance which included a statement of reasons for allowance. In the statement, the examiner explained her reasons for allowance of the claims. Upon receipt of the statement from the examiner, which of the following, if any, describes the most appropriate course of action the agent may take in reply to the examiner's reasons for allowance?

- (A) The agent may file a reply commenting on the examiner's statement, even though the failure to do so will not give rise to any implication that applicant agrees with or acquiesces in the examiner's reasoning.
- (B) The agent should object to the examiner's statement to avoid any implication that applicant agrees with or acquiesces in the examiner's reasoning.
- (C) Applicant may file comments on the reasons for allowance after payment of the issue fee upon submission of a petition for an extension of time.
- (D) Under current Office policy and procedure, the agent cannot reply to the examiner's statement.
- (E) The agent must file a timely reply to the examiner's statement to enable the examiner to reply to the comments submitted by applicant and to minimize processing delays.

16. Which of the following statements regarding plant patent applications is (are) true?

- (A) Only one claim is necessary and only one claim is permitted.
- (B) The oath or declaration required of the applicant, in addition to the averments required by 37 CFR § 1.63, must state that he or she has asexually reproduced the plant.
- (C) A method claim in a plant patent application is improper.
- (D) Specimens of the plant variety, its flower or fruit, should not be submitted unless specifically called for by the examiner.
- (E) All of the above.

17. The last day of a three month shortened statutory period to reply to a non-final rejection occurs today, April 21, 1999. Your client is overseas and sends you a facsimile asking you to cancel all of the current claims in the application. There is no deposit account. She further advises you that a new set of claims to replace the current claims will be sent to you no later than April 29, 1999. Which of the following would be the most appropriate course of action to take with regard to the outstanding Office action?

- (A) File a request for a one month extension of time today and pay the fee when you file the amendment.
- (B) File an amendment today canceling all claims in accordance with your client's instructions.
- (C) Await receipt of the new claims and then file the amendment and request for reconsideration with the appropriate fee for an extension of time, no more than 6 months from the date of the non-final rejection.
- (D) File a request for reconsideration today and state that a supplemental amendment will be forthcoming.
- (E) File a request for reconsideration today, stating that the rejection is in error because the claims define a patentable invention.

18. Which of the following statements is true respecting product-by-process claims?

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

19. Patent applicant Smith claims “a rotary vane pump having impellers coated with ceramic X for the purpose of preventing cavitation of the impellers.” The examiner rejected the claim under 35 U.S.C. § 103 as being unpatentable over a patent to John in view of a patent to Alex. John teaches a rotary vane pump having impellers coated with epoxy resin for the purpose of preventing corrosion of the impellers. Alex teaches a mixing device having agitator blades coated with ceramic X for the purpose of preventing corrosion of the blades. Alex also suggests that the ceramic X coating material “is useful on various types of pumps for the purpose of preventing corrosion.” The examiner determined that (i) it would have been obvious to one having ordinary skill in the art to substitute the ceramic X coating material taught by Alex for the epoxy resin coating material in John and (ii) the resultant rotary vane pump would have coated impeller blades which would inherently prevent cavitation. The combination of John and Alex:

- (A) cannot support a *prima facie* case for obviousness unless the Alex reference contains a suggestion that ceramic X will cause cavitation.
- (B) cannot support a *prima facie* case for obviousness inasmuch as the discovery that ceramic X prevents cavitation imparts patentability to a known composition.
- (C) may support a *prima facie* case for obviousness even though the Alex reference does not disclose that ceramic X will prevent cavitation or can be used on the impellers of a rotary vane pump.
- (D) cannot shift the burden of proof to the applicant to show that the prior invention lacked the newly discovered property asserted for the claimed invention unless one of the references discloses the property.
- (E) can support a *prima facie* case for obviousness only if both references show or suggest that ceramic X can be used in a rotary vane pump.

20. Claim 1 is independent. Claim 2 depends from Claim 1. Claim 3 depends from Claim 2. Claim 4 depends from Claims 2 or 3. Claim 5 depends from Claim 3. Claim 6 depends from Claims 2, 3 or 5. The application contains one independent claim. How many dependent claims are there for fee calculation purposes?

- (A) 5
- (B) 7
- (C) 8
- (D) 9
- (E) 11

Answer questions 21 and 22 based on the following facts:

Registered patent practitioner P prepares and files a patent application for his Japanese client, XYZ Corp., on October 5, 1998. The application claims a banana peeler device. A Notice to File Missing Parts dated December 7, 1998, is received by P on December 10, 1998. P submits an executed oath, along with the surcharge, in order to fully reply to the Notice to File Missing Parts which is received by the PTO on December 23, 1998. In the first Office action dated January 6, 1999, the examiner rejects all of claims 1-5 as being anticipated by the disclosure of a U.S. patent to Apple. The Apple patent discloses, but does not claim, a banana peeler. The Apple patent issued October 7, 1997, and is based on an application filed on June 26, 1996. On January 20, 1999, P faxes a copy of the Office action and the Apple patent to his client in Japan. There is no common ownership between the prior art patent and XYZ's patent application. On March 20, 1999, XYZ faxed instructions to P which distinguish the claims from the Apple patent and includes a reference to a U.S. patent to Zucchini. XYZ discovered the Zucchini patent in February 1999. The Zucchini patent issued on January 12, 1993, and contradicts the teachings of the Apple patent.

21. On March 20, 1999, XYZ instructs P to file an Information Disclosure Statement (IDS) which includes the Zucchini patent, ten Japanese patents, and a November 13, 1998, magazine article. The magazine article and the ten patents were received from the Japanese Patent Office in XYZ's counterpart foreign application on February 1, 1999. Which of the following actions, if any, taken by P would best comply with PTO practice and procedure?

- (A) File a properly drafted IDS via "Express Mail" in accord with 37 CFR § 1.10 on March 30, 1999, with the fee set forth in 37 CFR § 1.17(p).
- (B) File a properly drafted IDS via first class mail with a Certificate of Mailing dated March 30, 1999, with the required fee and a statement that each item of information was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the IDS.
- (C) File a properly drafted IDS via facsimile with a Certificate of Transmission on March 23, 1999, along with a legible copy of each reference.
- (D) (B) and (C).
- (E) None of the above.

22. Which of the following most correctly sets forth the sections of Title 35 U.S.C. under which XYZ would not be entitled to a U.S. patent based on the Apple patent?

- (A) 102(a)
- (B) 102(c)
- (C) 102(d)
- (D) 102(f)
- (E) 102(g)

23. In a first action on the merits dated February 12, 1997, the examiner (1) rejected all of the claims under 35 U.S.C. § 112, second paragraph; (2) objected to new matter added to the specification by a preliminary amendment; and (3) required a substitute specification that includes a revised summary of invention, abstract, and an additional drawing showing the prior art. You, as a patent practitioner prosecuting the application, disagree with the propriety of the rejection, objection and requirement. Which of the following would be the most appropriate course of action to take to reply to the examiner's action?

- (A) File a petition with the Group Director requesting withdrawal of the examiner's objection to the specification, and suspension of further action on the claims until three months after the petition has been decided.
- (B) File a request for reconsideration and present arguments distinctly and specifically pointing out the supposed errors in the examiner's requirement, rejection, and objection, and otherwise fully reply to the rejection and objection.
- (C) Appeal the objection and requirement of the examiner to the Board of Patent Appeals and Interferences, and request that the final rejection of the claims be suspended until the appeal is decided.
- (D) Amend the claims to overcome the examiner's rejection under 35 U.S.C. § 112, and file a motion to the Board of Patent Appeals and Interferences appealing the examiner's objection to the specification.
- (E) Change the summary of invention to conform to the broadest claim, request reconsideration of the requirement for a substitute specification, request that the requirement for submission of the additional drawings be held in abeyance until after allowance of the application, and generally allege that the claims define a patentable invention.

24. Which of the following statements correctly sets forth the manner in which Inventor Ann, a U.S. citizen, may file documents regarding her international patent application with the United States Receiving Office?

- 4 (A) Where the document is the PCT international application and Ann needs to receive an April 1, 1999, filing date, Ann should file her PCT international application via first class mail with the United States Post Office and include a Certificate of Mailing dated April 1, 1999.
- (B) Where the document is a Demand for international preliminary examination, two weeks before the deadline, Ann should file her Demand by facsimile transmission with a dated Certificate of Transmission.
- (C) Where the document is the PCT international application and Ann needs to receive an April 12, 1999, filing date, Ann should file a copy of her international application via facsimile transmission with a Certificate of Transmission dated April 12, 1999.
- (D) Where the documents are substituted drawing sheets due on April 15, 1999, Ann should file her substitute drawing sheets via facsimile on April 15, 1999.
- (E) All of the above.

25. A multiple dependent claim _____

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

26. A design patent application was filed on July 5, 1995, which issued as a design patent on December 3, 1996. On December 16, 1996, a proper reissue design application was filed. The reissue patent was granted on September 2, 1997. When will the first maintenance fee be due?

- (A) December 2, 2000
- (B) December 16, 1999
- (C) December 3, 1999
- (D) March 3, 2000
- (E) None of the above

27. After one of your client's claims has been allowed, another claim in the same application stands objected to as being a substantial duplicate of the allowed claim, i.e. they both cover the same thing. You and your client agree that the claim is a substantial duplicate. Which of the following could **NOT** overcome the objection?

- (A) Amending the claim objected to in a manner consistent with the specification to have a different scope.
- (B) Amending the allowed claim consistent with the specification to have a different scope.
- (C) Canceling the allowed claim to obviate the objection.
- (D) Filing a divisional application that includes the objected claim.
- (E) Canceling the claim objected to so as to permit issuance of the allowed claim.

28. Which of the following statements regarding reissue applications is **false**?

- (A) If the file record is silent as to the existence of an assignee, it will be presumed that an assignee does exist.
- (B) An examination on the merits of a reissue application will not be made without an offer to surrender the original patent, the actual surrender, or an affidavit or declaration to the effect that the original is lost or inaccessible.
- (C) A broadened claim can be presented after two years from the grant in a broadening reissue which was filed within two years from the grant.
- (D) The filing of a continued prosecution application (CPA) under 37 CFR § 1.53(d) of a reissue application will not be announced in the *Official Gazette*.
- (E) When making amendments to the claims, patent claims must not be renumbered and the numbering of any claims added to the patent must follow the number of the highest numbered patent claim.

29. Employees Larry and Curly work for Taylor, Inc., each with knowledge of the other's work, and with obligations to assign to Taylor inventions conceived while employed by Taylor. Larry invented a novel coating apparatus which utilized a spring released mechanism that worked well at temperatures of at least 32° F. Larry discussed his invention with Curly during work at Taylor. After their discussion, Curly conceived of an improvement and developed a piston activated mechanism for use in Larry's novel coating apparatus. Curly's piston activated mechanism worked extremely well at temperatures between 45 to 60° F. On April 8, 1997, Curly filed a patent application in the PTO disclosing the fact that Larry invented a novel coating apparatus and claiming an improved coating apparatus with a piston activated mechanism. Curly's specification disclosed the excellent results obtained when the piston activated mechanism was used at temperatures between 45 to 60° F. On August 14, 1997, Larry's application claiming the coating apparatus with the spring released mechanism for use at temperatures of at least 32° F. was filed in the PTO. On December 29, 1998, a patent was granted to Larry. In an Office action dated March 18, 1999, the examiner rejected the claims in Curly's application under 35 U.S.C. §§ 102(g)/103 over Larry's patent in view of a patent granted to Moe on August 25, 1992. Larry's patent claims the coating apparatus with the spring released mechanism for operation at temperatures of at least 32° F. The patent to Moe discloses a piston activated mechanism (substantially similar to Curly's piston activated mechanism) in combination with a different coating apparatus. The Moe patent also discloses that the piston activated mechanism would only operate at temperatures below 32° F. The examiner properly found that substitution of the piston activated mechanism of Moe for the spring released mechanism in Larry's coating apparatus would have been obvious. As a registered practitioner hired by Taylor to prosecute both the Larry and Curly applications, which of the following best describes the course of action you should take to provide Taylor with all the patent protection it is entitled to receive?

- (A) Traverse the rejection by arguing that the rejection is improper, and in support thereof, submit an affidavit under 37 CFR § 1.132 signed by an officer of Taylor, Inc. attesting to the fact that at the time the inventions were made, Larry and Curly were obligated to assign their inventions to Taylor, Inc.
- (B) Traverse the rejection by arguing that the rejection is improper and provide an affidavit signed by Larry stating that Curly derived his work from Larry and that both Curly and Larry were under an obligation to assign their inventions to Taylor.
- (C) Traverse the rejection and submit an affidavit signed by Curly under 37 CFR § 1.131 stating that he made his invention in the United States before Larry filed his patent application and that both Larry and Curly were obligated to assign their inventions to Taylor, Inc. at the time the inventions were made.

- (D) Amend the Curly application to claim only a piston activated mechanism which operates at temperatures between 45 - 60° F., and delete the coating apparatus from the claims.
- (E) File a terminal disclaimer to have any patent granted on Curly's application expire on the same date the Larry patent expires.

Questions 30 and 31 are based on the following facts. Each question should be answered independently of the other.

Horatio invented a new widget for vacuum cleaners. You prepared and filed a patent application containing claims 1 through 10 directed to the widget. In a second Office action dated September 10, 1998, the examiner rejected claims 1 through 10 for the second time and on the same grounds and set a three month shortened statutory period for reply. You filed a reply to the second Office action on December 9, 1998. On January 8, 1999, the examiner sent another Office action containing a final rejection of claims 1 through 10 and set a three month shortened statutory period for reply.

30. Horatio asked you to file a Notice of Appeal. In which of the following situations, would the Notice of Appeal be considered **acceptable**?

- (A) A Notice of Appeal signed by you, and the appropriate appeal fee are filed on April 8, 1999. The Notice does not identify the rejected claims appealed.
- (B) A unsigned Notice of Appeal and the appropriate appeal fee is filed on April 8, 1999, and the Notice identifies the rejected claims appealed.
- (C) A Notice of Appeal, signed by you, with the necessary fee for appeal and extension of time, are filed on July 8, 1999, without identifying the rejected claims appealed.
- (D) (A) and (B).
- (E) (A), (B), and (C).

31. An acceptable Notice of Appeal is timely filed in the PTO on March 23, 1999. Absent extraordinary circumstances, which of the following is the **last day** that an appeal brief can be filed if a proper petition and the necessary fees for the brief and extension of time are filed with the brief?

- (A) April 8, 1999
- (B) Monday, October 25, 1999
- (C) August 23, 1999
- (D) Monday, May 24, 1999
- (E) September 23, 1999

32. On a sunny January day in Minnesota, neighbors X and Y working together stumble across a novel means for melting snow with a device that X and Y have jointly invented. Being low on funds to market their invention, X and Y decide to save money and file their own patent application. X and Y decide to file a provisional patent application in order to have more time to market their invention. X and Y carefully prepare all the necessary papers for the filing of their provisional patent application and come up with the money to cover the filing fee. On Saturday, January 9, 1999, X and Y meet at their favorite coffee shop to take a final look at the specification and drawings they had prepared and to prepare a cover letter to accompany their application. In their eagerness to get to the Post Office after drinking two double mocha cappuccinos, the handwritten cover letter prepared by X and Y fails to identify X as an inventor. The cover letter only identifies the application as a provisional patent application; inventor Y's full name, residence and correspondence address; and the title of the invention. Unaware that X has not been identified as an inventor, X and Y make a copy of their application papers and mail the cover letter with the specification, drawings and the proper fee to the Patent and Trademark Office via first class mail that same morning. A huge winter storm is expected to hit Minnesota by dusk and X and Y hurry home to conduct further experiments with their snow melting invention. The papers are received in the Patent and Trademark Office on Monday, January 11, 1999.

Three weeks later, X and Y return to their favorite coffee shop to celebrate the outstanding success of their experiments with their snow melting device during the huge winter storm which hit Minnesota and to discuss the minor adjustment they made to their invention. In reviewing their application papers for the first time since they were mailed, X notices that the handwritten cover letter does not identify him as an inventor, and fails to include his residence and correspondence address. Which of the following is the best action to be taken by X and Y to correct these omissions from their handwritten cover letter in accordance with proper PTO practice and procedure?

- (A) X and Y should timely file an amendment to the provisional patent application to add X as an inventor, accompanied by a petition stating that the error occurred without deceptive intent on the part of X and the appropriate fee.
- (B) X and Y should file an amendment to their provisional patent application which describes the minor adjustment made to the snow melting device and sign the amendment naming X and Y as joint inventors.
- (C) X and Y should file a request for a certificate of correction and with an explanation of how the error occurred without deceptive intent.
- (D) X and Y should file a continuation application with a new declaration signed by X and Y.
- (E) X and Y should timely file a new cover sheet during the pendency of their provisional application which identifies both X and Y as inventors, and provides the title of the

invention, as well as the residences of X and Y and the correspondence address.

33. The claim, “An alloy consisting of 70.5 to 77.5% iron, 15.0 to 17.0% cobalt, 0.5 to 1.0% carbon, up to 2.5% chromium, and at least 7.0% tungsten” is anticipated by a reference disclosing an alloy having:

- (A) 76.0% iron, up to 15.0% cobalt, 0.5% carbon, and 8.5% tungsten.
- (B) 71% iron, 15% cobalt, 1.0% carbon, 1% chromium, 8% tungsten, and 4% nickel.
- (C) 71.3% iron, 15.2% cobalt, 0.9% carbon, 2.6% chromium, and 10% tungsten.
- (D) 76% iron, 15% cobalt, 1.0% carbon, at least 2.0% chromium, and 6% tungsten.
- (E) 72.0% iron, 16.5% cobalt, at least 2.0% carbon, 2.5% chromium, and up to 7.0% tungsten.

34. On January 6, 1999, Doe asked patent agent Bronson to prepare and file a patent application on an automobile jack which Doe had invented. Doe gave Bronson several sketches and a written description of the jack which described and showed the jack as utilizing only a scissors-type lifting mechanism. Bronson prepared a patent application disclosing the scissors-type lifting mechanism based on information provided by Doe. The claims of the patent application recited the lifting mechanism generically as “lifting means” since the specific type of lifting mechanism was not thought by Doe to be critical to the inventive feature of his jack. After Doe reviewed and signed the application, Bronson filed it in the PTO on February 3, 1999. On March 19, 1999, Doe discovered that his jack worked much better with a screw-type lifting mechanism as opposed to the scissors-type mechanism. The screw-type lifting mechanism is not disclosed in the application. Doe immediately informed Bronson of this fact. In reply to the first Office action, Bronson canceled all of the original claims and presented a new claim to the jack which included the provision of the screw-type lifting mechanism. Is the new claim proper at this stage of the prosecution?

- (A) Yes, because the claim particularly points out and distinctly claims the subject matter which Doe regards as his invention or discovery.
- (B) No, because the claim could be properly rejected under 35 U.S.C. § 112, first paragraph.
- (C) Yes, because the claim sets forth the best mode contemplated by Doe for carrying out his invention.
- (D) No, because the claim could be properly rejected under 35 U.S.C. § 132.
- (E) No, because the claim could be properly rejected under 35 U.S.C. § 112, sixth paragraph.

35. On January 7, 1998, you filed a U.S. patent application containing Claims 1 through 8 on behalf of your client, Grumpy. In a first Office action, the examiner rejected Claims 1-8 under 35 U.S.C. § 103 over a U.S. patent to Happy in view of a U.S. patent to Sleepy. The Happy patent issued on January 6, 1998, based on an application filed on June 11, 1996. The Sleepy patent issued in 1950. Which of the following responses would be the most persuasive in having the rejections withdrawn?

- (A) Argue that the claimed invention is patentably distinguishable over the combination of the Happy and Sleepy patents, pointing out the specific language in the claims that is not shown by the combination of the references.
- (B) Argue that the Sleepy patent is outdated and that its teachings are so obsolete that it would no longer be read by one of ordinary skill in the art.
- (C) Argue that the claimed invention is patentably distinguishable from Sleepy, and point out the specific language in the claims that is not shown by Sleepy.
- (D) Argue that the devices disclosed by Sleepy and Happy are not physically combinable.
- (E) Argue that the Happy patent is not prior art because it was not granted more than one year before Grumpy filed his patent application.

36. The specification shall conclude with one or more claims and must set forth:

- (A) the manner of making the invention, the theory of why the invention works, and at least one working example showing how the invention works.
- (B) the manner and process of making and using the invention, a written description of the invention, and the best mode of carrying out the invention.
- (C) a description of the invention, how the invention is distinguishable over the most relevant prior art, and the best mode of carrying out the invention.
- (D) only a full, clear, and concise description of the invention.
- (E) a complete description of the invention, and how to use the invention so that a person having ordinary skill in the art to which the invention pertains would be able to practice the invention.

37. Which of the following statements, if any, is true?

- (A) A claim for a "soap composition comprising a maximum of 0.2 parts by weight of X per part by weight of Y" is anticipated by a soap composition disclosed in a publication as having 5 parts by weight of X per part weight of Y.
- (B) A claim for "a laminate circuit material comprising a sheet of adhesive film, and a sheet of conductive material disposed on said sheet of adhesive film" is **not** anticipated by an article of manufacture consisting of an adhesive film disposed on one surface of a sheet of conductive material and a glass reinforced adhesive film disposed on the opposite surface of said sheet of conductive material."
- (C) An independent Claim 1 for an "article comprising a widget having a coating from 0.05 to 1 mm thickness," and a dependent Claim 2 for "an article according to Claim 1 wherein the coating is 0.3 mm thick," both are anticipated by "a widget having a coating of 0.5 mm thickness" described in a printed publication.
- (D) A claim for a "nickel alloy comprising nickel, chromium, iron and at least one member selected from the group consisting of copper, silver and tin" is anticipated by a printed publication which discloses "an alloy consisting of nickel, silver, chromium, iron, copper, and cobalt."
- (E) None of the above.

38. On Monday, April 5, 1999, an Office action was mailed to practitioner P. The Office action contained a rejection of all claims in the application and set a three month shortened statutory period for reply. The very last day for filing a reply without requesting an extension of time would be _____.

- (A) July 2, 1999
- (B) July 3, 1999
- (C) July 5, 1999
- (D) July 6, 1999
- (E) August 3, 1999

39. Jones invented a widget. She disclosed to her patent agent that the widget can be any combination of colors, the most preferred embodiment being a widget having a blue, orange, yellow or purple color. The agent prepared a patent application which disclosed a widget having a blue, orange or purple color and which included the following claim: "1. A widget having a blue, orange or purple color." On January 8, 1999, Jones reviewed the application and signed the oath. Just after Jones left the agent's office, the agent remembered that Jones had also disclosed to him a yellow widget. The attorney immediately prepared a preliminary amendment which included instructions to amend the specification to also include a yellow widget and to rewrite Claim 1 as follows: "A widget having a blue, orange, yellow or purple color." The specification, oath, and the amendment were mailed to the PTO in the same envelope and were received in the PTO on January 12, 1999. Given these facts, which one of the following statements is true?

- (A) Claim 1 cannot be properly rejected under 35 U.S.C. § 102(a) as being anticipated by a patent to Smith which was filed on March 2, 1997, and issued on August 13, 1998, and which discloses but does not claim, a widget having an orange color.
- (B) Claim 1 can be considered to contain new matter even though the preliminary amendment was filed concurrently with the filing of the specification.
- (C) Claim 1 can be properly rejected under 35 U.S.C. § 112, second paragraph, because the use of the word "or" renders the metes and bounds of the claim indeterminate.
- (D) Claim 1 can be properly rejected on the ground of disclaimer.
- (E) None of the above statements is true.

40. In order to calculate when an appeal brief must be filed, which of the following documents should be used to establish the date that a Notice of Appeal was filed?

- (A) A separate letter sent from the Patent and Trademark Office which acknowledges receipt of your Notice of Appeal.
- (B) A self-addressed postcard included with the filing of your Notice of Appeal which was date stamped and returned to you.
- (C) A copy of the Certificate of Mailing you signed which states the date you deposited the Notice of Appeal via first class mail.
- (D) (A), (B), and (C).
- (E) (B) and (C).

41. Which of the following choices would be considered as independent grounds for filing a reissue application?

- (I) The claims are too narrow or too broad.
- (II) The disclosure contains inaccuracies.
- (III) Applicant failed to or incorrectly claimed foreign priority.
- (IV) The specification contains a plurality of obvious spelling and grammatical errors.
- (V) Applicant failed to make reference to or incorrectly made reference to prior copending applications.

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

42. On April 19, 1999, Inventor Mary hires you for advice on a patent application. Mary informs you that she previously filed a provisional application for her invention on May 1, 1998. However, Mary has since made some improvements that were not described in her provisional application. To fully protect Mary's patent rights, what is the best course of action to recommend to Mary?

- (A) File an amendment in the provisional application on or before May 1, 1999, which describes the improvements made by Mary.
- (B) Immediately file a continued prosecution application based on the provisional application filed on May 1, 1998, and include a preliminary amendment which adds a description of the improvements made.
- (C) File a second provisional patent application which claims the benefit of the May 1, 1998, filing date of the first provisional patent application.
- (D) File a continuation-in-part application as soon as possible which adds a disclosure of the improvements made.
- (E) None of the above.

43. A U.S. patent application to AuGratin, a French national, was filed in the U.S. Patent and Trademark Office on August 10, 1997. The application disclosed and claimed an apparatus having a combination of elements A, B, and C. AuGratin filed a claim for priority in his U.S. application based upon an application which he filed in the French Patent Office on September 16, 1996. AuGratin's U.S. patent application as filed is an exact English translation of his French application. AuGratin's French application was issued and published as French Patent No. 1,234,567 on March 20, 1998. On April 12, 1999, AuGratin filed a continuation-in-part application (CIP) containing disclosure of new element D in the apparatus. The CIP application included new claims to an apparatus comprising a new combination of elements A, B, C, and D. The examiner properly rejected the new claims in the CIP application as being obvious over AuGratin's French Patent No. 1,234,567 in view of a U.S. patent to Baker which clearly suggests modifying AuGratin's apparatus by adding element D to the combination of elements A, B, and C. The rejection is a *prima facie* case of obviousness. Can AuGratin's French patent be removed as a reference?

- (A) Yes, because AuGratin can swear behind French Patent No. 1,234,567 since the publication date of AuGratin's French patent is less than one year prior to AuGratin's August 10, 1997, U.S. filing date.
- (B) Yes, because the claims in the parent application are supported in the CIP application.
- (C) No, because the new claims in the CIP are not entitled to the benefit of the filing date of the parent application since the combination of elements A, B, C, and D is not supported in the parent application.
- (D) Yes, because AuGratin's French patent cannot be used as prior art in view of the claim for priority in the parent application.
- (E) No, because the new claims are not supported in the CIP application.

44. A Customer Number in the USPTO may be used to do which of the following?

- (A) Designate the fee address of a patent.
- (B) Designate the correspondence address of a patent application.
- (C) Serve as the Deposit Account Number to pay an extension of time fee.
- (D) Submit a list of practitioners so that an applicant may in a Power of Attorney appoint those practitioners associated with the Customer Number.
- (E) (A), (B), and (D).

45. Where a flat board and parallel legs are separate elements which are intended to be included in a claim to the combination of the flat board and legs, the combination is properly set forth in which of the following claims?

- (A) A table having a flat board and parallel legs secured to the flat board.
- (B) A table having a flat board capable of being connected to parallel legs.
- (C) A table having a flat board and means for securing parallel legs to the flat board.
- (D) A table having a flat board with means whereby parallel legs can be secured to the flat board.
- (E) A table having a flat board for receiving parallel legs.

46. Which of the following statements regarding design patent applications is (are) false?

- (A) The use of trademarks in design patent application specifications is permitted under limited circumstances.
- (B) It is improper to use a trademark alone or coupled with the word "type" in the title of a design patent.
- (C) A design patent and a trademark may be obtained on the same subject matter.
- (D) It is the policy of the Patent and Trademark Office to prohibit the inclusion of a copyright notice in a design patent application.
- (E) (A) and (B).

47. Which of the following statements concerning the confidentiality of patent applications before the Patent and Trademark Office is true?

- (A) All documents filed as part of the Disclosure Document Program are open to the public two years after filing.
- (B) All reissue applications are open to the public.
- (C) Copies of any document contained in the application file for which the United States acted as the International Preliminary Examining Authority will be furnished in accordance with Patent Cooperation Treaty (PCT) Rule 94.2 or 94.3 upon payment of the appropriate fee.
- (D) (B) and (C).
- (E) (A) and (B).

48. Apple's claims have been properly rejected under 35 U.S.C. § 102(e) as being anticipated by Carrot. The rejection is based upon the disclosed, but unclaimed, subject matter in the Carrot patent. The Carrot patent issued six months after the filing date of Apple's application. The unclaimed subject matter in the Carrot patent was not invented by Carrot, but rather was disclosed to Carrot by Apple. Carrot's claimed invention is patentably distinct from Apple's claimed invention. The proper reply to obviate this rejection would be to:

- (A) Copy the claims in the Carrot patent to provoke an interference.
- (B) File an affidavit by Carrot establishing that Carrot derived his knowledge of the relevant subject matter from Apple.
- (C) Argue that the Carrot patent is not prior art because the patent did not issue before Apple filed his application.
- (D) File a terminal disclaimer signed by Apple.
- (E) File a terminal disclaimer signed by Carrot.

49. In which of the following situations does the prohibition against double patenting rejections under 35 U.S.C. § 121 not apply?

- (A) The applicant voluntarily files two or more cases without a restriction requirement by the examiner.
- (B) The requirement for restriction was only made in an international application by the International Searching Authority or the International Preliminary Examining Authority.
- (C) The requirement for restriction was withdrawn by the examiner before the patent issues.
- (D) The claims of the second application are drawn to the "same invention" as the first application or patent.
- (E) All of the above.

50. A patent application is filed with 10 claims. Claims 1, 2, and 3 are independent claims directed to a product. Claim 4 is an independent claim directed to a process for making the product. Which of the following would be acceptable form for a dependent Claim 5?

- (A) A product as in claims 1-3, wherein ...
- (B) A product as claimed in claims 1, 2, and 3, wherein ...
- (C) A product as in claim 1, made by the process of claim 4.
- (D) A product as claimed in any one of claims 1, 2, or 3 wherein ...
- (E) A product as claimed in claim 6 or claim 7, wherein ...

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

NOVEMBER 3, 1999

Morning Session (50 Points)

Time: 3 Hours

DIRECTIONS

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

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

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

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

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO

1. Abigail has invented a novel watering mechanism for a flower pot. The flower pot also possesses a unique ornamental design. Abigail consults with patent practitioner P for advice on the differences between a design patent and a utility patent. Which of the following general statements regarding design and utility patents, if made by P, would be accurate?

- (A) A “utility patent” protects the way an article is used and works, while a “design patent” protects the way an article looks.
- (B) Unlike utility patent applications, a design patent application may not make a claim for priority of a provisional patent application.
- (C) Maintenance fees are required for utility patents, while no maintenance fees are required for design patents.
- (D) Both design and utility patents may be obtained on an article if the invention resides both in its utility and ornamental appearance.
- (E) All of the above.

2. A patent application filed in the PTO claims a nylon rope coated with element E for the purpose of preventing breakage of the rope. In the first Office action, the examiner rejects the claim as obvious over P in view of a trade journal publication, T. P teaches a nylon rope coated with resin for the purpose of making the rope waterproof. T teaches a nylon tent fabric coated with element E for the purpose of making the tent waterproof, and suggests the use of element E for making other nylon products waterproof. Following proper PTO practices and procedures, the combination of P and T:

- (A) cannot support a prima facie case of obviousness because T lacks a suggestion to combine with P for the purpose of preventing breakage in nylon rope.
- (B) cannot support a prima facie case of obviousness because P lacks a suggestion to combine with T for the purpose of preventing breakage in nylon rope.
- (C) cannot support a prima facie case of obviousness because T only contains a suggestion to combine with P for the purpose of waterproofing nylon rope.
- (D) can support a prima facie case of obviousness, even though T only contains a suggestion to combine with P for the purpose of waterproofing nylon rope.
- (E) can support a prima facie case of obviousness because the applicant is always under an obligation to submit evidence of non-obviousness regardless of whether the examiner fully establishes a prima facie case of obviousness.

3. What would **not** be permitted to be incorporated by reference in your client’s U.S. utility patent application?

- (A) Essential material from a U.S. patent.
- (B) Essential material from a foreign application.
- (C) Non-essential material from a prior filed, commonly owned U.S. application.
- (D) Essential material from a magazine article.
- (E) (B) and (D).

4. Beverly is a research chemist. While cleaning a clogged shower drain she recovers several ounces of goop from the drain. She analyzes the ingredients and properties, and finds that the goop makes a highly effective industrial lubricant. She comes to you for help in preparing and filing an application. She informs you that the goop is formed from equal parts of chemicals W, X, Y and Z. She knows that chemical W comes from the soap she uses and that chemicals Y and Z are components of the conditioner she uses on her hair. Her soap uses the tradename "Acme SmellNice", and her shampoo and conditioner both use the tradename "A-1 Silky." Chemicals W, Y and Z are all readily available on the commercial market. Chemical X is also a common, readily available chemical, but she cannot determine how it got in the shower drain. She suspects it is the result of a reaction between A-1 Silky shampoo and Acme SmellNice soap that occurs when the two are mixed in the presence of hot water. You prepare an application describing a prophetic example setting forth one way to make the goop from commercially available chemicals and a working example describing (as well as the inventor can) how the goop is formed in the bathroom drain. The working example describes mixing of A-1 Silky shampoo and Acme SmellNice soap in the presence of water having a temperature of at least 100°F to form chemical X. Because you know that the ingredients for at least Acme SmellNice soap have recently changed, but the nature of the change is unknown, you list every ingredient of A-1 Silky shampoo, and Acme SmellNice soap in positive language so there will be no confusion as to what is meant. The application includes the following claims:

- Claim 1. An industrial lubricant consisting essentially of equal parts of chemical W, chemical X, chemical Y and chemical Z.
- Claim 2. The industrial lubricant of Claim 1, wherein said chemical X is formed by mixing A-1 Silky shampoo and Acme SmellNice soap in the presence of water having a temperature of at least 100°F.

Which of the following statements is/are correct?

- (A) Claim 1 cannot be supported by an enabling specification because Beverly does not fully understand the processes that occurred in the drain, and a prophetic example alone is never sufficient to enable a claim.
- (B) Claim 2 is not patentable because it sets forth an incorrect theory of formation of chemical X.
- (C) Claim 1 is not patentable because Beverly merely found the goop in her drain and did not formulate it herself.
- (D) Claim 2 is not patentable because it is indefinite.
- (E) (B) and (D).

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

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

6. You are preparing a patent application for filing in the PTO. The application contains the following partial claim:

A walking device comprising:

- (i) a vertical member having opposing top and bottom portions;
- (ii) a handle connected to the top portion of the vertical member forming a 45E angle with the top portion of the vertical member;
- (iii)
- (iv) a set of non-skid covers for the set of legs, said set of legs being aluminum.

Following proper PTO practices and procedures, which of the following claim limitations best completes the claim by providing the missing limitation (iii)?

- (A) a horizontal member, substantially round in shape, having opposing sides connected along one of the opposing sides to the bottom side of the vertical member and along the other of the opposing sides to a set of legs; and
- (B) a horizontal member, substantially round in shape, having first and second opposing sides connected along the first opposing side to the bottom side of the vertical member and along the second opposing side to a set of legs; and
- (C) a horizontal member, substantially round in shape, connected to the bottom portion of the vertical member; and
- (D) a horizontal member, substantially round in shape, having opposing top and bottom portions; the top portion of the horizontal member is connected to the bottom portion of the vertical member, and the bottom portion long the bottom portion of the vertical member is connected to a set of legs; and
- (E) a horizontal member, substantially round in shape, having a top side connected to the bottom side of the vertical member and a bottom side connected to the set of legs; and

7. Which of the following statements, regarding amendments filed after final rejection in a timely manner, is correct?

- (A) Amendments touching upon the merits of the application presented after final rejection shall be entered upon payment of the proper fee and a showing of good and sufficient reasons why they are necessary and were not earlier presented.
- (B) An amendment filed after final rejection is entitled to entry if it amends only the claims that were finally rejected.
- (C) Amendments after final rejection may be made canceling claims or complying with any requirement of form expressly set forth in the final Office action.
- (D) An amendment after final rejections is entitled to entry if it cancels claims and adds new claims that clearly set forth a previously unclaimed embodiment of the invention.
- (E) Applicant cannot make any further amendments after final rejection, but may submit remarks and a notice of appeal.

8. In which of the following situations, considered independently of each other, is the original, new, or amended claim supported in the application as filed?

- (A) An amendment to the specification changing the definition of “holder” from “is a hook” to “is a hook, clasp, crimp, or tong” and no amendment is made of the claim, which uses the term “holder.” The amendment is filed one month after the application was filed. There was no previous supporting disclosure in the specification of the holder being a clasp, crimp, or tong.
- (B) An amendment to the specification and claims changing the definition of “holder” from “is a hook” to “is a hook, clasp, crimp, or tong.” The amendment is filed one month after the application was filed. There was no previous supporting disclosure in the specification of the holder being a clasp, crimp, or tong.
- (C) Original claim 1 in the application refers to “a holder,” and original claim 2 depends from and refers to claim 1 stating, “said holder is a hook, clasp, crimp, or tong.” There is no disclosure in the specification preceding the claims in the application as filed for the holder to be a clasp, crimp, or tong.
- (D) An amendment is filed presenting a claim to an electrical insulating device, copied from a patent for the purpose of provoking an interference. The claim refers to “nonconductive plastic holder.” The application as filed contains a broad generic disclosure describing electrical insulating devices. The holder is described in the specification of the application as “conducting electricity.” There is no disclosure in the specification of the holder being “nonconductive.”
- (E) All of the above.

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

Claim 1. A doughnut making machine comprising:

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

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

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

10. Which of the following dependent claims, each occurring in different patent applications, is in a proper claim format?

- (A) Claim 4. The process of claim 5, further characterized by...
- (B) Claim 2. The process of claim 1 or claim 5, further comprising...
- (C) Claim 6. The widget as in claims 1, 2 or 3, further including...
- (D) Claim 3. The widget as in the preceding claims, further containing...
- (E) Claim 5. The process as in claims 1-2 or 3, further comprising...

11. In August 1999, a recently registered patent agent, who is not an attorney, asked a registered patent attorney to help the agent establish a practice. Considering the additional facts in the following choices separately, which choice best comports with the professional responsibilities of both the agent and the attorney?

- (A) The agent advertises as a registered practitioner authorized to practice before the Office in patent and trademark cases. The attorney supervises all the trademark work done by the agent.
- (B) The agent advertises on television and radio as a registered patent agent and accepts patent cases on a reasonable contingent fee.
- (C) The attorney has the agent prosecute trademark applications before the Office and the attorney signs all the papers submitted to the Office without reading the papers.
- (D) The attorney and agent enter into a partnership agreement that has no health or retirement benefits, but specifies that after termination of the partnership, the agent and the attorney will not practice in each other's neighborhoods or accept each other's established clients.
- (E) Without receiving anything of value from the agent, the attorney refers patent application clients to the agent, the agent informs the clients that the agent is a registered patent attorney, and the agent competently represents the clients in patent cases.

12. On February 12, 1999, you filed a patent application containing two independent claims, Claims 1 and 2, directed to methods of forming an integrated circuit device. The applicant conceived the methods in Jacksonville, Florida on June 10, 1997. Commencing on June 10, 1997, the applicant exercised due diligence until she reduced the methods to practice on February 27, 1998. In an Office action dated August 18, 1999, the examiner rejected Claim 1 as being anticipated by Doppler under 35 U.S.C. § 102(b). Doppler is a French patent that was filed on July 18, 1996, and issued on January 13, 1998. The Doppler patent claims the method of the applicant's Claim 1 for forming integrated circuit devices. Claim 2 was rejected as being anticipated by Spot under 35 U.S.C. § 102(e). Spot is a U.S. patent that was filed on January 7, 1998, and discloses, but does not claim, the method of applicant's Claim 2 for forming an integrated circuit device. The Spot patent issued on May 5, 1999. Which of the following would be the most proper course of action to take to respond to the rejections?

- (A) File an antedating affidavit to overcome the rejection of Claim 1 and cancel Claim 2.
- (B) File an antedating affidavit to overcome both the rejections and request that an interference be declared with the Doppler patent.
- (C) File an antedating affidavit to overcome the rejection of Claim 2 and cancel Claim 1.
- (D) File a reply arguing that the rejections are improper because the Spot patent issued after the filing date of your client's application.
- (E) File an antedating affidavit to overcome both rejections.

13. Able files a patent application in 1999 disclosing a barstool having a rectangular molded plastic seat portion supported by four adjacent vertical tubular steel legs connected to the underside of the seat portion. A set of four horizontal tubular steel support members connects adjacent tubular steel legs to brace the legs. The barstool further includes a plastic back member connected to the topside of the plastic seat portion. The application states that wood could be used in place of tubular steel for the legs and horizontal support members. No alternative to plastic is mentioned in the application for use in the seat portion, but it is well known in the art that plastic and wood are interchangeable. As originally filed, Baker's application included the following Claim 1:

- Claim 1. A barstool comprising:
- (i) a rectangular seat portion having four vertical edges, an underside and a topside;
 - (ii) means for supporting said seat portion such that said underside is substantially horizontal; and
 - (ii) a back member connected to one of the vertical edges of said seat portion, said back member being substantially perpendicular to the topside of said seat portion.

The Examiner rejects the claim under 35 U.S.C. § 102 as being anticipated by a 1997 publication by Baker showing a three-legged wooden barstool with a rectangular seat, a back and arms. The Examiner cites, but does not apply against Claim 1, a 1996 patent to Charlie that discloses a four-legged wooden barstool with a round wooden seat. The Charlie patent states that in barstools the use of plastic and/or tubular steel is equivalent to the use of wood. Able responds to the rejection by amending his claim to require that the seat portion be formed of plastic, and by arguing that Baker does not disclose the recited "supporting means" because Baker utilizes only three legs, which is less stable than four legs. The examiner finds a 1980 Wilson patent that structurally equates three legged barstools to four-legged barstools. Which of the following is in accordance with proper PTO practices and procedures?

- (A) The anticipation rejection is withdrawn only because Baker does not disclose a plastic seat portion. An obviousness rejection is then made based on Baker in view of Charlie since Charlie suggests replacing a wood seat with a plastic seat. Able's argument concerning the recited "supporting means" of Claim 1 does not provide a basis for overcoming the anticipation rejection.
- (B) The anticipation rejection should be withdrawn because Baker does not disclose a plastic seat portion and because Baker does not disclose a four legged supporting means. An obviousness rejection is then made based on Baker in view of Charlie because Charlie suggests modifying Baker to utilize a plastic seat and four legs. The anticipation rejection is maintained because one of ordinary skill in the art would understand that a plastic seat could readily replace a wood seat. Furthermore, Able's argument that the "supporting means" of Claim 1 is not disclosed because Baker utilizes only three legs is unsupported by any limitation in the Claim.
- (D) The anticipation rejection is withdrawn because Baker does not disclose a plastic seat. However, a rejection is made under 35 USC §112, paragraph 1 as being

- based upon an inadequate disclosure because the specification does not specify that the use of a plastic seat is critical to the invention.
- (E) (B) and (D).

14. A patent application filed in the PTO contains the following original claim:

Claim 1. A talbecloth for protecting the finish of a table comprising:
a layer of cotton;
a layer of vinyl affixed to the layer of cotton; and
a backing of felt.

Which of the following amendment(s) is/are not in accord with proper PTO amendment practices and procedures?

- (A) In claim 1, line 3, add -with an epoxy resin-.
(B) In claim 1, line 2, after "cotton" add -woven to have 250 threads per inch-.
(C) In claim 1, line 3, before "layer" add -thin-.
(D) In claim 1, line 1, correct the spelling of "talbecloth" please.
(E) All of the above.

15. You draft a patent application disclosing and describing an electrical chronometer containing a resistor having a resistance of 20-90 ohms, preferably 40 ohms. You draft the following independent claim:

1. An electrical chronometer comprising a resistor with a resistance of 20-90 ohms.

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

- (A) 2. The electrical chronometer of Claim 1 wherein the resistor has a resistance of 40 ohms.
(B) 2. An electrical chronometer as in Claim 1 wherein the resistor has a resistance of 40-90 ohms.
(C) 2. An electrical chronometer as in Claim 1 wherein the resistor has a resistance of about 20 - 90 ohms.
(D) 2. The electrical chronometer of Claim 1 wherein the resistor has a resistance of between 50 and 90 ohms.
(E) (C) and (D).

16. When does jurisdiction over an application normally transfer from the examining group to the Board of Patent Appeals and Interferences?

- (A) After the examiner has notified the appellant by written communication that the reply brief has been entered and considered, and that the application will be forwarded to the Board.
- (B) After a supplemental examiner's answer, pursuant to a remand from the Board, has been mailed.
- (C) After 2 months from the examiner's answer, plus mail room time, if no reply brief has been timely filed.
- (D) (A), (B), or (C).
- (E) (A) or (C).

17. A request for reexamination of U.S. Patent X,XXX,XXX (the 'XXX patent) was filed by ABC Technology, Inc. (ABC) on the ground that a substantial new question of patentability exists. In the first Office Action during reexamination, all the claims, i.e., claims 1 through 4, were rejected as unpatentable under 35 U.S.C. § 103 over U.S. Patent Z,ZZZ,ZZZ (the 'ZZZ patent). Claims 1 through 4 are all independent and original claims, and are the only claims that were presented during prosecution of the application that matured into 'XXX patent. All the claims are directed to a hydrocyclone separator apparatus. 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. Assuming no issues under 35 U.S.C. §§ 102, 103, or 112 are raised, which of the following claims, if any, would be properly subject to rejection under 35 U.S.C. § 305?

- (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.

18. A patent application filed in the PTO contains the following dependent claim:

2. The method of Claim 1, further consisting of the step of cooling the mixture to a temperature of 32° F.

Following proper PTO practices and procedures, from which of the following claims does the dependent claim not properly depend?

- (A) 1. A method of making liquid compound A consisting of the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (B) 1. A method of making liquid compound A comprising the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (C) 1. A method of making liquid compound A including the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (D) 1. A method of making liquid compound A characterized by the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (E) (C) and (D).

19. If a claim has been properly rejected under 35 U.S.C. § 103 as being rendered obvious over a combination of prior art references, then in accordance with proper PTO practice and procedure:

- (A) it is not necessary that the prior art suggests the combination to achieve the same advantage or result discovered by the applicant, if the combination provides motivation to make the claimed invention.
- (B) the rationale to modify or combine the prior art must be found expressly set forth in the prior art.
- (C) in considering the disclosure of prior art it is proper to take into account the specific teachings of the reference. It is not proper to take into account the inferences that one skilled in the art could reasonably draw from the specific teachings.
- (D) it is improper for a patent examiner to take official notice of facts outside the record which are capable of instant and unquestionable demonstration as being “well known.”
- (E) it is proper to rely on equivalence in support of the rejection, the equivalence may be recognized in the prior art or in the applicant’s disclosure.

20. An application is directed to novel and unobvious scissors for cutting hair having a pair of cutter blades and a pointer loop. The application includes the following partial independent Claim 1 and dependent Claims 2-5.

Claim 1.

An apparatus for cutting hair, said apparatus comprising:

- (i) a first cutting member having a first cutting edge at one end and the other end of said first cutting member terminating in a thumb loop;
- (ii) a second cutting member having a second cutting edge at one end and the other end terminating in a finger loop having an arcuate finger brace extending therefrom;
- (iii) _____
- (iv) said second cutting member additionally including a pointer loop between said finger loop and said mid-point, said finger loop having a finger loop center such that a plane through said finger loop center and said pointer loop center is generally parallel to said second cutting edge in order for the apparatus for cutting hair to be generally balanced when held by a user.

Claim 2.

The apparatus of claim 1, wherein said first cutting member includes a threaded aperture extending entirely therethrough between said thumb loop and said mid-point, and an adjusting screw that extends through said threaded aperture to engage a bearing surface below the pointer loop on said second cutting member.

Claim 3.

The apparatus of claim 2, wherein said connector is a rivet.

Without regard to prior art, and in view of partial Claim 1, which of the following best completes missing paragraph (iii) of Claim 1 while maintaining the broadest scope of protection and complying with proper PTO practice and procedure?

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

21. Which of the following would be a proper rejection in a reexamination proceeding?

- (A) A rejection under 35 U.S.C. § 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 U.S.C. § 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 U.S.C. § 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 U.S.C. § 102(f) that the applicant did not himself invent the subject matter sought to be patented.
- (E) A rejection under 35 U.S.C. § 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.

22. Patentee P wishes to amend Claim 1 in the patent granted to P, and obtain the following amended Claim 1 either through reexamination or reissue:

- 1. A ball valve comprising:
 - i) a housing;
 - ii) a valve [member] ball rotatably joined in the housing;
 - iii) a [flanged] seal engagable with surfaces of the [member] ball; and
 - iv) a linear spring [means] interposed between the housing and the seal and biasing the seal into engagement with the [member] ball.

The amended claim is supported by the original disclosure in the application, which matured into P's patent. In the absence of questions of recapture, novelty, obviousness, and utility which of the following statements is/are true?

- (A) A claim so amended is properly presented in a reissue application filed on October 14, 1999, and a reissue patent is grantable where reissuance is sought of a patent granted on September 9, 1997.
- (B) A claim so amended is properly presented in a reissue application filed on September 9, 1999, and a reissue patent is grantable where reissuance is sought of a patent granted on October 7, 1997.
- (C) A claim so amended is properly presented in a request for reexamination filed on October 14, 1999, and a certificate of reexamination is grantable where reexamination is sought of a patent granted on September 9, 1997.
- (D) A claim so amended is properly presented in a request for reexamination filed on September 9, 1999, and a certificate of reexamination is grantable where reexamination is sought of a patent granted on October 7, 1997.
- (E) (B) and (D).

23 and 24. Answer Questions 23 and 24 based on the following facts.

Your client, Homer, invented a new system for laying underground pipes for in-ground sprinkler systems utilizing a tunneling tool he calls “the Mole.” The Mole is placed in a small hole is dug in the ground at a starting location. A target is placed in the ground at the desired ending location. The Mole automatically tunnels through the ground to the target. The Mole has a clamp to pull flexible pipe behind it as it tunnels. A high-pressure air source is connected to the Mole to remove dirt as the Mole progresses toward the target. Homer informs you that he has continuously used this original system for three years in his commercial landscaping business, displayed the system to his numerous customers, and handsomely profited from his original system. In the original system, the Mole sensed and moved toward the target emitting electromagnetic signals. Recently, the Mole sometimes gets confused due to interference from ferromagnetic underground pipes and overhead power lines. Two months ago Homer modified the system to utilize ultrasonic signals emitted from the target. The ultrasonic signals are encoded with location information derived by the target from a Global Positioning System (GPS) satellite. The modified system decodes the location information and tunnels toward the specified location. The use of ultrasonic signals in the modified system is new and unobvious. Homer has reduced the modified system to actual practice, and kept it confidential. Homer prepared a draft patent application fully describing both the original system and the modified system. He wants you to review the draft application, make sure it meets all requirements, and revise it as necessary prior to filing. The draft application prepared by Homer includes the following draft claims:

- Claim 1. A system for laying underground flexible pipe in the ground, said system comprising:
- (i) a target placed in the ground at a target location and including a transmitter which emits target signals;
 - (ii) a tunneling device including a clamp operable to connect one end of said flexible pipe to said tunneling device, said tunneling device further including a sensor which detects said target signals and steers said tunneling device to move toward said target; and
 - (iii) a source of high pressure air connected with said tunneling device for removing dirt as said tunneling device moves toward said target.
- Claim 2. The system of claim 1, wherein said transmitter emits electromagnetic signals.
- Claim 3. The system of claim 1, wherein said transmitter emits ultrasonic signals.
- Claim 4. The system of claim 3, wherein said ultrasonic signals include encoded position information that is decoded by the decoder portion of said tunneling device sensor.
- Claim 5. The system of claim 1, wherein said transmitter emits signals having encoded position information.

23. Which of the following would not be reasonable advice to Homer?
- (A) Claim 5 is not indefinite even though it is not limited to ultrasonic target signals and the only disclosed embodiment that utilizes encoded position information utilizes ultrasonic target signals.
 - (B) Claim 1, as presently written, is statutorily barred, and the claimed invention should be limited to the modified system.
 - (C) Because the original system had a drawback in that it sometimes got confused by ferromagnetic underground pipes or power lines, and because Homer continued to develop the system to overcome these drawbacks, the original system was experimental and does not constitute prior art against the modified system.
 - (D) Claim 4 is indefinite.
 - (E) The language in Claim 1 reciting the “target” should be reworded to clarify that the ground is not part of the claimed combination, *e.g.*, by adding the words “adapted to be” before “placed”.
24. Claims 1 and 2 are unpatentable under which of the following statutory provisions?
- (A) 35 U.S.C. § 102(b).
 - (B) 35 U.S.C. § 102(c).
 - (C) 35 U.S.C. § 102(d).
 - (D) 35 U.S.C. § 102(e).
 - (E) None of the above.
25. Which of the following is not a PTO recommendation or requirement?
- (A) Claims should be arranged in order of scope so that the first claim presented is the least restrictive.
 - (B) Product and process claims should be separately grouped.
 - (C) Every application should contain no more than three dependent claims.
 - (D) A claim which depends from a dependent claim should not be separated from that dependent claim by any claim which does not also depend from the dependent claim.
 - (E) Each claim should start with a capital letter and end with a period.

26. A patent was granted to inventor Munch on August 3, 1999, on a patent application filed in the PTO on March 5, 1997. In which of the following circumstances in a reexamination proceeding of the Munch patent, considered independently of each other, will the cited prior art reference(s) properly support a determination that there is substantial new question of patentability?

- (A) In a reexamination proceeding, claims 7-15 in the Munch patent are rejected as being anticipated under 35 U.S.C. § 102(a) by the disclosure in the Leal patent. The Leal patent was granted on January 21, 1997. It is the only rejection in the reexamination proceeding. During the original prosecution of the Munch application, the Leal patent was used by the examiner as prior art to reject original claims 1-5 as being anticipated under 35 U.S.C. § 102(a).
- (B) In a reexamination proceeding, newly added claims 16-20 in the Munch patent are rejected as being anticipated under 35 U.S.C. § 102(b) by the disclosure in the Zellot patent. The Zellot patent was granted in 1987. It is the only rejection in the reexamination proceeding. During the original prosecution of the Munch application the examiner cited the Zellot patent against claims 1-7 in the patent application Munch filed on March 5, 1997.
- (C) In a reexamination proceeding, claims 1-15 in the Munch patent are rejected as being obvious under 35 U.S.C. § 103 over the Wills patent in view of the Note patent. The Wills patent was granted on December 3, 1996, and the Note patent was granted in 1994. It is the only rejection in the reexamination proceeding. During the original prosecution of the Munch application the examiner used the Wills patent as prior art to reject original claims 1 and 2 in the Munch application. The Note patent was never before the examiner during the original prosecution of the Munch application, is not cumulative with the prior art cited during the original prosecution, and is material to the question of obviousness.
- (D) In a reexamination proceeding, claims 1-15 in the Munch patent are rejected as being anticipated under 35 U.S.C. § 102(a) by the disclosure in the Richards patent. The Richards patent was granted on January 14, 1997. It is the only rejection in the reexamination proceeding. During the original prosecution of the Munch application, the examiner used the Richards patent in combination with a patent to Smith, granted in 1923, to reject original claims 1-5 in the application as being obvious under 35 U.S.C. § 103.
- (E) All of the above.

27. Which of the following statements explains why Claim 1 below does recite subject matter eligible for protection under the Patent Statute?

- Claim 1. A top soil for retaining water comprising:
about 10% of material X;
about 60% of material Y; and
balance of material Z.
- (A) The subject matter is eligible if the top soil occurs in nature, and M was the first to find the topsoil on a remote tropical island.
- (B) The subject matter is eligible if M developed the top soil through extensive research and experimentation with various materials, including materials X, Y, and Z.
- (C) The subject matter is eligible because all inanimate objects are subject matter eligible for protection under the patent statute.
- (D) The subject matter is eligible because the claim is sufficiently broadly written as not to exclude the inclusion of a living organism.
- (E) (A) and (B).

28. A patent application filed in the PTO contains the following three claims, including product by process Claim 3:

- Claim 1. A method for making an Ethernet cable comprising the steps of A, B and C.
- Claim 2. The method of claim 1, further characterized by the step of D.
- Claim 3. The Ethernet cable as in any one of the preceding claims.

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

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

29. Which of the following statements is in accordance with proper PTO practice and procedure?

- (A) Unlike questions of public use, there is no requirement that “on sale” activity be “public.”
- (B) Sales to toy stores throughout the United States of a claimed rocking horse by an independent third party more than one year before the filing date of applicant’s patent application without the applicant’s consent will not bar applicant from obtaining a patent for the rocking horse.
- (C) An offer for sale of a claimed invention, where the offer originates in the United States and is communicated to a potential buyer in Europe, more than one year before the filing date of applicant’s patent application, cannot be sufficient activity to bar applicant from obtaining a patent for the invention.
- (D) Delay alone in filing a patent application is sufficient to infer any required intent by the inventor to abandon the invention.
- (E) “Patented” in 35 U.S.C. § 102(e) includes the publication of German applications as printed documents called Offenlegungsschrift.

30. On September 14, 1999, you filed a patent application in the PTO on behalf of a large corporation together with an authorization to charge the filing fee to your deposit account. However, due to unforeseen circumstances, measures were not taken to cover the \$760.00 filing fee against the amount in your deposit account, which has a \$10.00 balance. Consequently, you received a notice from the PTO dated September 28, 1999, that your deposit account has insufficient funds. Which of the following steps avoids abandonment of the recently filed application?

- (A) On September 29, 1999, replenish the deposit account with \$800.00 in cash to encompass the filing fee, and the \$10 fee required by 37 CFR § 1.21(b)(1).
- (B) On September 29, 1999, open a new deposit account with \$800.00 in cash, and file in the PTO correspondence authorizing the fee for filing the application be charged against your new deposit account.
- (C) On September 29, 1999, file in the PTO a check for \$760.00 for the filing fee, and file in the PTO correspondence authorizing the balance of the filing fee be paid from your deposit account.
- (D) On September 29, 1999, replenish the deposit account with \$890.00 in cash to cover the filing fee, and a surcharge fee for late payment of the filing fee, and file in the PTO correspondence authorizing the fees for the application be charged to your deposit account.
- (E) (B) or (C).

31. The following claims are included in a newly filed patent application:

Claim No.

1. Independent
2. Dependent on claim 1
3. Dependent on claim 1
4. Dependent on claims 2 and 3
5. Independent
6. Dependent on claim 1, 2 or 5
7. Dependent on claim 6
8. Independent

Which of the following represents the proper number of total claims for fee calculation purposes?

- (A) 10
- (B) 13
- (C) 11
- (D) 12
- (E) 8

32. On August 23, 1999, you file a patent application in the PTO. Along with the application, you file an unexecuted declaration that refers to the application and a preliminary amendment that describes the best mode of carrying out the claimed invention. Subsequently, you file a signed declaration in reply to a Notice to File Missing Parts. The best mode is described only in the preliminary amendment. In the first Office action, the examiner objects to the preliminary amendment as adding new matter to the specification and requires cancellation of the new matter. Considering the following responses and the additional facts separately, the best way to respond to and overcome the objection, and obtain a patent is to:

- (A) file a reply pointing out that the objection is improper because the declaration filed in reply to the Notice to File Missing Parts is a properly executed declaration that refers only to the amendment.
- (B) file a reply pointing out that the objection is improper because the declaration filed in reply to the Notice to File Missing Parts is a properly executed declaration that refers only to the application and amendment.
- (C) file a reply pointing out that the objection is improper because the declaration filed in reply to the Notice to File Missing Parts is a properly executed supplemental declaration that refers only to the amendment.
- (D) file an appeal to the Board of Patent Appeals and Interference requesting review of the examiner's objection to the amendment as adding new matter.
- (E) file a reply to the Office action canceling the new matter.

33. During a reexamination proceeding, you submit the following amendment less than two years from the date that a patent was granted with the claim:

1. (once amended) An application specific integrated circuit for calculating a correlation coefficient, comprising: a multiplication unit [having a plurality of sixty-four bit shift registers]; an integration unit coupled to said multiplication unit; and a digital filter unit coupled to said integration unit and to said multiplication unit.

The original disclosure in the patent application stated that a plurality of thirty-two bit shift registers could be used to form the multiplication unit. In accordance with PTO rules and procedure, which, if any, of the following statements, including any reasons given in support thereof, concerning the amendment is true?

- (A) The form of the amendment is improper, since underlining and brackets are not proper in proceedings where only issues concerning substantial new questions of patentability may be raised.
- (B) The claim as amended should be allowed if it overcomes the art of record in the application since the amendment was made less than two years from the date that a patent was granted.
- (C) The claim as amended should be allowed if it overcomes the art of record in the application since the amendment, although broader in some respects than the claim of the patent, is narrower in other respects.
- (D) The claim as amended should not be allowed since it broadens the scope of the claim of the patent.
- (E) None of the above.

34. If a claim has been properly rejected under 35 U.S.C. § 103 as being rendered *prima facie* obvious over a combination of prior art references, then the rejection can be rebutted in accordance with proper PTO practice and procedure by:

- (A) showing the criticality of the claimed range where the range in the claim overlaps the range disclosed in one or both prior art references.
- (B) arguing that the client has recognized latent properties in the prior art which were not recognized by the prior art references.
- (C) arguing that a combination would not be made by a businessman for economic reasons.
- (D) contending that each of the prior art references, taken individually, does not teach or render obvious the claimed invention.
- (E) (A), (B), and (C).

35. Morris, a registered practitioner with a solo practice he operates out of his house, obtained a plant patent for a client on a commercial catnip hybrid. One morning, over four years later, as he was sorting through his cat's toys, he came across a letter from his client indicating the client's belief that a maintenance fee was due four years after issuance. By the time Morris found the letter, it was eight months after the four year anniversary of the plant patent's issuance. Morris should immediately:

- (A) Tender the maintenance fee and submit a petition (with the required fee) for acceptance of payment where the delay was unintentional.
- (B) Pay the maintenance fee plus the surcharge for filing a maintenance fee during the grace period.
- (C) Write the client that no maintenance fee is in fact owed, and apologize for the delay in responding to the client.
- (D) Do nothing because the patent is irrevocably lost due to failure to pay the maintenance fee within the grace period.
- (E) Tender the maintenance fee and submit a petition (with an affidavit blaming the cat and with the required fee) for acceptance of payment where the delay was unavoidable.

36. Following proper PTO practices and procedures, which of the following reference(s) anticipates Claim 1:

- 1. A composition consisting of:
 - 60-80% cellulose;
 - 16-18% nylon;
 - up to 0.5% fiber; and
 - at least 6% cotton;said composition being capable of absorbing water in the amount of not more than 45% by weight of the composition.
- (A) A reference disclosing a sponge having 69% cellulose, 16% nylon, 0.4% fiber, 7% cotton, and 7.6% silk.
- (B) A reference disclosing a sponge having 78% cellulose, 17% nylon, 0.2% fiber, 4.8% cotton, and a water content of 30% by weight.
- (C) A reference disclosing a sponge having 76% cellulose, 16% nylon, 8% cotton and containing no water.
- (D) A reference disclosing a sponge having 61% cellulose, 18% nylon, 0.6% fiber, 20.4% cotton, and a water content of 45% by weight.
- (E) (B) and (D).

37. A patent application includes the following partial Claim 1:

- Claim 1. A shaving implement comprising
- (i) _____
 - (ii) a shaving head including a razor, said shaving head being connected to said handle at said first end;
 - (iii) a collapsible tube of shaving cream positioned in and substantially filling said chamber, said tube including a neck having a dispensing opening;
 - (iv) a tube squeezing slide positioned within said channel and said chamber, said slide including opposed slots thereon, said slots being in sliding engagement with said longitudinal sides of said channel; and
 - (v) a tube closure connected to said neck of said collapsible tube.

Which of the following, if included as paragraph (i) of Claim 1, best completes the claim while giving the client the broadest protection?

- (A) a substantially rigid handle including a chamber and a channel formed in said handle, said channel being defined by longitudinal sides within said handle;
- (B) a substantially rigid handle having a first end, said handle including a chamber and a channel formed in said handle, said channel being defined by longitudinal sides within said handle;
- (C) a substantially rigid handle having a first end, said handle including a chamber and an elongated channel formed in said handle;
- (D) a substantially rigid handle having a first end, said handle including a chamber and a channel formed in said handle;
- (E) a substantially rigid handle having a first end, said handle including a channel formed in said handle, said channel being defined by longitudinal sides within said handle;

38. Which of the following must be included in a petition for a retroactive license to file a patent application in a foreign country?

- (A) A verified statement containing an averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order.
- (B) A verified explanation of why the material was filed abroad through error and without deceptive intent without the required license first having been obtained.
- (C) A listing of each of the foreign countries in which the unlicensed patent application was filed.
- (D) (A) and (B).
- (E) (A), (B) and (C).

39. Applicant filed a patent application claiming a polyol. The application discloses that the claimed polyol is used to form rigid polyurethane foam having a structural formula. The examiner properly rejected the claimed polyol as unpatentable over prior art disclosing the claimed polyol and its use to form rigid polyurethane foam having the same structural formula. Given the fact that applicant's specification discloses that the polyol may be produced by a process comprising steps A, B, C, and D, and the process is novel and unobvious, which of the following claims, if introduced by amendment, would overcome the rejection?

- (A) A polyol having the property of forming rigid polyurethane foam having structural formula Z, the polyol being produced by the process comprising the steps A, B, C, and D.
- (B) A polyol produced by the process comprising the steps A, B, C, and D, said polyol having the property of forming rigid polyurethane foam having structural formula Z.
- (C) A polyol produced by the process comprising the steps A, B, C, and D.
- (D) A polyol comprising the resultant product of steps A, B, C, and D.
- (E) A polyol-producing process comprising steps A, B, C, and D, said process resulting in a polyol capable of forming rigid polyurethane foam having structural formula Z.

40. In the course of prosecuting a patent application before the PTO, you receive a non-final Office action allowing Claim 1, and rejecting Claims 2 through 6, the remaining claims in the case. Claim 1 reads as follows:

- 1. A ship propeller exhibiting excellent corrosion resistance, said ship propeller consisting essentially of a copper base alloy consisting of 2 to 10 percent tin, 0.1 to 0.9 percent zinc, and copper.

The specification of the application teaches that the copper base alloy made with the addition of 2 to 10 percent aluminum increases the alloy's wear resistance without detracting from its corrosion resistance. However, adding aluminum to the surface of the propeller does not increase wear resistance. Which of the following claims, if any, if added by amendment would accord with proper PTO practice and procedure?

- (A) 7. A copper base alloy according to Claim 1 wherein said alloy includes 2 to 10 percent aluminum.
- (B) 7. A ship propeller according to Claim 1 including the step of adding 2 to 10 percent aluminum to the copper base alloy.
- (C) 7. A ship propeller according to Claim 1 including 2 to 10 percent aluminum.
- (D) 7. A ship propeller according to Claim 1 wherein said alloy includes 2 to 10 percent aluminum.
- (E) None of the above.

41. A claim limitation reads “a pH range between 7 and 12, preferably between 9 and 10.” Which of the following is correct?

- (A) Since the limitation properly sets forth outer limits, it is definite.
- (B) As long as the limitation is supported in the written description, it is proper.
- (C) The limitation is indefinite.
- (D) Since the limitation sets forth a preferred range, it is definite.
- (E) An applicant is precluded from expanding the claim coverage beyond a pH range of 7-12 under the doctrine of equivalents.

42. Patent practitioner Wally is hired to prepare a patent application directed to a method of making a particular composition. After consulting with his client, Wally believes that schematic drawings would be helpful, and that color drawings would be most helpful in disclosing the method. Wally diligently contacts a draftsman to prepare the color drawings and proceeds to complete his draft patent application. The application contains only method claims. Upon completing the application, Wally forwards the draft application to his client for review. The application contains method claims, and does not include any reference to drawing figures. Before the color drawings are complete, Wally receives an urgent call from his client directing Wally to file the application by the close of business that day due to an unforeseen statutory bar date. Drawings are not required to understand the claimed method. A patent would be barred if the application is filed the following day. Which of the following combination of acts presents the **minimum** course of action to be taken by Wally in order to obtain a filing date that avoids the statutory bar?

- (A) File the application, oath and filing fee by the close of business without the drawings.
- (B) File the application by the close of business without the oath, filing fee or drawings.
- (C) File the application and filing fee without the drawings and later file a petition for accepting the color drawings along with the petition fee; three (3) sets of color drawings; and a proposed amendment to insert the following in the specification: “The file of this patent contains at least one drawing executed in color. Copies of this patent with color drawing(s) will be provided by the Patent and Trademark Office upon request and payment of the necessary fee.”
- (D) File the application without the drawings by the close of business; file a preliminary amendment the next day that amends the specification to refer to drawing figures and which includes a set of black and white drawings.
- (E) None of the above.

43. You received an Office action dated March 17, 1999, rejecting the claims of a pending patent application filed April 22, 1998. You prepared a timely reply that would overcome the examiner's rejections and place the application in condition for allowance. You put the reply in a correctly addressed envelope, with a metered mail stamp having a date of June 4, 1999. Your procedure is to give all outgoing mail to your staff assistant who keeps it locked in his desk drawer until he can mail it at the end of his work day. The reply fell inside the desk, behind the drawer, and was never mailed. Today, November 3, 1999, you receive a Notice of Abandonment of the patent application for which the reply was prepared. You searched and found the unopened and unmailed envelope. You know that the applicant, your mother, sold five items covered by all the claims of the now abandoned application over a year ago (but not before the original application was filed) and that her commercial survival depends on obtaining the claims in the abandoned application. A valid patent, including the claims in the abandoned application, can be obtained for your mother, if:

- (A) you submit a new reply to the patent examiner arguing the commercial success of the item as shown by the sales of the five items sold over a year ago with affidavits under 37 CFR § 1.132 traversing the holding of abandonment.
- (B) you mail the reply today in its original, sealed envelope which takes precedence over the Notice of Abandonment since the date stamped on the envelope is both before the due date for reply and before the Notice of Abandonment.
- (C) the applicant files a petition to revive an unintentionally abandoned application stating that the entire delay in filing the required reply was unintentional, files the reply that was prepared by you in June 1999, and submits the appropriate petition fee.
- (D) you provide the unopened envelope as evidence of the staff assistant's negligence and petition the Group Director to reopen prosecution of the application on the merits.
- (E) you file a petition to revive an unavoidably abandoned application stating that the entire delay in filing the reply was unavoidable, submitting the required reply prepared by you in June 1999, the proper petition fee, and a terminal disclaimer and fee dedicating to the public a terminal part of the term of any patent granted equivalent to the period of abandonment of the application.

44. A practitioner should consider whether information presented during prosecution of an application may be used by the examiner as evidence against the applicant. What evidence may an examiner not use to demonstrate that a claim fails to correspond in scope with that which an applicant regards as his or her invention?

- (A) Arguments, containing admissions, advanced in a reply filed by the practitioner representing the applicant.
- (B) Admissions contained in a brief.
- (C) The lack of agreement between the claims and the specification.
- (D) Affidavits, containing admissions, filed under 37 CFR § 1.132.
- (E) All of the above.

45. Which of the following statements regarding a reissue patent application is *true*?

- (A) Only one reissue patent application is permitted to be issued for distinct and separate parts of the thing patented.
- (B) New matter may be properly added in a reissue application to correct an error made during the prosecution of the original patent application.
- (C) A reissue will not be granted to “recapture” claimed subject matter deliberately canceled in an application to obtain a patent.
- (D) To retain the benefit of priority under 35 U.S.C. § 119, it is not necessary to make a new claim for priority in the reissue patent application if a claim for priority was perfected in the application on which the original patent was made.
- (E) (C) and (D).

46. You filed a patent application for Sam, who invented an apparatus for labeling and identifying baseballs. In the application, the apparatus is described as including means for marking baseballs; an ultraviolet light source; and a computer coupled to both the means for marking baseballs and the ultraviolet light source. The only means for marking baseballs set forth in the application was a commercially available invisible ink stamper, also known as a marker. The specification described the invention as being useful for identifying home run baseballs. The application was filed with one claim, which stated:

Claim 1. An apparatus, comprising: an invisible ink stamper; an ultraviolet light source; and a computer coupled to said invisible ink stamper and to said ultraviolet light source.

Claim 1 was properly rejected under 35 U.S.C. §102(b) as being anticipated by a patent issued to McGoo, which disclosed an apparatus having only an invisible ink stamper, an ultraviolet light source, and a computer coupled to the invisible ink stamper and to the ultraviolet light source. The McGoo patent did not mention identifying baseballs, but described the invention as useful for labeling and identifying baseball bats. Which of the following amendments, if any, avoids anticipation of Claim 1 by the McGoo patent?

- (A) 1. (amended once) An apparatus intended to be used to identify home run baseballs, comprising: an invisible ink stamper; an ultraviolet light source; and a computer coupled to said invisible ink stamper and to said ultraviolet light source.
- (B) 1. (amended once) An apparatus, [comprising] consisting of: an invisible ink stamper, an ultraviolet light source, and a computer coupled to said invisible ink stamper and to said ultraviolet light source.
- (C) 1. (amended once) An apparatus, comprising: [an invisible ink stamper] a marker; an ultraviolet light source, and a computer coupled to said means for marking baseballs and to said ultraviolet light source.
- (D) (B) and (C).
- (E) None of the above.

47. 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 1800°C to 2000°C;
- (ii) passing a first gas over said heated base, said first gas comprising a mixture of hydrogen, SiCl₄, phosphorus, and methane, whereby said first gas decomposes over said heated base and thereby forms a first deposited layer of silicon, phosphorus and carbon on said heated base;
- (iii) heating said base having said deposited layer to a second temperature of approximately 1620°C; and
- (iv) passing a second gas over said base heated to said second temperature, said second gas consisting of a mixture of hydrogen, SiCl₄, AlCl₃, and methane, whereby said second gas decomposes over said heated base to form a second deposit layer adjacent said first layer, said second layer comprising silicon, aluminum and carbon.

Assuming proper support in the specification, which of the following claims, if presented in the same application, is a proper claim?

- (A) Claim 2. The method of claim 1, wherein said first temperature is in the range of 1875°C to 1925°C, and preferably between 1895°C and 1905°C.
- (B) Claim 3. The electrical device of claim 1, wherein said first gas further comprises an inert gas such as Argon.
- (C) Claim 4. The method of claim 1, wherein said second gas further consists of Argon.
- (D) Claim 5. The method of claim 1, wherein said first gas further comprises an inert gas such as Argon.
- (E) Claim 6. The electrical device of claim 1, wherein said heated base has a first layer comprising silicon, phosphorus, and carbon.

48. An original claim in a patent application to a mechanical arts invention recites the limitation of “a clip,” which is shown in an original application drawing as being one of several elements of the invention. The “clip” is well known in the mechanical arts. However, “a clip” does not appear in the original written description part of the application. Which of the following is correct?

- (A) The written description may not be properly amended to include “a clip.”
- (B) The claim is indefinite with respect to “a clip.”
- (C) The application lacks an enabling disclosure as to “a clip.”
- (D) The claim is definite with respect to “a clip.”
- (E) The application fails to set forth the best mode for “a clip.”

49. A nonprovisional patent application has been filed for inventor Alton disclosing and claiming an alumino-silicate catalyst for oxidizing organic compounds. Which of the following statements, considered separately, about the best mode contemplated by Alton for the alumino-silicate catalyst is not true?

- (A) The best mode must be designated as the best mode in the application if the application contains several embodiments, one of which is the best mode.
- (B) The presence of one specific example in the specification is evidence that the best mode has been disclosed.
- (C) The best mode need not be updated if, between the time of filing the non-provisional patent application and a continuation application, Alton discovered a better catalyst than the best mode disclosed in the non-provisional application.
- (D) A failure to disclose the best mode in the application as filed cannot be cured by first introducing into the application by amendment a specific mode of practicing the invention.
- (E) There is no statutory requirement for the best mode being disclosed in the specification as a specific example.

50. You are drafting a patent application disclosing and describing a door assembly wherein a door, a door frame, and a pair of hinges are separate elements which must be included in a claim to the assembled combination of a door secured to a door frame by a pair of hinges. The application discloses that it is essential to the invention that the door is secured to the doorframe in the described manner to permit the door to be readily opened and closed. The application further discloses that it is also essential to the invention for the assembly, in a closed relationship, to keep out exterior elements, while providing privacy and permitting quick egress in an emergency. Which of the following claims properly sets forth the combination?

- (A) An assembly having a door capable of being hingedly connected to a doorframe.
- (B) An assembly having a door and means for securing the door.
- (C) An assembly having a door and a pair of hinges for securing the door.
- (D) An assembly having a door, and a doorframe, said door being secured to said doorframe with a pair of hinges.
- (E) An assembly having a door adapted to be secured to a doorframe with a pair of hinges.

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

NOVEMBER 3, 1999

Afternoon Session (50 Points)

Time: 3 Hours

DIRECTIONS

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

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

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

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

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO

1. Your client, Smith, invents a composition for adhering metal to glass. You prepare a patent application including a specification and several claims of varying scope. Your specification includes a detailed description of Smith's invention, which sets forth the following: the composition is made from, among other things, a combination of A, B, and C; the composition is at least 20% A but can be up to 30% A; the composition works best if it is 24% to 26% A; and the composition contains substantially equal portions of B and C. Your specification also includes guidelines for determining what would constitute substantially equal portions of B and C in the composition. Furthermore, your specification includes a detailed explanation of why it is preferable to use 24% to 26% A. Among the following claims drawn to Smith's invention, which is the broadest claim that is unlikely to be properly rejected under 35 U.S.C. 112, second paragraph?

- (A) A composition comprising 20 to 30% A, and substantially equal portions of B and C.
- (B) A composition comprising 20 to 30% A, preferably 24% to 26%A.
- (C) A composition comprising 20 to 30% A, 30% B, and 30% C.
- (D) A composition comprising 24% A, and substantially equal portions of B and C.
- (E) A composition comprising 20 to 30% A, and equal portions of B and C.

2. On August 17, 1999, you filed a reissue application to enlarge the scope of the claims directed to an electrical device in a patent granted to your client on January 20, 1998. In the patent, as well as the patent application on which the patent was granted, the broadest disclosure (including the specification and the original claim) regarding the resistance of the device is that "the device's resistance is .02 to 1.5 ohms." The examiner issued a non-final first Office action containing a rejection of several claims in the reissue application. Your reply to the first Office action includes presentation of an amendment to the specification adding the following disclosure: "The device can have a resistance of 3.0 to 4.5 ohms." No petition and fee requesting entry of the amendment was filed. In accordance with PTO practice and procedure,

-
- (A) the amendment will be entered, and if the examiner objects to the amendment to the specification as being new matter, you should traverse the objection on the grounds that the patent owner is entitled to enlarge the scope of the content of the patent.
 - (B) the amendment will not be entered because the amendment to the specification does not enlarge the scope of the claim.
 - (C) the amendment will not be entered because a petition and necessary fee requesting entry of the amendment was not filed.
 - (D) the amendment will be entered, and if the examiner objects to the amendment to the specification as being new matter, you should file another amendment canceling "The device can have a resistance of 3.0 to 4.5 ohms."
 - (E) the amendment will be entered because is does not introduce new matter.

3. Smith received a second Office action in his pending application finally rejecting pending claims 1-20 on prior art grounds. Claims 1 and 11 are presented in independent form, claims 2-10 depend from claim 1, and claims 12-20 depend from claim 11. To continue prosecution, Smith submitted an Amendment After Final Rejection narrowing the scope of independent claims 1 and 11. Smith believed the Amendment placed the application in condition for allowance and, accordingly, requested entry of the Amendment and allowance of the application. However, the Examiner denied entry on the ground that the Amendment presented new issues requiring further consideration or search. Rather than appeal the rejection, Smith filed a request for a Continuing Prosecution Application (CPA), and asked that the Amendment After Final be entered as a Preliminary Amendment. The Examiner issued a first Office action in the CPA allowing claims 1-10 and finally rejecting claims 11-20 on substantially the same grounds that these claims had been rejected in the parent application. Which of the following statements regarding the first Office action in the CPA is correct?

- (A) The Examiner cannot properly allow claims 1-10 because a determination was made in the parent application that the Amendment After Final Rejection presented new issues requiring further consideration or search.
- (B) The Examiner is precluded from rejecting claims 11-20 on substantially the same grounds that these claims had been rejected in the parent application because a determination was made in the parent case that the Amendment After Final Rejection presented new issues requiring further consideration or search.
- (C) The Amendment After Final Rejection cannot be entered as a Preliminary Amendment in the CPA application.
- (D) The finality of the rejection of claims 11-20 is improper.
- (E) (B) and (D).

4. After filing a proper appeal brief for an application you are prosecuting, you begin to have doubts as to how convincing your arguments would be to the Board of Patent Appeals and Interferences ("Board"). After further consideration, you agree to the examiner's suggestions. You file an amendment incorporating all of the examiner's suggestions after you filed the appeal brief and before an examiner's answer is mailed in this patent application. In accordance with PTO practice and procedure, the amendment _____

- (A) may be entered if the amendment obviously places the application in condition for allowance and there is a showing of good and sufficient reasons why it was not earlier presented.
- (B) will not be entered as it was not sent prior to or with the appeal brief.
- (C) will not be entered because it was not in the form of a petition.
- (D) will be entered and appended to the appeal brief for the Board's consideration.
- (E) will not be entered because a petition should have accompanied it since it was filed after the appeal brief.

5. On March 1, 1995, applicant filed a nonprovisional patent application for a stool. The original disclosure set forth that a base member of the stool was generally elliptical and, in particular, could be circular (a special kind of ellipse). It also stated that all leg members must be parallel to each other. The only claim included in the application stated as follows:

1. A stool for sitting on, comprising a circular shaped base member having a top surface and a bottom surface; said bottom surface having a center portion and three circular holes equally spaced about said center portion; and three leg members connected to said bottom surface, each hole having a leg member protruding therefrom.

In a first Office action rejection, the examiner rejected claim 1 under 35 U.S.C. § 102(e) as unpatentable over a U.S. Patent to Pigeon. The Pigeon patent specified that each of the leg members formed a thirty degree angle with each of the other leg members. Applicant filed a timely response to the Office action, amending the specification to state that the leg members could be substantially parallel and including guidelines for determining what would be considered “substantially parallel.” Applicant also amended claim 1 as follows:

1. (once amended) A stool for sitting on, comprising a circular shaped base member having a top surface and a bottom surface; said bottom surface having a center portion and three circular holes equally spaced about said center portion; and three leg members connected to said bottom surface, each hole having a leg member protruding therefrom, wherein the leg members are parallel to each other.

The examiner allowed Claim 1 as amended and a patent was granted to applicant on January 5, 1997. On January 5, 1999, applicant filed a reissue application, including a proper declaration pursuant to 37 CFR § 1.175. Assume that there is no other relevant prior art. In accordance with PTO rules and procedure, which of the following statements concerning the reissue application is true?

- (A) Any amendment to claim 1 so as to broaden its scope will likely be considered untimely.
- (B) If applicant amends claim 1 to replace “a circular shaped member” with “an elliptical shaped member,” then the amendment should be considered untimely since the amendment would broaden the scope of the claim.
- (C) If applicant amends claim 1 to delete “wherein the leg members are parallel to each other,” then the amended claim should be allowed.
- (D) If applicant amends claim 1 to replace “parallel” with “substantially parallel,” then the amended claim will likely be allowed.
- (E) None of the above.

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

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

7. You were drafting a patent application claiming a widget invented by your client Able. While drafting the application, you looked through a recent *Official Gazette* and noticed a patent, No. 888,888,888, directed to a widget that appears to be the same as the widget you are claiming. You obtained a copy of the patent and discovered that the patent was granted on May 4, 1999, to your client's strongest competitor, QED Incorporated. Claim 5 in the QED patent is the same widget Able invented. Claim 6 in the QED patent is an improvement to Able's widget. The QED patent was granted on a patent application filed on December 22, 1997. You have evidence that Able invented his widget before December 22, 1997. You copied, as claim 9 in Able's application, QED claim 5. Today, November 3, 1999, you are about to file, in the PTO, Able's nonprovisional patent application containing claim 9, and an information disclosure statement (IDS) listing several patents, including the QED patent, and publications. Which of the following would be the most proper course of action to take to comply with your duties to your client and the PTO?

- (A) In the IDS, state and explain why the identified patents may be relevant, and state that the burden has shifted to the examiner to find and disclose other pertinent or relevant prior art.
- (B) Identify the QED patent in bold in the list in the IDS, and include the following explanation about the QED patent: "QED discloses a relevant type of widget."
- (C) In the IDS, state, "The QED patent discloses a relevant type of widget," and provide a copy of the patent.
- (D) In the IDS, state, "Claim 9 in this application has been copied from claim 5 in the QED patent," and provide a copy of the patent.
- (E) In the IDS, state, "Claim 9 in this application has been copied from a claim in a QED patent," and argue that "Claim 6 in the QED patent is an obvious improvement to the instant invention," and provide a copy of a QED patent.

8. Jones' patent application was filed in the PTO in January 1999, claiming an invention Jones conceived and reduced to practice in the United States. Claim 1 in the application was rejected under 35 U.S.C. § 102 as being unpatentable over a U.S. patent to Smith. Smith did not derive anything from Jones, or *visa versa*. Smith and Jones were never obligated to assign their inventions to the same employer. In which of the following situations should a declaration by Jones under 37 CFR § 1.131 overcome the rejection in accordance with proper PTO practice and procedure?

- (A) The rejected claim is drawn to a genus. The Smith patent issued in March 1998, on an application filed in June 1994. The patent discloses, but does not claim, a single species of the genus claimed by Jones. The declaration shows completion in April 1994, of the same species disclosed by Smith.
- (B) The rejected claim is drawn to a species. The Smith patent issued in March 1998 on an application filed in June 1994. The patent discloses, but does not claim, the species claimed by Jones. The declaration shows completion in April 1994, of a different species.
- (C) The rejected claim is drawn to a genus. The Smith patent issued in March 1998, on an application filed in June 1994. The patent discloses, but does not claim, several species within the genus claimed by Jones. The declaration shows completion in April 1994, of a species different from the reference's species and the species within the scope of the claimed genus.
- (D) The rejected claim is drawn to a genus. The Smith patent issued in March 1997, on an application filed in June 1994. The patent discloses, but does not claim, several species within the genus claimed by Jones. The declaration shows completion in April 1994, of one or more of the species disclosed in the patent.
- (E) The rejected claim is drawn to a genus. The Smith patent issued in November 1998, on an application filed in June 1994, and the patent discloses and claims several species within the genus claimed by Jones. The declaration shows completion in April 1994, of each species claimed in the Smith patent.

9. A personal interview with an examiner to discuss the merits of the claims **may not** be properly conducted by:

- (A) the inventor, even though the attorney of record is present at the interview.
- (B) a registered practitioner who does not have power of attorney in the application, but who is known to the examiner to be the local representative of the attorney of record in the case.
- (C) an unregistered attorney who is the applicant in the application.
- (D) an unregistered attorney who has been given the associate power of attorney in the particular application.
- (E) a registered practitioner who is not an attorney of record in the application, but who brings a copy of the application file to the interview.

10. Which of the following claim phrases may be used 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.

11. A final rejection, with a mailing date of Thursday, February 4, 1999, was received Saturday, February 6, 1999. The examiner set a three month shortened statutory period for reply. Which of the following will be considered as being timely filed?

- (A) A reply, mailed using the U.S. Postal Service, first class mail, on Friday, August 6, 1999, and received by the PTO on Monday, August 9, 1999 accompanied by a petition and appropriate fee for a three-month extension of time, and a certificate of mailing stating, "I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on August 6, 1999." The certificate of mailing was signed by and contained the printed name of one who reasonably expected the response to be mailed in the normal course of business by another no later than August 6, 1999.
- (B) A reply, mailed using the U.S. Postal Service, on Tuesday, May 4, 1999 and received by the PTO on Thursday, May 6, 1999 accompanied by a copy of a U.S. Postal Service certificate of mailing, which states "One piece of ordinary mail addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231." The certificate of mailing contained an official U.S. Postal Service date stamp of May 4, 1999, and the printed name of one who reasonably expected the response to be mailed in the normal course of business no later than May 4, 1999.
- (C) A reply, mailed using the U.S. Postal Service, first class mail, on Wednesday, August 4, 1999, and received by the PTO on Monday, August 9, 1999, accompanied by a petition and the appropriate fee for a three-month extension of time, and a certificate of mailing stating, "I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on August 6, 1999." The certificate of mailing was signed by and contained the printed name of one who reasonably expected the response to be mailed in the normal course of business by another no later than August 4, 1999.
- (D) (A) and (C).
- (E) None of the above.

12. Which of the following statements is true concerning terms of degree (relative terms, e.g., such as, “hotter”) used in claim language?

- (A) Definiteness of claim language using terms of degree should not be analyzed using a claim interpretation that would be given by one possessing the ordinary level of skill in the art, and only the specification should be used to interpret the claim.
- (B) A claim may be rendered indefinite even if the specification uses the same term of degree as the claim language, if the term of degree is not understandable by one of ordinary skill in the art when the term of degree is read in light of the specification.
- (C) If the specification includes guidelines which would enable one of ordinary skill in the art to determine the scope of a claim having a term of degree, then the language of the guidelines must be included in the claim in order to render the claim definite.
- (D) If the original disclosure does not include guidelines which would enable one of ordinary skill in the art to determine the scope of a claim having a term of degree, then as long as the term of degree in the claim was part of the original disclosure, the claim will be properly rendered definite by amending the specification to provide guidelines concerning the term of degree which would enable one of ordinary skill in the art to determine the scope of the claim.
- (E) None of the above.

13. You are a registered patent agent prosecuting a patent application filed on behalf of Harry. You received an Office action having a mailing date of August 13, 1999, in which the examiner set a three month shortened statutory period for reply and rejected all of the claims in the application under 35 U.S.C § 112 for failing to particularly point out and distinctly claim the invention. After receiving the Office action, you discovered a recently issued U.S. patent that you believe discloses and claims your client’s invention. On September 28, 1999, you filed an amendment copying some of the claims from the patent for the purpose of provoking an interference and notify the examiner that you have copied specific claims from the patent. In a second Office action dated October 13, 1999, the examiner rejected the copied claims under 35 U.S.C. § 112 as being based on a non-enabling disclosure and set a three month shortened statutory period for reply. If no requests for an extension of time are filed, the last day(s) for filing replies to the first and second Office actions, is(are):

- (A) Monday, November 15, 1999.
- (B) Monday, November 15, 1999, and Thursday, January 13, 2000, respectively.
- (C) Monday, November 29, 1999, and Wednesday, January 12, 2000 respectively.
- (D) Tuesday, December 28, 1999.
- (E) Thursday, January 13, 2000.

14. Claim 1 in a patent application states the following:

1. A modular telephone plug crimping tool comprising:
 - (i) a pair of body parts comprising first and second body parts, each having a fixed length;
 - (ii) a flexible member connecting an end of the first body part to an end of the second body part;
 - (iii) a hand lever;
 - (iv) a pivot pin connecting the hand lever to the first body part;
 - (v) an interchangeable crimping punch removably seated in the first body part and guided relative to an interchangeable crimping anvil removably seated in the second body part;
 - (vi) a roller mounted on the pivot pin for engaging the crimping punch; and
 - (vii) a guide pin being fixed in said second body part and extending in aligned bores in said pair of body parts.

Which, if any, of the following claims, if presented in the application, is a proper dependent claim in accordance with PTO rules and procedure.

- (A) 2. The modular telephone according to claim 1, wherein said crimping punch comprises integral contact and strain relief punch portions.
- (B) 2. The modular telephone plug crimping tool according to claim 1, wherein said second body part has an adjustable length.
- (C) 2. A process for using the modular telephone plug crimping tool of claim 1 to connect a telephone to a telephone line.
- (D) 2. The modular telephone plug crimping tool according to claim 1, further comprising: a free end on each of said first and second body parts; first and second stripping blades adjustably and detachably provided at said free ends of said first and second body parts, respectively; and at least one severing blade held in cooperating relationship with a severing anvil, said severing blade and severing anvil being provided on said first and second body parts, respectively.
- (E) None of the above.

15. You are prosecuting an application for inventor Smith that receives a rejection under 35 U.S.C. § 102(b) based on a U.S. patent to Jones that discloses and claims the same invention. Which of the following, if any, will overcome the rejection?

- (A) An affidavit or declaration showing that Jones is not the true inventor.
- (B) An affidavit or declaration showing commercial success of the Smith invention.
- (C) An affidavit or declaration containing an argument that the invention claimed in the Smith application provides synergistic results.
- (D) An affidavit or declaration swearing back of the Jones patent.
- (E) None of the above.

Questions 16 and 17 are based on the following facts. Answer each question independently of the other.

A patent application contains a single independent claim:

1. A process for manufacturing water soluble crayons which comprises (i) preparing one or more water soluble alkoxylation products by contacting an organic compound selected from the group consisting of alcohols and carboxylic acids, with an alkylene oxide in the presence of an effective amount of a catalyst under alkoxylation conditions; (ii) preparing a water soluble crayon composition by adding a coloring agent to the one or more water soluble alkoxylation products; (iii) pouring said water soluble crayon composition into a mold; and (iv) solidifying said water soluble crayon composition by cooling.

The coloring agents disclosed in the specification include pigments selected from the group consisting of titanium dioxide, red iron oxide and carbon black. These pigments are used in an amount of about 1 to 30 weight percent or greater, preferably about 4 to about 25 weight percent, of the total weight of the crayon composition. As disclosed in the specification, preferred organic compounds useful in the process of this invention also include alcohols, carboxylic acids, and amines. The specification also discloses that the water soluble crayon compositions harden readily upon cooling, i.e. when exposed to a temperature of from about 10°C. to 15°C.

16. Which of the following choices would be a proper dependent claim which could be added to the application by amendment and be supported by the specification?

- (A) 2. A process according to Claim 1 wherein said water soluble crayon composition is exposed to a temperature of at least 10°C.
- (B) 2. A process as set forth in Claim 1 wherein said coloring agent is titanium dioxide.
- (C) 2. A process for manufacturing water soluble crayons as set forth in Claim 1 wherein said coloring agent is 1 to 30 weight percent of the total weight of the crayon composition.
- (D) 2. A process as set forth in Claim 1 wherein said organic compound further comprises amines.
- (E) (B) and (C).

17. Which of the following amendments to Claim 1 are in accordance with PTO policy and procedure and are supported by specification?

- (A) In Claim 1, line 3, before “alcohols” delete “monohydric”.
- (B) In Claim 1, line 4, after “alcohols” insert “amines”.
- (C) In Claim 1, line 6, delete “a coloring agent” and insert “titanium dioxide”.
- (D) In Claim 1, line 7, after “cooling” insert “to a temperature of 13°C.”
- (E) (B) and (C).

18. Bill wishes to amend the sole, original Claim 1 of the patent granted to him and obtain the following amended Claim 1. The amended Claim 1 set forth below is fully supported by the original disclosure in the application:

- 1. A computer processor comprising:
 - a. a plurality of registers divided into a global port subset and a local pool subset;
 - b. means for distinguishing a successful [unconditional] interruptable jump operation;
 - c. means for receiving interrupts or exceptions; and
 - d. an interrupt or exception handler for handling the interrupts or exceptions in response to distinguishing the [unconditional] interruptable jump operation [from the local pool subset].

In the absence of questions of recapture, novelty, obviousness, and utility, which of the following statements, if any, is true?

- (A) A claim so amended is properly presented during a reexamination proceeding where a request for reexamination was filed on September 9, 1999, and a certificate of reexamination may be issued where reexamination is sought of a patent granted on July 15, 1997.
- (B) A claim so amended is properly presented in a reissue application filed on September 9, 1999, and a reissue patent is grantable where reissuance is sought of a patent granted on July 15, 1997.
- (C) A claim so amended is properly presented in a reissue application filed on September 9, 1999, and a reissue patent is grantable where reissuance is sought of a patent granted on November 18, 1997.
- (D) A claim so amended is properly presented in a request for reexamination filed on September 9, 1999, and a certificate of reexamination may be issued where reexamination is sought of a patent granted on November 18, 1997.
- (E) A claim so amended is properly presented in a reissue application filed any time before expiration of the term of the patent inasmuch as the scope of Claim 1 in the original patent is narrowed by replacing the word “unconditional” with the word “interruptable.”

19. Which of the following requirements of 35 U.S.C. § 112 does not apply to design patent claims?

- (A) The written description requirement of the first paragraph.
- (B) The best mode requirement of the first paragraph.
- (C) The requirement in the second paragraph to distinctly claim the subject matter which the applicant regards as his invention.
- (D) The requirement in the third paragraph for an independent claim.
- (E) None of the above.

20. Inventors Moe and Jeff originally gave attorney Curly a power of attorney to prosecute their application before the PTO. At this time, inventor Jeff has decided that he no longer wants attorney Curly to represent him. Instead, inventor Jeff wants you to represent him. Thus, Jeff wants the power of attorney to Curly revoked. Moe does not agree and wants Curly to continue. How, if at all, should the revocation and appointment of a new power of attorney be properly handled?

- (A) Papers revoking Curly's power of attorney with regard to Jeff, and giving you a new power of attorney need to be signed by Jeff and must include a statement from Moe indicating that Moe wishes to retain Curly.
- (B) Papers revoking Curly's power of attorney with regard to Jeff, and giving you a new power of attorney cannot be accepted without concurrence by Curly.
- (C) Papers revoking Curly's power of attorney with regard to Jeff, and giving you a new power of attorney signed only by you should be accompanied by a petition giving good and sufficient reasons as to why such papers should be accepted upon being filed together with an appropriate fee.
- (D) Papers revoking Curly's power of attorney with regard to Jeff, and giving you a new power of attorney signed only by Jeff should be accompanied by a petition giving good and sufficient reasons for acceptance should be filed together with an appropriate fee.
- (E) Papers revoking Curly's power of attorney with regard to Jeff, and giving you a new power of attorney cannot be accepted without concurrence of Moe and Curly.

21. Which of the following files is ordinarily **not open** to the public?

- (A) A substitute application.
- (B) An interference proceeding file involving a U.S. patent.
- (C) A reissue application.
- (D) A reexamination proceeding file.
- (E) All of the above.

22. You are preparing a patent application for filing in the PTO. The application describes a microcomputer having several components. You have drafted the following independent claim:

1. A micro-computer comprising:
 - (i) a central processing unit for processing information;
 - (ii) a memory unit for storing information;
 - (iii) an input device for entering information characterized by a keyboard;
 - (iv) an output device for viewing information consisting of a video monitor; and
 - (v) a bus for interconnecting the central processing unit to the memory unit, the input device and the output device.

In the absence of issues of supporting disclosure, and following proper PTO practices and procedures, which of the following dependent claim(s) is (are) an improper dependent claim?

Claim 2.	The micro-computer of Claim 1, wherein the memory unit contains random access memory.
Claim 3.	The micro-computer of Claim 1 or 2, wherein the input device includes a light pen.
Claim 4.	The micro-computer in any one of the preceding claims, wherein the output device is a printer or a video monitor.
Claim 5.	The micro-computer of Claim 4, wherein the memory unit contains read-only memory.
(A)	Claim 2.
(B)	Claim 2 and Claim 3.
(C)	Claim 3.
(D)	Claim 5.
(E)	Claim 4 and Claim 5.

23. To avoid a proper rejection of a claim for being indefinite, which of the following expressions in the claims must be supported by a specification disclosing a standard for ascertaining what the inventor means to cover?

(A)	“relatively shallow.”
(B)	“of the order of.”
(C)	“similar” in the following claim preamble: “A nozzle for high-pressure cleaning units or similar apparatus.”
(D)	“essentially” in the following phrase following the claim preamble: “a silicon dioxide source that is essentially free of alkali metal.”
(E)	All of the above.

24. Claims 1 through 5 in a patent application read as follows:

1. A computer comprising:
 - (i) a microprocessor having a maximum clock rate of 350 megahertz;
 - (ii) a random access memory chip coupled to said microprocessor;
 - (iii) a read only memory chip coupled to said microprocessor; and
 - (iv) a case enclosing said microprocessor, said random access memory chip, and said read only memory chip.
2. The computer of claim 1, wherein said case has an outer surface comprised of plastic.
3. The computer of claims 1 or 2, further comprising a peripheral controller chip coupled to said microprocessor.
4. The computer of claim 1, wherein said memory chip has eight million storage locations.
5. The computer of claim 2, wherein said microprocessor has a maximum clock rate of 400 megahertz.

Which of the following is/are proper dependent claims(s) in accordance with 37 CFR §1.75?

- (A) Claims 2 and 3.
- (B) Claim 4 only.
- (C) Claims 2 and 5.
- (D) Claim 2 only.
- (E) None of the above.

25. Gonnagerich Corporation asked you to represent, before the PTO, some of its employees who have invented an apparatus. On Tuesday, August 17, 1999, you deposited a nonprovisional patent application containing a specification with ten claims drawn to the apparatus via hand delivery to the PTO. At that time, you neither supplied the names of any of the actual inventors with the application, nor did you file with the application drawings necessary to understand the invention. The specification refers to the drawings. You sent the drawings by first class mail to the PTO on Wednesday, September 13, 1999, and the PTO received them on Wednesday, September 15, 1999. On Wednesday, September 29, 1999, using the "Express Mail Post Office to Addressee" service of the U.S. Postal Service, and so certifying in compliance with 37 CFR § 1.10, you deposited with the U.S. Postal Service a declaration pursuant to 37 CFR § 1.63 signed by all the actual inventors. On Friday, October 1, 1999, the PTO received the signed declaration. What will be the earliest filing date given to the application by the PTO?

- (A) August 17, 1999.
- (B) September 13, 1999.
- (C) September 15, 1999.
- (D) September 29, 1999.
- (E) October 1, 1999.

26. X invented a laminate which is most broadly disclosed in a patent application as containing a transparent protective layer and a light-sensitive layer, without an intermediate layer. The prior art included a laminate containing a transparent protective layer and a light-sensitive layer held together by an intermediate adhesive layer. Which of the following claims would overcome a 35 USC § 102 rejection based on the prior art?

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

27. On April 21, 1998, a patent was issued to Belinda on a novel switching circuit. Shortly after receiving the patent grant, Belinda assigned 50% of her right, title and interest in her patent to Ace and 25% of the right, title and interest to Duce. After the assignments were recorded in the PTO, Belinda discovered that her claim coverage is too narrow because her patent attorney did not appreciate the full scope of her invention. Today, November 3, 1999, Belinda consults you about filing a reissue application. The reissue oath must be signed and sworn to by:

- (A) Belinda, Ace and Duce.
- (B) Belinda only.
- (C) Belinda and either Ace or Duce.
- (D) Ace and Duce only.
- (E) the attorney or agent of record.

28. A patent specification can be altered by interlineation before it is filed in the PTO. Such alterations are permitted if each interlineation is initialed and dated by the:

- (A) registered practitioner who prepared the specification, even if the applicant is available to sign the oath or declaration.
- (B) applicant, before the oath or declaration is signed by the registered practitioner.
- (C) applicant, at any time after the oath or declaration is signed.
- (D) applicant, before the oath or declaration is signed by the applicant.
- (E) registered practitioner who prepared the specification before the oath or declaration is signed by the applicant.

29. On January 2, 1999, Billie files a U.S. patent application that discloses forming a naturally occurring composition X by a chemical reaction of compounds A, B and C under specified ranges of temperature and pressure. The application includes a statement "The most common meaning of the term 'fluid' includes both gases and liquids. However, it has been determined that the present invention properly operates when B is in a gaseous, fluid, or solid state, so long as temperature of the solid B is above 2°C. Below that temperature, it is believed the chemical reaction will not occur. Thus, in the context of the present invention, the term 'fluid' means 'gaseous', 'liquid', and/or certain solid states." However, research conducted in 1998 by Greene in England shows that the desired chemical reaction would occur with solid compound B at a temperature of 1°C. Greene also showed the reaction with compound B in a liquid and gaseous states. Greene submitted his research results to a British technical journal in November 1998, and they were published on January 5, 1999. Originally filed Claim 1 of Billie's application is directed to "[a] method for forming composition X comprising mixing compound A with fluid compound B at a temperature between 0°C and 10°C". Examiner Redd locates the published Greene research results that disclose the identical method set forth in Billie's Claim 1. Which rejection of Claim 1 is in accordance with proper PTO practices and procedures?

- (A) Claim 1 is rejected under 35 U.S.C. § 112, paragraph 2 as being indefinite because the meaning of the term "fluid" is unclear. Billie is encouraged to clarify the claim by deleting "fluid" and inserting --liquid-- in its place.
- (B) Claim 1 is rejected under 35 U.S.C. § 102(a) as being anticipated by Greene because, although the research results were published after Billie's filing date, the research results were submitted to the British technical journal before the filing date and were therefore known in the art.
- (C) Claim 1 is rejected under 35 U.S.C. § 112, paragraph 1 as being based on an insufficient specification because the claim does not specify a pressure at which A and B are mixed and, depending on that pressure, compound B could be either a gas or a liquid at the recited temperature range.
- (D) Claim 1 is rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter because composition X occurs naturally.
- (E) Claim 1 is rejected under 35 U.S.C. § 112, paragraph 2 as being based on an incorrect theory of operation because the theory of operation disclosed in the specification is inconsistent with the claim.

30. Which of the following may not properly apply for a patent on an invention?

- (A) A child.
- (B) A convicted felon.
- (C) A British subject.
- (D) A current employee of the PTO.
- (E) A scientist who has assigned to his employer all rights to the invention.

31. An international application under the Patent Cooperation Treaty (PCT), which designated the United States, was filed on November 1, 1996. The application claimed priority of a prior French national application filed on December 6, 1995. A copy of the international application was communicated to the United States as a designated office on June 20, 1997. A demand for international preliminary examination, in which the United States was elected, was filed on June 5, 1997. Accordingly, the thirty month period of PCT Article 39(1)(a) expired at midnight on June 6, 1998. The applicant submitted the basic national fee to enter the United States national stage on June 2, 1998. On August 3, 1998, the applicant timely submitted a translation of the international application and a declaration of the inventors in compliance with PCT regulations in reply to a Notice of Missing Requirements. Also, on August 10, 1998, the applicant timely submitted a translation of amendments under Article 19 of the PCT in reply to the Notice of Missing Requirements. On August 29, 1998, a Notice of Acceptance was mailed to the applicant. The national stage application issued as a U.S. patent on October 13, 1999. What is the effective date of the U.S. patent as a reference under 35 U.S.C. § 102(e)?

- (A) November 1, 1996.
- (B) June 2, 1998.
- (C) August 3, 1998.
- (D) August 10, 1998.
- (E) October 13, 1999.

32. A client comes to you and tells you that he has been informed by his competitor that he is infringing the competitor's patent. Your client tells you that the competitor's invention was well known in the field at the time the application for the patent was filed. Your client shows you several published articles, two United States patents, and two written statements by experts in the field which clearly support his conclusion. Upon further investigation, you find that the published articles and patents were not considered by the examiner during the prosecution of the patent application. Your client informs you that he would like to avoid litigation, and have the PTO take action to invalidate the patent. Which of the following choices would be an appropriate course of action to take on behalf of your client?

- (A) Petition the Commissioner of Patents and Trademarks to revoke the patent.
- (B) File a request and fee for reexamination of the claims in the patent relying on the published articles and the U.S. patents as the basis for reexamination, and include all statements, information, and documents required by PTO rules for initiating reexamination proceedings.
- (C) File a protest in the PTO with copies of the published articles, patents and the written statements from the experts, along with an explanation of their pertinence to the claims of the patent.
- (D) File in the PTO copies of all of the documents provided to you by your client and request that they be made of record in the patented file.
- (E) (B) and (C).

33. Ann invented an electrical signal filter for obtaining increased signal-to-noise ratios in certain electrical systems. Ann filed a first non-provisional patent application on May 1, 1997, fully disclosing and claiming one embodiment of her invention, a capacitor. The sole claim stated: “a capacitor for filtering electrical signals, comprising: a first terminal connected to a first plate; a second terminal connected to a second plate; and an electrical insulator between said first plate and said second plate.” The first application also disclosed that even better results could be obtained if the capacitor were coupled to a resistor. Ann wanted to file a second application in the future specifically claiming the combination of the capacitor and resistor. On February 1, 1999, while Ann’s first application was still pending, Ann filed a continuation application under 37 CFR § 1.53(b). The continuation application contains the following single claim: “a capacitor for filtering electrical signals, comprising: a first terminal connected to a first plate; a second terminal connected to a second plate; an electrical insulator between said first plate and said second plate; and a resistor, connected to said first terminal.” Ann received a non-final Office action wherein the claim in the continuation application was provisionally rejected under the judicially created doctrine of double patenting over the claim drawn to a capacitor in Ann’s copending first application. The rejection correctly stated that the subject matter claimed in Ann’s continuation application was fully disclosed in her copending first application and would be covered by a patent granted containing the claim in the first application. Neither application was ever assigned to anyone. The rejection may be properly overcome by a timely reply:

- (A) traversing the rejection and arguing that since the first application had not yet matured into a patent, a double patenting rejection was unfounded.
- (B) arguing that rejections of this type are no longer warranted for continuation applications, since any utility application filed on or after June 8, 1995, will expire 20 years from its filing date, and therefore Ann’s continuation application, which gets the benefit of the filing date of the first application, would expire at the same time as the first application, anyway.
- (C) arguing that the claim in the continuation application is patentably distinct and unobvious from the claim in the first application.
- (D) including a terminal disclaimer, signed by Ann, disclaiming any portion of the term of any patent granted on the continuation application beyond twenty years from May 1, 1997, and including a provision in the terminal disclaimer that any patent granted on the continuation application shall be enforceable only for and during such period that said patent is commonly owned with the first application.
- (E) including the filing of a terminal disclaimer, signed by Ann, disclaiming any portion of the term of any patent granted on the continuation application beyond twenty years from May 1, 1997.

34. Your client, Vada, disclosed the following information to you. While vacationing on a desert island, she discovered a salt lake where the water was a solution saturated with NaCl. Vada experimented with the solution and determined that it could be used to cure skin rashes if applied directly to the skin. By further experimentation, Vada determined that the best results could be obtained if the solution were first heated to an ideal temperature (T_i) equal to skin temperature (T_s) plus the square of the difference between room temperature (T_r) and skin temperature (T_s). Vada documented her findings in the form of the following equation: $T_i = T_s + (T_r - T_s)^2$. Vada further experimented and found that she could obtain the exact same solution that she discovered while vacationing, by mixing NaCl with water followed by heating the mixture to 212°F and cooling it to 80°F. You draft a patent application with a specification including all the information disclosed to you by Vada. Which, if any, of the following claims, included in the application, would provide the proper basis for a rejection pursuant to 35 U.S.C. § 101?

- (A) A composition comprising: water saturated with NaCl.
- (B) A composition for restoring youth.
- (C) A composition and method for treating skin rashes, comprising: a solution of water saturated with NaCl; heating said solution to a temperature defined by skin temperature plus the square of the difference between room temperature and skin temperature; and applying said solution to skin rashes.
- (D) An expression comprising: $T_i = T_s + (T_r - T_s)^2$.
- (E) All of the above.

35. Which, if any, of the following statements is true according to PTO rules and procedure?

- (A) If a claim is cancelled by an amendment and a new claim is added in the amendment, then the new claim should be numbered using the number previously assigned to the canceled claim.
- (B) A claim which recites the best mode of carrying out the invention can only properly incorporate by reference the limitations having the essential material into the claim, for purposes of satisfying the requirements of 35 U.S.C. § 112, second paragraph, if the reference is made to a U.S. patent or U.S. patent application.
- (C) For fee calculation purposes, a multiple dependent claim which refers directly to independent claims and dependent claims will always be considered to be the number of independent claims to which direct reference is made therein.
- (D) The subject matter disclosed in a first claim which is part of the original disclosure in a nonprovisional patent application may be relied upon for purposes of enabling a second claim in the application in order to satisfy the requirements of 35 U.S.C. § 112, first paragraph, even if the detailed description and drawings, taken alone, are inadequate to satisfy the requirements of 35 U.S.C. § 112, first paragraph, with respect to the second claim.
- (E) None of the above.

36. A patent application includes a specification describing a mechanical fastener that attaches a rubber heel to the bottom of a shoe. The particular structure of the fastener allows the heel to maintain a secure attachment to the shoe while providing a cushioning effect when the shoe is worn. The specification includes a drawing clearly illustrating the fastener. The written portion of the specification accurately explains the structure of the fastener, the manner in which the fastener attaches the heel to the shoe, and how the cushioning effect is obtained. Additionally, the last paragraph of the specification states “It should be understood that the present invention is not limited to the preferred embodiment described above, and that changes may be made without departing from the spirit or scope of the invention. For example, an adhesive may be used in conjunction with the mechanical fastener to more securely attach the heel to the shoe.” No specific formulation of adhesive is given in the specification, but such adhesives are well known in the art. Claim 1 of the application reads:

1. A system for securely attaching a rubber heel to the bottom of a shoe and providing a cushioning effect when worn, said system comprising cushioning means for mechanically fastening said heel to said shoe.

Which of the following statements is correct?

- (A) Claim 1 is a “means plus function” claim subject to the provisions of 35 U.S.C. § 112, paragraph 6 and is therefore construed to cover the corresponding structure disclosed in the specification for performing the recited function and equivalent structures. Thus, claim 1 is properly construed to cover only the specific mechanical structure of the fastener described in the specification and equivalents of that mechanical structure.
- (B) Claim 1 is a “means plus function” claim subject to the provisions of 35 U.S.C. § 112, paragraph 6 and is therefore construed to cover the corresponding structure disclosed in the specification for performing the recited function and equivalent structures. Thus, claim 1 is properly construed to cover both (a) the specific mechanical structure of the fastener described in the specification and equivalents of that mechanical structure; and (b) the specific mechanical structure of the fastener described in the specification together with an adhesive and equivalents of that mechanical structure together with an adhesive.
- (C) Claim 1 is indefinite because it covers every conceivable means for achieving the stated result.
- (D) Claim 1 is not supported by an enabling specification because the claim covers every conceivable means for achieving the stated result.
- (E) Because claim 1 is drafted in means plus function language, proper claim interpretation under 35 U.S.C. § 112, paragraph 6 requires that there be a specific description in the specification of an acceptable adhesive formulation.

37. Fred files a patent application disclosing and claiming an electrical circuit. The disclosed circuit has, in series, (i) a DC current source capable of producing a variable current of 10-30 amperes, preferably 18-22 amperes; (ii) a resistor having a value in the range of 10-20 ohms, preferably 14-16 ohms; and (iii) a fixed capacitor in the range of 3-8 microfarads (mf), preferably 5-6 mf. The application includes the following four original claims:

- Claim 1. An electrical circuit comprising, in series, a DC current source, a resistor and a capacitor, wherein said DC current source is capable of producing current of 18-22 amperes, said resistor has a value in the range 10-20 ohms, and said capacitor has a value in the range of 5-6 mf.
- Claim 2. The electrical circuit of claim 1, wherein said resistor has a value in the range of 14-16 ohms.
- Claim 3. The electrical circuit of claim 1, wherein said capacitor has a value in the range of 3-8 mf.
- Claim 4. The electrical circuit of claim 1, wherein the DC current source produces variable current in the range of 18-22 amperes.

Barry's Canadian patent, published thirteen months before the effective filing date of Fred's application, discloses an electrical circuit having, in series, a DC current source which produces 20 ampere current, a 12 ohm resistor, and a 6 mf capacitor. Which of the following statements regarding the claims is correct?

- (A) Each of Claims 1- 4 is patentable over Barry's Canadian patent.
- (B) Claim 1 is unsupported by a sufficient written description because the specification does not set forth the claimed combination of component values in a single disclosed embodiment.
- (C) Claim 2 is an improper dependent claim.
- (D) Claim 3 is an improper dependent claim.
- (E) Claim 4 is an improper dependent claim.

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

- (A) A process for using monoclonal antibodies to isolate and purify interferon.
- (B) A process of using paint to cover a surface comprising applying paint to a surface and removing any excess paint.
- (C) A use of a metallic fibrous compound having a proportion of metallic granules as a motor compression part subject to stress by sliding friction.
- (D) The use of a sustained release therapeutic agent in a human body wherein said sustained release therapeutic agent comprises a painkiller absorbed on a polymeric surface.
- (E) All of the above.

39. You prepared a patent application on behalf of inventors Jo and Tommie. Jo invented a new and unobvious technique for inexpensively manufacturing a known chemical compound. Tommie invented a new and unobvious technique that uses the chemical to clean-up toxic waste spills. Both inventions have been assigned to Ace Chemical Company. The patent application fully discloses and claims both inventions. Both inventors approve the application, but Tommie is unavailable to sign an inventors' oath before an upcoming statutory bar date. In accordance with instructions, you to immediately file the application under 37 CFR §1.53(b) without an executed oath, but with an information sheet to identify the application. Tommie was inadvertently left off the list of inventors on the information sheet, which listed Jo as a sole inventor. After receiving a Notice to File Missing Parts, you submit an oath executed by both Jo and Tommie. No paper was filed to change the named inventive entity. You later receive an Office action restricting the application between Jo's invention, and Tommie's invention. In response, you elect Jo's invention, cancel the claims directed to Tommie's non-elected invention, and immediately file a divisional application directed to Tommie's invention together with an inventor's oath executed by Tommie only. The divisional application includes a specific reference to the original application. Which of the following statements is correct?

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

40. Which of the following factors would **not** be indicative of an experimental purpose for testing a utility invention?

- (A) Testing is conducted over a substantial period of time to determine the operativeness of the invention.
- (B) Testing is conducted under the supervision and control of the inventor.
- (C) Testing to determine product acceptance or market testing.
- (D) The nature of the invention was such that any testing had to be, to some extent, public.
- (E) The inventor regularly inspected the invention during the period of experimentation.

41. Your client has invented a miniature vacuum tube comprising a capacitor having a capacitance of 0.003 to 0.012 μf , preferably 0.006 μf . You draft a patent application directed to your client's invention and satisfying the requirements of 35 U.S.C. § 112. You draft the following independent claim:

1. A miniature vacuum tube comprising a capacitor having a capacitance of 0.003 to 0.012 μf .

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

- (A) 2. The miniature vacuum tube of Claim 1 wherein the capacitor has a capacitance of 0.006 μf .
- (B) 2. A miniature vacuum tube as in Claim 1 wherein the capacitor has a capacitance of 0.006 to 0.012 μf .
- (C) 2. A miniature vacuum tube as in Claim 1 wherein the capacitor has a capacitance of about 0.003 to 0.011 μf .
- (D) 2. The miniature vacuum tube of Claim 1 wherein the capacitor has a capacitance of between 0.005 and 0.012 μf .
- (E) (C) and (D).

42. A multiple dependent claim may not properly depend upon _____.

- (A) an independent claim.
- (B) another dependent claim.
- (C) any other multiple dependent claim.
- (D) a claim containing Markush language.
- (E) a claim which is in Jepson-type format.

43. In which of the following situations, considered independently of each other, does the event described below not constitute a statutory bar to the granting of a patent on an application filed August 30, 1999, claiming a bottle cap?

- (A) The inventor reduced the invention to practice in June, 1998, and sold the claimed bottle caps to a bottling company on July 30, 1998. The sale was conditioned on the bottling company's satisfaction. The inventor and the company are located in New York.
- (B) The inventor reduced the invention to practice in June, 1998, sold the claimed bottle caps to bottling companies beginning on July 30, 1998. Although the inventor sold the bottle caps to commercially exploit his invention, the inventor's manufacturing and overhead costs exceeded his income from the sales and the inventor did not profit from the sales. The inventor and the companies are located in New York.
- (C) The inventor reduced the invention to practice in June, 1998, and on July 30, 1998, assigned to Company X his patent rights to the claimed bottle cap invention for good and valuable consideration. The inventor and Company X are located in New York.
- (D) The inventor reduced the invention to practice in June, 1998, and on July 30, 1998, the inventor offered to sell his inventory of the claimed bottle cap to a bottling company. The sale was not consummated until September 3, 1999. The inventor and the company are located in New York.
- (E) The inventor reduced the invention to practice in June, 1998, and the inventor's offer, on July 30, 1998, to sell the claimed bottle caps to a bottling company was delayed in the mail and not received by the company until September 10, 1998. The inventor and the company are located in New York.

44. G is the sole inventor in a patent application filed in the PTO describing and claiming a surgical instrument. H is the sole inventor in a patent application filed in the PTO describing G's surgical instrument, as well as describing and claiming a modified embodiment of G's surgical instrument. Following proper PTO practices and procedures, under which circumstance is it most likely that you will need to overcome a provisional 35 U.S.C. § 102(e)/103 rejection in G's application?

- (A) G's application is filed in the PTO before H's application, and they do not have a common assignee.
- (B) H's application is filed in the PTO before G's application, and they do not have a common assignee.
- (C) G's application is filed in the PTO on the same date as H's application, and they have a common assignee.
- (D) G's application is filed in the PTO after H's application, and they have a common assignee.
- (E) G's application is filed in the PTO before H's application, and they have a common assignee.

45. You have been asked to draft a patent application based on Figures 1 and 2 provided below. The inventor has provided you with a written disclosure which states that the invention is directed to a toy building element which may be mounted as a dump body on a toy vehicle. According to the inventor's description, the toy building element comprises an open container part and a bottom, said container part and bottom being hingedly interconnected, said bottom being moreover provided with coupling means for coupling with other toy elements. Referring to Figure 1, the inventor's description states that the toy building element (1), which is just called a dump body, consists of two parts which are interconnected via a hinge (2) viz a container part (3) and a bottom (4). The written description further provides that the container part (3) is formed by an upwardly open, box-like unit having a substantially square bottom and four side walls, one of which is considerably lower than the others. In the embodiment shown, the bottom of the container is provided with coupling studs (5) on which toy building elements may be coupled. As described by the inventor, the bottom (4), which is square in its base face, has a plane surface on which the container part (3) rests along its entire circumference when it is tilted down. The surface of the bottom (4) may be provided with well-known means for detachably retaining (not shown) the container part (3) so that "it just takes a small force to tilt the container part." Referring to Figure 2, the inventor's description states "Figure 2 shows the dump body (1) mounted to tilt rearwardly on a toy truck (6), which comprises a bottom (7), wheels (8), and a driver's cab (9)." It is further provided that "on the chassis at the rear end of the truck (6), the truck bottom (7) is equipped with a square, plane face provided with well-known coupling means (not shown) which meet with the well-known coupling means (not shown) positioned on the underside of the bottom (4) of the dump body (1).

Based on the drawings and description provided above, which of the following claims, if any, are in accordance with proper PTO practice and procedure?

- (A) A toy building element for use as a dump body (1) for a toy vehicle, said toy building element comprising an open container part (3) and a bottom (4).
- (B) A toy building element for use as a dump body (1) for a toy vehicle, said toy building element comprising an open container part (3) and a bottom (4), said container part (3) and bottom (4) being hingedly interconnected by a hinge (2).
- (C) A toy building element comprising an open container part and a bottom, said open container part and bottom being hingedly interconnected, said bottom being provided with coupling means for coupling with other toy building elements.
- (D) (A), and (B).
- (E) (A), (B), and (C).

46. On June 22, 1999, you receive a final Office action, dated June 17, 1999, rejecting numerous claims in a patent application that you filed in the PTO. The Office action did not set a shortened statutory period for reply. Following proper PTO practices and procedures, under which circumstances is it most likely your submission of new evidence under 37 CFR § 1.129(a) in support of patentability, along with the appropriate fee, will result in the automatic withdrawal of the finality of the final rejection?

- (A) The application is filed on June 8, 1995, it has an effective filing date of June 8, 1993, and you file the submission on October 14, 1999, one month after you file a Notice of Appeal to the Board of Patent Appeals and Interferences.
- (B) The application is filed on June 7, 1995, it has an effective filing date of June 8, 1993, and you file the submission on October 14, 1999, one month after you file an appeal brief to the Board of Patent Appeals and Interferences.
- (C) The application is filed on June 8, 1995, it has an effective filing date of June 7, 1993, and you file the submission on December 20, 1999.
- (D) The application is filed on June 7, 1995, it has an effective filing date of June 7, 1993, and you file the submission on the same day you file an appeal brief to the Board of Patent Appeals and Interferences.
- (E) (A) and (C).

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

- (A) Amending the claim by canceling elements B and C because the reference is concerned only with element A.
- (B) Arguing that the reference is not relevant because it lacks elements B and C.
- (C) Amending the claim by canceling element A from the Markush group.
- (D) Amending the claim by changing "consisting of" to "consisting essentially of."
- (E) Amending the claim to redefine X as "being a member selected from the group comprising elements A, B, and C."

48. Which of the following statements is in accordance with proper PTO practice and procedure?

- (A) A claim to a computer which recites that various components, such as motherboard and RAM, which are old in the art, as well as a novel disc drive, is unpatentable under 35 U.S.C. § 102(f) inasmuch as the inventor derived one or more components, and did not himself invent each of the components of the claimed computer.
- (B) Where a patent granted to Able discloses subject matter being claimed in an application filed by Baker undergoing examination, the designation of Able as the sole inventor in Able's patent raises a presumption of inventorship with respect to the subject matter disclosed but not claimed in the patent.
- (C) A terminal disclaimer overcomes a rejection under 35 U.S.C. § 102(e).
- (D) When Able's patent application, filed on June 2, 1999, is rejected based on unclaimed subject matter of a patent granted to Smith on July 6, 1999, on Smith's application filed on February 18, 1997, and the unclaimed subject matter is Able's own invention, Able may overcome a prima facie case by showing that the patent discloses Able's own previous work.
- (E) All of the above.

49. In preparing an application claiming only apparatus to be filed in the PTO, you inadvertently forgot to include a figure in the drawings. While, you did include a brief description of the figure in the written description of the invention in the specification nevertheless the invention of Claim 10 cannot be understood without the omitted figure in the drawings. Only after the application had been filed in the PTO did you realize that the figure was omitted. The application as filed included a proper declaration under 37 CFR § 1.63 signed by the inventor. What document(s), if any, must be filed in the PTO to obtain the original filing date in accordance with proper PTO practice and procedure?

- (A) An amendment deleting the description of the figure and Claim 10, and a petition with the proper fee to have the application accepted without the omitted figure.
- (B) An amendment filed before the first Office action deleting all references to the omitted figure and Claim 10 to have the application accepted without the omitted figure.
- (C) A petition and an amendment to add the figure to the application as soon as possible, and a supplemental declaration stating the omitted figure accurately illustrates and is part of the applicant's invention.
- (D) The omitted figure along with a supplemental oath or declaration stating that the omitted figure accurately illustrates and is part of the applicant's invention.
- (E) An amendment adding the figure to the application.

50. Prior art references have been combined to show obviousness of the claimed invention under 35 U.S.C. § 103. Which of the following most correctly completes the statement: “In establishing obviousness, _____

- (A) a suggestion to modify the art must be expressly stated in one of the references used to show obviousness.”
- (B) a suggestion to modify the art must be expressly stated in all the references used to show obviousness.”
- (C) a suggestion to modify the art may be inherently or implicitly taught in one of the references used to show obviousness.”
- (D) a suggestion to modify the art is unnecessary unless the patent applicant presents evidence or argument tending to show unobviousness.”
- (E) a suggestion to modify the art can come from recent nonanalogous prior art references.”

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

APRIL 12, 2000

Morning Session (50 Points)

Time: 3 Hours

DIRECTIONS

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

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

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

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

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO

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

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

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

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

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

3. A multiple dependent claim:

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

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

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

5. A patent application includes the following Claim 1:

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

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

Assuming proper support in the specification, which of the following claims, if presented in the same application, is a proper claim?

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

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

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

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

Claim 1.

An apparatus for shearing sheep, said apparatus comprising:

- (i) a first cutting member having a first cutting edge at one end and a thumb loop at the other end;
- (ii) a second cutting member having a second cutting edge at one end and a finger loop at the other end;

- (iii) _____;
- (iv) said second cutting member additionally including a pointer loop between said finger loop and said mid-point, said pointer loop having a pointer loop center, said finger loop having a finger loop center and said pointer loop having a pointer loop center such that a plane through said finger loop center and said pointer loop center is generally parallel to said second cutting edge for improved balance.

Claim 2. The apparatus of claim 1, wherein said first cutting member includes a threaded aperture extending entirely through said first cutting member between said thumb loop and said mid-point, and an adjusting screw that extends through said threaded aperture to engage a bearing surface below the pointer loop on said second cutting member.

Claim 3. The apparatus of claim 2, wherein said connector is a rivet.

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

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

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

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

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

- I. Applicant's entire reply to the restriction requirement is: "The examiner erred in distinguishing between Group 1 and Group 2, and therefore the restriction requirement is respectfully traversed and no election is being made, in order that applicant's right to petition the Commissioner to review the restriction requirement is preserved."
- II. Applicant's entire reply to the restriction requirement is: "Applicant elects Group 1 and respectfully traverses the restriction requirement, because the examiner erred in requiring a restriction between Group 1 and Group 2."
- III. Applicant's reply distinctly points out detailed reasons why applicant believes the examiner erred in requiring a restriction between Group 1 and Group 2, and additionally sets forth, "Applicant therefore respectfully traverses the restriction requirement and no election is being made, in order that applicant's right to petition the Commissioner to review the restriction requirement is preserved."
- IV. Applicant's reply distinctly points out detailed reasons why applicant believes the examiner erred in requiring a restriction between Group 1 and Group 2, and additionally sets forth, "Applicant therefore respectfully traverses the restriction requirement and elects Group 2."

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

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

10. Which of the following statements is most correct?

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

11. Which of the following statements is most correct?

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

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

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

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

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

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

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

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

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

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

- 9. A personal computer comprising a microprocessor and a random access memory including at least 1 gigabyte of storage.
- 10. The personal computer of Claim 9, wherein the microprocessor has a clock speed of 100-200 megahertz.
- 11. The personal computer of Claim 10, wherein the random access memory is greater than $\frac{1}{2}$ gigabyte of storage.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

23. Which of the following statements is correct?

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

24. Which of the following statements is most correct?

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

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

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

26. Which of the following statements is most correct?

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

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

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

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

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

28. Which of the following three statements is(are) **true** ?

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

39. Impermissible recapture in an application exists _____

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

49. Which of the following statements is NOT true?

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

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

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

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

APRIL 12, 2000

Afternoon Session (50 Points)

Time: 3 Hours

DIRECTIONS

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

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

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

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

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO

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

1. Which of the following does **not** constitute probative evidence of commercial success to support a contention of non-obviousness?
 - (A) In a utility case, gross sales figures accompanied by evidence as to market share.
 - (B) In a utility case, gross sales figures accompanied by evidence as to the time period during which the product was sold.
 - (C) In a utility case, gross sales figures accompanied by evidence as to what sales would normally be expected in the market.
 - (D) In a utility case, gross sales figures accompanied by evidence of brand name recognition.
 - (E) In a design case, evidence of commercial success clearly attributable to the design, and not to improved performance of the device.
2. Which of the following statements is **true** based on current PTO practice and procedure?
 - (A) Where claims in an application on appeal have been rejected on prior art, the Board cannot consider a reference having a publication date after the effective date of the application.
 - (B) Objective indicia of non-obviousness cannot depend on facts developed after the effective date of the application under consideration.
 - (C) Evidence that has developed only after the filing date of an application cannot be used to show non-obviousness.
 - (D) The scope of objective evidence of non-obviousness is independent of the scope of the claim for which the evidence is offered to support.
 - (E) Objective evidence of non-obviousness must be commensurate in scope with the claims for which the evidence is offered to support.
3. 100. Which of the following is **true** ?
 - (A) Interferences will generally be declared even when the applications involved are owned by the same assignee since only one patent may issue for any given invention.
 - (B) A senior party in an interference is necessarily the party who obtains the earliest actual filing date in the PTO.
 - (C) Reexamination proceedings may not be merged with reissue applications since third parties are not permitted in reissue applications.
 - (D) After a reexamination proceeding is terminated and the certificate has issued, any member of the public may obtain a copy of the certificate by ordering a copy of the patent.
 - (E) None of the above.

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

Claim 1. A shaving implement comprising

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

19. Which of the following is **true**?
- (A) A final decision by a United States District Court finding a patent to be invalid will have no binding effect during reexamination since the PTO may still find the claims of the patent to be valid.
 - (B) A final decision by a United States District Court finding a patent to be valid will have no binding effect during reexamination since the PTO may still find the claims of the patent to be invalid.
 - (C) Once the Court of Appeals for the Federal Circuit determines that the claims of a patent are valid, the USPTO may not find such claims invalid based upon newly discovered art.
 - (D) If a patentee fails to disclose prior art to the PTO during regular prosecution, the only way that a patentee can disclose later discovered prior art to the PTO after issuance is by filing a request for reexamination.
 - (E) Once a patent claim is found valid during a District Court Proceeding then the patent claims are entitled to a higher standard of patentability and the presumption of validity can only be rebutted by clear and convincing evidence in a concurrent or later reexamination proceeding.
20. Which of the following is (are) appropriate for restarting the period for replying to an Office action, dated September 25, 2000?
- I. The examiner set a shortened statutory period of three months for replying to the Office action, and three months from September 25, 2000 falls on Christmas Day, December 25, 2000, a federal holiday, and the registered practitioner calls this to the attention of the examiner within one month of the mail date of the Office action.
 - II. The examiner's interpretation of the prior art in rejecting certain claims, as set forth in the Office action, is believed by a registered practitioner to be contrary to the interpretation given by one of ordinary skill in the art, and the practitioner calls this alone to the examiner's attention within one month of the mail date of the office action.
 - III. The examiner incorrectly cited one of the references, and the registered practitioner calls this to the attention of the examiner within one month of the mail date of the Office action.
- (A) I.
 - (B) II.
 - (C) III.
 - (D) II and III.
 - (E) None of the above.

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

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

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

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

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

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

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

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

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

- I. Joe, in-house corporate counsel at Fix Corp., but not an officer of Fix, signs a submission, pursuant to 37 C.F.R. 3.73(b), establishing ownership of the entire interest in the application by Fix Corp., and forwards the submission along with a revocation of the power of attorney granted to you, to the PTO. Joe is not a registered practitioner, and he has not been authorized to bind Fix Corp.
- II. Fix Corp. signs a submission, pursuant to 37 C.F.R. 3.73(b), establishing ownership of the entire interest in the application by Fix Corp., and forwards the submission along with a Snix-signed revocation of the power of attorney granted to you, to the PTO.
- III. Joe, in-house corporate counsel at Fix Corp., advises Snix, president of Fix Corp., that the assignment by Smith to Fix Corp, automatically operates as a revocation of the power of attorney granted to you, and Snix relies upon Joe's advice in good faith and takes no further action toward revoking the power of attorney. Joe is not a registered practitioner, and he has not been authorized to bind Fix Corp.

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

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

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

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

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

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

A steam cooker comprising:

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

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

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

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

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

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

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

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

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

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

33. A claim limitation reads “having 10 to 20 grams of iron, preferably 13-18 grams of iron.” The specification preceding the claim supports not only the limitation, but also the broader amounts of iron. Which of the following statements is correct?
- (A) The limitation may be indefinite.
 - (B) Since the limitation properly sets forth outer limits, it is definite.
 - (C) As long as the limitation is supported in the written description, it is proper.
 - (D) The limitation is definite since the limitation sets forth a preferred range.
 - (E) The applicant, having set forth a limitation in the claim, i.e., a range of 10 to 20 grams, is precluded by the doctrine of equivalents from expanding the claim coverage beyond the 10 to 20 grams of iron.
34. A Notice of Allowance, setting a three month statutory period for reply, is dated and mailed on April 4, 2000, to the applicant. In which of the following situations would the issue fee be considered to be paid late?
- (A) The issue fee is filed in the PTO on Monday, July 3, 2000.
 - (B) The issue fee is filed in the PTO on Wednesday, July 5, 2000, inasmuch as the PTO was closed for a Federal holiday on Tuesday, July 4, 2000.
 - (C) The issue fee is filed in the PTO on Wednesday, October 4, 2000, and is accompanied by a petition to the Commissioner for a three month extension of time, as well as the late payment fee.
 - (D) The issue fee is received in the PTO on Thursday, July 6, 2000, accompanied by a certificate of mailing complying with 37 C.F.R. § 1.8 and dated Monday, July 3, 2000.
 - (E) (B), (C), and (D).
35. Which of the following statements regarding design patent applications is not correct?
- (A) The specification may contain a brief description denoting the nature and environmental use of the claimed design.
 - (B) Different embodiments or modifications may be set forth in the specification, but do not need to be shown in the drawings.
 - (C) The drawings may be color drawings or color photographs if accompanied by a grantable petition.
 - (D) The design application may have only a single claim.
 - (E) The inventive novelty or nonobviousness of a design resides in the shape or configuration, and/or surface ornamentation embodied in or applied to an article of manufacture.

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

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

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

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

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

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

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

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

40. In which of the following situations is the Commissioner authorized to refund a fee?
- (A) After receiving a final rejection, a notice of appeal and appeal fee are filed. After the notice of appeal and correct appeal fee are filed, the examiner thereafter withdraws the final rejection.
 - (B) Upon a showing of an extraordinary situation, when justice requires refund of a fee paid to the PTO where a practitioner paid the correct fee for an extension of time to provide the client with time to given instructions, and the client thereafter informs the practitioner that the client would not pay the fee and authorizes the practitioner to permit the application to become abandoned.
 - (C) Upon a showing that the application, which had been filed in the PTO and for which the correct filing fee had been paid, has been withdrawn from examination and expressly abandoned.
 - (D) Upon a petition to the Commissioner to exercise his supervision to refund a fee, though paid in the correct amount, when the practitioner no longer desired copies of patents ordered.
 - (E) Upon a showing that the fee was paid by mistake or in excess of the amount required by law.
41. Which of the following may not be properly used as prior art for purposes of rejecting a claim under 35 U.S.C. § 102(b) in an application having an effective filing date of Monday, May 3, 1999?
- (A) A journal article, published Saturday, May 2, 1998, disclosing all the claimed elements and fully teaching how to make and use the invention as claimed.
 - (B) A foreign patent, published March 3, 1998, which applicant referenced in the application when claiming foreign priority based on the foreign application date, and applicant submitted a certified copy of the original foreign application.
 - (C) Applicant's statement in a declaration under 37 C.F.R. § 1.132 that although the invention as claimed had been offered for sale in department stores in New York during 1997, this was done only to analyze consumer acceptance of the packaging in which the invention is marketed.
 - (D) A journal article, published May 1, 1997, disclosing all the elements of the claim and teaching how to make and use the claimed invention. The examiner used the article in combination with another journal article in a previous non-final Office action to reject the same claim under 35 U.S.C. § 103.
 - (E) All of the above.

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

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

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

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

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

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

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

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

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

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

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

- I. Filing a request for reconsideration concerning the finality of the Office action, while the application is still pending before the primary examiner.
- II. Filing a Notice of Appeal, then a brief, and arguing in the brief the impropriety of the finality of the rejection.
- III. Filing a petition under 37 C.F.R. 1.181 based on improper finality of the rejection to stay the running of the period for reply set in the final Office action.

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

48. Which of the following statements regarding 35 U.S.C. § 103 is most correct?

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

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

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

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

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

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

OCTOBER 18, 2000

Morning Session (50 Points)

Time: 3 Hours

DIRECTIONS

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

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

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

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

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO

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

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

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

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

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

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

- I. The fee set forth in 37 C.F.R. § 1.17(i).
- II. John's birth certificate showing his date of birth.
- III. The doctor's certificate stating that John's health is such that he is unable to assist in the prosecution of his application.

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

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

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

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

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

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

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

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

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

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

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

8. Which of the following is true?

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

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

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

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

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

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

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

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

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

(A) Claim 2.

(B) Claim 3.

(C) Claim 4.

(D) Claims 2 and 3.

(E) Claims 3 and 4.

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

(A) The amendment is treated as untimely and the application becomes abandoned. However, applicant may petition to revive the abandoned application on the basis that the abandonment was unavoidable.

(B) The amendment is treated as untimely and the application becomes abandoned. However, applicant may petition to revive the abandoned application on the basis that the abandonment was unintentional.

(C) The petition for a one-month extension of time will be construed as a petition requesting the appropriate period of extension, and the appropriate fee will be charged to the deposit account.

(D) Applicant will be notified that the petition for extension of time was insufficient and will be given 30 days from the mailing date of the notification to request an extension of time for a second month.

(E) None of the above.

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

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

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

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

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

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

15. Which of the following would not be permitted to be incorporated by reference in your client's U.S. utility patent application?

- (A) Essential material from a U.S. patent.
- (B) Essential material from a foreign application.
- (C) Non-essential material from a prior filed, commonly owned U.S. application.
- (D) Essential material from a magazine article.
- (E) (B) and (D).

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

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

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

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

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

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

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

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

18. How do you best advise ManCo?

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

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

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

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

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

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

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

22. Which of the following is true?

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

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

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

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

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

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

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

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

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

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

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

28. Which of the following is true?

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

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

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

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

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

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

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

32. A patent application filed in the USPTO claims a nylon rope coated with element E for the purpose of preventing breakage of the rope. In the first Office action, the examiner rejects the claim as obvious over P in view of a trade journal publication, T. P teaches a nylon rope coated with resin for the purpose of making the rope waterproof. T teaches a nylon tent fabric coated with element E for the purpose of making the tent waterproof, and suggests the use of element E for making other nylon products waterproof. Following proper USPTO practices and procedures, the combination of P and T:

- (A) cannot support a prima facie case of obviousness because T lacks a suggestion to combine with P for the purpose of preventing breakage in nylon rope.
- (B) cannot support a prima facie case of obviousness because P lacks a suggestion to combine with T for the purpose of preventing breakage in nylon rope.
- (C) cannot support a prima facie case of obviousness because T only contains a suggestion to combine with P for the purpose of waterproofing nylon rope.
- (D) can support a prima facie case of obviousness, even though T only contains a suggestion to combine with P for the purpose of waterproofing nylon rope.
- (E) can support a prima facie case of obviousness because the applicant is always under an obligation to submit evidence of non-obviousness regardless of whether the examiner fully establishes a prima facie case of obviousness.

33. In which of the following situations, considered independently of each other, is the original, new, or amended claim supported in the application as filed?

- (A) An amendment to the specification changing the definition of “holder” from “is a hook” to “is a hook, clasp, crimp, or tong” and no amendment is made of the claim, which uses the term “holder.” The amendment is filed one month after the application was filed. There was no previous supporting disclosure in the specification of the holder being a clasp, crimp, or tong.
- (B) An amendment to the specification and claims changing the definition of “holder” from “is a hook” to “is a hook, clasp, crimp, or tong.” The amendment is filed one month after the application was filed. There was no previous supporting disclosure in the specification of the holder being a clasp, crimp, or tong.
- (C) Original claim 1 in the application refers to “a holder,” and original claim 2 depends from and refers to claim 1 stating, “said holder is a hook, clasp, crimp, or tong.” There is no disclosure in the specification preceding the claims in the application as filed for the holder to be a clasp, crimp, or tong.
- (D) An amendment is filed presenting a claim to an electrical insulating device, copied from a patent for the purpose of provoking an interference. The claim refers to “nonconductive plastic holder.” The application as filed contains a broad generic disclosure describing electrical insulating devices. The holder is described in the specification of the application as “conducting electricity.” There is no disclosure in the specification of the holder being “nonconductive.”
- (E) All of the above.

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

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

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

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

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

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

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

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

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

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

38. Which of the following would be the best advice from you to Ace?

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

39. Based on the foregoing facts, which of the following statements is true?

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

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

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

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

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

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

45. On February 12, 1999, you filed a patent application containing two independent claims, Claims 1 and 2, directed to methods of forming an integrated circuit device. The applicant conceived the methods in Jacksonville, Florida on June 10, 1997. Commencing on June 10, 1997, the applicant exercised due diligence until she reduced the methods to practice on February 27, 1998. In an Office action dated August 18, 1999, the examiner rejected Claim 1 as being anticipated by Doppler under 35 U.S.C. § 102(b). Doppler is a French patent that was filed on July 18, 1996, and issued on January 13, 1998. The Doppler patent claims the method of the applicant's Claim 1 for forming integrated circuit devices. Claim 2 was rejected as being anticipated by Spot under 35 U.S.C. § 102(e). Spot is a U.S. patent that was filed on January 7, 1998, and discloses, but does not claim, the method of applicant's Claim 2 for forming an integrated circuit device. The Spot patent issued on May 5, 1999. Which of the following would be the most proper course of action to take to respond to the rejections?

- (A) File an antedating affidavit to overcome the rejection of Claim 1 and cancel Claim 2.
- (B) File an antedating affidavit to overcome both the rejections and request that an interference be declared with the Doppler patent.
- (C) File an antedating affidavit to overcome the rejection of Claim 2 and cancel Claim 1.
- (D) File a reply arguing that the rejections are improper because the Spot patent issued after the filing date of your client's application.
- (E) File an antedating affidavit to overcome both rejections.

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

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

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

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

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

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

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

49. Which of the following is true?

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

50. Which of the following is true?

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

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

OCTOBER 18, 2000

Afternoon Session (50 Points)

Time: 3 Hours

DIRECTIONS

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

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

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

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

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO

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

1. Which of the following is not required in order for a foreign application that has matured into a foreign patent will qualify as a reference under 35 U.S.C. § 102(d)?
 - (A) The foreign application must be filed more than 12 months before the effective filing date of the United States application.
 - (B) The foreign and United States applications must be filed by the same applicant, his or her legal representatives or assigns.
 - (C) The foreign application must have actually issued as a patent or inventor's certificate before the filing of an application in the United States. It need not be published but the patent rights granted must be enforceable.
 - (D) The foreign application must have actually been published before the filing of an application in the United States, but the patent rights granted need not be enforceable.
 - (E) The same invention must be involved.
2. Which of the following is not a proper incorporation by reference in an application prior to allowance according to USPTO rules and procedures?
 - (A) Incorporating material necessary to describe the best mode of the claimed invention by reference to a commonly owned, abandoned U.S. application that is less than 20 years old.
 - (B) Incorporating non-essential material by reference to a prior filed, commonly owned pending U.S. application.
 - (C) Incorporating material that is necessary to provide an enabling disclosure of the claimed invention by reference to a U.S. patent.
 - (D) Incorporating non-essential material by reference to a hyperlink.
 - (E) Incorporating material indicating the background of the invention by reference to a U.S. patent which incorporates essential material.
3. Which of the following statements regarding amending a reissue application is not correct?
 - (A) An entire paragraph in the specification other than the claims may be deleted by a statement deleting the paragraph without presentation of the text of the paragraph.
 - (B) In a claim, hand entry of an amendment of five words or less is permitted.
 - (C) Each amendment submission must set forth the status, on the date of the amendment, of all patent claims and of all added claims.
 - (D) When responding to an Office action, each amendment when originally submitted must be accompanied by an explanation of the support in the disclosure of the patent for the amendment.
 - (E) A new claim added by amendment must be presented with underlining throughout the claim.

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

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

Which of the following is true?

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

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

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

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

- (A) Amending the claim by canceling elements B and C because the reference is concerned only with element A.
- (B) Arguing that the reference is not relevant because it lacks elements B and C.
- (C) Amending the claim by canceling element A from the Markush group.
- (D) Amending the claim by changing “consisting of” to “consisting essentially of.”
- (E) Amending the claim to redefine X as “being a member selected from the group comprising elements A, B, and C.”

7. Which of the following is true?

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

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

- (A) Since the MC Motors misappropriated the invention and since Eve did not authorize the sale, the rejection may be overcome by showing that the sales by MC Motors were not authorized by Eve.
- (B) Eve is not entitled to a patent since the invention was on sale in this country, more than one year prior to the date of the application for patent in the United States.
- (C) MC Motors is entitled to a patent since although it misappropriated the idea for the invention from Eve, the misappropriation was beyond the jurisdiction of the USPTO.
- (D) (B) and (C).
- (E) None of the above.

9. In August 1999, a recently registered patent agent, who is not an attorney, asked a registered patent attorney to help the agent establish a practice. Considering the additional facts in the following choices separately, which choice best comports with the professional responsibilities of both the agent and the attorney?

- (A) The agent advertises as a registered practitioner authorized to practice before the Office in patent and trademark cases. The attorney supervises all the trademark work done by the agent.
- (B) The agent advertises on television and radio as a registered patent agent and accepts patent cases on a reasonable contingent fee.
- (C) The attorney has the agent prosecute trademark applications before the Office and the attorney signs all the papers submitted to the Office without reading the papers.
- (D) The attorney and agent enter into a partnership agreement that has no health or retirement benefits, but specifies that after termination of the partnership, the agent and the attorney will not practice in each other's neighborhoods or accept each other's established clients.
- (E) Without receiving anything of value from the agent, the attorney refers patent application clients to the agent, the agent informs the clients that the agent is a registered patent attorney, and the agent competently represents the clients in patent cases.

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

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

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

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

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

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

12. Which of the following is true?

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

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

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

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

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

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

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

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

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

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

11. An electronic device comprising: circuitry; said circuitry operating to emit signals of a predetermined waveform; said signals being used to automatically change channels on a television set and automatically open the door of a garage.
12. A method for opening a garage door comprising using a television remote control device to emit signals, comprising the steps of:
 - a) adapting a television remote control device to emit signals to open a garage door;
 - b) pointing said television remote control device at said garage door; and
 - c) actuating said television remote control to cause said garage door to open.

Which of the following is true?

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

17. A patent application filed in the USPTO contains the following original claim:

Claim 1. A talbecloth for protecting the finish of a table comprising:
a layer of cotton;
a layer of vinyl affixed to the layer of cotton; and
a backing of felt.

Which of the following amendment(s) is/are not in accord with proper USPTO amendment practices and procedures?

- (A) In claim 1, line 3, add -with an epoxy resin-.
- (B) In claim 1, line 2, after "cotton" add -woven to have 250 threads per inch-.
- (C) In claim 1, line 3, before "layer" add -thin-.
- (D) In claim 1, line 1, correct the spelling of "talbecloth" please.
- (E) All of the above.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

22. A rejection based on 35 U.S.C. § 102(a) cannot be overcome by:
- (A) Filing an affidavit under 37 C.F.R. § 1.132 showing that the reference invention is not by “another.”
 - (B) Perfecting a claim to priority under 35 U.S.C. § 119(a)-(d).
 - (C) Filing an affidavit under 37 C.F.R. § 1.131 “swearing back” of a U.S. patent which substantially shows or describes, and claims the same patentable invention as the rejected invention.
 - (D) Amending the claims to patentably distinguish over the prior art.
 - (E) Persuasively arguing that the claims are patentably distinguishable from the prior art.
23. Which of the following statements is correct regarding an antedating declaration or affidavit being used in accordance with proper USPTO practice and procedure?
- (A) Where the reference, a U.S. Patent, with a patent issue date less than one year prior to applicant’s effective filing date, shows but does not claim the same patentable invention.
 - (B) Where the reference publication date is more than one year before applicant’s effective filing date.
 - (C) Where the reference is a prior U.S. patent to the same entity, claiming the same invention.
 - (D) Where the subject matter relied on in the reference is prior art under 35 U.S.C. § 102(g).
 - (E) Where the effective filing date of applicant’s parent application or an International Convention-proved filing date is prior to the effective date of the reference.
24. Abigail has invented a novel watering mechanism for a flower pot. The flower pot also possesses a unique ornamental design. Abigail consults with patent practitioner P for advice on the differences between a design patent and a utility patent. Which of the following general statements regarding design and utility patents, if made by P, would be accurate?
- (A) A “utility patent” protects the way an article is used and works, while a “design patent” protects the way an article looks.
 - (B) Unlike utility patent applications, a design patent application may not make a claim for priority of a provisional patent application.
 - (C) Maintenance fees are required for utility patents, while no maintenance fees are required for design patents.
 - (D) Both design and utility patents may be obtained on an article if the invention resides both in its utility and ornamental appearance.
 - (E) All of the above.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

32. Which of the following statements is not true?

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

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

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

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

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

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

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

- 2. The method of Claim 1, further consisting of the step of cooling the mixture to a temperature of 32° F.

Following proper USPTO practices and procedures, from which of the following claims does Claim 2 not properly depend?

- (A) 1. A method of making liquid compound A consisting of the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (B) 1. A method of making liquid compound A comprising the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (C) 1. A method of making liquid compound A including the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (D) 1. A method of making liquid compound A characterized by the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (E) (C) and (D).

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

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

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

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

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

Claim 1. An apparatus for sitting comprising:

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

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

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

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

39. 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?

- (A) AI should file a prior art statement under 37 C.F.R. § 1.501 that will be placed in the patent file upon issuance of the application as a patent.
- (B) Since the issue fee has been paid, 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 C.F.R. 1.312 deleting all of the claims which are unpatentable over the reference since an amendment deleting claims is entitled to entry as a matter of right.

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

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

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

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

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

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

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

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

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

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

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

44. Which of the following is true?

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

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

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

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

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

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

- Claim 1. A method for making an Ethernet cable comprising the steps of A, B and C.
- Claim 2. The method of claim 1, further characterized by the step of D.
- Claim 3. The Ethernet cable as in any one of the preceding claims.

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

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

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

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

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

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

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

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

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

APRIL 18, 2001

Morning Session (50 Points)

Time: 3 Hours

DIRECTIONS

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

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

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

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

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO

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

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

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

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

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

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

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

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

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

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

Please answer questions 5 and 6 based on the following information.

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

5. Under standard USPTO practice and procedure, where will the USPTO send any Maintenance Fee Reminder?
- (A) Joe Inventor’s address as indicated on the inventor’s declaration, unless a change of address had been filed for Mr. Inventor.
 - (B) Larry Practitioner’s address prior to September 2000.
 - (C) Larry Practitioner’s address subsequent to September 1, 2000.
 - (D) The fee address designated by Larry Practitioner at the time he paid the issue fee.
 - (E) The address of the assignee as indicated on the assignment recorded in the USPTO.
6. Under standard USPTO practice and procedure, where will the USPTO send a communication for Big Corporation concerning a request for reexamination involving the patent?
- (A) Joe Inventor’s address as indicated on the inventor’s declaration, unless a change of address had been filed for Mr. Inventor.
 - (B) Larry Practitioner’s address prior to September 2000.
 - (C) Larry Practitioner’s address subsequent to September 1, 2000.
 - (D) The fee address designated by Larry Practitioner at the time he paid the issue fee.
 - (E) The address of the assignee as indicated on the assignment recorded in the USPTO.

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

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

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

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

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

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

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

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

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

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

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

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

(A) Claim 2.

(B) Claim 3.

(C) Claim 4.

(D) Claims 2 and 3.

(E) Claims 3 and 4.

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

(A) An information disclosure statement, filed by Ethel on Monday, January 15, 2001, that complies with the provisions of 37 CFR § 1.98, listing a foreign patent, and stating that each item of information contained in the information disclosure statement was first cited in a communication from a foreign patent office less than three months prior to the filing of the information disclosure statement.

(B) A statement filed by Ethel on Wednesday, March 7, 2001, stating that Ethel is not an individual identified under 37 CFR § 1.56(c).

(C) A statement filed by Ethel on Thursday, March 8, 2001, with the appropriate petition and fee for a one-month extension, that states that the information required to be submitted is not readily available to the party from which it was requested.

(D) A statement filed by Ethel on Thursday, March 8, 2001, with the appropriate petition and fee for a one month extension, which states that Ethel has a good faith belief that the information required is not material to patentability.

(E) None of the above.

12. In January 2000, Chris invents an electrical door stop for automatically stopping a door at any position by simply pressing the doorknob downward. The doorknob is such that when carrying a large package, one may rest the package on the doorknob to stop the motion of the door. During a lunch break before completing the writing of the application for the patent on the automatic door stop, Chris' patent agent, Sam, visits a local Shack restaurant and notices a door stop which is actuated by stepping with one's foot on a mechanical lever located at the bottom of the door. Sam makes a mental note to ask a colleague as to whether he needs to disclose the doorstop at the Shack restaurant to the USPTO in conjunction with Chris' application in an information disclosure statement, but ultimately neglects to do so. Sam knows that the restaurant (and doorstop) was in existence at least one year prior to Sam's visit. In the first Office action, the only prior art uncovered by the examiner relates to stopping a door using a lever that engages a channel in the ceiling upon being pressed upward. The examiner rejects the claim asserting it would have been obvious to have either upward or downward actuating motion. In the reply to the first Office action Sam argues that the downward motion is essential because it affords the ability to actuate when one is carrying a package and that the prior art does not disclose a downwardly actuated doorstop. Following Sam's argument, the case issues. Claim 1 reads as follows:

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

Which of the following is true?

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

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

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

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

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

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

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

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

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

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

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

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

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

19. In early 1999, at the request of MC Motors, Eve demonstrated her reverse automobile heating system at a testing facility in Germany. MC Motors signs a confidentiality agreement and agrees not to disclose the invention to anyone. The test is conducted in a secluded area and the persons involved are sworn to secrecy. Unbeknownst to Eve, MC Motors installs the reverse heating system on its MC cars and begins selling its cars with the reverse heating system in the United States in September 1999. In August 2000, MC files a patent application in the United States for the reverse automobile heating system. In December 2000, Eve files a patent application claiming the automobile heating system. The examiner rejects all the claims in Eve’s application based upon an MC Motors brochure advertising its cars in September 1999. Which of the following is true?

- (A) Eve is not entitled to a patent since the invention was on sale in this country, more than one year prior to the date of the application for patent in the United States.
- (B) Since the MC Motors misappropriated the invention and since Eve did not authorize the sale, the rejection may be overcome by showing that the sales by MC Motors were not authorized by Eve.
- (C) MC Motors is entitled to a patent since although it misappropriated the idea for the invention from Eve, the misappropriation was beyond the jurisdiction of the USPTO.
- (D) (A) and (C).
- (E) None of the above.

20. A patent application filed in the USPTO claims a nylon rope coated with element E for the purpose of preventing breakage of the rope. In the first Office action, the examiner rejects the claim as obvious over P in view of a trade journal publication, T. P teaches a nylon rope coated with resin for the purpose of making the rope waterproof. T teaches a nylon tent fabric coated with element E for the purpose of making the tent waterproof, and suggests the use of element E for making other nylon products waterproof. Following proper USPTO practices and procedures, the combination of P and T:

- (A) cannot support a prima facie case of obviousness because T lacks a suggestion to combine with P for the purpose of preventing breakage in nylon rope.
- (B) cannot support a prima facie case of obviousness because P lacks a suggestion to combine with T for the purpose of preventing breakage in nylon rope.
- (C) cannot support a prima facie case of obviousness because T only contains a suggestion to combine with P for the purpose of waterproofing nylon rope.
- (D) can support a prima facie case of obviousness, even though T only contains a suggestion to combine with P for the purpose of waterproofing nylon rope.
- (E) can support a prima facie case of obviousness because the applicant is always under an obligation to submit evidence of non-obviousness regardless of whether the examiner fully establishes a prima facie case of obviousness.

21. Which of the following is true?

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

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

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

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

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

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

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

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

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

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

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

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

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

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

30. Which of the following is in accord with proper USPTO practice and procedure?

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

31. Which of the following statements is correct regarding an antedating declaration or affidavit being used in accordance with proper USPTO practice and procedure?

- (A) Where the reference publication date is more than one year before applicant's effective filing date.
- (B) Where the reference is a prior U.S. patent to the same entity, claiming the same invention.
- (C) Where the subject matter relied on in the reference is prior art under 35 U.S.C. § 102(g).
- (D) Where the reference, a U.S. Patent, with a patent issue date less than one year prior to applicant's effective filing date, shows but does not claim the same patentable invention.
- (E) Where the effective filing date of applicant's parent application or an International Convention-proved filing date is prior to the effective date of the reference.

32. Which of the following is in accordance with proper USPTO practice and procedure?
- (A) After issuance of a notice of allowance in November 2000, a petition to withdraw an application from issue and requisite fee are required if a request for continued examination, submission, and requisite fee are filed prior to the issuance of the patent.
 - (B) After issuance of a notice of allowance in April 2001 for an application, an amendment of the claims in the application may be filed before, with, or after payment of the issue fee.
 - (C) The Office ensures that any petition to withdraw an application from issue, filed after payment of the issue fee, will be acted upon prior to the scheduled date of patent grant.
 - (D) If a request for continued examination under 37 CFR § 1.114, accompanied by the requisite fee, but not a submission, are filed in March 2001, after an application was allowed in January 2001, the Office will notify the applicant and set a time period within which the deficiency must be corrected.
 - (E) An amendment filed in the Office in April 2001 in reply to a final rejection must comply with either the provisions of 37 CFR § 1.114 or the provisions of 37 CFR § 1.116(b) and (c).
33. In which of the following situations, considered independently of each other, is the original, new, or amended claim supported in the application as filed?
- (A) An amendment to the specification changing the definition of “holder” from “is a hook” to “is a hook, clasp, crimp, or tong” and no amendment is made of the claim, which uses the term “holder.” The amendment is filed one month after the application was filed. There was no previous supporting disclosure in the specification of the holder being a clasp, crimp, or tong.
 - (B) An amendment to the specification and claims changing the definition of “holder” from “is a hook” to “is a hook, clasp, crimp, or tong.” The amendment is filed one month after the application was filed. There was no previous supporting disclosure in the specification of the holder being a clasp, crimp, or tong.
 - (C) Original claim 1 in the application refers to “a holder,” and original claim 2 depends from and refers to claim 1 stating, “said holder is a hook, clasp, crimp, or tong.” There is no disclosure in the specification preceding the claims in the application as filed for the holder to be a clasp, crimp, or tong.
 - (D) An amendment is filed presenting a claim to an electrical insulating device, copied from a patent for the purpose of provoking an interference. The claim refers to “nonconductive plastic holder.” The application as filed contains a broad generic disclosure describing electrical insulating devices. The holder is described in the specification of the application as “conducting electricity.” There is no disclosure in the specification of the holder being “nonconductive.”
 - (E) All of the above.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

40. In June 1998, Jack and Jill, a married couple, are vacationing in Vietnam (not a WTO country) when they encounter a man selling bamboo knives for cleaning fish. The particular curvature of the bamboo both lends support to the knife to prevent it from bending and breaking and facilitates cleaning inside the fish. Jill takes a picture of Jack with the knife cleaning the fish. Subsequently, in November 1998, when Jack returns to the United States he begins to make and sell an identical knife to the one seen in Vietnam. In July 1999, he files a patent application claiming the nearly identical knife. Jack discloses no prior art during the prosecution of his application and fails to mention the knife he saw in Vietnam. The examiner finds no prior art similar to the claimed knife, and Jack is awarded a patent in December 2000. Meanwhile, Jill divorces Jack, and associates with Sam. Unfortunately, Sam is penniless. To raise cash, Sam and Jill begin selling a knife identical to the one Jack produces, only Sam and Jill make their knife out of plastic. The knives of Sam and Jill sell like hotcakes. Jack sues for infringement. Jill and Sam come to you for advice. Which of the following is not true?

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

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

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

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

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

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

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

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

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

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

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

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

- (A) Powers of attorney to firms submitted in applications filed in the year 2001 are recognized by the United States Patent and Trademark Office.
- (B) The associate attorney may appoint another attorney.
- (C) The filing and recording of an assignment will operate as a revocation of a power or authorization previously given.
- (D) Revocation of the power of the principal attorney or agent does not revoke powers granted by him or her to other attorneys or agents.
- (E) All notices and official letters for the patent owner or owners in a reexamination proceeding will be directed to the attorney or agent of record in the patent file at the address listed on the register of patent attorneys and agents.

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

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

48. Your Canadian client, UpNorth Incorporated, came to you on February 11, 2001 with a valuable invention for pulping timber. UpNorth informed you it had been successfully using the invention commercially for the past fourteen months deep in the Canadian forests. The invention has not been used anywhere else by UpNorth, and the pulped timber from the UpNorth operations has not left Canada. At least one competitor, another Canadian company, lawfully observed the invention in operation during its first month of use with no restriction as to confidentiality or disclosure. UpNorth filed a Canadian patent application in December 1, 1999, prior to commercial use of the invention, but (in an effort to hold down expenses) chose not file a corresponding application in the United States. The Canadian patent application remains pending. UpNorth learned that two months ago, in December 2000, that its competitor began using the invention commercially in the United States. The invention was never disclosed or used in the United States prior to two months ago. UpNorth would like for you seek a United States patent on the invention to block the competitor from continued use of the invention. Which of the following would be reasonable advice from you to UpNorth?

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

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

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

50. An article in a popular scientific journal, dated January 13, 2000, fully discloses and teaches how to make a "Smart Shoe" wireless telecommunications device. The article discloses a shoe having a dialer in a rubber sole of the shoe. The article does not teach a metallic shoelace or suggest using the same as an antenna or for any other purpose. Which of the following claims in an application filed January 22, 2001 is/are anticipated by the journal article, and is/are not likely to be properly rejected under 35 U.S.C. § 112, second paragraph as indefinite?

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

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

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

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

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

APRIL 18, 2001

Afternoon Session (50 Points)

Time: 3 Hours

DIRECTIONS

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

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

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

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

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO

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

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

1. Which of the following is in accord with proper USPTO practice and procedure?

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

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

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

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

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

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

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

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

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

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

- Claim 1. A method for making an Ethernet cable comprising the steps of A, B and C.
- Claim 2. The method of claim 1, further characterized by the step of D.
- Claim 3. The Ethernet cable as in any one of the preceding claims.

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

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

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

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

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

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

8. Which of the following statements is most correct?

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

9. Which of the following statements is most correct?

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

10. Sally, an employee of Ted, conceived of and reduced to practice a spot remover for Ted on May 1, 1998. Sally's spot remover was made from water, chlorine, and lemon juice. On June 2, 1998, Sally filed a nonprovisional U.S. patent application for the spot remover, and assigned the entire rights in the application to Ted. Sally's assignment was not recorded in the USPTO, but was referenced in her application. On June 12, 1999, Jane, also an employee of Ted, having no knowledge of Sally's spot remover, conceived of and reduced to practice a spot remover for Ted. Jane's spot remover was made from carbonated water, chlorine, and lemon juice. On May 25, 1999, the USPTO granted Sally a patent. On November 5, 1998, Jane filed a nonprovisional U.S. patent application for the spot remover. As noted in Jane's application, Jane assigned the entire rights in her application to Ted. Jane's assignment was duly recorded in the USPTO. The examiner mailed a non-final Office action rejection under 35 U.S.C. § 103 to Jane in March 2001, citing the patent to Sally as prior art. Which of the following, if timely filed by Jane, would be effective in disqualifying Sally's patent?

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

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

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

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

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

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

13. In August 2000, a recently registered patent agent, who is not an attorney, asked a registered patent attorney to help the agent establish a practice. Considering the additional facts in the following choices separately, which choice best comports with the professional responsibilities of both the agent and the attorney?

- (A) The agent advertises as a registered practitioner authorized to practice before the Office in patent and trademark cases. The attorney supervises all the trademark work done by the agent.
- (B) The attorney has the agent prosecute trademark applications before the Office and the attorney signs all the papers submitted to the Office without reading the papers.
- (C) The attorney and agent enter into a partnership agreement that has no health or retirement benefits, but specifies that after termination of the partnership, the agent and the attorney will not practice in each other's neighborhoods or accept each other's established clients.
- (D) The agent advertises on television and radio as a registered patent agent and accepts patent cases on a reasonable contingent fee.
- (E) Without receiving anything of value from the agent, the attorney refers patent application clients to the agent, the agent informs the clients that the agent is a registered patent attorney, and the agent competently represents the clients in patent cases.

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

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

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

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

16. In June 1998 Michael buys a television set with a remote control for automatically changing channels on the television set. In June 2000, Michael moves to a new neighborhood and discovers while watching television that the remote control for his television not only changes the channels on his television set but also operates to open his neighbor's garage door. Michael, believing that people no longer need to have separate devices for operating their television and opening their garage doors, goes to a registered practitioner to seek patent protection on his new idea. The practitioner files a patent application in 2000. During the prosecution of the patent for the circuit board device, the practitioner files the following claims 11 and 12:

11. An electronic device comprising: circuitry; said circuitry operating to emit signals of a predetermined waveform; said signals being used to automatically change channels on a television set and automatically open the door of a garage.
12. A method for opening a garage door comprising using a television remote control device to emit signals, comprising the steps of:
 - a) adapting a television remote control device to emit signals to open a garage door;
 - b) pointing said television remote control device at said garage door; and
 - c) actuating said television remote control to cause said garage door to open.

Which of the following is true?

- (A) Since the television and remote control were sold in June 1998, claims 11 and 12 are barred by 35 U.S.C. § 102(b) since the device was on sale more than one year prior to the invention by Michael.
- (B) Since the television remote control device was in public use more than one year prior to the filing date of the application, Michael may obtain the patent coverage for the method claim 12 but not the device of claim 11.
- (C) Although the device was bought in June 1998, Michael did not use it to open a garage door until 2000. Since claim 11 requires that the signals of the remote control operate to open the garage door, the limitations of claim 11 are not met by the device bought in 1998, and 35 U.S.C. § 102(b) does not apply.
- (D) Since Michael did not make the remote control himself and only inadvertently discovered that his neighbor's garage door opens when changing the channel on his television set, this is merely an inadvertent discovery and not entitled to patent protection.
- (E) Whether or not claim 11 is patentable is solely a question of obviousness. Michael need only produce evidence of commercial success to overcome an obviousness rejection.

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

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

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

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

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

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

20. In July 2000, Pete Practitioner files a reissue application for Sam's patent on a combination washing machine and dryer, which issued on August 4, 1998. The original 20 claims are filed in the reissue application along with two additional dependent claims. The declaration indicates that there was error without deceptive intent in that applicant failed to claim the subject matter of the two newly added dependent claims. Sam also indicates in the declaration that he has no intention doing anything other than adding the two dependent claims. In September 1999 the examiner allows claims 1-10 of the reissue but rejects claims 11-22. Sam is eager to enforce claims 1-10 against a competitor but does not want to give up prosecuting claims 11-22. Sam also wants to add additional claims 23-30 directed to an entirely different invention, which was disclosed in the patent but not claimed. To claim the new invention, Sam must file new independent claims, which claim subject matter not previously claimed. Pete practitioner has retired and Sam comes to you for advice. Which of the following is true?

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

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

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

22. A rejection based on 35 U.S.C. § 102(a) cannot be overcome by:

- (A) Filing an affidavit under 37 C.F.R. § 1.131 “swearing back” of a U.S. patent which substantially shows or describes, and claims the same patentable invention as the rejected invention.
- (B) Filing an affidavit under 37 C.F.R. § 1.132 showing that the reference invention is not by “another.”
- (C) Perfecting a claim to priority under 35 U.S.C. § 119(a)-(d).
- (D) Amending the claims to patentably distinguish over the prior art.
- (E) Persuasively arguing that the claims are patentably distinguishable from the prior art.

23. Mr. and Mrs. Noteworthy (Henry and Alice) are registered patent practitioners maintaining an office. After completing their busiest year since opening their practice, the Noteworthy's decide to take a break from their hectic business routine and embark on a two week vacation in Acapulco, Mexico. On the third day of their vacation, Henry fell ill, and was laid up in bed for two days. Feeling somewhat better on the second day of his illness, and bored while Alice was on the beach, Henry phoned his office and learned from his secretary that an Office action in a case that he had overlooked contained a shortened statutory period (SSP) which expires on the very same day. He immediately had the Office action faxed to him, and upon receipt, he worked feverishly to prepare a reply. Upon completion of the reply, Henry prepared a certificate of mailing in accordance with the suggested format set forth in MPEP § 512 and deposited the reply accompanied by the certificate of mailing, properly addressed to the USPTO, in the local post office on the very same day before the post office closed. On the 5th day of their vacation, Alice became ill and required bed rest. While Henry was on the beach, Alice called her office and learned that one of her cases had a SSP expiring on the same day. Alice immediately had the Office action faxed to her. Upon receipt of the fax, Alice prepared a proper response and forwarded same to the USPTO by facsimile accompanied by a certificate of transmission in accordance with the suggested format set forth in MPEP § 512 and in compliance with 37 C.F.R. § 1.6(d). Assume the certificate of mailing and the certificate of transmission recite deposit and transmission dates that are the same as their respective SSP expiration dates. Also assume that both communications are received in the USPTO after their respective SSP expiration dates and are stamped with the actual date of receipt. Which of the following statements is true?

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

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

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

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

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

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

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

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

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

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

28. In December 1988, Molly invents a new potato cutter that cuts the potatoes into shapes having a star cross section. Because of the proximity of the star outer surface to the inter core of the potato, the shape achieves optimal cooking of the potato when fried without resulting in an overly cooked outer surface. Molly, thinking that the invention is important, has two people, Sue and Tom, both sworn to secrecy, witness a drawing of the invention. Molly then locks the drawing in a safe deposit box where it remains for the next twelve years. Neither Molly, Sue, or Tom discloses the invention to anyone for the next twelve years. In December 2000, Troy invents a new potato cutter which produces potatoes having a star cross section, and the potatoes are then fried. The invention becomes an overnight success. Troy files a patent application on February 1, 2001. Molly, after seeing the success of Troy's invention in the marketplace, decides to file an application, also on February 1, 2001. The examiner is unable to find any prior art and no other prior art is cited by either applicant. Which of the following is true?

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

29. Which of the following is true?

- (A) The statement, “Whether claims 1 and 2 are unpatentable,” complies with the requirement of 37 C.F.R. § 1.192(c)(6) for a concise statement in the appeal brief of the issues presented for review.
- (B) Following a new ground of rejection raised by the Board of Patent Appeals and Interferences, the applicant may request a rehearing, or submit an appropriate amendment of the rejected claims or a showing of facts relating to the rejected claims.
- (C) A reissue application may be filed in order to broaden claims back to their original form where the claims were mistakenly narrowed during the original prosecution to avoid the prior art provided that the narrowing of the claims was made without deceptive intent on the part of the applicant.
- (D) If the Board of Patent Appeals and Interferences decides to require an appellant to address a particular matter, and the appellant cannot respond within the time period set, he may obtain an extension of time by paying the requisite fee.
- (E) In an ex parte reexamination proceeding of a patent that arises from an application filed in the United States before November 29, 1999, a third party requester who is dissatisfied with a decision of the Board of Patent Appeals and Interferences may seek judicial review by appeal to either the U.S. Court of Appeals for the Federal Circuit or by civil action in the U.S. District Court for the District of Columbia.

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

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

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

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

32. Your client, Bill, disclosed to you the following. While hiking, he found a natural specimen of tree sap that had bonded rock material to a log, and was impervious to water. Bill realized that the sap would be an excellent roofing material for bonding asphalt shingles to wooden sheathing. Bill performed a chemical analysis of the sap and determined it was 10% A, 30% B, and 60% C. Bill experimented and found that he could synthetically produce the sap by mixing one part A by weight and three parts B by weight at 20 degrees Celsius, heating the mixture of A and B to 100 degrees Celsius, adding six parts C by weight, and cooling the mixture of A, B, and C to 20 degrees Celsius. Bill further experimented and found that if he added an effective amount of D to the mixture of A, B, and C, prior to cooling, the viscosity of the product would decrease, making it easier for roofers to apply it to wooden sheathing. You draft a patent application with a specification having all the information disclosed to you by Bill, including guidelines that explained that an effective amount of D for decreasing the viscosity is between 1% to 2% of the total weight of the mixture of A, B, and C, after cooling. The guidelines also explained that an effective amount of D for brightening the color of the composition is between 3% to 4% of the total weight of the mixture of AB, and C, after cooling. Which if any of the following claims, included in Bill's application, would not be properly rejected pursuant to 35 U.S.C. § 101?

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

Claim 2. A composition produced by the steps of: mixing one part A by weight with three parts B by weight at 20 degrees Celsius to form a mixture of A and B; heating the mixture of A and B to 100 degrees Celsius; adding six parts C by weight to form a mixture of A, B, and C; cooling the mixture of A, B, and C to 20 degrees Celsius; and adding an effective amount of D to decrease the viscosity of the composition.

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

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

33. Which of the following statements concerning reliance by an examiner on common knowledge in the art, in a rejection under 35 U.S.C. § 103 is correct?
- An examiner's statement of common knowledge in the art is taken as admitted prior art, if applicant does not seasonably traverse the well known statement during examination.
 - Applicant can traverse an examiner's statement of common knowledge in the art, at any time during the prosecution of an application to properly rebut the statement.
 - If applicant rebuts an examiner's statement of common knowledge in the art in the next reply after the Office action in which the statement was made, the examiner can never provide a reference to support the statement of common knowledge in the next Office action and make the next Office action final.
- I.
 - II.
 - III.
 - I and II.
 - None of the above.
34. Registered practitioner Mike files a utility patent application in the USPTO having one claim on May 6, 1998. Following a proper final rejection dated June 28, 2000, of claim 1, Mike files a notice of appeal with the appropriate fee on September 12, 2000, and an appeal brief with the appropriate fee on October 12, 2000. On February 14, 2001, Mike learns about a publication (the "Valentine reference") which he knows to be material to patentability of claim 1. The Valentine reference was not considered by the examiner during prosecution of the application. According to proper USPTO rules and procedure, which of the following actions if taken by Mike on February 16, 2001, prior to a decision on the appeal, will be treated by the USPTO as a request to withdraw the appeal?
- Filing a request for continued examination of the application with an information disclosure statement that complies with the provisions of 37 CFR § 1.98, listing the Valentine reference, submitting the fee set forth in 37 CFR § 1.17(e), and notifying the Board of Patent Appeals and Interferences of the same.
 - Filing a request for continued examination of the application, and submitting the fee set forth in 37 CFR § 1.17(e), without filing any other submission, and notifying the Board of Patent Appeals and Interferences of the same.
 - Filing a request for continued examination of the application, and filing an information disclosure statement that complies with the provisions of 37 CFR § 1.98, listing the Valentine reference, without submitting the fee set forth in 37 CFR § 1.17(e), and notifying the Board of Patent Appeals and Interferences of the same.
 - Filing a request for continued examination of the application, without submitting the fee set forth in 37 CFR § 1.17(e), and without filing any other submission, and notifying the Board of Patent Appeals and Interferences of the same.
 - All of the above.

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

Claim 2. The method of Claim 1, further consisting of the step of cooling the mixture to a temperature of 32° F.

Following proper USPTO practices and procedures, from which of the following claims does Claim 2 not properly depend?

- (A) Claim 1. A method of making liquid compound A comprising the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (B) Claim 1. A method of making liquid compound A consisting of the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (C) Claim 1. A method of making liquid compound A including the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (D) Claim 1. A method of making liquid compound A characterized by the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (E) (C) and (D).

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

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

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

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

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

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

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

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

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

- (A) Amending the claim by canceling elements B and C because the reference is concerned only with element A.
- (B) Amending the claim by canceling element A from the Markush group.
- (C) Arguing that the reference is not relevant because it lacks elements B and C.
- (D) Amending the claim by changing "consisting of" to "consisting essentially of."
- (E) Amending the claim to redefine X as "being a member selected from the group comprising elements A, B, and C."

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

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

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

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

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

Claim 1. An apparatus for sitting comprising:

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

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

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

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

44. Which of the following is true?

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

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

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

46. Which of the following is in accordance with proper USPTO practice and procedure?
- (A) The fee an applicant must pay to request continued examination of an application is set in an amount equal to the basic filing fee the same applicant must pay for a utility patent application.
 - (B) A Certificate of Mailing or Transmission under 37 C.F.R. § 1.8 is proper for filing a Continued Prosecution Application under 37 C.F.R. § 1.53(d) to obtain the date of the Certificate as the filing date for the application.
 - (C) The Office does not charge a fee for processing a fee paid by a check that has been refused, i.e., dishonored and returned, by a financial institution.
 - (D) To first request conversion of a provisional application containing a claim to a nonprovisional application after the provisional application has become abandoned, a petition to revive, accompanied by the appropriate fees, a showing of unavoidable delay, and a request for the conversion must be filed within one year of the date of abandonment.
 - (E) The conversion of a provisional application, for which a basic filing fee was properly paid, to a nonprovisional application will result in the savings of filing and other fees over the filing of a nonprovisional application claiming the benefit under 35 U.S.C. § 119(e) and 37 C.F.R. § 1.78 of the earlier provisional filing date.
47. Applicant receives a rejection and objection in a non-final Office action dated December 12, 2000. Applicant timely files a reply dated February 12, 2001, that distinctly and specifically points out the supposed errors in the examiner's action. The reply addresses every ground of objection and rejection in the Office action dated December 12, 2000, by presenting arguments pointing out specific distinctions believed to render the claims, including any newly presented claims, patentable over the applied references. Applicant mails a second reply. Thereafter, Applicant mails a third reply to the USPTO, which would result in a change to the specification only, if entered. In accordance with proper USPTO rules and procedure, which of the following are factors that will be considered in deciding whether to disapprove Applicant's third reply?
- (A) Whether Applicant's reply dated February 12, 2001, includes a request that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated.
 - (B) The state of preparation of an Office action responsive to the Applicant's reply dated February 12, 2001, as of the date of receipt of Applicant's third reply.
 - (C) The nature of any changes to the specification that would result from entry of Applicant's second reply.
 - (D) (A), (B), and (C).
 - (E) (B) and (C).

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

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

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

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

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

- (A) As “Express Mail Post Office to Post Office” without the Express Mail mailing label number being placed on the application and with the “date-in” entered by the USPS on Friday, March 9, 2001, and the application being received in the USPTO on Monday, March 12, 2001.
- (B) As “Express Mail Post Office to Addressee” without the Express Mail mailing label number being placed on the application and with the “date-in” entered by the USPS on Saturday, March 10, 2001, and the application being received in the USPTO on Tuesday, March 13, 2001.
- (C) As “Express Mail Post Office to Addressee” without the Express Mail mailing label number being placed on the application and with the “date-in” entered by the applicant on Thursday, March 8, 2001, and the application being received in the USPTO on Wednesday, March 14, 2001.
- (D) As “Express Mail Post Office to Addressee” with the Express Mail mailing label number being placed on the application and with the “date-in” entered by the applicant on Thursday, March 22, 2001, and the application being received in the USPTO on Monday, March 26, 2001.
- (E) As “Express Mail Post Office to Post Office” with the Express Mail mailing label number being placed on the application and with the “date-in” entered by the USPS on Saturday, March 24, 2001, and the application being received in the USPTO on Monday, March 26, 2001.

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

OCTOBER 17, 2001

Morning Session (50 Points)

Time: 3 Hours

DIRECTIONS

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

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

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

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

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO

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

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

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

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

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

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

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

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

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

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

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

You have been asked to suggest steps to remove any formal objections that can be expected from the patent examiner, without incurring unnecessary government fees. You determine that the first color photograph is the only practical medium by which to disclose certain aspects of the claimed invention, but that the substance of the remaining photographs could readily be illustrated through ordinary ink drawings. You correctly recall that the Office announced in the Official Gazette in May 2001 (1246 OG 106) that it is *sua sponte* waiving 37 CFR 1.84(a)(2)(iii), and is no longer requiring a black and white photocopy of any color drawing or color photograph. Which of the following represents the most reasonable advice to the independent inventor?

- (A) Submit a request for approval of drawing changes wherein the first photograph is labeled "Figure 1" and the remaining photographs are cancelled in favor of corresponding ink drawings labeled Figures 2 through 4; and immediately withdraw the claim for small entity status because of the license to MEGACORP.
- (B) Submit a request for approval of drawing changes wherein the first photograph is labeled "Figure 1" and the remaining photographs are cancelled in favor of corresponding ink drawings labeled Figures 2 through 4; and submit a petition for acceptance of Figure 1 in the form of a color photograph along with three sets of the color photograph, a proposed amendment to insert language concerning the color photograph as the first paragraph of the specification and the required petition fee. The photographs must be sufficient quality that all details in the photographs are reproducible in a printed patent.
- (C) Submit a request for approval of drawing changes wherein the first photograph is labeled "Figure 1" and the remaining photographs are cancelled in favor of corresponding ink drawings labeled Figures 2 through 4.
- (D) Immediately withdraw the claim for small entity status because of the license to MEGACORP and submit to the USPTO the difference between the small entity filing fee and the large entity filing fee.
- (E) File a rewritten application as a continuation application including a color photograph as Figure 1, ink drawings as Figures 2-4, a new inventor's declaration and a small entity filing fee.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

14. Which of the following is not in accord with proper USPTO practice and procedure?
- (A) A written description as filed in a nonprovisional patent application is presumed adequate under 35 U.S.C. § 112 in the absence of evidence or reasoning to the contrary.
 - (B) An examiner may show that a written description as filed in a nonprovisional patent application is not adequate by presenting a preponderance of evidence why a person of ordinary skill in the art would not recognize in the applicant's disclosure a description of the invention defined by the claims.
 - (C) A general allegation of "unpredictability in the art" is sufficient to support a rejection of a claim for lack of an adequate written description.
 - (D) When filing an amendment, a practitioner should show support in the original disclosure for new or amended claims.
 - (E) When there is substantial variation within a genus, an applicant must describe a sufficient variety of species to reflect the variation within the genus.
15. Sam is a sole proprietor of *Sam's Labs*, which has no other employees. Sam invented a new drug while doing research under a Government contract. Sam desires to file a patent application for his invention and assign it to *Sam's Labs*. Sam has licensed Rick, also a sole proprietor with no employees, to make and use his invention. Sam wants to claim small entity status when filing a patent application for his invention. Sam also wants to grant the Government a license, but will not do so if he will be denied small entity status. Sam has limited resources and wants to know whether, how, and to what extent he may claim small entity status. Which of the following is not accurate with respect to proper USPTO procedure in relation to applications filed on or after January 1, 2001?
- (A) *Sam's Labs* is a small business concern for the purposes of claiming small entity status for fee reduction purposes.
 - (B) If Sam grants a license to the Government resulting from a rights determination under Executive Order 10096, it will not constitute a license so as to prohibit claiming small entity status.
 - (C) The establishment of small entity status permits the recipient to pay reduced fees for all patent application processing fees charged by the USPTO.
 - (D) Sam may establish small entity status by a written assertion of entitlement to small entity status. A written assertion must: (i) be clearly identifiable; (ii) be signed; and (iii) convey the concept of entitlement to small entity status, such as by stating that applicant is a small entity, or that small entity status is entitled to be asserted for the application or patent.
 - (E) While no specific words or wording are required to assert small entity status, the intent to assert small entity status must be clearly indicated in order to comply with the assertion requirement.

The following facts apply to Questions 16 and 17.

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

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

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

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

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

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

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

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

18. Which of the following is in accord with proper USPTO practice and procedure?

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

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

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

20. Which of the following is true?

- (A) The statement, “Whether claims 1 and 2 are unpatentable,” complies with the requirement of 37 CFR 1.192(c)(6) for a concise statement in the appeal brief of the issues presented for review.
- (B) A reissue application may be filed in order to broaden claims back to their original form where the claims were mistakenly narrowed during the original prosecution to avoid the prior art provided that the narrowing of the claims was made without deceptive intent on the part of the applicant.
- (C) Following a new ground of rejection raised by the Board of Patent Appeals and Interferences, the applicant may request a rehearing, or submit an appropriate amendment of the rejected claims or a showing of facts relating to the rejected claims.
- (D) If the Board of Patent Appeals and Interferences decides to require an appellant to address a particular matter, and the appellant cannot respond within the time period set, he may obtain an extension of time by paying the requisite fee.
- (E) In an *ex parte* reexamination proceeding of a patent that arises from an application filed in the United States before November 29, 1999, a third party requester who is dissatisfied with a decision of the Board of Patent Appeals and Interferences may seek judicial review by appeal to either the U.S. Court of Appeals for the Federal Circuit or by civil action in the U.S. District Court for the District of Columbia.

21. An inventor, working with prior art subject matter, changes the subject matter, and thereafter files a patent application only claiming the changed subject matter. Which of the following changes might render the claimed subject matter patentable?

- (A) Where the only difference between the prior art device and the claim device was a recitation of relative dimensions of the claimed device and the claimed device would not perform differently than the prior art device.
- (B) Where the only difference between the prior art device and the claimed device is the configuration of the claimed device, and the configuration is a matter of choice without significance regarding the use of the device.
- (C) Where the difference between the prior art, an impure material, and the claimed subject matter, the purified form of the impure material, is the purity of the material and the utility of the purified material, which differs from the impure material.
- (D) Where the only difference between the prior art device and the claimed device is a reversal of the parts that move relative to each other, and without any unexpected results.
- (E) Where the only difference between the prior art device and the claimed device is elimination of an element and its function, and elimination of the function was desired, required, or expected.

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

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

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

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

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

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

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

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

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

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

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

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

28. Which of the following is true?

- (A) When an applicant successfully petitions to make his case special, the special status ends if applicant appeals the case to the Board of Patent Appeals and Interferences.
- (B) A reissue application may be filed in order to broaden claims back to their original form where the claims were mistakenly narrowed during the original prosecution to avoid the prior art provided that the narrowing of the claims was made without deceptive intent on the part of the applicant.
- (C) If the Board of Patent Appeals and Interferences decides to require an appellant to address a particular matter, and the appellant cannot respond within the time period set, he may obtain an extension of time by paying the requisite fee.
- (D) Following a new ground of rejection raised by the Board of Patent Appeals and Interferences, the applicant may request a rehearing, or submit an appropriate amendment of the rejected claims or a showing of facts relating to the rejected claims.
- (E) In an *ex parte* reexamination proceeding, a third party requester who is dissatisfied with a decision of the Board of Patent Appeals and Interferences may seek judicial review by appeal to either the U.S. Court of Appeals for the Federal Circuit or by civil action in the U.S. District Court for the District of Columbia.

The following facts apply to Questions 29 through 32.

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

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

29. Which of the following statements is most true?

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

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

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

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

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

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

Claim 8. An aid for assisting a golfer comprising:

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

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

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

Which of the following best completes claim 8?

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

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

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

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

Claim 2. The method of Claim 1, further consisting of the step of cooling the mixture to a temperature of 32° F.

Following proper USPTO practices and procedures, from which of the following claims does Claim 2 not properly depend?

- (A) Claim 1. A method of making liquid compound A comprising the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (B) Claim 1. A method of making liquid compound A characterized by the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (C) Claim 1. A method of making liquid compound A including the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (D) Claim 1. A method of making liquid compound A consisting of the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (E) (B) and (C).

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

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

36. The claims of a pending patent application were rejected in an Office action mailed Thursday, November 23, 2000. The Examiner set a three-month shortened statutory period for reply. The applicant petitioned for a one-month extension of time on Friday, February 23, 2001 and paid the appropriate one-month extension fee. No further papers or fees were submitted and the application became abandoned. What was the date of abandonment?

- (A) Friday, February 23, 2001.
- (B) Friday, March 23, 2001.
- (C) Saturday, March 24, 2001.
- (D) Monday, March 26, 2001.
- (E) Thursday, May 24, 2001.

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

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

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

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

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

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

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

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

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

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

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

Claim 1. A doughnut making machine comprising:

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

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

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

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

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

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

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

45. Which of the following statements accords with proper USPTO practice and procedure?
- (A) A request for publication of a provisional application on a certain date will be treated as a request for publication as soon as possible.
 - (B) If an applicant filed an application in a foreign country and the description of the invention in the foreign application is less extensive than the description of the invention in the application filed in the USPTO, the applicant may submit a redacted copy, eliminating the description not contained in the foreign application, for publication within 12 months after the filing date for which a benefit is sought under 35 U.S.C.
 - (C) Early publication of a reissue application may be honored only if accompanied by a copy of the application in compliance with the Office electronic filing system requirements.
 - (D) If an applicant filed an application in a foreign country and the description of the invention in the foreign application is more extensive than the description of the invention in the application filed in the USPTO, the applicant may submit a redacted copy, eliminating the description not contained in the foreign application, for publication within 14 months after the filing date for which a benefit is sought under 35 U.S.C.
 - (E) Re-publication of a patent application is available where the Office makes a material mistake apparent from the records and the request for re-publication is filed within 3 months from the date of the patent application publication.
46. In early 1999, at the request of MC Motors, Eve demonstrated her automobile heating system at a testing facility in Germany. MC Motors signs a confidentiality agreement and agrees not to disclose the invention to anyone. The test is conducted in a secluded area and the persons involved are sworn to secrecy. Unbeknownst to Eve, MC Motors installs the heating system on its MC cars and begins selling its cars with the heating system in the United States in September 1999. In August 2000, MC files a patent application in the United States for the automobile heating system. In December 2000, Eve files a patent application claiming the automobile heating system. The examiner rejects all the claims in Eve's application based upon an MC Motors brochure advertising its cars in September 1999. Which of the following is true?
- (A) MC Motors is entitled to a patent even though it misappropriated the idea for the invention from Eve since the misappropriation was beyond the jurisdiction of the USPTO.
 - (B) Since the MC Motors misappropriated the invention and since Eve did not authorize the sale, the rejection may be overcome by showing that the sales by MC Motors were not authorized by Eve.
 - (C) Eve is not entitled to a patent since the invention was on sale in this country more than one year prior to the date of the application for patent in the United States.
 - (D) (A) and (C).
 - (E) None of the above.

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

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

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

- (A) The Amendment is treated as untimely and the application becomes abandoned. However, applicant may petition to revive the abandoned application on the basis that the abandonment was unavoidable.
- (B) The Amendment is treated as untimely and the application becomes abandoned. However, applicant may petition to revive the abandoned application on the basis that the abandonment was unintentional.
- (C) Applicant will be notified that the petition for extension of time was insufficient and will be given 30 days from the mailing date of the notification to request an extension of time for a second month.
- (D) The petition for a one-month extension of time will be construed as a petition requesting the appropriate period of extension.
- (E) Each of statements (A), (B), (C) and (D) is untrue.

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

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

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

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

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

OCTOBER 17, 2001

Afternoon Session (50 Points)

Time: 3 Hours

DIRECTIONS

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

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

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

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

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

9. Bill was working toward a Ph.D. in physics from a university in Japan. As part of his doctoral program, Bill prepared (in Japanese) a thesis directed to his work in the semiconductor field. Following approval of the thesis by his faculty advisor on December 21, 2000, the sole copy of Bill's thesis was placed on the shelves of the university library on January 29, 2001, where it was accessible to the faculty and students of the university as well as to the general public. At that time, the thesis was indexed in a general user's catalog maintained locally at the university library by author, title and subject. On March 4, 2001, the general user's catalog was made freely available on an Internet web page maintained by the university. Which of the following statements is most correct?

- (A) Bill's thesis may be used under 35 U.S.C. § 102(b) as a prior art printed publication against a United States application for patent filed January 4, 2002.
- (B) Bill's thesis may be used under 35 U.S.C. § 102(b) as a prior art printed publication against a United States application for patent filed February 19, 2002.
- (C) Bill's thesis may be used under 35 U.S.C. § 102(b) as a prior art printed publication against a United States application for patent filed March 6, 2002.
- (D) Each of statements (B) and (C) is correct.
- (E) Because the thesis was written in Japanese, it cannot be a prior art printed publication against a United States application for patent.

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

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

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

- Claim 1. A method for making an Ethernet cable comprising the steps of A, B and C.
- Claim 2. The method of claim 1, further characterized by the step of D.
- Claim 3. The Ethernet cable as in any one of the preceding claims.

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

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

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

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

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

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

The following facts apply to Questions 14 through 16.

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

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

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

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

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

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

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

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

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

- (A) Thomas may rescind his nonpublication request at any time.
- (B) By requesting nonpublication of the application, Thomas "opted out" of the statutory framework for patent term adjustment and, therefore, no patent term adjustment is available.
- (C) Submission of the nonpublication request does not affect any patent term adjustment that might be available to Thomas.
- (D) Statements (A) and (C) are true.
- (E) Statements (B) and (C) are true.

17. There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." Which of the following are among the factors for determining whether necessary experimentation is "undue"?

- (A) The breadth of the claims.
- (B) The nature of the invention.
- (C) The state of the prior art.
- (D) The level of one of ordinary skill.
- (E) (A), (B), (C) and (D).

18. Claims 1 and 2 in a patent application state the following:

Claim 1. An apparatus for sitting comprising:

- (i) a square shaped base member;
- (ii) four elongated members mounted to the bottom of the base member; and
- (iii) a circular back member mounted to the base member.

Claim 2. An apparatus as in claim 1, further comprising a spring connected to the back member and to the base member.

Which, if any, of the following claims fully supported by the specification and presented in the application, is in accordance with USPTO rules and procedure?

- (A) Claim 3. An apparatus as in claim 1, wherein the base member is rectangularly shaped.
- (B) Claim 3. An apparatus as in claim 2, wherein the wheels connected to each of the elongated members are plastic.
- (C) Claim 3. An apparatus as in any of the preceding claims, in which the circular back member is wooden.
- (D) Claim 3. An apparatus as in the preceding claims, further comprising a pressure-sensing device connected to the base member.
- (E) None of the above.

19. In accordance with proper USPTO practice and procedure, which of the following statements is true?

- (A) Where sole patent applicant Able claims his invention in a Jepson-type claim, and the specification discloses that the subject matter of the preamble was invented by Baker before applicant's invention, the preamble is properly treated as prior art.
- (B) Where the sole patent applicant Able claims his invention in a Jepson-type claim, and the specification makes it clear that the claimed invention is an improvement on Able's own prior invention, which Able discovered less than one year before the filing date of the application, the preamble in the claim is properly treated as prior art.
- (C) Where the sole patent applicant Able claims his invention in a Jepson-type claim, and the specification makes it clear that the claimed invention is an improvement on an invention that Able discovered and publicly used and commercially sold by Able in Texas for several years before the filing date of the application, the preamble in the claim cannot properly be treated as prior art.
- (D) Where the sole applicant, Baker, states that something is prior art, the statement can be taken as being admitted prior art only if corroborated by objective evidence proffered by Baker, or found by the examiner.
- (E) No claim, including a Jepson-type claim, carries with it an implied admission that the elements in the preamble are old in the art.

20. Which of the following is true?

- (A) In rejecting claims the examiner may rely upon facts within his own personal knowledge, unless the examiner qualifies as an expert within the art, in which case he is precluded from doing so, since only evidence of one of ordinary skill in the art is permitted.
- (B) If an applicant desires to claim subject matter in a reissue which was the same subject matter waived in the statutory invention registration of another, the applicant is precluded by the waiver from doing so, even though the applicant was not named in the statutory invention registration.
- (C) If an applicant, knowing that the subject matter claimed in his patent application was on sale in Michigan and sales activity is a statutory bar under 35 U.S.C. § 102(b) to the claims in his application, nevertheless withholds the information from the patent examiner examining the application, and obtains a patent including the claims in question, the applicant may remove any issue of inequitable conduct by filing a request for reexamination based on the sales activity.
- (D) An applicant for a patent may overcome a statutory bar under 35 U.S.C. §102(b) based on a patent claiming the same invention by acquiring the rights to the patent pursuant to an assignment and then asserting the assignee's right to determine priority of invention pursuant to 37 CFR 1.602.
- (E) None of the above.

21. An application, filed September 20, 2001, has not yet been examined. All claims in the application are drawn to a single invention. Which of the following, submitted (independently of each other) by a registered practitioner of record with an otherwise proper petition to make the application special, properly results in the application being advanced out of turn for examination?

- (A) A statement under 37 CFR 1.102 explaining how the invention contributes to the restoration of the basic life-sustaining elements to enhance the quality of the environment, without the petition fee set forth in 37 CFR 1.17(h).
- (B) A search made by a foreign patent office, one copy each of the references deemed most closely related to the subject matter encompassed by the claims, a detailed discussion of the references that points out with the particularity required by 37 CFR 1.111(b) and (c) how the claimed subject matter is patentable over the references, and the petition fee set forth in 37 CFR 1.17(h).
- (C) A doctor's certificate demonstrating that the applicant's health is such that he might not be available to assist in the prosecution of the application if it were to run its normal course, without the petition fee set forth in 37 CFR 1.17(h).
- (D) A birth certificate showing that applicant is 65 years of age, without the petition fee set forth in 37 CFR 1.17(h).
- (E) All of the above.

22. To satisfy the written description requirement of the first paragraph of 35 U.S.C. § 112, an applicant must show possession of the invention. An applicant's lack of possession of the invention may be evidenced by:

- (A) Original claims which recite an essential feature where the feature is not described in the specification or the claims, and is not conventional in the art or known to one of ordinary skill in the art.
- (B) A specification of a patent application that describes the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.
- (C) A specification of a patent application that describes an actual reduction to practice of the claimed invention.
- (D) An amendment to a claim seeking to add a limitation that is supported in the specification through implicit or inherent disclosure.
- (E) An amendment to a claim seeking to correct an obvious error by the appropriate correction.

23. Greene is a registered patent agent employed by an intellectual property law firm located in Arlington, Virginia. Greene is awakened at 5:30 AM one morning by a frantic call from Whyte, a senior partner at the law firm. Whyte informs Greene that Whyte has an examiner interview scheduled for 3:00 PM that day in connection with an important patent application Whyte is handling. However, a family emergency arose during the night and Whyte will not be able to attend the interview. It is also the last day of the statutory six-month period for reply, so the interview cannot be rescheduled. Whyte requests that Greene conduct the examiner interview for Whyte and, based on the outcome of the interview, file appropriate papers with the Patent Office. Whyte tells Greene exactly where Greene can locate the file in Whyte's office. Greene has not been given a power of attorney in the application, but has been given a power to inspect the Patent Office file for the application. Assuming Greene has adequate time to prepare for the interview and will competently represent the applicant, which of the following statements is true?

- (A) Greene must obtain either a written power of attorney from the applicant or a written associate power of attorney from Whyte before Greene can participate in the examiner interview.
- (B) Greene can participate in the interview if Greene brings along a copy of the application file and states to the examiner that Greene is authorized to represent the applicant.
- (C) Greene cannot participate in the examiner interview because Greene does not have an express power of attorney and has not previously made an appearance in the application.
- (D) A mere power to inspect is sufficient authority for an examiner to grant an interview involving the merits of an application.
- (E) Statements (B) and (D) are true.

24. Pete wants to file a protest against a patent application filed by a coworker. In the locker room at his place of employment, Pete overheard Sol talking about an application for a golf ball retriever. Pete feels that the invention strongly resembles a golf ball retriever device published in a 1995 edition of Popular Golf magazine. Pete comes to you to file a protest. Pete wants to know if it will be considered by the examiner, and if the applicant (Sol) is required to respond. Pete believes he heard Sol say the application was filed in May 2001, and wonders whether he should include evidence of fraud since Pete believes that his (Pete's) wife may have shown Sol the Popular Golf article. Which of the following is not accurate with respect to proper USPTO procedure in relation to applications filed on or after January 1, 2001?

- (A) Pete's protest against Sol's pending application will be referred to the examiner having charge of the subject matter involved provided Pete can adequately identify the application. Protests that do not adequately identify a pending patent application will be returned to the protestor and will not be further considered by the Office.
- (B) Pete's protest, provided it adequately identifies Sol's application, will be entered in the application file if: (1) the protest is submitted prior to the date the application was published or the mailing of a notice of allowance under § 1.311, whichever occurs first; and (2) the protest is either served upon Sol in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible.
- (C) If Pete submits evidence that his wife gave Sol a copy of the Popular Golf article and contends that Sol fraudulently copied the device from that disclosed in the article, the examiner will generally not comment on the issues related to fraud.
- (D) Pete's protest, provided it adequately identifies Sol's application and is submitted prior to the date the application was published or the mailing of a notice of allowance under § 1.311, and which is either served upon Sol in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible, will be considered by the Office if the application is still pending when the protest and application file are brought before the examiner, and the protest includes: (1) a listing of the patents, publications, or other information relied upon; (2) a concise explanation of the relevance of each listed item; (3) a copy of each listed patent or publication or other item of information in written form or at least the pertinent portions thereof; and (4) an English language translation of all the necessary and pertinent parts of any non-English language patent, publication, or other item of information in written form relied upon.
- (E) If Pete files the protest before the final office action, Sol has a duty to respond to the issues raised by Pete's protest even in the absence of a request by the USPTO for comments. If such issues are not addressed, the issues will be deemed admitted.

25. In accordance with USPTO rules and procedure, in which of the following situations may an applicant file a request on or after August 16, 2000 for continued examination of a non-provisional utility patent application with an earliest effective filing date of March 15, 1999?

- (A) The last Office action is a notice of allowance, the issue fee has been paid, and no petition to withdraw the application from issue has been granted.
- (B) The last Office action is a final action and the application is abandoned.
- (C) The last Office action is a non-final Office action containing a rejection of all claims under 35 U.S.C. § 102(b), and the applicant has filed no reply.
- (D) The last Office action is a notice of allowance, and after four months from the date of the notice of allowance, the issue fee has not been paid.
- (E) None of the above.

26. In a non-provisional utility patent application filed January 12, 1999, the examiner sends Applicant a final Office action dated February 14, 2001, rejecting claim 1 under 35 U.S.C. § 102(a), and objecting as to the form of claims 2 through 10. The examiner sets a three-month shortened statutory period for reply. According to USPTO rules and procedure, which of the following by Applicant ensures that the application does not go abandoned on Wednesday, August 15, 2001?

- (A) Mailing to the USPTO, using a certificate of mailing under 37 CFR 1.8, dated August 14, 2001, a petition and fee for an extension of three months, a request for a continued prosecution application, and the fee for a request for a continued prosecution application. The foregoing is received by the USPTO on August 17, 2001.
- (B) Mailing to the USPTO, using a certificate of mailing under 37 CFR 1.8, dated August 14, 2001, a petition and fee for an extension of three months, a request for continued examination with a submission that meets the reply requirements of 37 CFR 1.111, and the fee for a request for continued examination. The foregoing is received by the USPTO on August 17, 2001.
- (C) Mailing to the USPTO, using a certificate of mailing under 37 CFR 1.8, dated August 14, 2001, a petition and fee for an extension of three months. The foregoing is received by the USPTO on August 17, 2001. Also, telephoning the examiner on August 14, 2001 to discuss the rejections of claims in the final Office action, but without reaching an agreement with the examiner.
- (D) Mailing to the USPTO a petition and fee for an extension of three months, a request for continued examination with a reply that states, "Applicant requests that objections as to form be held in abeyance until allowable subject matter is indicated, at which time Applicant will reply to the rejection of claim 1," and the fee for a request for continued examination. The foregoing is received by the USPTO on August 14, 2001.
- (E) Each of items (A), (B), (C) and (D) would ensure that the application does not go abandoned on Wednesday, August 15, 2001.

27. Mary, a legally competent adult inventor, filed provisional application A on January 3, 2000, a nonprovisional application B one year later on January 3, 2001, and nonprovisional application C on February 28, 2001. Nonprovisional application B was abandoned when nonprovisional application C was filed. The provisional application and both nonprovisional patent applications were in Mary's name only, but a declaration has not yet been filed. Mary is living on a remote island in the middle of the Arctic Ocean where the only communication is in the summer months. Sam, the father of Mary, has been authorized by Mary to sign Mary's name to the § 1.63 declaration and also Sam's name. Sam, unbeknownst to Mary, also wants access to all three application files at the USPTO before he files the declaration to make certain Mary has properly described her invention. Sam acknowledges he is not an inventor but insists he must sign as an inventor so that he may act on behalf of Mary. Which of the following is not in accordance with proper USPTO procedure in relation to applications filed on or after January 1, 2001?

- (A) Sam may not add his name as an inventor since a patent is applied for only in the name or names of the actual inventor or inventors.
- (B) Since no declaration was filed during the pendency of application B, Sam may not see the Application papers for application B since he has not been authorized by Mary to see the application A and Sam is not an inventor.
- (C) Sam is not entitled to access to the provisional application A since he has not been authorized by Mary to see the application A and Sam is not an inventor.
- (D) Sam is precluded from access to the Application B since his name does not appear on the application papers and Sam is not an inventor.
- (E) Sam may sign Mary's name to the declaration since he was authorized by Mary to do so.

28. In which of the following instances is the reference properly available as prior art under 35 U.S.C § 102(d)?

- (A) A U.S. patent application is filed within the one year anniversary date of the filing date of the foreign application. The reference is the foreign application.
- (B) The applicant files a foreign application, later timely files a U.S. application claiming priority based on the foreign application, and then files a continuation - in - part (CIP) application, and the claims in the CIP are not entitled to the filing date of the U.S. parent application. The foreign application issues as a patent before the filing date of the CIP application and is used to reject the claims directed to the added subject matter under 35 U.S.C. §§ 102(d)/103. The reference is the foreign application.
- (C) The applicant files a foreign application, and later timely files a U.S. application claiming priority based on the foreign application. The examined foreign application has been allowed by the examiner and has not been published before the U.S. application was filed. The reference is the foreign application.
- (D) The reference is a defensive publication.
- (E) All of the above.

29. Which of the following is in accordance with proper USPTO practice and procedure?

- (A) A Certificate of Mailing or Transmission under 37 CFR 1.8 is proper for filing a Continued Prosecution Application under 37 CFR 1.53(d) to obtain the date of the Certificate as the filing date for the application.
- (B) The fee an applicant must pay to request continued examination of an application is set in an amount equal to the basic filing fee the same applicant must pay for a utility patent application.
- (C) The Office does not charge a fee for processing a fee paid by a check that has been refused, *i.e.*, dishonored and returned, by a financial institution.
- (D) To first request conversion of a provisional application containing a claim to a nonprovisional application after the provisional application has become abandoned, a petition to revive, accompanied by the appropriate fees, a showing of unavoidable delay, and a request for the conversion must be filed within one year of the date of abandonment.
- (E) The conversion of a provisional application, for which a basic filing fee was properly paid, to a nonprovisional application will result in the savings of filing and other fees over the filing of a nonprovisional application claiming the benefit under 35 U.S.C. § 119(e) and 37 CFR 1.78 of the earlier provisional filing date.

30. You file a nonprovisional patent application in the USPTO on December 27, 1999, on behalf of your client. On the basis of information provided to you, you assert entitlement to small entity status and pay the small entity status basic filing fee of \$345. On December 27, 2000, a first Office action is mailed. You file a reply to the Office action on February 2, 2001, accompanied by an Information Disclosure Statement (IDS) and the required fee of \$240 for filing the IDS at such time. You now learn that the small entity status was erroneous at the time it was established, although it was established in good faith, and the deficiency resulting from the previous erroneous payment must be paid and can be calculated from the following table:

	<u>Other than Small Entity</u>	<u>Small Entity</u>
Basic Fee at time of payment	\$690.00	\$345.00
IDS Fee at time of payment	\$240.00	\$240.00
Current Basic Fee	\$710.00	\$355.00
Current IDS Fee	\$180.00	\$180.00

In accordance with USPTO proper practice and procedure, which of the following is the proper deficiency amount?

- (A) \$365.00
- (B) \$355.00
- (C) \$305.00
- (D) \$295.00
- (E) \$335.00

31. Zak had expended a considerable amount of money, time, and effort in the pursuit of patent protection for an invention that he had conceived of many years before. His sacrifices had been large and his frustration and disappointment could be observed in the expression on his face when his attorney informed him that the Board of Patent Appeals and Interferences (“BPAI”) issued a decision on February 19, 2001, affirming the examiner’s rejection of all the claims in his application. Zak didn’t even think twice when he directed his attorney to immediately file a Request for Rehearing or Reconsideration. Assuming action on the Request for Rehearing or Reconsideration is unfavorable to Zak, which of the following options is available to Zak?

- (A) File a Notice of Appeal to the Court of Appeals of the Federal Circuit (“CAFC”) within 6 months of the BPAI decision, accompanied by a request for extension of time under 37 CFR 1.136 and the appropriate fee.
- (B) File a Notice of Appeal to the U.S. District Court of the District of Columbia (“DDC”) within 5 months of the BPAI decision, accompanied by a request for extension of time under 37 CFR 1.136 and the appropriate fee.
- (C) File a Notice of Appeal to the Court of Appeals of the Federal Circuit (“CAFC”) within 6 months after action on the Request for Rehearing or Reconsideration, accompanied by a request for extension of time under 37 CFR 1.136 and the appropriate fee.
- (D) File a Notice of Appeal to the U.S. District Court of the District of Columbia (“DDC”) within 5 months after action on the Request for Rehearing or Reconsideration, accompanied by a request for extension of time under 37 CFR 1.136 and the appropriate fee.
- (E) File a Notice of Appeal to the U.S. District Court of the District of Columbia (“DDC”) within 2 months after action on the Request for Rehearing or Reconsideration.

32. Which of the following is true?

- (A) Once the issue fee has become due, provided an original application has not been pending more than three years, the applicant may request and the Office may grant a request for deferral of payment of the issue fee.
- (B) The time period set for the payment of the issue fee is statutory and cannot be extended. However, if payment is not timely made and the delay in making the payment is shown to be unavoidable, upon payment of a fee for delayed payment, it may be accepted as though no abandonment had occurred, but there will be a reduction on the patent term adjustment for the period of abandonment.
- (C) Upon written request, a person citing patents and printed publications to the Office that the person believes has a bearing on the patentability of a particular patent, may request that his or her name remain confidential.
- (D) To obtain benefit of priority based on an earlier filed patent application, an applicant in a later filed continuation application is not required to claim priority under 35 U.S.C. § 120 to an earlier filed application.
- (E) Each of statements (B) and (C) is true.

The following facts pertain to questions 33 and 34.

Applicant Sonny filed a patent application having an effective U.S. filing date of February 15, 2000. The application fully discloses and claims the following:

Claim 1. An apparatus for converting solar energy into electrical energy comprising:

- (i) a metallic parabolic reflector;
- (ii) a steam engine having a boiler located at the focal point of the metallic parabolic reflector; and
- (iii) an electrical generator coupled to the steam engine.

In a non-final Office action dated March 15, 2001, the examiner rejects claim 1 under 35 U.S.C. § 102(d) as anticipated by a patent granted in a foreign country to Applicant Sonny ("Foreign patent"). The Foreign patent was filed February 1, 1999, and was patented and published on January 17, 2000. The examiner's rejection points out that the invention disclosed in the Foreign patent is a glass lens with a steam engine having a boiler at the focal point of the glass lens, and an electrical generator coupled to the steam engine. The rejection states that the examiner takes official notice that it was well known by those of ordinary skill in the art of solar energy devices, prior to Applicant Sonny's invention, to use either a lens or a parabolic reflector to focus solar rays.

33. Sonny informs you that you should not narrow the scope of the claims unless absolutely necessary to overcome the rejection. Which of the following, in reply to the Office action dated March 15, 2001, is best?

- (A) Traverse the rejection arguing that the examiner's use of the Foreign patent is improper because an applicant cannot be barred by a foreign patent issued to the same applicant.
- (B) Amend claim 1 to further include a feature that is disclosed only in the U.S. application, and point out that the newly added feature distinguishes Sonny's invention over the invention in the Foreign patent.
- (C) Traverse the rejection arguing that the examiner does not show why one of ordinary skill in the art of solar energy devices would be motivated to modify the Foreign patent.
- (D) Traverse the rejection arguing that the examiner's rejection under 35 U.S.C. § 102(d) was improper because claim 1 is not anticipated by the Foreign patent.
- (E) Traverse the rejection arguing that it was not well known to use either a lens or a parabolic reflector to focus solar rays, and submit an affidavit under 37 CFR 1.132.

34. Which of the following claims, if fully disclosed and presented in Sonny's U.S. application, provides a proper basis for an objection under 37 CFR 1.75(c)?

- (A) Claim 2. An apparatus as in claim 1, further comprising a voltage regulator coupled to the electrical generator.
- (B) Claim 2. An apparatus as in claim 1, wherein the metallic parabolic reflector is aluminum.
- (C) Claim 2. An apparatus as in claim 1, wherein the steam engine has two cylinders.
- (D) Claim 2. An apparatus as in claim 1, wherein the parabolic reflector is either metallic or plastic.
- (E) Claim 2. An apparatus as in claim 1, further comprising an electronic pressure sensor coupled to the steam engine.

35. Tony, a client, comes to you with regard to a competitor's two published patent applications, A and B, which were published one month ago. Tony shows you several material prior art publications and patents that he discovered for the first time while cleaning out his brother-in-law's attic last week. Assume no Notice of Allowance has been mailed in application A and a Notice of Allowance has been mailed in application B. Tony wants to know if it is too late to submit the information to the USPTO for consideration by the examiner. He also wants to know how it is accomplished, if the applicant needs to be served a copy, whether a fee is required and whether an explanation is needed for each reference. Which of the following is not accurate with respect to proper USPTO procedure?

- (A) The submission by Tony of patents or publications relevant to pending published application A will be permitted without the necessity of paying the processing or petition fee required by 37 CFR 1.17(i) if the patents or publications are submitted within two months of the publication of the competitor's application.
- (B) Each submission must identify the application to which it is directed by application number and include: (1) the appropriate fee set forth in 37 CFR 1.17(p); (2) a list of the patents or publications submitted for consideration by the Office, including the date of publication of each patent or publication; (3) a copy of each listed patent or publication in written form or at least the pertinent portions; and (4) an English language translation of all the necessary and pertinent parts of any non-English language patent or publication in written form relied upon.
- (C) The submissions by Tony of patents or publications relevant to both of the pending published applications A and B need not be served upon the applicant.
- (D) The submissions by Tony of patents or publications relevant to the pending published applications A and B shall not include any explanation of the patents or publications, or any other information.
- (E) The submission by Tony of patents or publications relevant to pending published application B will be permitted only if accompanied by the processing fee as set forth in 37 CFR 1.17(i).

36. Upon examination of your client's patent application, the patent examiner is considering whether and what rejections to apply to the claims. One or more of the limitations in the claims is indefinite or lacks supporting disclosure. The examiner may not properly take which of the following actions or inactions?

- (A) If the claim is subject to plural interpretations due to a limitation being indefinite, the examiner may disregard any possibility of multiple interpretations.
- (B) If a claim is subject to more than one interpretation due to a limitation being indefinite, at least one of which would render the claim unpatentable over the prior art, the examiner should reject the claim as indefinite under 35 U.S.C. § 112, second paragraph, and should reject the claim over the prior art based on the interpretation of the claim that renders the prior art applicable.
- (C) If no reasonably definite meaning can be ascribed to certain claim language, the examiner should reject the claim as indefinite under 35 U.S.C. § 112, second paragraph, and not reject the claim as obvious.
- (D) When evaluating claims for obviousness under 35 U.S.C. § 103, all the limitations of the claims, including new matter lacking supporting disclosure in the originally filed specification, must be considered and given weight.
- (E) (C) and (D).

37. Which of the following is true?

- (A) A claim to a process omitting a step in a disclosed process, where the step is disclosed in the specification to be essential to the invention, may not be properly rejected under 35 U.S.C. § 112, first paragraph, for lack of enablement where the specification provides an enabling disclosure only for the process which includes the essential step.
- (B) Failure to disclose the best mode must rise to the level of active concealment or grossly inequitable conduct in order to support a rejection under 35 U.S.C. § 112, first paragraph.
- (C) A claim failing to interrelate essential elements of the invention, as defined by the applicant in the specification, where the interrelation is critical to the invention may be properly rejected under 35 U.S.C. § 112, second paragraph, for failure to properly point out and distinctly claim the invention.
- (D) Where the best mode contemplated by the inventor at the time of filing the application is not disclosed, a proposed amendment adding a specific mode of practicing the invention would not be new matter.
- (E) The best mode requirement is the same as the enablement requirement of the first paragraph of 35 U.S.C. § 112.

38. Your clients, Able and Baker, filed a patent application. In accordance with proper USPTO practice and procedure, in which of the following instances, absent additional facts, is the reference or event either prior art or an act that may not be properly applied to reject claims in your client's application?

- (A) The patent application was filed on Tuesday, June 26, 2001 in the USPTO. The reference is an article in a trade magazine published on November 10, 2000. Able, Baker and McGeiver are the authors of the article. The article fully discloses the claimed invention and how to make and use it.
- (B) The patent application was filed on Monday, June 25, 2001 in the USPTO. Able and Baker placed the invention on sale in the United States on Monday, June 26, 2000. The public came into possession and understands the invention the day it is placed on sale. Your clients have disclosed this information when they filed the application.
- (C) The patent application was filed on Monday, June 25, 2001, in the USPTO. McGeiver, a friend of Baker, publicly used the invention in Hawaii on April 15, 2000. The public use was not experimental and was without Baker's knowledge or consent. The public came into possession of the invention the day it was used by McGeiver.
- (D) The patent application was filed on Monday, June 25, 2001, in the USPTO. The invention became known to the public in the United States in April 2000 as a result of disclosure on the Internet by Wilson, a party unknown to Able and Baker. The invention was not placed on sale or in public use prior to the filing date of the application.
- (E) More than one year prior to the filing in the USPTO of a patent application on Monday, June 25, 2001, in the USPTO, the invention, a machine, was used secretly by John, another inventor, to make a product. The details of the invention are ascertainable by inspection or analysis of the product made by John that was sold and publicly displayed.

39. A grant of small entity status entitles an applicant to which of the following?

- (A) Applicant will receive an accelerated examination by having the application advanced out of order.
- (B) Applicant can use a certificate of mailing under 37 CFR 1.8 to obtain a U.S. filing date that is earlier than the actual USPTO receipt date of the application.
- (C) Applicant will obtain a refund of all fees paid to the USPTO where applicant demonstrates: (i) a changed purpose for which the fees were paid, (ii) the fees were not paid by mistake, and (iii) the fees were not paid in excess of the amount required.
- (D) Applicant can pay a fee to file a request for continued examination pursuant to 37 CFR 1.114 that is less than the fee paid by other than a small entity.
- (E) None of the above.

40. Which of the following is not in accordance with proper USPTO practice and procedure?

- (A) Conversion of a provisional application to a nonprovisional application will result in the term of any patent to issue from the application being measured from at least the filing date of the provisional application.
- (B) Conversion of a provisional application to a nonprovisional application cannot adversely impact on the term of any patent to issue from the application.
- (C) An applicant having filed a provisional application can avoid any adverse patent term impact resulting from converting the provisional application to a nonprovisional application by instead filing a nonprovisional application claiming the benefit of the provisional application under 35 U.S.C. § 119(e).
- (D) An applicant filing nonprovisional application claiming the benefit under 35 U.S.C. § 119(e) and 37 CFR 1.78 of the earlier provisional application, and not requesting conversion of the provisional to the nonprovisional application can avoid the fee required to convert a provisional application to a nonprovisional application, as well as any adverse patent term effect that would result from a conversion.
- (E) The twelve month period of pendency of a provisional application extends to the next secular or business day which is not a Saturday, Sunday, or Federal holiday within the District or Columbia if the day that is twelve months after the filing date of the provisional application under 35 U.S.C. § 111(b) and 37 CFR 1.53(c) falls on a Saturday, Sunday, or a Federal holiday in the District of Columbia.

41. Mark Twine obtains a patent directed to a machine for manufacturing string. The patent contains a single claim (Claim 1) which recites six claim elements. The entire interest in Twine's patent is assigned to the S. Clemens String Co., and Twine is available and willing to cooperate with S. Clemens String Co. to file a reissue application. A subsequent reissue application includes Claim 2, which is similar to original Claim 1. However, one of the elements recited in Claim 2 is broader than its counterpart element in the original claim. The remaining five elements are narrower than their respective counterpart elements in the original patent claim. Which of the following scenarios accords with USPTO proper practice and procedure?

- (A) The S. Clemens String Co. files the reissue application more than 2 years after the issue date of the original patent application.
- (B) The S. Clemens String Co. files the reissue application less than 2 years after the issue date of the original patent but more than 2 years after original application filing date.
- (C) Mark Twine files the reissue application less than 2 years after the issue date of the original patent but more than 2 years after original application filing date.
- (D) Mark Twine files the reissue application more than 2 years after the issue date of the original patent.
- (E) Mark Twine and the S. Clemens String Co. jointly file the reissue application more than 2 years after the issue date of the original patent.

42. A maintenance fee in the correct amount is received by the USPTO in September 2001, prior to the due date. The maintenance fee payment includes identification of a U.S. patent number. In accordance with proper USPTO rules and procedure, in which of the following situations may the USPTO return the maintenance fee payment?

- (A) The maintenance fee payment is submitted by the patentee's grandmother, without authorization by the patentee, and includes identification of the U.S. application number for the patent.
- (B) The maintenance fee payment is submitted by the attorney of record in the application, without authorization by the patentee, and includes identification of the U.S. application number for the patent.
- (C) The maintenance fee payment is submitted by the attorney of record in the application, with authorization by the patentee, and does not include identification of the U.S. application number for the patent.
- (D) (A) and (B).
- (E) None of the above.

43. A claim in your client's patent application has been rejected as being anticipated by a prior art reference. In which of the following instances is the claim not necessarily anticipated?

- (A) The prior art is a U.S. patent issued five years before the effective date of your client's application. In your client's application, the claim is a generic claim. The prior art clearly discloses a species falling within the claimed genus in your client's application.
- (B) The prior art is a U.S. patent issued two years before the effective date of your client's application. In your client's application, claim 4 is directed to a species. The prior art discloses forty-six species. The species claimed in claim 4 is clearly disclosed by name in the prior art. The remaining forty-five species disclosed in the prior art do not anticipate or render obvious any subject matter claimed in your client's application.
- (C) The prior art is a U.S. patent issued two years before the effective date of your client's application. In your client's application, claim 1 is directed to "composition comprising copper oxygen, and 10 to 20 mg of sulfur." The prior art discloses a composition "comprising copper, oxygen and 15 mg. of sulfur."
- (D) The prior art is a U.S. patent issued two years before the effective date of your client's application. Claim 1 in your client's application is drawn to a composition of gases, and contains a narrow range of the amount of oxygen. The prior art discloses composition of the same gases, and a broad range of the amount of oxygen that is inclusive of the claimed narrow range, but does not disclose specific examples falling within the claimed narrow range. Your client not only discloses a different utility for the claimed invention, but also unexpected results achieved within the narrow range.
- (E) (A), (B), (C) and (D).

44. A condition for patentability is that an inventor is entitled to a patent unless he has abandoned the invention. Your client has engaged in conduct or omissions that may or may not be construed as abandonment of her invention. In which of the following situations would it be proper for a patent examiner to conclude, in an *ex parte* proceeding, that an inventor has abandoned the invention?

- (A) From the inventor's inaction, following conception, to do anything over a period of time to develop or patent his or her invention, the inventor's ridicule of another person's attempts to develop that invention, and the inventor's active show of interest in promoting and developing the invention only after successful marketing by another of a device embodying that invention.
- (B) When acts of another can be imputed to the inventor as an intent to abandon the invention.
- (C) From the inventor's delay alone in filing a first patent application for the invention.
- (D) From an inventor's delay in reapplying for patent after abandonment of a previous patent application.
- (E) From the inventor's act of disclosing but not claiming the subject matter in a previously issued patent, even though the inventor claims the subject matter in an another patent application that is filed within one year after the patent issued.

45. You are prosecuting a patent application wherein an Office Action has been issued rejecting the claims as being obvious over the prior art and objecting to the drawings as failing to illustrate an item that is fully described in the specification and included in a dependent claim. The Examiner has required an amendment to Figure 1 to illustrate the item. In preparing a reply to the Office Action, you identify several errors in Figure 2 that also should be corrected. Assuming that you make a small amendment to the claims and develop persuasive arguments to overcome the obviousness rejection, and that the Examiner will not object to your desired changes to Figure 2, which of the following actions is likely to lead to the most favorable result?

- (A) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. Submit a separate cover letter for replacement Figures 1 and 2 that incorporate the amendments to the drawings.
- (B) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. In the Remarks portion of the reply, explain the proposed drawing changes and attach copies of Figures 1 and 2 with the changes marked in red for the Examiner's review and approval.
- (C) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. In a separate paper, explain the proposed drawing changes and attach copies of Figures 1 and 2 with the changes marked in red for the Examiner's review and approval.
- (D) Options (A), (B) and (C) are equally likely to lead to the most favorable result.
- (E) Options (B) and (C) are equally likely to lead to the most favorable result.

46. According to USPTO rules and procedure, which of the following can be overcome by an affidavit under 37 CFR 1.131?

- (A) A rejection properly based on statutory double patenting.
- (B) A rejection properly made under 35 U.S.C. § 102(d) based on a foreign patent granted in a non-WTO country.
- (C) A rejection properly made under 35 U.S.C. § 102(a) based on a journal article dated one month prior to the effective filing date of the U.S. patent application. Applicant has clearly admitted on the record during the prosecution of the application that subject matter in the journal article relied on by the examiner is prior art.
- (D) A rejection properly made under 35 U.S.C. § 102(b) based on a U.S. patent that issued 18 months before the effective filing date of the application. The patent discloses, but does not claim, the invention.
- (E) None of the above.

47. Claims in your client's patent application have been rejected as unpatentable over prior art. In accordance with proper USPTO practice and procedure, which, if any, of the following statements is true?

- (A) The prior art is a U.S. patent issued five years before the effective date of your client's application. The claims are properly rejected under 35 U.S.C. § 102(b) of the disclosure in the patent that anticipates the claimed invention. Evidence of secondary considerations, such as unexpected results or commercial success, is relevant to the rejection and thus can overcome the rejection.
- (B) The prior art is a U.S. patent issued five years before the effective date of your client's application. The claims are properly rejected under 35 U.S.C. § 102(b) over the disclosure in the patent that anticipates the claimed invention. The rejection can be overcome by arguing that the alleged anticipatory prior art is "nonanalogous art."
- (C) The prior art is a U.S. patent issued five years before the effective date of your client's application. The claims are properly rejected under 35 U.S.C. § 102(b) over the disclosure in the patent that anticipates the claimed invention. The rejection can be overcome by arguing that the alleged anticipatory prior art teaches away from the invention.
- (D) The prior art is a U.S. patent issued five years before the effective date of your client's application. The claims are properly rejected under 35 U.S.C. § 102(b) over the disclosure in the patent that anticipates the claimed invention. The rejection can be overcome by arguing that the alleged anticipatory prior art is not recognized as solving the problem solved by the claimed invention.
- (E) None of the above.

48. Your longstanding client, Acme Chemical, comes to you for advice concerning a competitor's patent that Acme fears might cover Acme's key commercial product. Acme informs you that it began selling its product approximately eleven months before the competitor filed its patent application, and that a complete description of the product and how to make it was published in a trade magazine approximately ten months before the competitor's December 8, 1999 application filing date. Acme asks you to recommend options short of litigation that might be available to challenge validity of the patent. Acme also asks that in making your recommendation you take into account that Acme will not challenge the patent's validity unless it can be actively involved in all phases of the proceeding, even if that involvement will increase Acme's costs. Which of the following is the most reasonable advice to Acme?

- (A) You suggest that Acme request *ex parte* reexamination on the basis of the trade magazine publication and that Acme file a reply to any statement by the patent owner concerning any new question of patentability.
- (B) You suggest that Acme request *ex parte* reexamination on the basis of Acme's prior sales and the trade magazine publication.
- (C) You suggest that Acme request *inter partes* reexamination on the basis of the trade magazine publication only.
- (D) You suggest that Acme request *inter partes* reexamination on the basis of Acme's prior sales and the trade magazine publication.
- (E) You suggest that Acme inform the competitor in writing of the prior sales and trade magazine publication to force the competitor to inform the USPTO of this information and to force the competitor to initiate a reexamination of its own patent.

49. Which of the following statements accords with proper USPTO practice and procedure?

- (A) If a design patent was granted 3 years and 9 months ago, a maintenance fee paid today must include a surcharge because the payment is being made during the grace period.
- (B) If a design patent was granted 3 years and 9 months ago, and payment of the maintenance fee and surcharge is not paid through the day of the 4th anniversary of the grant for the first maintenance fee, the patent will expire.
- (C) If a plant patent was granted 7 years and 3 months ago, a maintenance fee must be paid, but a surcharge is not required, because the payment is not being made during the grace period.
- (D) If a utility patent was granted 7 years and 9 months ago, the first maintenance fee was timely paid, and the 8th anniversary of the patent grant falls on a Saturday, then the 2nd maintenance fee may be paid without surcharge on the next succeeding day which is not a Sunday or Federal holiday.
- (E) If a reissue application issues as a reissue patent exactly two years after the grant of the original patent, the maintenance fee for the 4th anniversary of the patent grant must be paid within eighteen months of the reissuance of the patent to avoid a surcharge.

50. On February 15, 2000, Debbie conceived a new, useful and nonobvious improvement in saddles for horses. Debbie spent the next four months working regularly on the idea and she built a prototype that implemented the concept on June 17, 2000. The prototype worked perfectly for its intended purpose. The next day, Debbie visited a patent attorney, Ginny, and asked her to prepare a patent application on Debbie's behalf. Ginny explained that her workload would prevent her from working on the application for at least four months. Ginny therefore declined representation of Debbie and gave her the names of a number of other qualified patent practitioners. Debbie, however, did not contact any of the individuals recommended by Ginny. Debbie visited Ginny again on December 1, 2000. At that time Ginny agreed to represent Debbie. A patent application was filed in the Patent Office on December 11, 2000.

On May 15, 2000, Billie conceived an idea substantively identical to Debbie's. Billie immediately prepared a detailed technical description including drawings and visited a patent attorney. Billie filed a patent application on June 14, 2000. Later, on July 9, 2000, Billie built a prototype that implemented the concept and had fully and successfully tested it by August 11, 2000.

With regard to a priority contest between Debbie and Billie, which of the following statements is most correct?

- (A) Debbie will be awarded priority only if she can establish diligence for the entire time between May 14, 2000 and her actual reduction to practice in June 2000, and can establish that she did not suppress, abandon or conceal the invention.
- (B) Debbie will be awarded priority only if she can establish diligence for the entire time between her conception in February 2000 and actual reduction to practice in June 2000, and can establish that she did not suppress, abandon or conceal the invention.
- (C) Debbie will be awarded priority if she can establish diligence for the entire time between May 14, 2000 and her patent filing in December 2000, and can establish that she did not suppress, abandon or conceal the invention.
- (D) To encourage prompt disclosure of inventions to the public, priority is always awarded to the first to file an application, in this case Billie.
- (E) Billie must be awarded priority because his patent application established a constructive reduction to practice prior to Debbie's actual reduction to practice, even if Debbie was diligent in reducing her invention to practice.

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**UNITED STATES PATENT AND TRADEMARK OFFICE
REGISTRATION EXAMINATION
FOR PATENT ATTORNEYS AND AGENTS**

APRIL 17, 2002

Morning Session (50 Points)

Time: 3 Hours

DIRECTIONS

This session of the examination is an open book examination. You may use books, notes, or other written materials that you believe will be of help to you *except* you may not use prior registration examination questions and/or answers. Books, notes or other written materials containing prior registration examination questions and/or answers *cannot* be brought into or used in the room where this examination is being administered. If you have such materials, you must give them to the test administrator before this session of the examination begins.

All questions must be answered in SECTION 1 of the Answer Sheet which is provided to you by the test administrator. You must use a No. 2 pencil (or softer) lead pencil to record your answers on the Answer Sheet. Darken *completely* the circle corresponding to your answer. You must keep your mark within the circle. Erase *completely* all marks except your answer. Stray marks may be counted as answers. No points will be awarded for incorrect answers or unanswered questions. Questions answered by darkening more than one circle will be considered as being incorrectly answered.

This session of the examination consists of fifty (50) multiple choice questions, each worth one (1) point. Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the *Official Gazette*, or a notice in the *Federal Register*. Each question has only one most correct answer. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer that will be accepted. Where two or more choices are correct, the most correct answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement that would make the statement *true*. If it is determined by the USPTO that there is more than one most correct answer to a question, each most correct answer will be accepted, but only one point will be given for the question. The presence of multiple most correct answers does not, in itself, render the question ambiguous. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

You may write anywhere on the examination booklet. However, do not remove any pages from the booklet. Only answers recorded in SECTION 1 of your Answer Sheet will be graded. YOUR COMBINED SCORE OF BOTH THE MORNING AND AFTERNOON SESSIONS MUST BE AT LEAST 70 POINTS TO PASS THE REGISTRATION EXAMINATION.

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO

This examination addresses statutes and rules that have been changed as a result of the enactment of the American Inventors Protection Act of 1999, Pub. L. No. 106-113 (“Act”). The 8th Edition of the Manual of Patent Examining Procedure should be used. The examination will apply rules that are in effect as April 1, 2002. The rule changes are posted under the heading “Recent Patent-Related Notices” on the USPTO web site (www.uspto.gov/web/offices/pac/dapp/ogsheet.html). A group of rule changes, published in 67 Federal Regulations 520 (January 4, 2002) under the name “Revision of the Time Limit for National Stage Commencement in the United States for Patent Cooperation Treaty Applications,” will be in effect on April 1, 2002. This rule change is also available at the USPTO web site cited above under the heading “Recent Patent Related Notices.”

1. Which of the following is the best way to recite a claim limitation so that it will be interpreted by the examiner in accordance with 35 U.S.C. § 112, paragraph 6?

- (A) dot matrix printer for printing indicia on a first surface of a label.
- (B) dot matrix printer means coupled to a computer.
- (C) means for printing indicia on a first surface of a label.
- (D) printer station for printing indicia on a first surface of a label.
- (E) All of the above.

2. Registered practitioner Pete received on September 13, 2001 a notice of allowance dated September 10, 2001 in a utility application filed December 5, 2000. The client for whom the application is being prosecuted has repeatedly stressed to counsel how valuable the invention is, and that it will remain so throughout the entire life of any patent that should issue. Pete is determined to take no chances with this application, particularly since patent term adjustment has been accumulated and the lack of any action or inaction by applicant that would cause loss of patent term adjustment. Thus, Pete is ready to pay the issue fee on the very day the Notice of Issue Fee Due is received. Before payment of the issue fee, the client faxes Pete information identifies prior art first cited on September 3, 2001 by the foreign office examining a foreign counterpart application. This prior art was not previously cited by another foreign patent office. The invention had been filed with a second foreign office that mailed the same prior art at a later date than the first foreign office. Also, this prior art was previously unknown to the client. The client is very desirous of having this cited art made of record in the file. Which of the following alternatives would best achieve the client's objectives of maximizing patent term and having the foreign cited prior art considered by the USPTO?

- (A) Pete should file a petition for withdrawal from issue of the allowed application for consideration of a request for continued examination based on an information disclosure statement (IDS) and include in the petition an offer to file the request and IDS upon the petition being granted.
- (B) As it is still within three months from the date cited by the foreign office, Pete can submit the prior art in the allowed application up to the last day of the three month period making any required statements and fee payments.
- (C) Pete should submit an IDS citing the prior art in the allowed application within 30 days of the September 3, 2001 mailing by the foreign office with any appropriate fees and statements.
- (D) If, Pete could use the date of mailing by the second foreign office to file the IDS in the allowed application within three months of the communication of prior art by the second foreign office thereby allowing the client extra time to evaluate the allowed claims and still have the IDS entered.
- (E) (B) and (D).

3. Belle Bordeaux files a French patent application for a rejuvenating lotion in the French Patent Office on January 10, 2000. On January 10, 2001, she files a PCT Chapter I Request in the EPO Receiving Office, in which she requests that the European Patent Office act as the International Searching Authority. In her PCT application, Bordeaux claims priority to the French application, and indicates the U.S. as a designated state. Bordeaux makes an appointment to meet with you on June 8, 2001, to discuss filing a patent application in the USPTO on the rejuvenating lotion, in which she wants to claim priority not only to the PCT application, but also the French application. In preparing for your meeting with Bordeaux, you realize that she has several options here, and so you prepare an analysis of the various options, which are detailed below. Before entering the U.S. national stage, Bordeaux wishes to have an official international preliminary search report that indicates claims having the best chance of being patentable. Which of the following will achieve Bordeaux's objective in accordance with proper USPTO practice and procedure?

- (A) Bordeaux should enter the national stage by filing an application under 35 U.S.C. § 371 on or before September 10, 2001.
- (B) Bordeaux should file an application under 35 U.S.C. § 111(a) on or before September 10, 2001, claiming priority under 35 U.S.C. § 120 to the PCT application, and claiming priority under 35 U.S.C. § 119 to the French application.
- (C) Bordeaux should first file a PCT Chapter II Demand in the USPTO on or before August 10, 2001, and then file a provisional application under 35 U.S.C. § 111 on or before September 4, 2001.
- (D) Bordeaux should first file a PCT Chapter II Demand in the USPTO on or before August 10, 2001, and then enter the national stage by filing an application under 35 U.S.C. § 371 on or before July 10, 2002.
- (E) All of the above.

4. The specification in your client's patent application has been objected to for lack of enablement. To overcome this objection, your client may do any of the following except:

- (A) traverse the objection and specifically argue how the specification is enabling.
- (B) traverse the objection and submit an additional drawing to make the specification enabling.
- (C) file a continuation-in-part application that has an enabling specification.
- (D) traverse the objection and file an amendment without adding new matter in an attempt to show enablement.
- (E) traverse the objection and refer to prior art cited in the specification that would demonstrate that the specification is enabling to one of ordinary skill.

5. Registered practitioner Joe files a design patent application under 37 CFR 1.53(b) having one claim on May 6, 1999. The USPTO sends Joe a notice of allowance dated November 10, 2000. Joe pays the issue fee on November 15, 2000. On November 23, 2000, Joe learns about a publication (the “Smith Reference”) which he knows to be material to patentability of the claim, but which was not considered by the examiner during prosecution of the application. Joe prepares an information disclosure statement that complies with the provisions of 37 CFR 1.98, listing the Smith reference. Which of the following actions, if taken by Joe on November 24, 2000, will result in a request for continued examination of the application being granted in accordance with USPTO rules and procedure?

- (A) Filing a request for continued examination of the application with the information disclosure statement listing the Smith Reference, without the fee set forth in 37 CFR 1.17(e).
- (B) Filing a request for continued examination of the application with the information disclosure statement listing the Smith Reference, and the fee set forth in 37 CFR 1.17(e).
- (C) Filing a request for continued examination of the application with the information disclosure statement listing the Smith Reference, the fee set forth in 37 CFR 1.17(e), and a petition under 37 CFR 1.313 with the fee set forth in 37 CFR 1.17(h).
- (D) (B) or (C) above.
- (E) None of the above.

6. Applicant Jones filed a request for a first continued prosecution application (CPA) on December 29, 2000 in a utility application that was filed on April 28, 2000. Jones received a final Office action mailed on June 28, 2001. In response, Jones filed an amendment amending the claims in the first CPA. Jones received an advisory action on September 27, 2001 stating that the proposed amendment to the first CPA would not be entered because it raises new issues that would require further consideration. Additionally, the proposed amendment did not meet the requirements for a complete reply under 37 CFR 1.111. On December 28, 2001, Jones filed a petition for a 3-month extension of time with appropriate petition fee, a request for a second continued prosecution application, a request for suspension of action, and appropriate processing fee for the request for suspension of action. No application filing fee was filed with the request for the second CPA. Which of the following would be a proper communication mailed by the Office based on Jones’ actions?

- (A) A Notice of Allowability.
- (B) A Notice to File Missing Parts.
- (C) A first Office action on the merits.
- (D) A notice of improper Request for Continued Examination (RCE) and a notice of abandonment.
- (E) A letter granting the suspension of action.

7. Evidence of unexpected results is relied upon to overcome a *prima facie* case of obviousness. Which of the following is incorrect?

- (A) The evidence must compare the claimed invention to the closest prior art.
- (B) The evidence must be commensurate in scope with the claims.
- (C) Data relied upon to show unexpected results need not cover the full range of the claims if one of ordinary skill in the art could ascertain a trend in the data that would allow that person to reasonably extend the probative value of the data to the full scope of the claims.
- (D) Unexpected results can be shown by factual evidence or, if no factual evidence is available to the applicant, by sound argument by the applicant's agent or attorney.
- (E) The evidence need not be in an affidavit or declaration under 37 CFR 1.132 if the evidence is presented in the specification of an application to which the applicant has attested.

8. On March 20, 2000, Patsy Practitioner filed a patent application on widget Y for the ABC Company based on a patent application filed in Germany for which benefit of priority was claimed. The sole inventor of widget Y is Clark. On September 13, 2000, Patsy received a first Office action on the merits rejecting all the claims of widget Y under 35 U.S.C. § 103(a) as being obvious over Jones in view of Smith. When reviewing the Jones reference, Patsy notices that the assignee is the ABC Company, that the Jones patent application was filed on April 3, 1999, and that the Jones patent was granted on January 24, 2000. Jones does not claim the same patentable invention as Clark's patent application on widget Y. Patsy wants to overcome the rejection without amending the claims. Which of the following replies independently of the other replies would not be in accordance with proper USPTO practice and procedures?

- (A) A reply traversing the rejection by correctly arguing that Jones in view of Smith fails to teach widget Y as claimed, and specifically and correctly pointing out claimed elements that the combination lacks.
- (B) A reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.131 that antedates the Jones reference.
- (C) A reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.132 containing evidence of criticality or unexpected results.
- (D) A reply traversing the rejection by stating that the invention of widget Y and the Jones patent were commonly owned by ABC Company at the time of the invention of widget Y, and therefore, Jones is disqualified as a reference via 35 U.S.C. § 103(c).
- (E) A reply traversing the rejection by perfecting a claim of priority to Clark's German application, filed March 21, 1999, disclosing widget Y under 35 U.S.C. § 119(a)-(d).

9. Which of the following is not in accord with proper USPTO practice and procedure?

- (A) A written description as filed in a nonprovisional patent application is presumed adequate under 35 U.S.C. § 112 in the absence of evidence or reasoning to the contrary.
- (B) An examiner may show that a written description as filed in a nonprovisional patent application is not adequate by presenting a preponderance of evidence why a person of ordinary skill in the art would not recognize in the applicant's disclosure a description of the invention defined by the claims.
- (C) A general allegation of "unpredictability in the art" is sufficient to support a rejection of a claim for lack of an adequate written description.
- (D) When filing an amendment, a practitioner should show support in the original disclosure for new or amended claims.
- (E) When there is substantial variation within a genus, an applicant must describe a sufficient variety of species to reflect the variation within the genus.

10. A nonprovisional patent application was filed by a registered practitioner in the USPTO with a declaration under 37 CFR 1.63. The declaration named the individuals known to the practitioner to be the inventors of the claimed invention, but the declaration was not signed by any of the individuals. Within two weeks of the filing the application, the practitioner discovered that there is one more individual, who was not named on the unexecuted declaration, who is an inventor in the claimed invention. Which of the following actions, if undertaken by the practitioner, would properly correct the inventorship in the patent application?

- (A) File a new declaration under 37 CFR 1.63, identifying all the inventors including the newly discovered inventor, which is signed by each of the inventors.
- (B) File only a letter requesting that the inventorship be changed to add the newly discovered inventor.
- (C) File a petition under 37 CFR 1.48(a) for correction of inventorship. The petition contains only a request to add the newly discovered inventor. File with the petition(1) a new oath or declaration identifying and signed by only the newly discovered inventor, and (2) the petition fee set forth in 37 CFR 1.17(j).
- (D) File a petition under 37 CFR 1.48(a) for correction of inventorship consisting only of a request to add the newly discovered inventor, a statement by the newly discovered inventor that the error occurred without deceptive intention on his part and a petition fee set forth in 37 CFR 1.17(i).
- (E) All of the above.

Questions 11 and 12 are based on the following factual background. Consider questions 11 and 12 independently of each other.

Applicant files a patent application in Japan on February 28, 1996. Applicant files a PCT international application designating the United States on February 27, 1997, based on the Japanese application. The international application is published in English on August 28, 1997. The international application enters the national stage in the United States on August 28, 1998. The USPTO publishes the application on June 7, 2001 at the request of the applicant. The application issues as a United States patent on December 4, 2001.

11. When examining an application filed on or after November 29, 2000 or any application that has been voluntarily published, what is its earliest possible prior art date, for the June 7th U.S. published application in view of 35 U.S.C. § 102(e) as amended by the American Inventors Protection Act of 1999?

- (A) February 28, 1996.
- (B) February 27, 1997.
- (C) August 28, 1997.
- (D) August 28, 1998.
- (E) June 7, 2001.

12. For the United States patent, what is the patent's earliest date, for prior art purposes as a patent, in view of the amendment to 35 U.S.C. § 102(e) by the American Inventors Protection Act of 1999?

- (A) February 28, 1996.
- (B) February 27, 1997.
- (C) August 28, 1997.
- (D) August 28, 1998.
- (E) December 4, 2001.

13. Which of the following could never qualify as a small entity under 37 CFR 1.27 for certain fee reductions?

- (A) A nonprofit organization.
- (B) A two-person business concern with a \$4,000,000 income.
- (C) A federal government agency.
- (D) A university in Canada.
- (E) A person.

14. Which of the following is not in accord with proper USPTO practice and procedure regarding *ex parte* reexaminations filed in March 2001?

- (A) In every instance of an interview with an examiner in an *ex parte* reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner.
- (B) Third party requesters have the option of attending interviews, but their presence is not mandatory.
- (C) A patent owner's reply to an outstanding Office action after the interview does not remove the necessity for filing the written statement of the reasons presented at the interview as warranting favorable action.
- (D) The written statement must be filed as a separate part of a reply to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.
- (E) An interview does not remove the necessity for reply to Office actions as specified in 37 CFR 1.111.

15. Able is a registered solo practitioner. Ben asks Able to prepare and prosecute an application for a utility patent. As part of the application, Able prepares a declaration and power of attorney, which Ben reviews and signs. Able files the application, the declaration, and power of attorney with the USPTO. Able quickly recognizes that help is necessary and contacts another registered practitioner, Chris, who often assists Able in such instances. Able, with Ben's consent, sends a proper associate power of attorney to the Office for Ben's application and directs that correspondence be sent to Chris. The examiner in the application takes up the application in the regular course of examination and sends out a rejection in an Office action. Chris sends a copy of the action to Ben to obtain Ben's comments on a proposed response. Unfortunately, after the first Office action, Able becomes terminally ill and dies. Ben does not know what to do, so Ben calls the examiner at the number on the Office action and explains that A died and Ben is worried how to proceed. Which of the following statement(s) is/are true?

- (A) Chris should inform Ben that the Office will not correspond with both the registered representative and the applicant and therefore, Ben should not have any further contact with the Office and let Chris send in a proper response.
- (B) Ben should send in a new power of attorney for anyone Ben intends to represent him before the Office.
- (C) Ben should execute and send to the USPTO a new power of attorney for any registered patent practitioner that Ben intends to have represent him before the Office.
- (D) (B) and (C).
- (E) None of the above.

16. Jill, a registered patent agent, receives a Notice of Allowance from the USPTO with a mail date of November 13, 2001, regarding a utility patent application for an improved garden hose which she had filed on behalf of one of her small entity clients. The Notice of Allowance specifies a sum that must be paid within three months of the mailing date to avoid abandonment. The sum specified includes both the issue fee and the publication fee. As a result of a small fire in her office building, Jill is unable to resubmit her files until the last day of the three month period. Jill mails a letter to the USPTO on February 13, 2002 using the U.S. Postal Service. Jill does not employ the procedures of 37 CFR 1.8 or 1.10 to mail the letter. The letter is received in the USPTO on February 15, 2002. The letter correctly identifies the application. The letter authorizes the USPTO to charge the proper issue fee for a small entity to her deposit account. The account has been identified in a previously filed authorization to charge fees. At the time the letter was filed in the USPTO, the account had a balance of \$1000.00 in funds. Nothing in the letter authorized payment of the publication fee, no petition for an extension of time was filed, and an Office-provided issue fee transmittal form was not filed. No postal emergency was involved in filing the letter. Which of the following statements accords with proper USPTO practice and procedure?

- (A) The application will become abandoned because Jill did not authorize payment of the publication fee.
- (B) The application will not become abandoned because the authorization to charge fees operates as a request to charge the correct fees to any deposit account identified in a previously filed authorization to charge fees.
- (C) The application will become abandoned because Jill's letter did not include a petition for an extension of time accompanied by the proper fee.
- (D) The application will become abandoned because a completed Office-provided issue fee transmittal form, PTOL-85B, did not accompany Jill's letter.
- (E) The application will become abandoned because Jill's letter was not timely filed in the USPTO and it was not mailed in accordance with the provisions of 37 CFR 1.8 or 1.10.

17. Which one of the following applications is eligible for Patent Term Adjustment under the Patent Term Guarantee Act of 1999?

- (A) A plant application filed June 8, 1995.
- (B) A utility application filed June 8, 1995.
- (C) A design application filed May 29, 2000.
- (D) A continued prosecution application (CPA) filed on June 6, 2001 where the CPA is based upon a plant application originally filed on February 2, 2000.
- (E) A utility application originally filed on February 2, 2000 when a request for continued examination (RCE) was filed on June 6, 2001.

18. To satisfy the written description requirement of the first paragraph of 35 U.S.C. § 112, an applicant must show possession of the invention. An applicant's lack of possession of the invention may be evidenced by:

- (A) Describing an actual reduction to practice of the claimed invention.
- (B) Describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.
- (C) Requiring an essential feature in the original claims, where the feature is not described in the specification or the claims, and is not conventional in the art or known to one of ordinary skill in the art.
- (D) Amending a claim to add a limitation that is supported in the specification through implicit or inherent disclosure.
- (E) Amending a claim to correct an obvious error by the appropriate correction.

19. On June 9, 2000, you file two complete patent applications on behalf of your client, ABC Inc. The subject matter of the patent applications relates to a new automotive body design. One of the applications is filed as a utility application (A#1), and other is filed as a design application (A#2). Prosecution of each application moves forward independently of each other, and you receive final office actions in each application rejecting the respective claim(s) in each application. Your client, in consultation with you, decides that she would rather pursue prosecution in each case rather than appeal the final rejections. Which of following options is available to you under the USPTO rules and procedures ?

- (A) File a request for continuing examination (RCE) for both A#1 and A#2.
- (B) File a request for continuing examination (RCE) for A#1 and a continuing prosecution application (CPA) for A#2.
- (C) File a request for continuing examination (RCE) for A#2 but not A#1.
- (D) File a continuing prosecution application (CPA) for both A#1 and A#2.
- (E) File a continuing prosecution application (CPA) for A#1 but not A#2.

20. J. Q. Practitioner represents the IMAKECOPY Corp., which is an importer of widgets into the USA. At the request of his client, J. Q. Practitioner is reviewing the prosecution history of a published patent application filed under 35 U.S.C. § 111, that contains process claims for making widgets and other claims directed to the widget products. The application lists Rob M. Blind as the inventor and Wesue Corp. as the assignee. Rob M. Blind is an employee of the Wesue Corp. which is a competitor of the IMAKECOPY Corp. The prosecution history of the published patent application contains a restriction requirement made by the examiner followed by an election of the process claims by the applicant, and cancellation of the non-elected product claims. No related patent applications are referenced in the published patent application or its prosecution history. A search of public USPTO databases indicates no divisional patent application has been published or issued as a patent. J. Q. Practitioner wants to obtain more information concerning the cancelled product claims. Which of the following statements is true?

- (A) J. Q. Practitioner cannot obtain other information because no information about pending unpublished applications is available under 35 U.S.C. § 122, except for previously filed applications.
- (B) J. Q. Practitioner may obtain a copy of the originally filed application and a copy of all unpublished divisional applications containing the non-elected product claims.
- (C) J. Q. Practitioner may obtain a copy of all unpublished applications including their prosecution histories for any patent application containing the non-elected product claims.
- (D) J. Q. Practitioner may file a written request for the File Information Unit (FIU) to ascertain if there are any earlier or subsequently filed applications claiming benefit under 35 U.S.C. § 120 of the published application and their status.
- (E) J. Q. Practitioner may request, either in person or in writing, that the File Information Unit (FIU) ascertain and disclose if there are any subsequently filed applications claiming benefit under 35 U.S.C. § 120 of the published application and their status.

21. Company X competes with Patentee Y. In response to an accurate notification from Company X, acting as a third party, that Patentee Y's patent contains a printing error, incurred through the fault of the USPTO, the USPTO:

- (A) must issue a certificate of correction.
- (B) must reprint the patent to correct the printing error.
- (C) need not respond to Company X.
- (D) should include Company X's notification in the patent file.
- (E) must notify Company X of any USPTO decision not to correct the printing error.

22. A patent application filed in the USPTO contains the following dependent claim:

Claim 2. The method of Claim 1, further consisting of the step of cooling the mixture to a temperature of 32° F.

Following proper USPTO practices and procedures, from which of the following claims does Claim 2 not properly depend?

- (A) Claim 1. A method of making liquid compound A consisting of the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (B) Claim 1. A method of making liquid compound A comprising the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (C) Claim 1. A method of making liquid compound A including the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (D) Claim 1. A method of making liquid compound A characterized by the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (E) (C) and (D).

23. An international application designating the United States is filed with the USPTO in its capacity as a Receiving Office, which properly accords the application an international filing date of 02 August 2001. The application properly claims priority solely to an earlier British application filed 02 August 2000. A Demand was not filed within 19 months from this priority date. On 10 April 2002, applicant filed a “Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Filing Under 35 U.S.C. § 371” (Form PTO-1390), which identified the international application, and was accompanied by payment in full of the basic national fee. An oath or declaration, as required under 35 U.S.C. § 371(c)(4), was not submitted. As of 10 April 2002, the U.S. national stage application was:

- (A) Abandoned for failure to submit the basic national fee within 20 months from the priority date.
- (B) Abandoned for failure to submit the basic national fee and copy of the international application within 20 months from the priority date.
- (C) Abandoned for failure to submit the basic national fee, copy of the international application, and oath or declaration within 20 months from the priority date.
- (D) Abandoned for failure to submit the basic national fee within 20 months from the international filing date.
- (E) Not abandoned.

24. Mr. Brick, the inventor, files an application with the USPTO on January 2, 2001 containing a single claim for his invention: a new bouncing ball called “Y”. Brick receives a first Office action dated June 4, 2001 from the primary examiner handling Brick’s application. The examiner rejected Brick’s claim only under 35 U.S.C. § 103 on the grounds that Reference X teaches a bouncing ball called “Q,” and that although “Y” and “Q” are not the same, it would have been obvious to one of ordinary skill to make changes to the “Q” ball in order to obtain a ball just like Brick’s “Y” ball.

On August 2, 2001, Brick responds by stating that his new “Y” ball bounces unexpectedly higher than the “Q” ball described in Reference X. Brick includes a declaration, signed by Mrs. Kane, that includes extensive data comparing the bouncing results for the “Y” and “Q” balls and showing that the “Y” ball bounces unexpectedly higher than the “Q” ball. Brick argues that the rejection under 35 U.S.C. § 103 should be withdrawn because he has proven that, in view of the unexpectedly higher bounce of the “Y” ball as compared to the “Q” ball, it would not have been obvious to one of ordinary skill in the art to make changes to the “Q” ball to obtain Brick’s “Y” ball.

On October 2, 2001, Brick receives a final rejection from the examiner. The rejection states, in its entirety: “The response has been reviewed but has not been found persuasive as to error in the rejection. The claim is finally rejected under 35 U.S.C. § 103 for the reasons given in the first Office action.” Brick believes he is entitled to a patent to his new bouncing ball “Y.” How should Brick proceed?

- (A) Brick should give up because the declaration did not persuade the examiner of the merits of Brick’s invention.
- (B) Brick should timely file a Request for Reconsideration asking the examiner to reconsider the rejection on the basis of the Kane declaration and, as a precaution against the Request for Reconsideration being unsuccessful, also timely file a Notice of Appeal.
- (C) Brick should respond by submitting a request for reconsideration presenting an argument that Reference X does not provide an enabling disclosure for a new ball with the unexpectedly higher bounce of his “Y” ball.
- (D) Brick should respond by submitting a request for reconsideration presenting an argument that Reference X does not provide a written description for a new ball with the unexpectedly higher bounce of his “Y” ball.
- (E) Brick should respond by submitting a request for reconsideration presenting an argument the declaration data proves that the “Q” ball and the “Y” are not identical.

25. John filed a utility patent application for a high strength steel composition on June 9, 1997. During prosecution of the application, an interference under 35 U.S.C. § 135(a) was declared on June 9, 1998 between John's application and an unexpired patent. Subsequently, the interference was terminated in John's favor on June 9, 2000. The year 2000 was a leap year having 366 days. Ultimately, John's application was allowed and issued as a patent on June 12, 2001. Based on proper USPTO practice and procedure, and absent any other events necessitating adjustment of the patent term, when should John's patent expire?

- (A) Twenty (20) years from issue date.
- (B) Twenty (20) years and one day from filing date.
- (C) Twenty (20) years plus three years inasmuch as granting of the patent was delayed by the interference.
- (D) Twenty (20) years plus the number of days in the period beginning the date prosecution is suspended in another application that is not in the interference, but is related to the application in interference.
- (E) Twenty (20) years plus the period beginning on the date the interference was declared and ending on the date that the interference was terminated with respect to the application.

26. Which of the following is not in accord with proper USPTO practice and procedure?

- (A) If a practitioner, "by mistake," files an application and basic filing fee, the submission of the filing fee with the application is treated by the Office as not a fee paid by mistake, and the fee will not be refunded.
- (B) If, in April 2001, a practitioner files an application, properly establishes the applicant's small entity status, and "by mistake" pays the filing fee by submitting a check drawn in the amount that is twice the amount of the small entity filing fee, a refund of the excess fee may be obtained upon request filed any time during pendency of the application and life of any patent granted on the application.
- (C) The paragraphs of the specification of an original utility patent application filed in January 2001 may, but are not required to be numbered at the time the application is filed.
- (D) If a provisional application is filed in a language other than English, an English language translation of the non-English language provisional application will not be required in the provisional application.
- (E) If a table having more than 50 pages of text is submitted on compact disc, the specification of a patent application must contain an incorporation-by-reference of the material on a compact disc in a separate paragraph, identifying each compact disc by the names of the files contained on each compact disc, their date of creation, and their sizes in bytes.

Questions 27 through 29 are based on the following factual background. Consider questions 27 through 29 independently of each other.

James Salt developed an environmentally friendly technique for controlling deer overpopulation. Briefly, Salt discovered a non-hormonal substance XYZ (“Antiagra”) that efficiently suppresses sexual function in male deer with minimal side effects. Salt determined that the use of a non-hormonal substance eliminated adverse long-term health effects that may be experienced with hormonal substances. He then dissolved an effective amount of Antiagra in salt water, poured the resulting solution into a plurality of twenty-gallon tubs, and heated the tubs to evaporate the water. The resulting blocks of salt, throughout which Antiagra was evenly disbursed, were distributed in overpopulated areas during deer mating season to serve as salt licks. Stags that used the salt lick show no interest in mating, thereby lowering the pregnancy rate among does and helping to control the deer population. Salt has retained you to conduct a prior art search and, if appropriate, prepare and file a patent application. The only relevant prior art located during the prior art search is a patent to Deere that discloses a salt lick on which a hormonal substance is sprayed. A doe that uses the salt lick ingests the hormonal substance which, in turn, suppresses ovulation and thereby reduces the pregnancy rate. You prepare and file a patent application that provides a fully enabling disclosure and includes four claims sets. Claims 1-5 are directed specifically to the non-hormonal substance (Antiagra), claims 6-9 are directed to a salt lick laced with a non-hormonal substance that, when ingested by a male deer, suppresses sexual function in the male deer, claims 9-14 are directed to the method of forming the salt lick, and claims 14-20 are directed to a method for controlling deer population by distributing salt licks that are treated with an effective amount of XYZ to reduce pregnancy rates. You also properly establish small entity status on behalf of Salt at the time the application is filed.

27. Upon initial examination, the patent examiner issues a requirement for restriction on the basis that the application claims two or more independent and distinct inventions. Specifically, the examiner requires an election between (a) claims directed to the non-hormonal substance *per se* (claims 1-5); (b) claims directed to the salt lick and to the method of forming the salt lick (claims 6-14); and (3) claims directed to the method of controlling deer population by distributing salt licks that are treated with XYZ to reduce pregnancy rates (claims 15-20). The restriction requirement was set forth in an Office action dated December 12, 2001, and the examiner set a one month (not less than 30 days) shortened statutory period for response. December has 31 calendar days. Which of the following is most likely to be treated by the USPTO as a timely, fully responsive reply to the Office action.

- (A) You contact the examiner on the telephone on December 27, 2001 and make an oral election of the subject matter of claims 6-14 without traverse, and request cancellation of claims 1-5 and 15-20 without prejudice to resubmission of those claims in a continuation application. You do not, however, subsequently confirm the substance of the telephone conversation in writing and the examiner does not complete an Interview Summary Record.
- (B) On February 12, 2002, you file a Reply to Office Action, a Petition for One Month Extension of Time and all necessary fees. The Reply to Office Action traverses the restriction requirement on the basis that the requirement would force the small entity applicant to file multiple patent applications and is therefore unduly burdensome. The Reply to Office Action requests reconsideration of the restriction without making an election.
- (C) On February 12, 2002, you file a Reply to Office Action, a Petition for Two Month Extension of Time and all necessary fees. The Reply to Office Action does not make an election. Instead, the Reply to Office Action traverses the restriction requirement and requests reconsideration of the restriction without specifically pointing out the supposed errors in the examiner's action.
- (D) On February 14, 2002, you file a Reply to Office Action, a Petition for One Month Extension of Time and all necessary fees. The Reply to Office Action traverses the restriction requirement on the basis that the claims as originally presented in a single application do not pose a serious burden on the examiner, and therefore requests reconsideration of the election requirement. The Reply to Office Action provisionally elects the subject matter of claims 6-14. There is no authorization to charge a deposit account.
- (E) On February 12, 2002, you file a Reply to Office Action, a Petition for One Month Extension of Time and all necessary fees. The Reply to Office Action elects claims 6-14 without traverse.

28. Claim 6 of the application reads: “A composition for reducing the pregnancy rate among wild deer population, said composition comprising salt and a non-hormonal substance that, when ingested by a male deer, is operable to suppress sexual function in the male deer.” Claim 7 reads: “The composition of claim 6, wherein said non-hormonal substance is XYZ.” Claim 8 reads, “The composition of claim 6, wherein said composition is formed in a block and wherein said non-hormonal substance is interspersed substantially evenly throughout said block.” Each of these claims is fully supported by the specification. An Office action is mailed March 15, 2002. Claim 6 was rejected under 35 U.S.C. § 103 as being unpatentable over the Deere patent. Which of the following arguments, if presented in a timely reply to the March 15 Office action, is most likely to persuade the examiner to remove the § 103 rejection without presenting unpersuasive arguments?

- (A) “The invention of claim 6 provides an advantageous feature in that the substance that helps reduce the pregnancy rate is interspersed throughout the salt lick. Thus, the present invention is effective to reduce the pregnancy rate in deer so long as any portion of the salt lick is available to deer. In contrast, the Deere patent utilizes a substance that is sprayed on the outer surface of the salt lick and, therefore, is effective only so long as the outer portion of the salt lick is available.”
- (B) “The invention of claim 6 provides an advantageous feature in that the substance that helps reduce the pregnancy rate is interspersed throughout the salt lick. Thus, the present invention is effective to reduce the pregnancy rate in deer so long as any portion of the salt lick is available to deer. In contrast, the Deere patent utilizes a substance that is sprayed on the outer surface of the salt lick and, therefore, is effective only so long as the outer portion of the salt lick is available.”
- (C) “In contrast to the present invention, the Deere patent calls for the use of a hormonal substance that suppresses ovulation in female deer. Deere neither discloses nor suggests the use of a non-hormonal substance that, when ingested by a male deer, is operable to suppress sexual function in the male deer, as set forth in claim 6.”
- (D) “The present invention relates to a technique for reducing deer overpopulation by causing male deer to ingest a novel substance (XYZ) that is operable to suppress sexual function in the male deer. The Deere patent neither discloses nor suggests such a technique and, therefore, claim 6 is neither anticipated nor rendered obvious by the Deere patent.”
- (E) “Applicant was aware of the Deere patent prior to filing of the present application, and the claims were carefully drafted to distinguish the present invention over the Deere patent. Accordingly, reconsideration and withdrawal of the § 103 rejection of claim 6 is respectfully requested.”

29. Claim 15 of the application reads: “A method for reducing pregnancy rate in wild deer population comprising the step of placing at least one salt lick containing an effective amount of XYZ in a location accessible to wild male deer so that XYZ is ingested by said male deer.” The specification provides adequate disclosure as to what constitutes an “effective amount” of XYZ. In addition to the Deere patent, the examiner locates a prior art patent to John Doe that discloses the non-hormonal substance XYZ for use as a softening agent in skin cream. There is no disclosure or suggestion in the Doe patent of any other potential use for XYZ. Which of the following statements is most consistent with proper USPTO practice and procedure?

- (A) The Examiner may properly reject claim 15 under 35 U.S.C. §103 as being obvious over Deere in view of Doe because Deere teaches the method of distributing salt licks treated with a substance to reduce pregnancy rates and suppression of sexual activity in male deer is merely an inherent characteristic of a known substance XYZ.
- (B) The examiner may not rely on the Doe patent in a 35 U.S.C. § 103 obviousness rejection because there is no evidence that Salt was aware of its teachings at the time the invention was made and therefore the invention could not have been obvious to Salt at that time.
- (C) The examiner may rely on the Doe patent in making an obviousness rejection under 35 U.S.C. §103 only if the Doe patent is in the field of Salt’s endeavor or, if not in that field, then reasonably pertinent to the problem with which Salt was concerned.
- (D) The examiner may properly reject claim 15 under the first paragraph of 35 U.S.C. §112 because the specification is inadequate to enable a person skilled in the art to which it pertains to practice the invention.
- (E) The examiner may properly reject claim 15 under the second paragraph of 35 U.S.C. § 112 because the recitation of “an effective amount of XYZ” renders the claim indefinite.

30. The following statements relate to “multiple dependent claims.” Which statement is not in accord with proper USPTO practice and procedure?

- (A) A multiple dependent claim contains all the limitations of all the alternative claims to which it refers.
- (B) A multiple dependent claim contains in any one embodiment only those limitations of the particular claim referred to for the embodiment under consideration.
- (C) A multiple dependent claim must be considered in the same manner as a plurality of single dependent claims.
- (D) Restriction may be required between the embodiments of a multiple dependent claim.
- (E) The limitations or elements of each claim incorporated by reference into a multiple dependent claim must be considered separately.

31. Which of the following practices or procedures may be properly employed to overcome a rejection properly based on 35 U.S.C. § 102(a)?

- (A) Perfecting a claim to priority under 35 U.S.C. § 119(a)-(d) based on a foreign application having a foreign priority filing date that antedates the reference.
- (B) Filing a declaration under 37 CFR 1.131 showing that the cited prior art antedates the invention.
- (C) Filing a declaration under 37 CFR 1.132 showing that the reference invention is by “others.”
- (D) Perfecting priority under 35 U.S.C. §§ 119(e) or 120 by, in part, amending the declaration of the application to contain a specific reference to a prior application having a filing date prior to the reference.
- (E) (A), (B) (C), and (D).

32. Johnnie owns a supermarket store in Cleveland, Ohio, and is constantly frustrated when little children drop their chewing gum on Johnnie's clean floor in the supermarket. In her spare time, Johnnie develops an entirely novel type of coating material that she applies to floor tile. The coating material resists adhesion to chewing gum. In order to check out the effectiveness of the floor tile coating material, on December 31, 2000, she secretly covers the floor tiles in her supermarket with the new chewing gum resistant floor tile coating material. Johnnie is amazed at the results inasmuch as cleaning the floor was never easier. On January 30, 2001, Johnnie, satisfied with the experimental use results, ceased testing the use of the coating material. The ability of the coating material to withstand chewing gum adhesion continued unabated throughout the remainder of 2001. On January 1, 2002, one of Johnnie's many customers, James, remarked at how clean the floor looked. Johnnie then told James of her invention. James thinks for one moment and suggests that the floor tile coating material may be useful in microwave ovens, so that food will not stick to the interior sides of the microwave oven. James discusses getting patent protection with Johnnie. Which of the following is true?

- (A) Johnnie could never be entitled to a patent on a floor tile in combination with a coating material affixed to the outer surface of the tile.
- (B) James can be named as a coinventor with Johnnie in a patent application claiming a microwave oven wherein the internal surfaces of the oven are coated with the coating material.
- (C) Since for one year Johnnie told nobody that the floor tile in her supermarket contained the new chewing gum resistant coating material, she would never be barred from obtaining patent protection for the floor coating material.
- (D) Use of the floor tile coating material in microwave ovens would have been obvious to one of ordinary skill in the art, since James thought of it within seconds after first learning of the floor tile coating material, and James was not skilled in the art.
- (E) The floor tile having the coating material affixed to the outer surface of the tile, an article of manufacture, would not be patentable as of January 1, 2002 inasmuch as the article was in public use on the supermarket floor for one year.

33. Which of the following may properly be required to submit information in reply to a requirement for information under 37 CFR 1.105 in a patent application filed in December 2002?

- (A) A named inventor in the application.
- (B) An assignee of the entire interest in the application.
- (C) An attorney who prepares and prosecutes the application.
- (D) All of the above.
- (E) (A) or (C).

34. Applicant received a final rejection dated and mailed Wednesday, February 28, 2001. The final rejection set a three month shortened statutory period for reply. In reply, applicant filed an amendment on Wednesday, March 21, 2001. In the amendment, applicant requested that block diagrams, figures 32-34, be amended by inserting the term - computer- in place of [CPU] in block "2" of each block diagram. Applicant further supplied a clean version of the entire set of pending claims. Applicant did not provide the proposed changes to the drawings on separate sheets marked in red nor did the applicant supply a marked-up version of any claim. The examiner upon receipt and review of the amendment discovered that the applicant made changes to pending claims 2 and 15 and that the applicant added claims 21-25 to the application. The examiner in an Advisory Action notifies the applicant that the amendment fails to comply with the requirements of 37 CFR 1.121. Which of the following answers is most correct?

- (A) Applicant is given a time period of one month or thirty days from the mailing date of the Advisory Action, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. This time period is in addition to any remaining period of time set in the final rejection.
- (B) Applicant may not provide a clean version of the entire set of pending claims because the applicant may only consolidate all previous versions of pending claims into a single clean version in an amendment after a non-final Office action.
- (C) Applicant must submit the proposed changes to figures 32-34 on a separate paper showing the proposed changes in red and a marked up version of new claims 21-25 as required by 37 CFR 1.121(c).
- (D) Applicant should request reconsideration by the examiner, pointing out that the Final Rejection was mailed on February 28, 2001, which precedes the March 1, 2001 effective date of the changes to patent rule 37 CFR 1.121.
- (E) Applicant must submit the changes to figures 32-34 on separate paper showing the proposed changes in red and a marked up version of rewritten claims 2 and 15 showing all changes (relative to the previous version of claims 2 and 15) shown by any conventional marking system as required by 37 CFR 1.121(c). Applicant should also indicate the status of claims 2 and 15, e.g. "amended," "twice amended," etc. on both the clean version of the claims and the marked up version.

35. Joe Inventor received a patent in July 1999, containing claims to both an article and an apparatus. When filed in the USPTO, the application contained disclosure of a method, but the method was not claimed. The patent contained the same disclosure of the method, but the method had never been claimed in the application. In May 2001, Joe asks Pete Practitioner to file a reissue application to add claims to the method disclosed in the specification. Once filed, which of the following will most likely occur during the prosecution of the reissue application in accordance with published USPTO practice and procedure?

- (A) The examiner should reject the added method claims on the basis of not being for the invention claimed in the original patent, under 35 U.S.C. § 251, citing *In re Rowand*, 187 USPQ 487, and allow the original unamended article and apparatus patent claims in the reissue application.
- (B) Following a restriction requirement by the examiner in the reissue application, the original unamended article and apparatus patent claims will be constructively elected, examined, and, if found allowable, passed to issue, while the non-elected method claims should be filed in a divisional application.
- (C) Following a restriction requirement in the reissue application and the filing of a divisional application to claim the method, the applicant should request a duplicate copy of the original patent so that a copy of said patent can be surrendered in each reissue application.
- (D) Following a restriction requirement by the examiner in the reissue application, the original unamended article and apparatus patent claims will be considered constructively elected; if after examination they become allowable in unamended form, they will be held in abeyance in a withdrawn status inasmuch as no “error” under 35 U.S.C. §251 exists, while Joe prosecutes the claims to the method in a divisional application.
- (E) A three-way restriction requirement among the article, apparatus and method claims should be made by the examiner in the reissue application, and an election made by applicant. Each invention should issue in a separate reissue patent.

36. Which of the following is not a USPTO recommendation or requirement?

- (A) Product and process claims should be separately grouped.
- (B) Claims should be arranged in order of scope so that the first claim presented is the least restrictive.
- (C) Every application should contain no more than three dependent claims.
- (D) A claim which depends from a dependent claim should not be separated from that dependent claim by any claim which does not also depend from the dependent claim.
- (E) Each claim should start with a capital letter and end with a period.

37. Select from the following an answer which completes the following statement, such that the completed statement accords with proper USPTO practice and procedure: “When the reference in question is a noncommonly owned U.S. patent claiming the same invention as applicant, and its issue date is _____,”

- (A) less than one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of requesting an interference.
- (B) exactly one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of requesting an interference.
- (C) more than one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of requesting an interference.
- (D) less than one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of affidavit or declaration “swearing back” of reference.
- (E) less than one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of affidavit or declaration traversing the ground of rejection.

38. Applicant files an application claiming a nutritional supplement comprising ingredients (1) through (9) on September 6, 2001. The examiner’s search on November 12, 2001 retrieved several documents, each of which provides an enabling disclosure of a nutritional supplement comprising ingredients (1) through (9). Which of the following documents retrieved by the examiner may be properly used by the examiner to reject applicant’s claims under 35 U.S.C. § 102(b)?

- (A) An advertisement in the September 2000 issue of Dieticians and Nutritionists Health Weekly where the examiner is not able to determine the actual date of publication.
- (B) A printout on November 12, 2001 by the examiner of a MEDLINE database abstract 123456 of an article by Food et al., “Nutritional supplements for infants,” published in Azerbaijan Pediatrics, Vol. 33, No. 8, pp. 33-37 (September 2000). The printout does not include the date on which the MEDLINE abstract was publicly posted.
- (C) A printout, on November 12, 2001 by the examiner, of a product brochure from the Internet website of PRO-BIOTICS VITAMIN CORP. The examiner determines that the brochure was posted on September 7, 2000 on the website.
- (D) A Japanese patent application published on September 1, 2000.
- (E) All of the above.

39. You are deciding whether to file continued prosecution applications (CPA) for prior applications before the earliest of payment of any issue fee on the prior application (and absent any petition under 37 CFR 1.313(c)), abandonment of the prior application, or termination of proceedings on the prior application. In which of the following circumstances is it proper to use the CPA procedure to file the application?

- (A) To file a continuation-in-part application of a prior complete nonprovisional utility application filed under 35 U.S.C. § 111(a). The nonprovisional application has an actual filing date prior to November 29, 1999.
- (B) To file a divisional application of a prior complete provisional application for a utility invention filed under 35 U.S.C. § 111(b). The provisional application has an actual filing date after June 8, 1995.
- (C) To file a continuation utility application of a prior complete nonprovisional utility application filed under 35 U.S.C. § 111(a). The nonprovisional application has an actual filing date prior to May 29, 2000.
- (D) To file a continuation utility application of a prior complete CPA utility application. The prior CPA application has an actual filing date of June 1, 2000, and is a continuation application of a prior complete utility application filed under 35 U.S.C. § 111(a) having an actual filing date of November 28, 1999.
- (E) To file a divisional application of a prior complete nonprovisional plant application filed under 35 U.S.C. § 111(a). The nonprovisional application has an actual filing date after May 29, 2000.

40. Which of the following identifications of document(s) set forth in a return postcard that is stamped and returned by the USPTO will suffice for the postcard receipt to serve as *prima facie* evidence of the USPTO's receipt of the document(s) specified where the USPTO cannot locate the document(s)?

- (A) For all pages of a complete new application **B** an identification stating: "the items listed in the transmittal letter that accompanied the application", where the registered practitioner can furnish a copy of the transmittal letter, and where the transmittal letter contained a list of the component parts of a complete application.
- (B) For all pages of a complete new application **B** an identification stating: "a complete application".
- (C) For all pages of a complete new application containing the following components **B** an identification stating: "specification (including written description, claims and abstract), drawings, declaration".
- (D) For two sheets of drawings **B** an identification stating "2 sheets of drawings".
- (E) All of the above.

41. Regarding an affidavit or declaration filed pursuant to 37 CFR 1.131, which of the following statements is incorrect?

- (A) The affidavit or declaration may establish a date of completion of applicant's claimed invention before January 1, 1996 in a NAFTA country or before December 8, 1993 in a WTO member country other than a NAFTA country.
- (B) The affidavit or declaration cannot be used to overcome a rejection under 35 U.S.C. § 102(e) based on a U.S. patent which claims the same patentable invention as defined in 37 CFR 1.601(n).
- (C) The affidavit or declaration may be used to overcome a rejection under 35 U.S.C. § 103 based on reference to a foreign patent which qualifies as prior art under 35 U.S.C. § 102(a).
- (D) The affidavit or declaration containing references to notebook entries may properly include reproductions of the notebook entries, as opposed to the original notebook pages.
- (E) The affidavit or declaration must show facts establishing reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to subsequent actual reduction to practice or to the filing of the application.

42. Applicant Homer filed a nonprovisional utility application on December 3, 2001 with 3 sheets of drawings. He received a non-final Office action on the merits on March 1, 2002 rejecting all claims under 35 U.S.C. § 102(b) with reference A and including objections to the drawings. The Office action set a shortened statutory period of 3 months for reply. Homer wants to submit several references in an information disclosure statement (IDS) for the examiner's consideration. Under proper USPTO practices and procedures which of the following actions, if taken, would avoid abandonment?

- (A) Homer timely files a continued prosecution application under 37 CFR 1.53(d) with an IDS and required fees.
- (B) Homer timely files a request for continued examination under 37 CFR 1.114 with an IDS and required fees.
- (C) Homer timely files a request for suspension of action under 37 CFR 1.103 with an IDS and required fees.
- (D) Homer timely files a photocopy of the originally filed claims with proposed amendments marked in red, arguments that support the claims are patentable over the reference, proposed drawing corrections, an IDS, and any required fees or certification.
- (E) Homer timely files conclusory arguments that the examiner's rejection is without merit and has no statutory basis.

43. The Commissioner may issue a certificate of correction to correct a mistake in a patent, incurred through the fault of the Office:

- (A) only if demanded by a third party having standing with the Office and the third party pays the fee required by 37 CFR 1.20(a).
- (B) without notifying the patentee, (including any assignee of record) if the correction is of a nature that the meaning intended is obvious from the context of the portion of the patent where the mistake occurs.
- (C) only if the request for correction relates to a patent involved in an interference.
- (D) acting *sua sponte*, after first notifying the patentee, for mistakes that the Office discovers.
- (E) only if patentee or the patentee's assignee makes a request.

44. An amendment filed in January 8, 2002, in an unassigned nonprovisional application seeks to cancel claims so that fewer than all of the currently named inventors are the actual inventors of the invention being claimed. The amendment includes a request to delete the names of the persons who are not inventors. In accordance with proper USPTO rules and procedure, the request may be signed by which of the following?

- (A) A registered practitioner not of record who acts in a representative capacity under 37 CFR 1.34(a).
- (B) All of the applicants (37 CFR 1.41(b)) for patent.
- (C) A registered practitioner of record appointed pursuant to 37 CFR 1.34(b).
- (D) (B) and (C).
- (E) (A), (B), and (C).

45. Which of the following practices or procedures may be properly employed to overcome a rejection properly based on 35 U.S.C. § 102(e)?

- (A) Persuasively arguing that the claims are patentably distinguishable from the prior art.
- (B) Filing an affidavit or declaration under 37 CFR 1.132 showing that the reference invention is not by "another."
- (C) Filing an affidavit or declaration under 37 CFR 1.131 showing prior invention, if the reference is not a U.S. patent that either claims the same invention or claims an obvious variation of the subject matter in the rejected claim(s).
- (D) (A) and (C).
- (E) (A), (B) and (C).

46. A product-by-process claim is properly rejected over a reference under 35 U.S.C. § 102(b). Which of the following statements is incorrect?

- (A) There is no anticipation unless each of the process steps recited in the claim is disclosed or inherent in the applied reference.
- (B) If the applied reference reasonably indicates that a product disclosed therein is the same or substantially the same as the claimed product, the burden shifts to the applicant to provide evidence to the contrary.
- (C) The rejection cannot be overcome by evidence of unexpected results.
- (D) The rejection can be overcome by evidence that the product in the reference does not necessarily or inherently possess a characteristic of the applicant's claimed product.
- (E) An affidavit or declaration under 37 CFR 1.131 cannot overcome a proper rejection under 35 U.S.C. § 102(b) over a reference.

47. Xavier residing in Canada, a NAFTA country, files an application for a Canadian patent Monday, September 18, 2000. At the same time, Xavier forwards a copy of the Canadian application to registered practitioner Young in the United States, asking that Young prepare a U.S. application based on the Canadian application and claim the benefit of the Canadian filing. Young advises Xavier on the relative merits of filing a provisional versus a non-provisional application and Xavier decides to have Young initially file a provisional U.S. application. Young prepares the application and files it as a provisional application on Friday, January 19, 2001, claiming the benefit of the Canadian application. In August 2001, Young reminds Xavier that the filing was only provisional and that Xavier must decide whether to file a non-provisional application. In early January 2002, Xavier directs Young to get a non-provisional application, with a certified copy of the English language Canadian application, into the Office, which Young does on Friday January 11, 2002. Young files no other correspondence prior to the first Office action. Which of the following is true?

- (A) Because of the federal holiday, the filing of the non-provisional is timely to maintain a priority claim to the provisional application under 35 U.S.C. § 119(e), and therefore also to maintain a priority claim to the Canadian application filed less than 12 months before the initial US application.
- (B) If Young files the non-provisional application by converting the provisional application to a non-provisional application. The patent term will be measured from the date of conversion.
- (C) If Young files the non-provisional application by submitting a new application that claims the benefit of the provisional application and the Canadian application, in a first Office action rejection an examiner may apply a reference published September 19, 2000 as a prior art publication.
- (D) (A) and (B).
- (E) All of the above.

48. Engineers and scientists at Poly Tech Institute (PTI) have invented a new system for a wireless computer network. On November 9, 2001, they asked you to file a U.S. patent application for their invention. PTI is located in the United States, has an attendance of over 5,000 students, and (1) admits, as regular students, only persons having a certificate of graduation from a school providing secondary education, or the recognized equivalent of such a certificate, (2) is legally authorized within the jurisdiction in which it operates to provide a program of education beyond secondary education, (3) provides an educational program for which it awards a bachelor's degree or provides less than a 2-year program which is acceptable for full credit toward such a degree, (4) is a public institution, and (5) is accredited by a nationally recognized accrediting agency. You also find out that Poly Tech's research which led to the invention of the new system was funded by Atlantic Telcom Corporation (ATC) (a for profit corporation with over 500 employees and that does not meet the small business standard defined in 13 CFR 121) and a license agreement has been signed which would give ATC the right to participate in the prosecution of the patent application and also the right to make and use the invention, upon the payment of royalties, if the application ultimately issues as a patent. Based on the above facts, you should advise PTI that:

- (A) the application must be filed under large entity status because enrollment in the university exceeds 500.
- (B) the application must be filed under large entity status because PTI has entered into a license agreement.
- (C) the application may be filed under small entity status because the enrollment at PTI exceeds 5000 students.
- (D) the application may be filed under small entity status because PTI is an institution of higher education located in the United States.
- (E) None of the above.

49. Which of the following practices or procedures may be properly employed to overcome a rejection properly based on 35 U.S.C. § 102(e)?

- (A) Claiming priority under 35 U.S.C. § 119(a)-(d) based on a foreign application having a foreign priority filing date that antedates the reference.
- (B) Claiming priority under 35 U.S.C. §§ 119(e) or 120 by filing an application data sheet under 37 CFR 1.76 that contains a specific reference to the prior application in accordance with 37 CFR 1.78(a), where the prior application has a filing date prior to the reference.
- (C) Claiming priority under 35 U.S.C. §§ 119(e) or 120 by amending the specification of the application to contain a specific reference to a prior application having a filing date prior to the reference.
- (D) Amending the claims to patentably distinguish over the prior art.
- (E) (A), (B), (C), and (D).

50. Which of the following is not required in order for a foreign application that has matured into a foreign patent to qualify as a reference under 35 U.S.C. § 102(d)?

- (A) The foreign application must have actually been published before the filing of an application in the United States, but the patent rights granted need not be enforceable.
- (B) The foreign application must be filed more than 12 months before the effective filing date of the United States application.
- (C) The foreign and United States applications must be filed by the same applicant, his or her legal representatives or assigns.
- (D) The foreign application must have actually issued as a patent or inventor's certificate before the filing of an application in the United States. It need not be published but the patent rights granted must be enforceable.
- (E) The same invention must be involved.

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**UNITED STATES PATENT AND TRADEMARK OFFICE
REGISTRATION EXAMINATION
FOR PATENT ATTORNEYS AND AGENTS**

APRIL 17, 2002

Afternoon Session (50 Points)

Time: 3 Hours

DIRECTIONS

This session of the examination is an open book examination. You may use books, notes, or other written materials that you believe will be of help to you *except* you may not use prior registration examination questions and/or answers. Books, notes or other written materials containing prior registration examination questions and/or answers *cannot* be brought into or used in the room where this examination is being administered. If you have such materials, you must give them to the test administrator before this session of the examination begins.

All questions must be answered in SECTION 1 of the Answer Sheet which is provided to you by the test administrator. You must use a No. 2 pencil (or softer) lead pencil to record your answers on the Answer Sheet. Darken *completely* the circle corresponding to your answer. You must keep your mark within the circle. Erase *completely* all marks except your answer. Stray marks may be counted as answers. No points will be awarded for incorrect answers or unanswered questions. Questions answered by darkening more than one circle will be considered as being incorrectly answered.

This session of the examination consists of fifty (50) multiple choice questions, each worth one (1) point. Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the *Official Gazette*, or a notice in the *Federal Register*. Each question has only one most correct answer. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer that will be accepted. Where two or more choices are correct, the most correct answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement that would make the statement *true*. If it is determined by the USPTO that there is more than one most correct answer to a question, each most correct answer will be accepted, but only one point will be given for the question. The presence of multiple most correct answers does not, in itself, render the question ambiguous. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

You may write anywhere on the examination booklet. However, do not remove any pages from the booklet. Only answers recorded in SECTION 1 of your Answer Sheet will be graded. YOUR COMBINED SCORE OF BOTH THE MORNING AND AFTERNOON SESSIONS MUST BE AT LEAST 70 POINTS TO PASS THE REGISTRATION EXAMINATION.

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO

This examination addresses statutes and rules that have been changed as a result of the enactment of the American Inventors Protection Act of 1999, Pub. L. No. 106-113 (“Act”). The 8th Edition of the Manual of Patent Examining Procedure should be used. The examination will apply rules that are in effect as April 1, 2002. The rule changes are posted under the heading “Recent Patent-Related Notices” on the USPTO web site (www.uspto.gov/web/offices/pac/dapp/ogsheet.html). A group of rule changes, published in 67 Federal Regulations 520 (January 4, 2002) under the name “Revision of the Time Limit for National Stage Commencement in the United States for Patent Cooperation Treaty Applications,” will be in effect on April 1, 2002. This rule change is also available at the USPTO web site cited above under the heading “Recent Patent Related Notices.”

1. Mr. Block, the inventor, files an application with the USPTO on January 2, 2001 containing a single claim for his invention: a new bouncing ball called "O." As part of his duty of disclosure, he also files a copy of a written agreement that he and Mrs. Cone signed on January 2, 1998. The agreement states, in its entirety, that "Mr. Block will transfer my new bouncing ball 'O' to Mrs. Cone for experimental uses only to perfect the ball's bounce. Mr. Block retains full control over the new bouncing ball 'O.'" The primary examiner has no evidence that the ball was ever actually delivered to Cone.

On June 2, 2001, Block receives an Office action dated June 4, 2001 from the primary examiner. The examiner has rejected Block's claim only under 35 U.S.C. § 102(b). The examiner explains in the Office action that "the 1998 written agreement signed by Block and Cone proves that the new bouncing ball 'O' was in public use more than one year prior to the January 2, 2001 filing date of the application." Block believes he is entitled to a patent for his new bouncing ball "O." How should Block respond to the rejection of his claim?

- (A) Block should give up because the agreement is dated more than one year before the filing date of the application and that is enough to statutorily bar Block from getting a patent under 35 U.S.C. § 102(b).
- (B) Block should respond by arguing that although the agreement was signed more than one year prior to the filing date of the application, it was never published and therefore cannot be relied upon as a "printed publication" under 35 U.S.C. § 102(b).
- (C) Block should respond by presenting evidence by way of an oath or declaration of experimental use and arguing that any use of the ball by Cone would have been experimental use, not "public" use.
- (D) Block should respond by arguing the agreement was signed by him, the same person who filed the application, which means that the invention was not "known or used by others in this country."
- (E) Block should respond by arguing that even though the agreement may suggest that the ball was in use more than one year prior to the filing of the application, it does not indicate that the ball was put on sale in this country.

2. For purposes of determining whether a request for continued examination is in accordance with proper USPTO rules and procedure, in which of the following situations will prosecution be considered closed?

- (A) The last Office action is a final rejection.
- (B) The last Office action is an Office action under *Ex Parte Quayle*.
- (C) A notice of allowance has issued following a reply to a first Office action.
- (D) The application is under appeal.
- (E) All of the above.

3. When filing a reissue application in November 2001 for the purpose of expanding the scope of the original patent claims, which of the following would not be in accordance with the USPTO rules of practice and procedure?

- (A) The specification, including the claims, of the patent for which reissue is requested, must be furnished in the form of a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper.
- (B) Applicant's intent to broaden the scope of the claims can be made known in a reissue application filed within 2 years of the patent grant date by presenting in the application when filed new or amended claims.
- (C) Any amendments made to the original patent by physically incorporating the changes within the specification or by way of a preliminary amendment must comply with the revised amendment practice of 37 CFR 1.121(b) and (c) and include appropriate "clean" and "marked-up" versions of the paragraphs or claims being amended.
- (D) Applicant's intent to broaden the scope of the claims can be made in a reissue application filed within 2 years of the patent grant date by specifying in the reissue declaration as one of the errors on which the reissue is based is that applicant claimed less than he had a right to claim.
- (E) None of the above.

4. Assume that conception of applicant's complex invention occurred prior to the date of the reference, but reduction to practice occurred after the date of the reference. Which of the following is sufficient to overcome the reference in accordance with proper USPTO practice and procedure?

- (A) In a 37 CFR 1.131 affidavit or declaration, it is sufficient to allege that applicant or patent owner has been diligent.
- (B) In a 37 CFR 1.131 affidavit or declaration, it is sufficient to clearly establish conception of the invention prior to the effective date of the reference, and diligence from just prior to the effective date of the reference to actual reduction to practice. The presence of a lapse of time between the reduction to practice of an invention and the filing of an application thereon is not relevant.
- (C) In a 37 CFR 1.131 affidavit or declaration, it is sufficient to clearly establish conception of the invention prior to the effective date of the reference. Diligence need not be considered.
- (D) In a 37 CFR 1.131 affidavit or declaration, it is sufficient to show conception and reduction to practice in any country.
- (E) In a 37 CFR 1.131 affidavit or declaration, it is always sufficient to prove actual reduction to practice for all mechanical inventions by showing plans for the construction of the claimed apparatus.

5. Regarding correction of inventorship in a pending application, where no waiver is granted, which of the following is not required under USPTO practice and procedure?

- (A) In connection with filing an amendment to correct inventorship in a nonprovisional application, seeking the deletion of one of the four co-inventors, because, in light of the cancellation of three claims, that inventor's invention is no longer being claimed, the submission of a statement from the person whose name is being deleted that there was no deceptive intent on his part in being named in the original application.
- (B) In connection with filing an amendment to correct inventorship in a provisional application, seeking the deletion of one of the four co-inventors, the submission of a statement from the person whose name is being deleted that there was no deceptive intent on his part in being named in the original application.
- (C) In connection with filing an amendment to correct inventorship by adding previously omitted inventors to a nonprovisional application that has been assigned, the submission of a written consent from the assignee.
- (D) In connection with filing an amendment to correct inventorship by adding previously omitted inventors to a provisional application, the submission of a statement that the inventorship error occurred without deceptive intention on the part of the omitted inventors.
- (E) In connection with filing an amendment to correct inventorship in a nonprovisional application involved in an interference, the submission of a motion under 37 CFR 1.634.

6. Patent practitioner files a patent application on behalf of inventors X, Y and Z. The patent application includes ten claims. X, Y and Z are joint inventors of the subject matter of claims 1-5. X and Y are joint inventor of the subject matter of claims 6-8. Y invented the subject matter of claim 9. Z is the inventor of the subject matter of claim 10. A patent examiner properly rejects independent claim 10 under 35 U.S.C. § 102(a) as anticipated by reference A, which is not a patent. In an attempt to overcome this rejection, a declaration that clearly antedates reference A is filed under 37 CFR 1.131. The declaration is signed by inventor Z, but not by X and Y. The declaration is:

- (A) improper because all named inventors of an application must sign a declaration filed under 37 CFR 1.131.
- (B) improper because the patent practitioner did not sign the declaration.
- (C) proper if it is shown that inventor Z is the sole inventor of the subject matter of claim 10.
- (D) proper because 37 CFR 1.131 has no requirement on who must sign the declaration.
- (E) proper because 37 CFR 1.131 only requires that the declaration be signed by an inventor named in the application.

7. Which of the following is not in accordance with proper USPTO practice and procedure?

- (A) Conversion of a provisional application to a nonprovisional application will result in the term of any patent to issue from the application being measured from at least the filing date of the provisional application.
- (B) Conversion of a provisional application to a nonprovisional application cannot adversely impact on the term of any patent to issue from the application.
- (C) An applicant having filed a provisional application can avoid any adverse patent term impact resulting from converting the provisional application to a nonprovisional application by instead filing a nonprovisional application claiming the benefit of the provisional application under 35 U.S.C. § 119(e).
- (D) An applicant filing a nonprovisional application claiming the benefit under 35 U.S.C. § 119(e) and 37 CFR 1.78 of an earlier provisional application, and not requesting conversion of the provisional to a nonprovisional application can avoid the fee required to convert a provisional application to a nonprovisional application, as well as an adverse patent term effect that would result from a conversion.
- (E) The twelve month period of pendency of a provisional application extends to the next secular or business day which is not a Saturday, Sunday, or Federal holiday in the District of Columbia if the day that is twelve months after the filing date of the provisional application under 35 U.S.C. § 111(b) and 37 CFR 1.53(c) falls on a Saturday, Sunday, or a Federal holiday in the District of Columbia.

8. A grant of small entity status entitles an applicant to which of the following?

- (A) Applicant can pay a fee to file an information disclosure statement pursuant to 37 CFR 1.97(c) that is less than the fee required to be paid by other than a small entity.
- (B) Applicant can file a Continued Prosecution Application (“CPA”) using a certificate of mailing under 37 CFR 1.8 to obtain a U.S. filing date that is earlier than the actual USPTO receipt date of the CPA.
- (C) Applicant can pay a fee to file a petition for revival of an unavoidably abandoned application under 35 U.S.C. § 111 that is less than the fee required to be paid by other than a small entity.
- (D) After issuance of a non-final first action, but before the close of the prosecution in a patent application, applicant may properly file a Request for Continued Examination and pay a fee that is less than the fee required to be paid by other than a small entity.
- (E) None of the above.

9. An applicant's claim stands rejected under 35 U.S.C. § 103 as being obvious over Larry in view of Morris. Larry and Morris are references published more than one year before applicant's effective filing. Although the examiner cites no suggestion or motivation for combining the references, they are, in fact, combinable. Which of the following arguments could properly show that the claim is not obvious?

- (A) The inventions disclosed by Larry and Morris cannot be physically combined.
- (B) Neither Larry nor Morris provides an express suggestion to combine the references.
- (C) As recognized by businessmen, the high cost of Larry's device teaches away from combining it with the simpler device of Morris.
- (D) Absent a suggestion or motivation, the examiner has not shown that combining Larry's with Morris's device would have been within the level of ordinary skill of the art.
- (E) None of the above.

10. A maintenance fee in the correct amount is received by the USPTO on February 8, 2001, prior to the due date. The maintenance fee payment includes identification of a U.S. patent number. In accordance with proper USPTO rules and procedure, in which of the following situations may the USPTO return the maintenance fee payment?

- (A) The maintenance fee payment is submitted by the patentee's grandmother, without authorization by the patentee, and includes identification of the U.S. application number for patent.
- (B) The maintenance fee payment is submitted by the attorney of record in the application, without authorization by the patentee, and includes identification of the U.S. application number for the patent.
- (C) The maintenance fee payment is submitted by the attorney of record in the application, with authorization by the patentee, and does not include identification of the U.S. application number for the patent.
- (D) (A) and (B).
- (E) None of the above.

11. While vacationing in Mexico on April 14, 2001, Henrietta invented a camera that operated at high temperature and is waterproof. She carefully documented her invention and filed a provisional application in the USPTO on April 30, 2001. She conducted tests in which the camera withstood temperatures of up to 350 degrees Fahrenheit. However, when the camera was placed in the water leaks were discovered rendering the camera inoperable. On April 12, 2002, Henrietta conceived of means that she rightfully believed will fix the leakage issue. Henrietta came to you and asked whether she can file another application. Henrietta desires to obtain the broadest patent protection available to her. Which of the following is the best manner in accordance with proper USPTO practice and procedure for obtaining the patent covering both aspects of her invention?

- (A) She can file a nonprovisional application on April 30, 2002 claiming benefit of the filing date of the provisional application, disclosing the means for fixing the leak and presenting a claim covering a camera that operates at high temperatures and a claim covering a camera that is waterproof, or presenting a claim covering a camera that both operates at high temperatures and is waterproof.
- (B) Henrietta cannot rightfully claim a camera that is waterproof in a nonprovisional application filed on April 30, 2002, since she tested the camera and the camera developed leaks.
- (C) Henrietta can file another provisional application on April 30, 2002 and obtain benefit of the filing of the provisional application filed on April 30, 2001.
- (D) Henrietta may establish a date of April 14, 2001 for a reduction to practice of her invention for claims directed to the waterproofing feature.
- (E) Henrietta should file a nonprovisional application on April 30, 2002 having claims directed only to a camera that withstands high temperatures since the camera that she tested developed leaks.

12. An applicant's claim stands rejected as being obvious under 35 U.S.C. § 103 over Lance in view of Barry. Lance and Barry are patents that issued and were published more than one year before applicant's effective filing date. Which of the following arguments could properly overcome the rejection?

- (A) Barry's device is too large to combine with Lance's device.
- (B) The Barry reference is nonanalogous art, because, although pertinent to the particular problem with which Lance was concerned, it relates to a different field of endeavor than the applicant's invention.
- (C) The combination of Lance and Barry would have precluded Lance's device from performing as Lance intended.
- (D) The Barry reference does not show all of the claimed elements arranged in the same manner as the elements are set forth in the claim.
- (E) All of the above.

13. Which of the following is or are a factor that will be considered in disapproving a preliminary amendment in an application filed November 10, 2000?

- (A) The nature of any changes to the claims or specification that would result from entry of the preliminary amendment.
- (B) The state of preparation of a first Office action as of the date of receipt of the preliminary amendment by the Office.
- (C) The state of preparation of a first Office action as of the certificate of mailing date under 37 CFR 1.8, of the preliminary amendment.
- (D) All of the above.
- (E) (A) and (B).

14. On November 7, 2000, registered practitioner Toby files in the USPTO a utility patent application having only one claim. The USPTO sends Toby a non-final Office action dated May 11, 2001 setting a three month shortened statutory period for reply, and properly rejecting the claim under 35 U.S.C. § 102(b). On June 1, 2001, Toby learns about a publication ("the Jones reference"). Toby determines that the Jones reference is material to patentability of the claim, but the publication has not been considered by the examiner during prosecution of the application. Toby prepares a complete reply ("complete reply") to the Office action dated May 11, 2001, pursuant to 37 CFR 1.111 traversing the rejection. Toby also prepares an information disclosure statement ("IDS") that complies with the provisions of 37 CFR 1.98, listing the Jones reference. In accordance with USPTO rules and procedure, which of the following actions, if taken by Toby, will result in the examiner considering the Jones reference during prosecution of the application?

- (A) On July 2, 2001, submitting to the USPTO a request for continued examination ("RCE") and fee for an RCE, with the complete reply and the IDS, but with neither the fee set forth in 37 CFR 1.17(p) nor the statement required by 37 CFR 1.97(e).
- (B) On October 12, 2001, submitting to the USPTO a request for continued examination ("RCE") and fee for an RCE, with the complete reply and the IDS, but with neither the fee set forth in 37 CFR 1.17(p) nor the statement required by 37 CFR 1.97(e).
- (C) On October 12, 2001, submitting to the USPTO the complete reply and the IDS, but with neither the fee set forth in 37 CFR 1.17(p) nor the statement required by 37 CFR 1.97(e).
- (D) On July 2, 2001, submitting to the USPTO the complete reply and the IDS, and the fee set forth in 37 CFR 1.17(p), but without the statement required by 37 CFR 1.97(e).
- (E) None of the above.

15. Applicant files a preliminary amendment on Friday, March 2, 2001, in an application filed on November 6, 2000. In the preliminary amendment, applicant provides instructions to amend paragraph one of the specification to include a claim for priority to a previously filed U.S. patent application as required by 35 U.S.C. § 120. Applicant provides instructions to insert the priority claim in line one of paragraph one on page one of the specification. Applicant also directs that page 20 of the specification be replaced with a new page 20 supplied therewith and that claims 9 and 10 be cancelled. Upon receipt and review of the preliminary amendment in the Technology Center, wherein the application has been assigned, the designated USPTO Legal Instruments Examiner (LIE) mails applicant a Notice of Non-Compliant Amendment. Select from the following an answer that completes the following statement, such that the completed statement accords with proper USPTO practice and procedure: “Applicant has received the Notice of Non-Compliant Amendment _____.”

- (A) in error because applicant’s preliminary amendment was filed in an application filed on November 6, 2000, which precedes the effective date, November 7, 2000, of the Patent Business Goals rules.
- (B) due to applicant’s failure to amend the specification at page one (1) and page 20 by providing a clean version of the paragraph(s), with no underlining or bracketing, with an instruction to substitute it for the pending paragraph(s), and an accompanying marked-up version of the paragraph(s) with all changes, relative to the prior paragraph(s), being shown by any conventional comparison system as required by 37 CFR 1.121(b).
- (C) due to applicant’s failure to provide a marked-up version of claims 9 and 10.
- (D) due only to applicant’s failure to amend the specification at page 20 by providing a clean version of the paragraph(s), with no underlining or bracketing, with an instruction to substitute it for the pending paragraph, and an accompanying marked-up version of the paragraph(s) with all changes, relative to the prior paragraph(s), being shown by any conventional comparison system as required by 37 CFR 1.121(b).
- (E) and now has a one month extendable time period in which to resubmit the preliminary amendment in compliance with revised 37 CFR 1.121. Extensions of time may be granted under 37 CFR 1.136.

16. A patent application filed in the USPTO contains the following three original claims, including product by process Claim 3:

Claim 1. A method for making an Ethernet cable comprising the steps of A, B and C.

Claim 2. The method of claim 1, further characterized by the step of D.

Claim 3. The Ethernet cable as in any one of the preceding claims.

In the first Office action, the examiner objects to Claim 3 as being an improper dependent claim and requires cancellation of the claim. Following proper USPTO practices and procedures, which of the following replies best overcomes the examiner's objection and provides the client with the broadest patent protection?

- (A) Amend Claim 3 to read: "The Ethernet cable as made by the process set forth in claims 1-2."
- (B) Cancel Claim 3. Add Claim 4, which reads: "An Ethernet cable made by a process comprising the steps of A, B and C." Add Claim 5, which reads: "An Ethernet cable made by a process comprising the steps of A, B, C and D."
- (C) Cancel Claim 3 and add Claim 4, which reads: "An Ethernet cable made by a process comprising the steps of A, B and C."
- (D) Cancel Claim 3 and add Claim 4, which reads: "An Ethernet cable made by a process comprising the steps of A, B, C and D."
- (E) Cancel Claim 3.

17. It is a late spring day in 2001. Mr. Gordon bursts into your office. "I want you to get rid of my competitor's patents," shouts Mr. Gordon "They're no good. Look at these references! But I've got to tell the USPTO what's really going on." The first patent, P1, issued on March 6, 2001, based on an application filed on November 29, 1999. The second patent, R2, is a reissue, filed on January 3, 2000, of a patent issued in 1995. The third patent, P3, issued on March 6, 2001, based on an application filed in 1994. Mr. Gordon wants to participate as much as possible in the proceedings at the USPTO. Which of the following options should be followed to accomplish Mr. Gordon's objective?

- (A) File requests for inter partes reexaminations of P1, R2, and P3.
- (B) File requests for ex parte reexaminations of P1 and P3, and a request for inter partes reexamination of R2.
- (C) File requests for ex parte reexaminations of R2 and P3, and a request for inter partes reexamination of P1.
- (D) File requests for ex parte reexamination of P1, R2, and P3.
- (E) File requests for inter partes reexaminations of P1 and P3, and a request for ex parte reexamination of R2.

Questions 18 through 20 are based on the following factual background. Consider questions 18 through 20 independently of each other.

Roger Rocket is a designer of paper cups at Paper America. During his free time, he likes to attend baseball games at Yankee Stadium. One day, while seated in the stands, he caught a fly ball. He took the baseball home and played catch with his friends Andy Cannon, Orlando Torpedo, and Mariano Missile. Unfortunately for Rocket, Cannon has a problem with accuracy. Cannon threw the ball over Rocket's head and straight through a neighbor's front window. The shattered glass ripped the lining off of the baseball. Instantly, Rocket conceived a more durable baseball with an exterior similar to that of a golf ball. Rocket worked for months on his invention in Missile's garage. His new baseball was comprised of a titanium core, and a plastic shell having circular dimples and V-shaped laces. Torpedo realized and told Rocket that Y-shaped laces would enable baseball players to throw the ball faster. Cannon, an engineer in a radar gun laboratory, tested the velocity of the baseball with both V and Y-shaped laces. To Cannon's surprise, the baseball traveled 10 M.P.H. faster with the Y-shaped laces. Rocket wanted patent protection for a baseball having a titanium core, and a plastic shell having circular dimples and Y-shaped laces, so he approached Yogi Practitioner for assistance. Rocket has no obligation, contractual or otherwise, to assign his inventions to Paper America.

18. In accordance with proper USPTO practice and procedure, who should execute the oath?

- (A) Rocket
- (B) Rocket and Torpedo
- (C) Rocket and Cannon
- (D) Rocket, Torpedo, and Cannon
- (E) Rocket, Torpedo, Cannon, and Missile

19. Before executing the oath, Rocket wanted to ask Practitioner a question. On his way to Practitioner's office, Rocket was instantly killed when a drunk driver hit his car. The officers or employees of Paper America are not related to Rocket. Who can execute an oath on Rocket's behalf?

- (A) The President of Paper America
- (B) The CEO of Paper America
- (C) Rocket's manager at Paper America
- (D) Rocket's legal representative
- (E) None of the above

20. On October 12, 2001, Practitioner received all of the proper papers required to receive a filing date. However, due to an unexpected emergency, he had to fly out of the country that evening to conduct discovery in another matter. Practitioner knew that he would be out of the office for at least 4 weeks, so before leaving, he left a note instructing his assistant to file the Rocket application on October 13, 2001, using an Express Mailing label. His assistant did not see the note until 8:00 P.M. on Friday, October 19, 2001. On Monday, October 22, 2001, Rocket's assistant deposited the Rocket application in the United States Postal Service with a proper Express Mailing label. The Postal Service properly completed a legible label showing an October 22, 2001 date in. The correspondence was received in the USPTO on October 27, 2001. What is the filing date of the Rocket application absent any Postal Service Emergency?

- (A) October 12, 2001
- (B) October 13, 2001
- (C) October 19, 2001
- (D) October 22, 2001
- (E) October 27, 2001

21. As a new member of a law firm, you are assigned to continue the prosecution of a patent application that was prosecuted by Stewart, who recently joined another law firm. After reviewing the file, you note that Stewart's reply to a first Office included two amendments: Amendment #1 introduced a change to the specification which did not affect the claims; Amendment #2 introduced a change to the specification, which change was also introduced to all of the claims currently in the application. You also note that the examiner in a current Office action has taken the position that both amendments constituted new matter, required cancellation of the new matter, and rejected all the claims on the ground that they recited elements without support in the original disclosure under 35 U.S.C. § 112, first paragraph. For the purpose of reviewing the examiner's requirement, which of the following statements accords with proper USPTO practice and procedure?

- (A) Both Amendment #1 and Amendment #2 give rise to appealable questions.
- (B) Review of the examiner's requirement for cancellation of both Amendment #1 and Amendment #2 is by way of petition.
- (C) Review of the examiner's requirement for cancellation of Amendment #1 is by way of petition, and review of the examiner's requirement for cancellation of Amendment #2 is by way of appeal.
- (D) Review of the examiner's requirement for cancellation of Amendment #1 is by way of appeal, and review of the examiner's requirement for cancellation of Amendment #2 is by way of petition.
- (E) Both Amendment #1 and Amendment #2 give rise to questions which may be reviewed either by petition or on appeal.

22. Patentee, Iam Smarter, filed and prosecuted his own nonprovisional patent application on November 29, 1999, and received a patent for his novel cellular phone on June 5, 2001. He was very eager to market his invention and spent the summer meeting with potential licensees of his cellular phone patent. Throughout the summer of 2001, all of the potential licensees expressed concern that the claim coverage that Smarter obtained in his cellular phone patent was not broad enough to corner the market on this technology, and therefore indicated to him that they feel it was not lucrative enough to meet their financial aspirations. By the end of the summer, Smarter is discouraged. On September 5, 2001, Smarter consults with you to find out if there is anything he can do at this point to improve his ability to market his invention. At your consultation with Smarter, you learn the foregoing, and that in his original patent application, Smarter had a number of claims that were subjected to a restriction requirement, but were nonelected and withdrawn from further consideration. You also learn that Smarter has no currently pending application, that the specification discloses Smart's invention more broadly than he ever claimed, and that the claims, in fact, are narrower than the supporting disclosure in the specification. Which of the following will be the best recommendation in accordance with proper USPTO practice and procedure?

- (A) Smarter should immediately file a divisional application under 37 CFR 1.53(b) including the nonelected claims that were subjected to a restriction requirement in the nonprovisional application that issued as the patent.
- (B) Smarter should file a reissue application under 35 U.S.C. § 251, including the nonelected claims that were subjected to the restriction requirement in the nonprovisional application that issued as the patent.
- (C) Smarter should file a reissue application under 35 U.S.C. § 251, broadening the scope of the claims of the issued patent, and then file a divisional reissue application presenting only the nonelected claims that were subjected to a restriction requirement in the nonprovisional application which issued as the patent.
- (D) Smarter should simultaneously file two separate reissue applications under 35 U.S.C. § 251, one including broadening amendments of the claims in the original patent, and one including the nonelected claims that were subjected to a restriction requirement in the nonprovisional application which issued as the patent.
- (E) Smarter should file a reissue application under 35 U.S.C. § 251 on or before June 5, 2003, broadening the scope of the claims of the issued patent.

23. On September 12, 2001, Jill and Jack invent a new electrically charged brush that removes lint from black wool sweaters and coats. Jill and Jack draft a nonprovisional application and send it to the USPTO and the mailing envelope is postmarked September 13, 2001. They fail to use Express Mail and their application becomes delayed in the mail for over a month. The USPTO finally receives the Jill and Jack application on December 3, 2001. On September 14, 2001, Mike and Millie invent a new electrically charged brush that removes lint from black wool sweaters and coats. Mike and Millie had no knowledge of Jill and Jack and/or their invention on September 14, 2001. Mike and Millie draft a nonprovisional application and send it to the USPTO on September 15, 2001, using U.S. Postal Service Express Mail and include the Express Mail label number on the cover sheet of their application. The mailing envelope received by the U.S. Postal Service and the date-in is clearly marked on the Express Mail label as September 15, 2001. The application of Mike and Millie becomes delayed in the mail for two months. The USPTO receives the Mike and Millie application on December 5, 2001. Assume the inventions of Jill and Jack, and of Mike and Millie are the same. Also assume that no Postal Service Emergency was involved in the delivery of the mail. Which of the following is true?

- (A) The nonprovisional application of Mike and Millie will be accorded a filing date of September 15, 2001 upon receipt in the USPTO, and their filing date will be prior to that of Jill and Jack's application.
- (B) Since the time the application was lost in the mail was unforeseeable, Jill and Jack will be entitled upon petition the USPTO to the benefit of a filing date as of the time they mailed their application on September 13, 2001.
- (C) Since Jill and Jack were the first inventors, unless Jill and Jack draft their claims so as to read directly on or substantially for the same invention as Mike and Millie claim, both applications would issue as patents since the United States has a first to invent patent system.
- (D) The application for the invention of Jill and Jack will be accorded a September 13, 2001 filing date in the USPTO, since the postmark or date placed on the envelope by the U.S. Postal Service is the determinative date for the purposes of according a filing date.
- (E) Since the application of Mike and Millie sent by Express Mail was not received until December 5, 2001, Mike and Millie will need to certify that they mailed their application on September 15, 2001, before the USPTO will accord them a filing date of September 15, 2001.

24. In 1995 Patent Agent filed a U.S. patent application containing five claims (Application 1). All five claims are fully supported under 35 U.S.C. § 112 by the disclosure of Application 1. In 2000, Patent Agent filed a U.S. patent application (Application 2) that was a continuation-in-part of Application 1. Application 2 adds new subject matter to the disclosure of Application 1, and ten additional claims. Of the fifteen claims in Application 2, claims 1-5 are exactly the same as Application 1, claims 6-10 are fully supported under 35 U.S.C. § 112 by the disclosure of Application 1, and claims 11-15 are fully supported under 35 U.S.C. § 112 only by the newly added subject matter of Application 2. The effective filing date for claims in Application 2 is:

- (A) 1-15 is 2000.
- (B) 1-15 is 1995.
- (C) 1-10 is 1995.
- (D) 11-15 is 2000.
- (E) (C) and (D).

25. In which of the following instances is the filing of a request for continued examination (RCE) of an application, together with a submission and payment of the appropriate fee, in accordance with proper USPTO practice and procedure?

- (A) The RCE, including an amendment to the written description, is filed on April 17, 2001, in a nonprovisional utility application having a filing date in July 1998. A Notice of Appeal to the Board of Patent Appeals and Interferences had been filed in November 2000, and as of April 17th the appeal is awaiting a decision.
- (B) The RCE, including an amendment to the written description, is filed on April 17, 2001, in a nonprovisional utility application having a filing date in July 1996. A Notice of Appeal to the United States Court of Appeals for the Federal Circuit was properly filed in January 2001, and the appeal has not terminated as of April 17th.
- (C) The RCE, including an amendment to the written description, is filed on April 17, 2001, in a nonprovisional utility application having a filing date in July 1999. The issue fee was filed in the Office on Friday, January 19, 2001, but a petition and fee to withdraw the application has not been filed.
- (D) The RCE, including an amendment to the written description, is filed on April 17, 2001, for a nonprovisional utility application having a filing date in July 1996. On Monday, April 2, 2001, Applicant withdrew a Notice of Appeal to the United States Court of Appeals for the Federal Circuit. There were no allowed claims in the application, and the Court's dismissal of the appeal did not indicate any further action to be taken by the Office.
- (E) The RCE, including an amendment to the written description, is filed on April 17, 2001, for a provisional utility application having a filing date in July 2000.

26. Jack Flash filed an application for patent on December 16, 1998, disclosing and claiming self-extinguishing safety candles, methods of making them, and a special reflective housing for holding the burning candles. Following a three-way restriction, Mr. Flash prosecuted the claims for the candle, and was granted a patent (“P1”), which issued on April 6, 1999. Mr. Flash filed a divisional application containing claims for the method of making the candles and for the reflective housing on April 5, 1999. The examiner did not restrict the claims, but before the first action on the merits was mailed, Mr. Flash suffered business reversals and canceled the claims to the reflective housing to reduce the cost of obtaining his patent. A patent on the method of making the candles (“P2”), issued on November 30, 1999. Although you reviewed and signed all of the papers in the prosecution of the applications, your assistant, Annie, did all the work under your supervision.

On April 1, 2001, Mr. Flash jumps into your office. He has just won a million dollars on some television game show you’ve never heard of, and he wants to “revive his patents.” He is also concerned about an article he tore out of the February 1986 issue of the trade publication Wicks and Sticks, that shows a drawing of a dissimilar candle that would nevertheless raise a question of patentability, with the caption “It’s just a dream: it can’t be made we’ve tried a thousand times, don’t bother.” He also has a video tape first sold by a local hobbyist at his store in October 1999, showing a process of candle making that may be within the scope of his process claims. “But it’s such a stupid way to do things - it’s expensive and it doesn’t work very well- it doesn’t even make a safety candle,” Jack shouts, jumping on your desk. He is so excited he can barely get the words out. Annie volunteers to work with him to figure out what he can do. On the next day, Friday, April 2, just as you are getting ready to close up and head for the LeTort Creek with your cane rod Annie drops five proposals on your desk. After reviewing Annie’s proposals, but before you leave, you must instruct her to take the action that will best protect Mr. Flash’s patent rights. Which of the following acts would be in accordance with proper USPTO practice and procedure, and Annie should be authorized to follow?

- (A) File a broadening reissue application on P1, alleging error in failing to claim sufficiently broadly by not filing claims for the reflective housing.
- (B) File a request for reexamination of P1 based on the Wicks and Sticks article.
- (C) File a new, nonprovisional patent application claiming benefit of the filing date of parent application that issued as patent P2.
- (D) File a request for reexamination of P2 in view of the video tape, intending to narrow the process claims to avoid the video tape if the USPTO finds a significant new question of patentability, and seeking to add claims to the reflective housing.
- (E) File a broadening reissue of P2, alleging error in claiming the process too broadly, because it covers the process disclosed on the video tape, and alleging further error in claiming less than the inventor had a right to claim, by not claiming the reflective housing.

27. Judy Practitioner is preparing the declaration form (PTO/SB/01) for her clients, inventors A and B, to sign prior to filing their utility patent application. Inventor A lives in California, and inventor B lives in Germany. Prior to sending declaration forms to the inventors, only inventor A had reviewed the final version of the application. Which of the following situations below would result in the declaration form(s) being compliant with 37 CFR 1.63(a) and (b)?

- (A) Judy mailed only a copy of the declaration form (PTO/SB/01), which identified the application and both inventors by their full names and citizenships, to inventor A with the instruction to return to her after he signs the declaration form. After inventor A returned the form, Judy then proceeded to mail out the declaration form to inventor B. After inventor B signed the declaration, Judy then attached the declaration, signed by both inventors, to the application and filed it with the USPTO.
- (B) Judy mailed to inventor A only a copy of the declaration form (PTO/SB/01) which identified the application and only inventor A's full name and citizenship. At the same time, Judy sent by facsimile to inventor B only a copy of the declaration form, which identified the application and only inventor B's full name and citizenship. Judy then attached both signed declaration forms to the patent application and filed it with the USPTO.
- (C) Judy sent by facsimile (e.g. fax) to inventor A only a copy of the declaration form (PTO/SB/01) which identified the application and both inventors by their full names and citizenships. At the same time, Judy mailed to inventor B a copy of the application and a copy of the declaration form, which identified the application and both inventors by their full name and citizenship. Judy then attached both signed declaration forms to the patent application and filed it with the USPTO.
- (D) Judy mailed only a copy of the declaration form (PTO/SB/01), which identified the application and both inventors by their full names and citizenships, to inventor A. Judy then attached the declaration, signed only by inventor A, to the application and filed it with the USPTO.
- (E) Judy files a petition under 37 CFR 1.48 just stating that inventor B's signature could not be obtained at this time, and files a copy of the declaration form (PTO/SB/01), which identified the application and both inventors by their full names and citizenships, signed by only inventor A.

28. In accordance with proper USPTO practice and procedure, a submission for a request for continued examination does not include:

- (A) An appeal brief or reply brief (or related papers).
- (B) New arguments in support of patentability.
- (C) New evidence in support of patentability.
- (D) An amendment of the drawings.
- (E) An amendment of the claims.

29. On June 1, 2001, a redacted copy of a pending patent application is filed by the inventor, I. M. Abridged and is published pursuant to 35 U.S.C. § 122(b). J. Q. Practitioner has reason to believe that the application is still pending. J. Q. Practitioner is not an attorney or agent for I. M. Abridged. J. Q. Practitioner is entitled to see or obtain copies of which, if any, portions of the Abridged application?

- (A) J.Q. Practitioner may order only the redacted printed publication document since pending patent applications are otherwise preserved in confidence.
- (B) J.Q. Practitioner may order a copy of the redacted printed publication document, and inspect, but not copy, the file.
- (C) J.Q. Practitioner may inspect the contents of the entire patent application file and obtain copies thereof in addition to obtaining copies of the redacted application publication.
- (D) J.Q. Practitioner may inspect and obtain copies of only the redacted application and no other documents unless applicant I. M. Abridged supplied them in a redacted form.
- (E) J.Q. Practitioner may obtain a copy of the entire application and the file contents if applicant I. M. Abridged failed to submit redacted copies of those documents forming the subsequent prosecution history; otherwise, J.Q. Practitioner may obtain a copy of the redacted application including the redacted contents of the file.

30. Regarding the specification of a nonprovisional patent application, which of the following practices is in accordance with proper USPTO practice and procedure?

- (A) The specification may include tables and chemical formulas.
- (B) The specification must begin with one or more claims.
- (C) The specification may include hyperlinks or other forms of browser-executable code embedded in the text.
- (D) The specification may include graphical illustrations or flowcharts.
- (E) The specification may include a reservation for a future application of subject matter disclosed but not claimed in the application.

31. Applicant Smith filed a nonprovisional utility application on January 2, 2001 claiming the benefit of a prior provisional application filed January 3, 2000. He received a filing receipt with a projected publication date of July 5, 2001. He did not want his application to be published under the provisions of eighteen-month publication. On April 2, 2001, Applicant Smith asked you what is the best way to avoid pre-grant publication of his application with respect to proper USPTO procedure. Which of the following represents the best advice to Applicant Smith without forfeiting his patent rights if you are representing him?

- (A) File a nonpublication request that certifies that the invention disclosed in the nonprovisional application has not been and will not be the subject of an application filed in another country (or under international agreement) that requires eighteen-month publication.
- (B) File a petition to convert the nonprovisional application to a provisional application under 37 CFR 1.53(c)(2) accompanied by the petition fee, and then file a second non-provisional application with a nonpublication request that includes a proper certification, claiming the benefit of the prior provisional application under 35 U.S.C. § 119(e).
- (C) File a petition for express abandonment to avoid publication under 37 CFR 1.138(c) accompanied by the petition fee.
- (D) File (1) a continued prosecution applications under 35 U.S.C. §§ 119(e) claiming the benefit of the prior applications under 37 CFR 1.53(d) and 120 with a nonpublication request that includes a proper certification, (2) a petition for express abandonment to avoid publication under 37 CFR 1.138(c) for the application filed on January 2, 2001, and (3) the required fees.
- (E) File (1) a continuing application under 37 CFR 1.53(b) claiming the benefit of the prior applications under 35 U.S.C. §§ 119(e) and 120 with a nonpublication request that includes a proper certification, (2) a petition for express abandonment to avoid publication under 37 CFR 1.138(c) for the application filed on January 2, 2001, and (3) the required fees.

32. On behalf of your client you have appealed to the Board of Patent Appeals and Interferences a final rejection of claims in the client's patent application. To request an oral hearing for the appeal, you must in a timely manner:

- (A) show that the hearing is necessary and desirable for a proper presentation of the appeal.
- (B) telephone the Board to schedule the hearing and pay the appropriate fee.
- (C) visit the Board to schedule the hearing and pay the appropriate fee.
- (D) confer with the examiner for a date, file a written request, and pay the appropriate fee.
- (E) file a written request and pay the appropriate fee.

33. In early 1999, at the request of MC Motors, Eve demonstrated her reverse automobile heating system at a testing facility in Germany. MC Motors signs a confidentiality agreement and agrees not to disclose the invention to anyone. The test is conducted in a secluded area and the persons involved are sworn to secrecy. Unbeknownst to Eve, MC Motors installs the reverse heating system on its MC cars and begins selling its cars with the reverse heating system in the United States in September 1999. In August 2000, MC files a patent application in the United States for the reverse automobile heating system. In December 2000, Eve files a patent application claiming the automobile heating system. The examiner rejects all the claims in Eve's application based upon an MC Motors brochure advertising its cars in September 1999. Which of the following is true?

- (A) Eve is not entitled to a patent since the invention was on sale in this country, more than one year prior to the date of the application for patent in the United States.
- (B) Since the MC Motors misappropriated the invention and since Eve did not authorize the sale, the rejection may be overcome by showing that the sales by MC Motors were not authorized by Eve.
- (C) MC Motors is entitled to a patent since although it misappropriated the idea for the invention from Eve, the misappropriation was beyond the jurisdiction of the USPTO.
- (D) (A) and (C).
- (E) None of the above.

34. On June 9, 1995 you filed a nonprovisional utility patent application on behalf of your client. On May 30, 2000, you have successfully obtained allowance of the claims, and you have paid the issue fee. After further discussions with your client you discover that the client would like to amend the claims by possibly adding new claims that are fully supported by the original disclosure. The new claims would likely be allowable over the prior art in the record. Shortly after paying the issue fee, but before issuance of a patent on the application, you file a request for continued examination along with a proposed amendment and the necessary fee. No other documents are filed. Have you done all that is necessary for your request for continued examination to be granted?

- (A) Yes, since prosecution was closed and your filing date was after June 8, 1995, you can file an RCE upon submitting a request, a submission and the proper fee.
- (B) No, because after the issue fee is paid, you cannot file an RCE unless you have successfully withdrawn the case from issue by petition under 37 CFR 1.313.
- (C) Yes, because the application had not yet been abandoned.
- (D) No, because the application was not a provisional application.
- (E) Yes, because the patent had not been issued at the time the request was filed.

35. Ramone filed a nonprovisional patent application in the USPTO on November 5, 1999. A patent was granted on the application on December 5, 2000. On January 5, 2001, Ramone files an application for reissue of the patent accompanied by an amendment enlarging the scope of the claims. On February 5, 2001, Ramone also files in the USPTO a copy of the application, as amended, in compliance with the Office electronic filing system requirements. Which of the following statements is true based upon proper USPTO practice and procedure?

- (A) The copy of the reissue application as amended is subject to pre-grant publication because it was supplied to the USPTO within one month of the actual filing date of the reissue application, i.e., within one month of January 5, 2001.
- (B) The copy of the reissue application as amended is subject to pre-grant publication because it was supplied to the USPTO within fourteen months of the filing date of the issued patent, i.e., within fourteen months of November 5, 1999.
- (C) The reissue application is subject to pre-grant publication because it was not accompanied by a nonpublication request at the time of filing.
- (D) The reissue application is exempt from pre-grant publication.
- (E) The reissue application unchanged by the amendment is subject to pre-grant publication.

36. Which of the following is not in accordance with proper USPTO practice and procedure regarding design patent applications filed in March 2001?

- (A) The expedited treatment available for design applications under 37 CFR 1.155 expedites design application processing by, among other things, decreasing clerical processing time as well as the time spent routing the application between processing steps.
- (B) The “petition to make special” procedure is also available for designs and the petition fee is less than the fee for expedited examination.
- (C) To qualify for expedited examination: (1) the application must include drawings in compliance with 37 CFR 1.84; (2) the applicant must have conducted a preexamination search; and (3) the applicant must file a request for expedited examination including: (i) The appropriate fee; and (ii) a statement that a preexamination search was conducted. The statement must also indicate the field of search and include an information disclosure statement in compliance with 37 CFR 1.98.
- (D) If the design application is not effectively expedited by the Office, the fee for expediting the application will be refunded.
- (E) The Office will not examine an application that is not in condition for examination (e.g., missing basic filing fee) even if the applicant files a request for expedited examination under this section.

37. Applicant Einstein files a patent application on November 26, 1999, that claims a new type of football pads. Prosecution is conducted and the application issues as a patent to Einstein on April 3, 2001. A competitor, Weisman, who has been making and selling football pads since April of 1998, learns of Einstein's patent when Einstein approaches him on May 3, 2001, with charges of infringement of the Einstein patent. Weisman makes an appointment to see you to find out what he can do about Einstein's patent, since Weisman believes that he is the first inventor of the claimed subject matter. At your consultation on May 17, 2001, with Weisman, you discover that Weisman widely distributed printed publications containing a fully enabling disclosure of the invention and all claimed elements in the Einstein patent. Weisman used the printed publication for marketing his football pads in April of 1998. Weisman explains that he wishes to avoid litigation. Which of the following is a proper USPTO practice and procedure that is available to Weisman?

- (A) Weisman should file a petition to correct inventorship under 37 CFR 1.324 in the patent, along with a statement by Weisman that such error arose without any deceptive intention on his part, requesting that a certificate of correction be issued for the patent under 35 U.S.C. § 256, naming the correct inventive entity, Weisman.
- (B) Weisman should file a reissue application under 35 U.S.C. § 251, requesting correction of inventorship as an error in the patent that arose or occurred without deceptive intention, wherein such error is corrected by adding the inventor Weisman and deleting the inventor Einstein, as well as citing Joe Weisman's April 1998 printed publication for the football pads as evidence that Weisman is the correct inventor.
- (C) Weisman should file a prior art citation under 35 U.S.C. § 301, citing the sales in April 1998 of football pads, and explain the pertinency and manner of applying such sales to at least one claim of the Einstein patent.
- (D) Weisman should file a request for *ex parte* reexamination of the Einstein patent under 35 U.S.C. § 302, citing the April 1998 printed publication of football pads in, and explain the pertinency and manner of applying such prior art to at least one claim of the Einstein patent.
- (E) Weisman should file a request for *inter partes* reexamination of the Einstein patent under 35 U.S.C. § 311, citing public use of the football pads in April 1998, and explain the pertinency and manner of applying such prior use to at least one claim of the Einstein patent.

38. Which of the following can correct the inventorship of a patent application in accordance with proper USPTO practice and procedure?

- (A) An unexecuted nonprovisional application was filed January 3, 2001 naming Jones and Smith as inventors. Smith was named an inventor in error. A Notice to File Missing Parts of Application was mailed by the Office, that requested a surcharge and an executed oath or declaration under 37 CFR 1.63 by Jones and Smith. A registered practitioner in timely response to the Notice submitted the requested surcharge and a declaration under 37 CFR 1.63 that named only Jones as the inventor, which declaration was only executed by Jones. The registered practitioner had determined that a request to correct inventorship under 37 CFR 1.48(a) was unnecessary. No papers were submitted, by Smith, clarifying that she is not an inventor.
- (B) A nonprovisional application was filed January 3, 2001 with a declaration under 37 CFR 1.63 naming Jones and Smith as inventors, which declaration was signed only by Jones. Smith was named an inventor in error. A Notice to File Missing Parts of Application was mailed by the Office that requested a surcharge and an executed oath or declaration by Smith. A registered practitioner timely responded to the Notice by submitting the requested surcharge and a new declaration under 37 CFR 1.63 that identified Jones as the sole inventor, which declaration was executed only by Jones.
- (C) A nonprovisional application was filed February 28, 2000 that improperly named Jones as the sole inventor in a declaration under 37 CFR 1.63. Only Jones executed the declaration. Applicant need only re-file the application as a continued prosecution application naming the correct inventorship of Jones and Smith in the new application's transmittal letter.
- (D) A continuation application was filed under 37 CFR 1.53(b) using a copy of an executed declaration from the prior application for which a continuation was filed to correct the inventorship. The continuation application papers were accompanied by a request by a registered practitioner, in the continuation application transmittal paper, that Smith, named as an inventor in the prior application, be deleted as an inventor in the continuation application.
- (E) (A) and (D).

39. A nonprovisional application under 37 CFR 1.53(b) is filed with a check for the exact amount of a small entity basic filing fee. A registered practitioner's well trained legal assistant when filing the application forgot to also submit a written assertion of entitlement to small entity status that had been executed by the sole assignee who is a small entity. Which of the following is/are in accordance with proper USPTO practice and procedure?

- (A) Applicant need not supplement the initial filing with the omitted written assertion of small entity status as the payment of the small entity filing fee will suffice to accord small entity status.
- (B) If the application is allowed, applicant cannot pay the issue fee in the small entity amount unless the fee is accompanied by a written assertion of small entity status.
- (C) If after filing of the application small entity status becomes no longer appropriate, applicant may continue to pay small entity fees for newly added claims in a response to a first Office action rejection.
- (D) If the application is allowed, a registered practitioner could pay a small entity issue fee solely based on the assignee's written assertion of small entity status that was not originally submitted if the practitioner now submits it with the issue fee.
- (E) (A) and (C).

40. Claims 1 and 2 in a patent application state the following:

- Claim 1. An apparatus for sitting comprising:
- (i) a square shaped base member;
 - (ii) four elongated members mounted to the bottom of the base member;
- and
- (iii) a circular back member mounted to the base member.
- Claim 2. An apparatus as in claim 1, further comprising a spring connected to the back member and to the base member.

Which, if any, of the following claims fully supported by the specification and presented in the application, is in accordance with USPTO rules and procedure?

- (A) 3. An apparatus as in claim 1, wherein the base member is rectangularly shaped.
- (B) 3. An apparatus as in claim 2, wherein the wheels connected to each of the elongated members are plastic.
- (C) 3. An apparatus as in the preceding claims, further comprising a pressure-sensing device connected to the base member.
- (D) 3. An apparatus as in any of the preceding claims, in which the circular back member is wooden.
- (E) None of the above.

41. Which of the following USPTO practices or procedures may be properly employed to overcome a rejection properly based on 35 U.S.C. § 102(b)?

- (A) Timely perfecting a claim to priority under 35 U.S.C. § 119(a)-(d) based on a foreign application having a foreign priority filing date that antedates the reference.
- (B) Filing a declaration under 37 CFR 1.131 that antedates the cited prior art.
- (C) Timely perfecting priority under 35 U.S.C. §§ 119(e) or 120 by amending the specification of the application to contain a specific reference to a prior application having a filing date that antedates the reference.
- (D) (A) and (C).
- (E) (A), (B) and (C).

42. Regarding a power of attorney or authorization of agent in a patent application, which of the following is in accordance with proper USPTO practice and procedure?

- (A) Powers of attorney to firms submitted in applications filed in the year 2001 are recognized by the United States Patent and Trademark Office.
- (B) The associate attorney may appoint another attorney.
- (C) The filing and recording of an assignment will operate as a revocation of a power or authorization previously given.
- (D) Revocation of the power of the principal attorney or agent does not revoke powers granted by him or her to other attorneys or agents.
- (E) All notices and official letters for the patent owner or owners in a reexamination proceeding will be directed to the attorney or agent of record in the patent file at the address listed on the register of patent attorneys and agents.

43. On December 24, 2001, you were retained to file a U.S. nonprovisional patent application for inventions X, and Y. In preparing the U.S. patent application, you discovered that the same inventors filed an application for invention X in Germany on December 28, 2000 and an application for inventions X and Y in France on March 13, 2001. The German application was never published and was abandoned on July 2, 2001. What is the latest date you could file a U.S. patent application at the USPTO to properly have the right of priority for the inventions disclosed in the U.S. patent application?

- (A) December 27, 2001 (Thursday)
- (B) December 28, 2001 (Friday)
- (C) January 2, 2002 (Wednesday)
- (D) March 12, 2002 (Tuesday)
- (E) March 13, 2002 (Wednesday)

44. A U.S. patent application discloses an adhesive composition described as useful for causing a football to stick to human skin. The application discloses that the composition is made of known materials in equal amounts by weight of A and B. The application discloses that A must be at a temperature between 10 and 30 degrees Celsius, and that B can be either of known materials X or Y. The application discloses that by adding different effective amounts of known material C to the composition, the composition's stickiness or hardness can be changed. In one example, the application discloses an effective amount of material C that can be added to the composition to increase stickiness of the composition. The application also discloses in another example a different effective amount of material C that must be added to the composition to increase the composition's hardness. The effective amounts of material C used in the two examples differ, and the examples describe the effective amounts. Which of the following claims, included in the application, complies with the requirements of 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 101?

- (A) Claim 1. A process for using a composition to cause a football to stick to human skin.
- (B) Claim 2. A composition comprising equal amounts by weight of A and B, wherein A is at a temperature between 10 and 30 degrees Celsius, and B is X or Y.
- (C) Claim 3. A composition comprising equal amounts by weight of A and B, and an effective amount of C, wherein A is at a temperature between 10 and 30 degrees Celsius.
- (D) Claim 4. A composition comprising equal amounts by weight of A and B, wherein A is at a temperature between 10 and 30 degrees Celsius, preferably between 15 and 20 degrees Celsius.
- (E) Claim 5. A composition comprising equal amounts by weight of A and B and a process of using the composition to cause a football to stick to human skin.

45. An application is transmitted to the USPTO on January 12, 2001, without an oath or declaration by any of the inventors. Which of the following, prior to the filing of an oath or declaration, may properly change the address to which the Office will direct all notices, official letters, and other communications relating to the application?

- (A) A registered practitioner that filed the application.
- (B) Any registered practitioner named in the transmittal papers accompanying the original application, if the application was filed by a registered practitioner.
- (C) One inventor who solely filed the application, where two inventors are named in the transmittal papers accompanying the original application.
- (D) (A), (B), and (C).
- (E) (A) and (B).

46. Which of the following is/are information which the USPTO may require an attorney of record in a reissue application to submit in a reply to a first Office action dated April 12, 2001?

- (A) Information used in invention process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.
- (B) The publication date of an undated document mentioned by applicant which may qualify as printed publication prior art.
- (C) Comments on a new decision by the Federal Circuit that appears on point in the examination of the application.
- (D) (A), (B), and (C).
- (E) None of the above.

47. Practitioner prepared a patent application containing a table of 52 pages and a computer program listing of 360 lines (up to 72 characters per line). The application is sent via the U.S. Mail to the USPTO. Which of the following identifies the proper submission using electronic media in accordance with USPTO rules and procedure?

- (A) The computer program listing must be submitted on a duplicate set of compact discs, while the table may be submitted on a duplicate set of compact discs.
- (B) The computer program listing may be submitted on a magnetic floppy disc and the rest of the application must be submitted on paper.
- (C) The computer program listing and the table may be submitted on a magnetic floppy disc, magnetic tape or paper.
- (D) The table must be submitted, and optionally the computer program listing may be submitted, on either magnetic floppy disc, compact disc, magnetic tape.
- (E) The entire application may be sent on a single copy of a compact disc.

48. On March 29, 2002, you received a Notice of Allowability (PTO-37) and Notice of Allowance (PTOL-85) on the first application that you filed as a registered practitioner. The Notice of Allowability and the Notice of Allowance were dated March 26, 2002, and mailed from the USPTO on March 26, 2002. Each notice set a three month period for reply. The Notice of Allowability indicated that new drawings were required to incorporate the proposed drawing correction you filed with your reply to the final Office action. The Notice of Allowance indicated that you must pay the issue fee and publication fee. What is the latest date you could file new drawings to prevent the abandonment of the application?

- (A) June 25, 2002 (Tuesday).
- (B) June 26, 2002 (Wednesday).
- (C) July 29, 2002 (Monday), with a petition for a one-month extension of time.
- (D) August 26, 2002 (Monday), with a petition for a two-month extension of time.
- (E) September 25, 2002 (Wednesday), with a petition for a three-month extension of time.

49. On January 2, 2001, Mr. Star filed a patent application naming Mr. Stripe, Ms. Ross and Mr. Flag as joint inventors using the Express Mail service of the United States Post Office. The filing fee was included with the application on filing. The application that was filed on January 2, 2001 was not filed with an executed declaration, but the transmittal letter for the application clearly identified Stripe, Ross and Flag as joint inventors. On February 15, 2001, a "Notice to File Missing Parts of Application" was mailed, requiring an executed oath or declaration, and a surcharge for their late filing. Star mailed a copy of a blank declaration naming Stripe, Ross and Flag as joint inventors and a copy of the application papers (specification, claims and drawings) to each named inventor. Ross and Flag contact Star and inform him that Stripe was not an inventor. Stripe does not reply and Star is unable to reach Mr. Stripe. Star investigates the matter, and determines that the correct inventorship is Ross and Flag. Which of the following should be filed in reply to the Notice, together with a surcharge?

- (A) A declaration under 37 CFR 1.63 that names Stripe, Ross, and Flag as inventors, and is signed by Ross and Flag.
- (B) A request to delete Mr. Stripe as an inventor under 37 CFR 1.48 and an executed declaration signed by Ross and Flag.
- (C) A petition under 37 CFR 1.47 to accept a declaration under 37 CFR 1.63 signed by Ross and Flag, but without the signature of Stripe.
- (D) A declaration under 37 CFR 1.63 that names only Ross and Flag as inventors, and is signed by Ross and Flag.
- (E) A request to hold the requirements of the notice in abeyance pending further inquiry into the inventorship.

50. Regarding claims, which of the following practices is not in accordance with proper USPTO practice and procedure?

- (A) A singular dependent claim 2 could read as follows:
2. The product of claim 1 in which...
- (B) An application may contain a series of singular dependent claims in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.
- (C) A dependent claim may refer back to any preceding independent claim.
- (D) A claim which depends from a dependent claim may be separated therefrom by any claim which does not also depend directly or indirectly from said "dependent claim."
- (E) Each claim begins with a capital letter and ends with a period.

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**UNITED STATES PATENT AND TRADEMARK OFFICE
REGISTRATION EXAMINATION
FOR PATENT ATTORNEYS AND AGENTS**

OCTOBER 16, 2002

Morning Session (50 Points)

Time: 3 Hours

DIRECTIONS

This session of the examination is an open book examination. You may use books, notes, or other written materials that you believe will be of help to you *except* you may not use prior registration examination questions and/or answers. Books, notes or other written materials containing prior registration examination questions and/or answers *cannot* be brought into or used in the room where this examination is being administered. If you have such materials, you must give them to the test administrator before this session of the examination begins.

All questions must be answered in SECTION 1 of the Answer Sheet which is provided to you by the test administrator. You must use a No. 2 pencil (or softer) lead pencil to record your answers on the Answer Sheet. Darken *completely* the circle corresponding to your answer. You must keep your mark within the circle. Erase *completely* all marks except your answer. Stray marks may be counted as answers. No points will be awarded for incorrect answers or unanswered questions. Questions answered by darkening more than one circle will be considered as being incorrectly answered.

This session of the examination consists of fifty (50) multiple choice questions, each worth one (1) point. Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the *Official Gazette*, or a notice in the *Federal Register*. Each question has only one most correct answer. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer that will be accepted. Where two or more choices are correct, the most correct answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement that would make the statement *true*. If it is determined by the USPTO that there is more than one most correct answer to a question, each most correct answer will be accepted, but only one point will be given for the question. The presence of multiple most correct answers does not, in itself, render the question ambiguous. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

You may write anywhere on the examination booklet. However, do not remove any pages from the booklet. Only answers recorded in SECTION 1 of your Answer Sheet will be graded. YOUR COMBINED SCORE OF BOTH THE MORNING AND AFTERNOON SESSIONS MUST BE AT LEAST 70 POINTS TO PASS THE REGISTRATION EXAMINATION.

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO

1. In accordance with the MPEP and USPTO rules and procedure, an application for patent may be made on behalf of a joint inventor in certain situations. Who, by petition, may make application on behalf of a joint inventor who has refused to sign the application (“nonsigning inventor”), if the other joint inventor (“signing inventor”) executes the application?

- (A) A person other than the signing inventor, to whom the nonsigning inventor has assigned the invention.
- (B) A person other than the signing inventor, with whom the nonsigning inventor has agreed in writing to assign the invention.
- (C) The signing inventor.
- (D) A person other than the signing inventor, who shows a strong proprietary interest in the invention.
- (E) All of the above.

2. To satisfy the written description requirement of the first paragraph of 35 USC 112, an applicant must show possession of the invention. An applicant’s lack of possession of the invention may be evidenced by:

- (A) Describing an actual reduction to practice of the claimed invention.
- (B) Describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.
- (C) Requiring an essential feature in the original claims, where the feature is not described in the specification or the claims, and is not conventional in the art or known to one of ordinary skill in the art.
- (D) Amending a claim to add a limitation that is supported in the specification through implicit or inherent disclosure.
- (E) Amending a claim to correct an obvious error by the appropriate correction.

3. Which of the following is not in accordance with the recommended format for a claim set forth in the provisions of the MPEP?

- (A) Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation.
- (B) A claim may include plural indentations to further segregate subcombinations or related steps.
- (C) The claim or claims must commence on a separate sheet after the detailed description of the invention.
- (D) Each claim should end with a period.
- (E) A claim should always begin with “A”, “An” or “In.”

4. An application as originally filed contains the following Claim 1:

Claim 1. A doughnut making machine comprising:

- (i) an input conveyor that receives dough to be used in making said doughnuts; means for portioning dough from said input conveyor into a plurality of dough balls, each of said plurality of balls containing dough sufficient to create a single doughnut;
- (ii) means for forming each of said dough balls into a ring of dough;
- (iii) a deep fat fryer which receives rings of dough from said forming means and cooks said rings of dough;
- (iv) means for selectively applying a flavored coating on cooked rings of dough to produce doughnuts; and
- (v) means for placing a plurality of said doughnuts on a flat sheet.

The specification adequately describes the claimed subject matter. Two different “means for selectively applying” are described in the specification: a sprayer and a brush. Which of the following original claims is an improper dependent claim?

- (A) Claim 2. The doughnut making machine of Claim 1, wherein said placing means is a conveyor that extends from said applying means to said flat sheet.
- (B) Claim 3. The doughnut making machine of Claim 1, wherein said forming means includes a cutter that removes a center portion of each of said dough balls to form a ring of dough.
- (C) Claim 4. The doughnut making machine of Claim 1, wherein said applying means includes a sprayer which receives a sugar based flavored coating, wherein said sugar based flavored coating is sprayed on said cooked rings of dough.
- (D) Claim 5. The doughnut making machine of Claim 1, wherein said applying means is a sprayer.
- (E) Claim 6. The doughnut making machine of Claim 1, wherein said applying means is omitted for making plain doughnuts.

5. Where a final rejection of claims has been made, any question of prematurity of the final rejection should be raised, if at all:

- (A) as a ground of appeal.
- (B) as the basis of a complaint before the Board of Patent Appeals and Interferences.
- (C) by petition under 37 CFR 1.181 while the application is pending before the examiner.
- (D) after 2 months from the examiner’s answer plus mail room time, if no reply brief has been timely filed during an appeal to the Board of Patent Appeals and Interferences.
- (E) after a supplemental examiner’s answer, pursuant to a remand from the Board of Patent Appeals and Interferences has been mailed.

6. According to USPTO rules and procedure, which of the following can be overcome by an affidavit under 37 CFR 1.131?

- (A) A rejection properly based on statutory double patenting.
- (B) A rejection properly made under 35 USC 102(d) based on a foreign patent granted in a non-WTO country.
- (C) A rejection properly made under 35 USC 102(a) based on a journal article dated one month prior to the effective filing date of the U.S. patent application. Applicant has clearly admitted on the record during the prosecution of the application that subject matter in the journal article relied on by the examiner is prior art.
- (D) A rejection properly made under 35 USC 102(b) based on a U.S. patent that issued 18 months before the effective filing date of the application. The patent discloses, but does not claim, the invention.
- (E) None of the above.

7. Paul, a registered patent practitioner and counsel for Superior Aircraft, Inc. ("Superior"), filed a patent application naming chief engineer Davis as sole inventor, and claiming a titanium and aluminum alloy designed for use in advanced gas turbine engines in aircraft. The application described the alloy as having unexpectedly excellent and improved room temperature ductility. The application was filed with an assignment document transferring all right, title and interest in the application to Superior. During prosecution of the application, the examiner had an interview with Paul and Davis of Superior. The examiner noted the existence of a prior art publication that disclosed test data demonstrating that the claimed alloys exhibited poor room temperature ductility, and stated that he had personal knowledge that the alloy was old and well known. Davis agreed with the examiner, and stated that such information was "old hat," but that they overcame the ductility problem by simply resorting to a 3-step process of microstructure refinement. Paul concurred and pointed to the fact that not only had they disclosed the process in the application, but that microstructure refinement of alloys to improve ductility was so well-known that the technique was even taught in metallurgy courses in college. Which of the following statements is false?

- (A) The examiner may reject the alloy claims on the basis of the prior art publication.
- (B) The examiner may not reject the alloy claims on the basis of the prior art publication, because the alloys of the application are characterized by unexpected, improved ductility properties.
- (C) The examiner may rely upon the chief engineer's statement as an admission against patentability.
- (D) The examiner may rely upon the patent counsel's statement as an admission against patentability.
- (E) The examiner, having facts within his or her personal knowledge, may rely on the facts in rejecting the alloy claims.

8. The MPEP and USPTO rules and procedure provide for ways that a nonstatutory double patenting rejection can be overcome. Which of the following is an effective way to overcome a nonstatutory double patenting rejection?

- (A) Filing a 37 CFR 1.131 affidavit to swear behind the patent on which the rejection is based.
- (B) Filing a terminal disclaimer under 37 CFR 1.321(c).
- (C) Filing a 37 CFR 1.131 affidavit arguing that the claims are for different inventions that are not patentably distinct.
- (D) Filing a reply arguing that there is only one common inventor regarding the claims of the application and the claims of the patent.
- (E) All of the above.

9. Which of the following is not in accordance with the provisions of the MPEP?

- (A) The title of the invention should be placed at the top of the first page of the specification unless it is provided in the application data sheet.
- (B) The title need not be technically accurate, but should be descriptive and should contain fewer than 10 words.
- (C) Inasmuch as the words “improved,” “improvement of,” and “improvement in” are not considered as part of the title of an invention, these words should not be included at the beginning of the title of the invention and will be deleted when the Office enters the title into the Office’s computer records, and when any patent issues.
- (D) If a satisfactory title is not supplied by the applicant the examiner may, at the time of allowance, change the title by examiner’s amendment. If the change to the title is the only change being made by the examiner at the time of allowance, a separate examiner’s amendment need not be prepared and the examiner is to indicate the change in title in the file.
- (E) A title in a U.S. application need not be identical to the corresponding foreign filed application.

10. In accordance with proper USPTO practice and procedure, a submission for a request for continued examination does not include:

- (A) An amendment of the drawings.
- (B) New arguments in support of patentability.
- (C) New evidence in support of patentability.
- (D) An appeal brief or reply brief (or related papers).
- (E) An amendment of the claims.

11. In accordance with MPEP § 1500, relating to design patent applications:

- (A) the invention may be properly represented in a single application by both an ink drawing and a black and white photograph.
- (B) the invention may be properly represented in a single application by a black and white photograph disclosing environmental structure by broken lines, in lieu of an ink drawing if the invention is shown more clearly in the photograph.
- (C) the invention may be properly represented in a single application by both an ink drawing and a color photograph, and the application should be accompanied by the required petition, fee, three sets of color photographs, and an amendment to the specification.
- (D) the invention may be properly represented by a color photograph disclosing environmental structure by broken lines, in lieu of an ink drawing if the invention is not capable of being illustrated in an ink drawing.
- (E) the invention may be properly represented by a color photograph if the invention is not capable of being illustrated in an ink drawing, and if the application is accompanied by the required petition, fee, and an amendment to the specification is presented to insert required language regarding the color photographs, and three sets of color photographs.

12. Inventor A filed a patent application and assigned the entire interest in the application to his employer, MegaCorp. The application issued as a utility patent on July 9, 2002. In June 2004, MegaCorp's management first learns that a second inventor, Inventor B, should have been named as a co-inventor with respect to at least one claim of the issued patent. There was no deceptive intent in failing to name Inventor B in the original application. Inventor A, who is unfamiliar with patent law and concepts of inventorship, incorrectly believes that he should be the sole named inventor on the patent, and refuses to cooperate with any effort by MegaCorp to change the named inventive entity. The issued patent contains no other error. In accordance with the Manual of Patent Examining Procedure, which of the following procedures is/are available for MegaCorp to seek correction of the named inventive entity without any agreement, cooperation or action from Inventor A?

- (A) File, on or before July 9, 2004, a reissue application, made by MegaCorp only, that seeks to add Inventor B.
- (B) File, after July 9, 2004, a reissue application, made by MegaCorp only, that seeks to add Inventor B.
- (C) Request a Certificate of Correction to add Inventor B as a named inventor.
- (D) Submit in the issued patent file: a Request for Correction of Inventorship Under the Provisions of 37 CFR 1.48 that sets forth the desired inventorship change; a statement by Inventor B that the error in inventorship occurred without deceptive intention on her part; an oath or declaration executed by Inventor B; all required fees; and the written consent of MegaCorp.
- (E) A and B are each available procedures.

13. Which of the following statements concerning reliance by an examiner on common knowledge in the art, in a rejection under 35 USC 103 is correct?

- I. An examiner's statement of common knowledge in the art is taken as admitted prior art, if applicant does not seasonably traverse the well known statement during examination.
- II. Applicant can traverse an examiner's statement of common knowledge in the art, at any time during the prosecution of an application to properly rebut the statement.
- III. If applicant rebuts an examiner's statement of common knowledge in the art in the next reply after the Office action in which the statement was made, the examiner can never provide a reference to support the statement of common knowledge in the next Office action and make the next Office action final.

- (A) I.
- (B) II.
- (C) III.
- (D) I and II.
- (E) None of the above.

14. Claims in your client's patent application have been rejected as unpatentable over prior art. In accordance with proper USPTO practice and procedure, which, if any, of the following statements is true?

- (A) The prior art is a U.S. patent issued five years before the effective date of your client's application. The claims are properly rejected under 35 USC 102(b) of the disclosure in the patent that anticipates the claimed invention. Evidence of secondary considerations, such as unexpected results or commercial success, is relevant to the rejection and thus can overcome the rejection.
- (B) The prior art is a U.S. patent issued five years before the effective date of your client's application. The claims are properly rejected under 35 USC 102(b) over the disclosure in the patent that anticipates the claimed invention. The rejection can be overcome by arguing that the alleged anticipatory prior art is "nonanalogous art."
- (C) The prior art is a U.S. patent issued five years before the effective date of your client's application. The claims are properly rejected under 35 USC 102(b) over the disclosure in the patent that anticipates the claimed invention. The rejection can be overcome by arguing that the alleged anticipatory prior art teaches away from the invention.
- (D) The prior art is a U.S. patent issued five years before the effective date of your client's application. The claims are properly rejected under 35 USC 102(b) over the disclosure in the patent that anticipates the claimed invention. The rejection can be overcome by arguing that the alleged anticipatory prior art is not recognized as solving the problem solved by the claimed invention.
- (E) None of the above.

15. The MPEP and USPTO rules and procedure provide for ways that a statutory double patenting rejection can be overcome. Which of the following is an effective way to overcome a statutory double patenting rejection?

- (A) Filing a 37 CFR 1.31 affidavit to swear behind the patent on which the rejection is based.
- (B) Filing a terminal disclaimer under 37 CFR 1.321(c).
- (C) Filing a 37 CFR 1.131 affidavit and arguing that the conflicting claims are coextensive in scope.
- (D) Amending the conflicting claims so that they are not coextensive in scope.
- (E) All of the above.

16. Applicant received a final rejection dated and mailed Wednesday, February 28, 2001. The final rejection set a three month shortened statutory period for reply. In reply, applicant filed an amendment on Wednesday, March 21, 2001. In the amendment, applicant requested that block diagrams, figures 32-34, be amended by inserting the term - computer- - in place of [CPU] in block "2" of each block diagram. Applicant further supplied a clean version of the entire set of pending claims. Applicant did not provide the proposed changes to the drawings on separate sheets marked in red nor did the applicant supply a marked-up version of any claim. The examiner upon receipt and review of the amendment discovered that the applicant made changes to pending claims 2 and 15 and that the applicant added claims 21-25 to the application. The examiner in an Advisory Action notifies the applicant that the amendment fails to comply with the requirements of 37 CFR 1.121. Which of the following answers is most correct?

- (A) Applicant is given a time period of one month or thirty days from the mailing date of the Advisory Action, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. This time period is in addition to any remaining period of time set in the final rejection.
- (B) Applicant may not provide a clean version of the entire set of pending claims because the applicant may only consolidate all previous versions of pending claims into a single clean version in an amendment after a non-final Office action.
- (C) Applicant must submit the proposed changes to figures 32-34 on a separate paper showing the proposed changes in red and a marked up version of new claims 21-25 as required by 37 CFR 1.121(c).
- (D) Applicant should request reconsideration by the examiner, pointing out that the Final Rejection was mailed on February 28, 2001, which precedes the March 1, 2001 effective date of the changes to patent rule 37 CFR 1.121.
- (E) Applicant must submit the changes to figures 32-34 on separate paper showing the proposed changes in red and a marked up version of rewritten claims 2 and 15 showing all changes (relative to the previous version of claims 2 and 15) shown by any conventional marking system as required by 37 CFR 1.121(c). Applicant should also indicate the status of claims 2 and 15, e.g. "amended," "twice amended," etc. on both the clean version of the claims and the marked up version.

17. Which of the following statements is true?

- (A) In the context of 35 USC 102(b), a magazine need only be placed in the mail to be effective as a printed publication.
- (B) The earliest date declassified printed material may be taken as *prima facie* evidence of prior knowledge under 35 USC 102(a) is as of the date the material is cataloged and placed on the shelf of a public library.
- (C) Declassified printed material is effective as a printed publication under 35 USC 102(b) as of the date of its release following declassification.
- (D) The American Inventors Protection Act (AIPA) amended 35 USC 102(e) to provide that U.S. patents, U.S. application publications, and certain international application publications can be used as prior art under 35 USC 102(e) based on their earliest effective filing date only against applications filed on or after November 29, 2000.
- (E) The American Inventors Protection Act (AIPA) amended 35 USC 102(e) to provide that U.S. patents, U.S. application publications, and certain international application publications can be used as prior art under 35 USC 102(e) based on their earliest effective filing date only against applications filed prior to November 29, 2000 which have been voluntarily published.

18. While traveling through Germany (a WTO member country) in December 1999, Thomas (a Canadian citizen) conceived of binoculars for use in bird watching. The binoculars included a pattern recognition device that recognized birds and would display pertinent information on a display. Upon Thomas' return to Canada (a NAFTA country) in January 2000, he enlisted his brothers Joseph and Roland to help him market the product under the tradename "Birdoculars." On February 1, 2000, without Thomas' knowledge or permission, Joseph anonymously published a promotional article written by Thomas and fully disclosing how the Birdoculars were made and used. The promotional article was published in the Saskatoon Times, a regional Canadian magazine that is also widely distributed in the United States. Thomas first reduced the Birdoculars to practice on March 17, 2000 in Canada. A United States patent application properly naming Thomas as the sole inventor was filed September 17, 2000. That application has now been rejected as being anticipated by the Saskatoon Times article. Which of the following statements is most correct?

- (A) Thomas can rely on his activities in Canada in establishing a date of invention prior to publication of the Saskatoon Times article.
- (B) In a priority contest against another inventor, Thomas can rely on his activities in Canada in establishing a date of invention.
- (C) In a priority contest against another inventor, Thomas can rely on his activities in Germany in establishing a date of invention.
- (D) Statements (A) and (B) are correct, but statement (C) is incorrect.
- (E) Statements (A), (B), and (C) are each correct.

19. Which of the following is not in accordance with the provisions of the MPEP Chapter 600?

- (A) A request for a refund must be filed within two years from the date the fee was paid or, in the case of a fee paid by mistake, within one year from the time the error was discovered.
- (B) A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid, including an application, an appeal or a request for an oral hearing, will not entitle a party to a refund of such fee.
- (C) The Office will not refund amounts of twenty-five dollars or less, unless a refund is specifically requested.
- (D) Any refund of a fee paid by credit card will be by a credit to the credit card account to which the fee was charged.
- (E) When a fee is paid where no fee is required, this is considered to be a fee paid by mistake.

20. There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is “undue.” Which of the following are among the factors for determining whether necessary experimentation is “undue”?

- (A) The breadth of the claims.
- (B) The nature of the invention.
- (C) The state of the prior art.
- (D) The level of one of ordinary skill.
- (E) (A), (B), (C) and (D).

21. Which of the following documents is not open to public inspection?

- (A) The abandoned parent application of a divisional application. A patent was granted on the divisional application, which refers to the abandoned parent application.
- (B) Assignment document relating to both an issued patent and a patent application not published under 35 USC 122(b).
- (C) Assignment document relating to a pending reissue application.
- (D) Copy of assignment record relating to both a pending patent application and an abandoned patent application not published under 35 USC 122(b).
- (E) Assignment document relating to both an abandoned patent application not published under 35 USC 122(b) and a pending reissue application.

22. Which of the following is not in accordance with provisions of the MPEP?
- (A) In return for a patent, the inventor gives a complete disclosure of the invention for which protection is sought.
 - (B) Amendments filed after the filing date that lack descriptive basis in the original disclosure involve new matter.
 - (C) If during the course of examination of a patent application, an examiner notes the use of language that could be deemed offensive to any race, religion, sex, ethnic group, or nationality, he or she should object to the use of the language as failing to comply with the Rules of Practice.
 - (D) The examiner should object to application drawings that include depictions or caricatures that might reasonably be considered offensive to any race, religion, sex, ethnic group or nationality.
 - (E) Where an amendment is filed with a patent application that has no signed oath or declaration, a subsequently filed oath or declaration must refer to both the application and amendment, but in any case the amendment will not be considered as part of the original disclosure and will be treated as new matter.
23. Which of the following is the best way to recite a claim limitation so that it will be interpreted by the examiner in accordance with 35 USC 112, paragraph 6?
- (A) dot matrix printer for printing indicia on a first surface of a label.
 - (B) dot matrix printer means coupled to a computer.
 - (C) means for printing indicia on a first surface of a label.
 - (D) printer station for printing indicia on a first surface of a label.
 - (E) All of the above.
24. Which of the following is not in accordance with Office practice under 35 USC 42?
- (A) The Director may refund any fee paid by mistake or any amount paid in excess of that required.
 - (B) A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent for which the fee was paid, including an application, an appeal or a request for an oral hearing, will not entitle a party to a refund of such fee.
 - (C) Even if an applicant specifically requests a refund, the Office will not refund amounts of twenty-five dollars or less.
 - (D) Any refund of fee paid by credit card will be by a credit to the credit card account to which the fee was charged.
 - (E) If an applicant mistakenly files an application, the filing fee is not considered a fee paid by mistake.

25. If a *prima facie* case of obviousness is properly established by a primary examiner, how can an applicant effectively rebut the rejection in accordance with proper USPTO practice and procedure?

- (A) Rebuttal may be by way of arguments of counsel used in place of factually supported objective evidence to rebut the *prima facie* case.
- (B) Rebuttal may be by way of an affidavit or declaration under 37 CFR 1.132 containing objective evidence arising out of a secondary consideration related to the claimed invention.
- (C) No substantive showing is required by applicant. The burden remains on the examiner to maintain a *prima facie* case.
- (D) Rebuttal evidence must be found elsewhere than in the specification.
- (E) Rebuttal may be by way of arguing that the prior art did not recognize latent properties.

26. Which of the following is not in accordance with the recommended form for an abstract of the disclosure as provided for in the MPEP?

- (A) A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains.
- (B) If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure.
- (C) If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement.
- (D) In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or a use thereof.
- (E) The abstract should compare the invention with the prior art.

27. Office policy has consistently been to follow *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), in the consideration and determination of obviousness under 35 USC 103. Each of the following are the four factual inquiries enunciated therein as a background for determining obviousness except:

- (A) Determining the scope and contents of the prior art.
- (B) Resolving any issue of indefiniteness in favor of clarity.
- (C) Ascertaining the differences between the prior art and the claims in issue.
- (D) Resolving the level of ordinary skill in the pertinent art.
- (E) Evaluating evidence of secondary considerations.

The following facts apply to Questions 28 and 29.

Claims 1 and 2, fully disclosed and supported in the specification of a patent application having an effective filing date of March 15, 2000, for sole inventor Ted, state the following:

Claim 1. An apparatus intended to be used for aerating water in a fish tank, comprising:

- (i) an oxygen source connected to a tube, and
- (ii) a valve connected to the tube.

Claim 2. An apparatus as in claim 1, further comprising an oxygen sensor connected to the valve.

28. Which of the following claims, if fully disclosed and supported in the specification, and included in the application, provides a proper basis for an objection under 37 CFR 1.75(c)?

- (A) Claim 3. An apparatus as in any one of the preceding claims, in which the tube is plastic.
- (B) Claim 3. An apparatus according to claims 1 or 2, further comprising a temperature sensor connected to the valve.
- (C) Claim 3. An apparatus as in the preceding claims, in which the tube is plastic.
- (D) Claim 3. An apparatus as in any preceding claim, in which the tube is plastic.
- (E) Claim 3. An apparatus as in either claim 1 or claim 2, further comprising a temperature sensor connected to the valve.

29. Which of the following, if relied on by an examiner in a rejection of claim 2, can be a statutory bar under 35 USC 102 of claim 2?

- (A) A U.S. patent to John, issued February 2, 1999, that discloses and claims an apparatus intended to be used for aerating ice cream, having an oxygen source connected to a tube, a valve connected to the tube, and a battery coupled to the oxygen source.
- (B) A U.S. patent to John, issued April 6, 1999, that discloses and claims an apparatus intended to be used for aerating water in a fish tank, having an oxygen source connected to a tube, a valve connected to the tube, and an oxygen sensor connected to the tube.
- (C) A U.S. patent to Ned, issued February 9, 1999, that discloses, but does not claim, an apparatus intended to be used for aerating ice cream, having an oxygen source connected to a tube, a valve connected to the tube, an oxygen sensor connected to the valve, and a battery coupled to the oxygen source.
- (D) A foreign patent to Ted issued April 12, 2000, on an application filed on March 12, 1997. The foreign patent discloses and claims an apparatus intended to be used for aerating water in a fish tank, having an oxygen source connected to a tube, a valve connected to the tube, and an oxygen sensor connected to the tube.
- (E) None of the above.

30. In accordance with the MPEP, and USPTO rules and procedure, a patent application may be made by someone other than the inventor in certain situations. In which of the following situations would an application not be properly made by someone other than the inventor?

- (A) The inventor is deceased, and the application is made by the legal representative of the deceased inventor.
- (B) The inventor is deceased, and the application is made by one who has reason to believe that he or she will be appointed legal representative of the deceased inventor.
- (C) The inventor is a minor (under age 18) who understands and is willing to execute the declaration, but the application is made by the minor's legal representative.
- (D) The inventor is insane, and the application is made by the legal representative of the insane inventor.
- (E) The inventor is legally incapacitated, and the application is made by the legal representative of the legally incapacitated inventor.

31. Assuming that each of the following claims is in a separate application, and there is no preceding multiple dependent claim in any of the applications, which claim is in acceptable multiple dependent claim form?

- (A) Claim 8. A machine according to any one of the preceding claims wherein...
- (B) Claim 5. A device as in one of claims 1-4, wherein...
- (C) Claim 10. A device as in any of claims 1-4 or 6-9, in which...
- (D) Claim 4. A machine according to claim 2 or 3, also comprising...
- (E) The claim form in (A), (B), (C) and (D) is acceptable.

32. A product-by-process claim is properly rejected over a reference under 35 USC 102(b). Which of the following statements is incorrect?

- (A) There is no anticipation unless each of the process steps recited in the claim is disclosed or inherent in the applied reference.
- (B) If the applied reference reasonably indicates that a product disclosed therein is the same or substantially the same as the claimed product, the burden shifts to the applicant to provide evidence to the contrary.
- (C) The rejection cannot be overcome by evidence of unexpected results.
- (D) The rejection can be overcome by evidence that the product in the reference does not necessarily or inherently possess a characteristic of the applicant's claimed product.
- (E) An affidavit or declaration under 37 CFR 1.131 cannot overcome a proper rejection under 35 USC 102(b) over a reference.

33. Xavier files a complete first reply exactly 2 months after the mailing date of a final Office action which sets a 3 month shortened statutory period for reply. An Examiner's Amendment is necessary for the purpose of placing the application in condition for allowance. Which of the following statements is true?

- (A) If the Examiner's Amendment is mailed exactly 5 months after Xavier's reply, the application will be allowed.
- (B) The Examiner's Amendment must be made within the 3 month shortened statutory period of the final Office action to avoid abandonment of the application.
- (C) If the Examiner's Amendment is made exactly 4 months after Xavier's reply, the application will be allowed.
- (D) The Examiner's Amendment may be made at any time within 6 months of Xavier's reply to avoid abandonment.
- (E) Abandonment of the application will be avoided if Xavier accompanies his reply with a request for extension of time accompanied by the proper fee and the Examiner's Amendment is made within 6 months of Xavier's reply.

34. Jane files a nonprovisional application with the USPTO containing at least one drawing figure under 35 USC 113 (first sentence) and at least one claim. Subsequently, Jane receives a "Notice of Omitted Items" from the USPTO indicating that the application which Jane filed lacks page 5 of the specification. Assuming that the application without page 5 satisfies 35 USC 112, which of the following statements is true based on proper USPTO practice and procedure?

- (A) If Jane is willing to accept the application as filed, she need not respond to the Notice, and the Office will accord the filing date of the original application. Jane will need to file an amendment renumbering the pages consecutively and canceling incomplete sentences caused by the missing page 5.
- (B) Jane must promptly submit the omitted page and accept an application filing date as of the date of submission of the omitted page.
- (C) Jane must promptly submit the omitted page and will be accorded a filing date as of the date of filing the original application.
- (D) Within 3 months of the Notice date, Jane must file an affidavit asserting that page 5 was in fact deposited in the USPTO with the original application. Jane will be accorded the filing date of the original application.
- (E) Within 3 months of the Notice date, Jane must file a proper petition asserting that page 5 was in fact deposited in the USPTO with the original application, accompanied by the proper petition fee and evidence that page 5 was in fact deposited as alleged. Jane will be accorded the original filing date of the application.

35. Where subject matter for which there is an enabling disclosure, but is not shown in the drawing or described in the detailed description preceding the claim(s), which of the following is not in accordance with the provisions of the MPEP?

- (A) In establishing a disclosure, applicant may rely not only on the description and drawing as filed but also on the original claims to show compliance with the first paragraph of 35 USC 112.
- (B) Where subject matter not shown in the drawing or described in the description is claimed in the application as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits, and the applicant should be required to amend the drawing and description to show this subject matter.
- (C) If subject matter appearing in the original claim is not found in the drawing or detailed description, the claim should be rejected for noncompliance with the first paragraph of 35 USC 112.
- (D) If the subject matter found in the claim is lacking in the drawing or detailed description, it is the drawing and description that are defective, not the claim.
- (E) The subject matter found in the original claims, but lacking in the drawing or detailed description, must be sufficiently specific and detailed to support an amendment of the drawing and detailed description.

36. A patent application filed in the USPTO contains the following dependent claim:

Claim 2. The method of Claim 1, further consisting of the step of cooling the mixture to a temperature of 32° F.

Following proper USPTO practices and procedures, from which of the following claims does Claim 2 not properly depend?

- (A) Claim 1. A method of making liquid compound A consisting of the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (B) Claim 1. A method of making liquid compound A comprising the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (C) Claim 1. A method of making liquid compound A including the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (D) Claim 1. A method of making liquid compound A characterized by the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (E) (C) and (D).

37. Which of the following is not in accordance with the provisions of the MPEP regarding an abstract of the disclosure?

- (A) The abstract of the disclosure has been interpreted to be a part of the specification for the purpose of compliance with paragraph 1 of 35 USC 112.
- (B) Any submission of a new abstract of the disclosure or amendment to an existing abstract should be carefully reviewed for introduction of new matter.
- (C) If an application is otherwise in condition for allowance except that the abstract of the disclosure does not comply with the guidelines, the examiner generally cannot make any necessary revisions by examiner's amendment, but should instead issue an *Ex parte Quayle* action requiring applicant to make the necessary revisions.
- (D) Under current practice, in all instances where the application contains an abstract of the disclosure when sent to issue, the abstract will be printed on the patent.
- (E) The content of a patent abstract should be such as to enable the reader thereof, regardless of his or her degree of familiarity with patent documents, to ascertain quickly the character of the subject matter covered by the technical disclosure and should include that which is new in the art to which the invention pertains.

38. Applicant files an application claiming a nutritional supplement comprising ingredients (1) through (9) on September 6, 2001. The examiner's search on November 12, 2001 retrieved several documents, each of which provides an enabling disclosure of a nutritional supplement comprising ingredients (1) through (9). Which of the following documents retrieved by the examiner may be properly used by the examiner to reject applicant's claims under 35 USC 102(b)?

- (A) An advertisement in the September 2000 issue of Dieticians and Nutritionists Health Weekly where the examiner is not able to determine the actual date of publication.
- (B) A printout on November 12, 2001 by the examiner of a MEDLINE database abstract 123456 of an article by Food et al., "Nutritional supplements for infants," published in Azerbaijan Pediatrics, Vol. 33, No. 8, pp. 33-37 (September 2000). The printout does not include the date on which the MEDLINE abstract was publicly posted.
- (C) A printout, on November 12, 2001 by the examiner, of a product brochure from the Internet website of PRO-BIOTICS VITAMIN CORP. The examiner determines that the brochure was posted on September 7, 2000 on the website.
- (D) A Japanese patent application published on September 1, 2000.
- (E) All of the above.

39. Which of the following is not in accordance with the provisions in the MPEP?
- (A) A continuation-in-part is an application filed during the lifetime of an earlier nonprovisional application by the same applicant, which repeat either some substantial portion or all of the earlier nonprovisional application, and adds matter not disclosed in the said earlier nonprovisional application.
 - (B) A continuation-in-part application may only be filed under 37 CFR 1.53(b).
 - (C) A continuation-in-part application cannot be filed as a continued prosecution application (CPA) under 37 CFR 1.53(d).
 - (D) An application claiming the benefits of a provisional application under 35 USC 119(e) should not be called a “continuation-in-part” of the provisional application.
 - (E) One of the formal requirements of 35 USC 120 is that a continuation-in-part application must be “filed before a notice of allowance or abandonment is mailed in the prior application.”
40. Which of the following is not a USPTO recommendation or requirement?
- (A) Product and process claims should be separately grouped.
 - (B) Claims should be arranged in order of scope so that the first claim presented is the least restrictive.
 - (C) Every application should contain no more than three dependent claims.
 - (D) A claim which depends from a dependent claim should not be separated from that dependent claim by any claim which does not also depend from the dependent claim.
 - (E) Each claim should start with a capital letter and end with a period.
41. The following statements relate to “multiple dependent claims.” Which statement is not in accord with proper USPTO practice and procedure?
- (A) A multiple dependent claim contains all the limitations of all the alternative claims to which it refers.
 - (B) A multiple dependent claim contains in any one embodiment only those limitations of the particular claim referred to for the embodiment under consideration.
 - (C) A multiple dependent claim must be considered in the same manner as a plurality of single dependent claims.
 - (D) Restriction may be required between the embodiments of a multiple dependent claim.
 - (E) The limitations or elements of each claim incorporated by reference into a multiple dependent claim must be considered separately.

42. Absent a Certificate of Mailing or Transmission, or use of Express Mail, which of the following actions requires a petition for an extension of time and the appropriate fee?

- (A) Applicant's complete first reply to a final Office action filed on the first day following the end of a shortened statutory period for reply. The Shortened Statutory Period ended on a Wednesday that was not a federal holiday, and the Office is open.
- (B) Interview with examiner conducted after the expiration of the shortened statutory period for reply to a final Office action, but within the 6 months statutory period.
- (C) Action by applicant to correct formal matters identified for the first time after a reply was made to a final Office action in an *Ex parte Quayle* action where the application is otherwise in condition for allowance.
- (D) Applicant's complete first reply to a final Office action filed within 2 months of the final Office action setting a 3 month shortened statutory period for reply.
- (E) Applicant's complete first reply to an Office action on the last day of a shortened statutory period for reply, where the Office action withdraws the finality of a previous Office action in view of a new ground of rejection.

43. Upon examination of your client's patent application, the patent examiner is considering whether and what rejections to apply to the claims. One or more of the limitations in the claims is indefinite or lacks supporting disclosure. The examiner may not properly take which of the following actions or inactions?

- (A) If the claim is subject to plural interpretations due to a limitation being indefinite, the examiner may disregard any possibility of multiple interpretations.
- (B) If a claim is subject to more than one interpretation due to a limitation being indefinite, at least one of which would render the claim unpatentable over the prior art, the examiner should reject the claim as indefinite under 35 USC 112, second paragraph, and should reject the claim over the prior art based on the interpretation of the claim that renders the prior art applicable.
- (C) If no reasonably definite meaning can be ascribed to certain claim language, the examiner should reject the claim as indefinite under 35 USC 112, second paragraph, and not reject the claim as obvious.
- (D) When evaluating claims for obviousness under 35 USC 103, all the limitations of the claims, including new matter lacking supporting disclosure in the originally filed specification, must be considered and given weight.
- (E) (C) and (D).

44. Jack, a registered patent agent, received a final rejection of all of the claims in an application directed to an article of manufacture. Jack is about to file a timely Notice of Appeal to the Board of Patent Appeals and Interferences. Before filing his notice of appeal, Jack would like to tie up some loose ends by amendment. Which of the following reply (replies) may he file without triggering the requirements of 37 CFR 1.116(b)?

- (A) A reply that presents his argument in a more defensible light and adds additional claims.
- (B) A reply amending the claims into process claims.
- (C) A reply amending all of the independent claims, accompanied by a declaration from the inventor.
- (D) A reply complying with a requirement of form expressly set forth in the previous Office action.
- (E) (A) and (D).

45. John filed a nonprovisional patent application in the USPTO claiming two distinct inventions, a combination and a subcombination. At the time of filing the nonprovisional application, he recorded an assignment of all right, title, and interest in the inventions claimed in the application to ABC Corporation. In the first Office action, the examiner required restriction, and John elected the combination. A year later, during the pendency of the nonprovisional application, John filed a divisional patent application claiming the subcombination. At the time of filing the divisional application, John assigned all right, title, and interest in the inventions claimed in the divisional application to XYZ Corporation, and the latter party recorded the assignment within three months of the assignment. Following recordation of the assignment to XYZ Corporation, which of the following statements is false?

- (A) The Office should treat John as having no ownership rights in the combination.
- (B) The Office should treat John as having no ownership rights in the subcombination.
- (C) ABC Corporation has no ownership rights in the subcombination.
- (D) XYZ Corporation has no ownership rights in the combination.
- (E) XYZ Corporation has no ownership rights in the subcombination.

46. Which of the following statements relevant to a third party submission in a published patent application accords with proper USPTO practice and procedure?

- (A) A submission of patents by a member of the public must be made within 2 months of the date of publication of the application.
- (B) A submission of patents by a member of the public must be made prior to the mailing of a Notice of Allowance.
- (C) A submission of patents by a member of the public must be made within 2 months of the date of publication of the application or prior to the mailing of a Notice of Allowance, whichever is later.
- (D) A submission of patents by a member of the public must be made within 2 months of the date of publication of the application or prior to the mailing of a Notice of Allowance, whichever is earlier.
- (E) Any submission not filed within the period set forth in the patent rules will be accepted provided it is accompanied by the processing fee set forth in 37 CFR 1.17(i).

47. An examiner has advanced a reasonable basis for questioning the adequacy of the enabling disclosure in the specification of your client's patent application, and has properly rejected all the claims in the application. The claims in the application are drawn to a computer program system. In accordance with proper USPTO practice and procedure, the rejection should be overcome by submitting _____

- (A) factual evidence directed to the amount of time and effort and level of knowledge required for the practice of the invention from the disclosure alone.
- (B) arguments by you (counsel) alone, inasmuch as they can take the place of evidence in the record.
- (C) an affidavit under 37 CFR 1.132 by an affiant, who is more than a routineer in the art, submitting few facts to support his conclusions on the ultimate legal question of sufficiency, *i.e.*, that the system "could be constructed."
- (D) opinion evidence directed to the ultimate legal issue of enablement.
- (E) patents to show the state of the art for purposes of enablement where these patents have an issue date later than the effective filing date of the application under consideration.

48. The MPEP and USPTO rules and procedure set out factual inquiries that are employed when making an obviousness-type double patenting analysis. Which of the following is not a factual inquiry that would be properly employed when making an obviousness-type double patenting determination with regard to a pending application vis-a-vis a claim in an issued patent?

- (A) Determine the level of ordinary skill in the pertinent art.
- (B) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue.
- (C) Evaluate any objective indicia of nonobviousness of the claim of the application at issue.
- (D) Determine the differences between the scope and content of: the patent claim and the prior art determined in choice (B) above and the claim in the application at issue.
- (E) None of the above (that is, each of the above factual inquiries is properly employed when making an obviousness-type double patenting determination with regard to an issued patent).

49. In accordance with the MPEP and USPTO rules and procedure, correspondence transmitted to the USPTO by facsimile is not permitted in certain situations. Which of the following facsimile transmissions to the USPTO will be accorded a date of receipt by the USPTO?

- (A) Facsimile transmission of a request for reexamination under 37 CFR 1.510 or 1.913.
- (B) Facsimile transmission of drawings submitted under 37 CFR 1.81, 1.83 through 1.85, 1.152, 1.165, 1.174, or 1.437.
- (C) Facsimile transmission of a response to a Notice of Incomplete Nonprovisional Application for the purpose of obtaining an application filing date.
- (D) Facsimile transmission of a correspondence to be filed in a patent application subject to a secrecy order under 37 CFR 5.1 through 5.5 and directly related to the secrecy order content of the application.
- (E) Facsimile transmission of a continued prosecution application under 37 CFR 1.53(d) and an authorization to charge the basic filing fee to a deposit account.

50. If a reissue application is filed within two years of the original patent grant, the applicant may subsequently broaden the claims during prosecution of the pending reissue prosecution beyond the two year limit, _____.

- (A) if the applicant indicates in the oath accompanying the reissue application that the claims will be broadened.
- (B) if an intent to broaden is indicated in the reissue application at any time within three years from the patent grant.
- (C) if the reissue application is filed on the 2-year anniversary date from the patent grant, even though an intent to broaden the claims was not indicated in the application at that time.
- (D) if the reissue application is a continuing reissue application of a parent reissue application, and neither reissue application contained an indication of an intent to broaden the claims until 4 years after the patent grant..
- (E) provided, absent any prior indication of intent to broaden, an attempt is made to convert the reissue into a broadening reissue concurrent with the presentation of broadening claims beyond the two year limit.

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**UNITED STATES PATENT AND TRADEMARK OFFICE
REGISTRATION EXAMINATION
FOR PATENT ATTORNEYS AND AGENTS**

OCTOBER 16, 2002

Afternoon Session (50 Points)

Time: 3 Hours

DIRECTIONS

This session of the examination is an open book examination. You may use books, notes, or other written materials that you believe will be of help to you *except* you may not use prior registration examination questions and/or answers. Books, notes or other written materials containing prior registration examination questions and/or answers *cannot* be brought into or used in the room where this examination is being administered. If you have such materials, you must give them to the test administrator before this session of the examination begins.

All questions must be answered in SECTION 1 of the Answer Sheet which is provided to you by the test administrator. You must use a No. 2 pencil (or softer) lead pencil to record your answers on the Answer Sheet. Darken *completely* the circle corresponding to your answer. You must keep your mark within the circle. Erase *completely* all marks except your answer. Stray marks may be counted as answers. No points will be awarded for incorrect answers or unanswered questions. Questions answered by darkening more than one circle will be considered as being incorrectly answered.

This session of the examination consists of fifty (50) multiple choice questions, each worth one (1) point. Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the *Official Gazette*, or a notice in the *Federal Register*. Each question has only one most correct answer. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer that will be accepted. Where two or more choices are correct, the most correct answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement that would make the statement *true*. If it is determined by the USPTO that there is more than one most correct answer to a question, each most correct answer will be accepted, but only one point will be given for the question. The presence of multiple most correct answers does not, in itself, render the question ambiguous. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

You may write anywhere on the examination booklet. However, do not remove any pages from the booklet. Only answers recorded in SECTION 1 of your Answer Sheet will be graded. YOUR COMBINED SCORE OF BOTH THE MORNING AND AFTERNOON SESSIONS MUST BE AT LEAST 70 POINTS TO PASS THE REGISTRATION EXAMINATION.

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO

1. Which of the following is not in accordance with the provisions of the MPEP?

- (A) Where joint inventors are named, the examiner should not inquire of the patent applicant concerning the inventors and the invention dates for the subject matter of the various claims until it becomes necessary to do so in order to properly examine the application.
- (B) Under 35 USC 119(a), the foreign priority benefit may be claimed to any foreign application that names a U.S. inventor as long as the U.S. named inventor was the inventor of the foreign application invention and 35 USC 119(a)-(d) requirements are met.
- (C) Where two or more foreign applications are combined in a single U.S. application, to take advantage of the changes to 35 USC 103 or 35 USC 116, the U.S. application may claim benefit under 35 USC 119(a) to each of the foreign applications provided all the requirements of 35 USC 119(a)-(d) are met.
- (D) One of the conditions for benefit under 35 USC 119(a) is that the foreign application must be for the same or a nonobvious improvement of the invention described in the United States application.
- (E) If a foreign application for which priority is being claimed under 35 USC 119 is filed in a country which does not afford similar privileges in the case of applications filed in the United States or to citizens of the United States and the foreign country is not a WTO member country, any claim for the foreign priority thereto by a U.S. application will not be effective.

2. Assume that conception of applicant's complex invention occurred prior to the date of the reference, but reduction to practice occurred after the date of the reference. Which of the following is sufficient to overcome the reference in accordance with proper USPTO practice and procedure?

- (A) In a 37 CFR 1.131 affidavit or declaration, it is sufficient to allege that applicant or patent owner has been diligent.
- (B) In a 37 CFR 1.131 affidavit or declaration, it is sufficient to clearly establish conception of the invention prior to the effective date of the reference, and diligence from just prior to the effective date of the reference to actual reduction to practice. The presence of a lapse of time between the reduction to practice of an invention and the filing of an application thereon is not relevant.
- (C) In a 37 CFR 1.131 affidavit or declaration, it is sufficient to clearly establish conception of the invention prior to the effective date of the reference. Diligence need not be considered.
- (D) In a 37 CFR 1.131 affidavit or declaration, it is sufficient to show conception and reduction to practice in any country.
- (E) In a 37 CFR 1.131 affidavit or declaration, it is always sufficient to prove actual reduction to practice for all mechanical inventions by showing plans for the construction of the claimed apparatus.

3. Which of the following establishes a statutory bar under 35 USC 102 to patentability of Applicant's claimed invention?

- (A) To further develop the invention, Applicant's invention was tested and experimented with in the United States more than one year prior to applicant's effective U.S. filing date, but the invention at the time was not fit for its intended purpose and important modifications concerning the claimed features resulted from the experimentation. The first actual reduction to practice occurred after the effective U.S. filing date.
- (B) Applicant's invention was sold in a WTO member country outside the United States more than one year prior to applicant's effective U.S. filing date, and the sale was merely market testing of the invention to determine product acceptance.
- (C) Applicant's invention is rendered obvious by the combination of two U.S. patents, both of which were patented more than one year prior to applicant's effective filing date.
- (D) Applicant's invention was sold outside the United States in a non-WTO member country, more than one year prior to applicant's effective U.S. filing date, but the sale was merely an attempt at market penetration.
- (E) None of the above.

4. A patent examiner resigned from the USPTO on June 7, 2001, and returned to Sheboygan, Wisconsin. The next day, on June 8, 2001, the former examiner signed up for a one week seminar entitled, "How to Become Rich Without Really Working." During the seminar, the sponsors offered the former examiner a golden opportunity to purchase a 10% interest in a U.S. patent application that they stated is "guaranteed to produce significant royalties and give her a 1000% return on her investment." Soon after attending the seminar, the former examiner became a registered practitioner. Which of the following accords with proper practice and procedure?

- (A) The former examiner may accept the offer, but only if an ownership interest in the application is transferred to the former examiner by an instrument in writing.
- (B) The former examiner can accept the offer, but only if an ownership interest in the application is transferred to the former examiner by an instrument in writing, which is made of record in the assignment records of the USPTO.
- (C) The former examiner can accept the offer, but only if an ownership interest in the application is transferred to the former examiner by an instrument in writing, which is made of record in the file of the application.
- (D) The former examiner should accept the offer, but only if an ownership interest in the application is transferred to the former examiner by an instrument in writing, and the original or a true copy of the original instrument, in writing, is made of record in the assignment records of the USPTO and in the file of the application.
- (E) The former examiner cannot accept the offer because she is incapable of acquiring an interest in the application at that time under the circumstances.

5. In accordance with the MPEP and USPTO rules and procedure, certain individuals owe a duty to the USPTO to disclose all information known to be material to patentability of the claim(s) pending in an application. Which of the following parties does not have the duty?

- (A) An inventor named in the application who relies on a patent attorney to prepare and prosecute the application.
- (B) A corporation to which an assignment of the entire interest in the application is on record at the USPTO.
- (C) An agent who prepares the application.
- (D) An attorney who prosecutes the application.
- (E) A person, who is not an inventor named in the application, who is substantively involved in the preparation and prosecution of the application, and who is associated with an inventor named in the application.

6. An examiner has properly established a prima facie showing of no specific and substantial credible utility for the claimed invention in a patent application filed in February 2001. An applicant can sustain the burden of rebutting and overcoming the showing by:

- (A) Providing reasoning or arguments rebutting the basis or logic of the prima facie showing.
- (B) Amending the claims.
- (C) Providing evidence in the form of a declaration under 37 CFR 1.132 rebutting the basis or logic of the prima facie showing.
- (D) Providing evidence in the form of a printed publication rebutting the basis or logic of the prima facie showing.
- (E) All of the above.

7. Which of the following requests by the registered practitioner of record for an interview with an examiner concerning an application will be granted in accordance with proper USPTO rules and procedure?

- (A) A request for an interview in a substitute application prior to the first Office action, for the examiner and attorney of record to meet in the practitioner's office without the authority of the Commissioner.
- (B) A request for an interview in a continued prosecution application prior to the first Office action, to be held in the examiner's office.
- (C) A request for an interview in a non-continuing and non-substitute application, prior to the first Office action to be held in the examiner's office.
- (D) None of the above.
- (E) All of the above.

8. An application includes independent claims 1 and 2. Which of the following, in a reply to a non-final Office action, provides the proper basis for a rejection under 35 USC 112, first paragraph?

- (A) Applicant amends claim 2 of the originally filed application by adding a limitation which was previously written only in claim 1 of the originally filed application, and one of ordinary skill in the art is enabled by the original disclosure to make and use the invention as claimed in amended claim 2.
- (B) Applicant amends claim 1 of the originally filed application by adding a limitation that was written in the original disclosure of the application, but the original disclosure does not enable one of ordinary skill in the art to make or use the invention as claimed in amended claim 1.
- (C) Applicant amends and broadens claim 2 by removing a limitation which was written in the original disclosure of the application, and one of ordinary skill in the art is enabled by the original disclosure to make and use the invention as claimed in amended claim 2.
- (D) Applicant adds new matter to the disclosure, but does not amend the claims of the originally filed application, and one of ordinary skill in the art is enabled by the original disclosure to make and use the invention as described in each of the claims.
- (E) None of the above.

9. In accordance with proper USPTO practice and procedure, which of the following statements is true?

- (A) Where sole patent applicant Able claims his invention in a Jepson-type claim, and the specification discloses that the subject matter of the preamble was invented by Baker before applicant's invention, the preamble is properly treated as prior art.
- (B) Where the sole patent applicant Able claims his invention in a Jepson-type claim, and the specification makes it clear that the claimed invention is an improvement on Able's own prior invention, which Able discovered less than one year before the filing date of the application, the preamble in the claim is properly treated as prior art.
- (C) Where the sole patent applicant Able claims his invention in a Jepson-type claim, and the specification makes it clear that the claimed invention is an improvement on an invention that Able discovered and publicly used and commercially sold by Able in Texas for several years before the filing date of the application, the preamble in the claim cannot properly be treated as prior art.
- (D) Where the sole applicant, Baker, states that something is prior art, the statement can be taken as being admitted prior art only if corroborated by objective evidence proffered by Baker, or found by the examiner.
- (E) No claim, including a Jepson-type claim, carries with it an implied admission that the elements in the preamble are old in the art.

10. Which of the following is true?

- (A) There is no practical difference between an objection and rejection of a claim.
- (B) If the form of the claim (as distinguished from its substance) is improper, an objection is made.
- (C) An objection, if maintained by an examiner, is subject to review by the Board of Patent Appeals and Interferences.
- (D) An example of a proper objection is where the claims are refused because they fail to comply with the second paragraph of 35 USC 112.
- (E) An example of a proper rejection is a rejection of a dependent claim for being dependent on a claim that has been rejected only over prior art, where the dependent claim is otherwise allowable.

11. Which of the following practices or procedures may be properly employed to overcome a rejection properly based on 35 USC 102(e)?

- (A) Persuasively arguing that the claims are patentably distinguishable from the prior art.
- (B) Filing an affidavit or declaration under 37 CFR 1.132 showing that the reference invention is not by "another."
- (C) Filing an affidavit or declaration under 37 CFR 1.131 showing prior invention, if the reference is not a U.S. patent that either claims the same invention or claims an obvious variation of the subject matter in the rejected claim(s).
- (D) (A) and (C).
- (E) (A), (B) and (C).

12. In accordance with the MPEP and USPTO rules and procedure, a joint inventor on behalf of himself or herself and a nonsigning joint inventor in certain circumstances may make a patent application. Which of the following is an acceptable reason for filing an application with a declaration signed by a joint inventor, who is not the legal guardian of the other joint inventor, on behalf of himself and the nonsigning joint inventor?

- (A) The nonsigning joint inventor refuses to join in the application.
- (B) The nonsigning joint inventor is on vacation and is temporarily unavailable to sign the declaration.
- (C) The nonsigning joint inventor is hospitalized and is temporarily unavailable to sign the declaration.
- (D) The nonsigning joint inventor is out of town and is temporarily unavailable to sign the declaration.
- (E) All of the above.

13. Which of the following is in accordance with the practice and procedures of Chapter 600 of the MPEP and/or 37 CFR 1.52(c)?

- (A) Handwritten alterations to the claims in a newly filed patent application should be dated and initialed or signed by the applicant on the same sheet of paper.
- (B) The Office will consider evidence of whether noninitialed and/or nondated alterations were made before or after the signing of the oath or declaration rather than require a new oath or declaration.
- (C) Any alteration to a patent application made by the applicant may be made after the application was signed and sworn to.
- (D) Non-initialed or non-dated handwritten alterations to the claims on an application filed in the USPTO are considered to be a minor informality. Thus, the Office personnel should not object to the same.
- (E) It is proper for an applicant to sign an oath or declaration even when the oath or declaration (i) does not identify a patent application or (ii) is not attached to or physically located together with the patent application.

14. Which of the following timely actions should you take to accord maximum patent protection at minimum government fees for your client whose invention is described in a provisional patent application that was filed 6 months ago with no claim?

- (A) File a request to convert the provisional application to a nonprovisional application, accompanied by a proper executed declaration, an amendment including at least one claim as prescribed by paragraph 2 of 35 USC 112 and the proper fee set forth in 37 CFR 1.17(i).
- (B) File a request to convert the provisional application to a nonprovisional application, accompanied by a proper executed declaration, an amendment including at least one claim as prescribed by paragraph 2 of 35 USC 112, the proper fee set forth in 37 CFR 1.17(i), and the basic filing fee for the nonprovisional application.
- (C) File a request to convert the provisional application to a nonprovisional application, accompanied by a proper executed declaration, an amendment including at least one claim as prescribed by paragraph 2 of 35 USC 112, the proper fee set forth in 37 CFR 1.17(i), the basic filing fee for the nonprovisional application, and the surcharge required by 37 CFR 1.16(e).
- (D) File a nonprovisional application including at least one claim accompanied by a proper executed declaration, and the basic filing fee. The application contains a specific reference to the provisional application in compliance with 37 CFR 1.78(a)(5).
- (E) File a nonprovisional application including at least one claim accompanied by a proper executed declaration but without the basic filing fee. The application contains a specific reference to the provisional application in compliance with 37 CFR 1.78(a)(5).

15. Independent claim 1, fully supported by the specification in a patent application states:

Claim 1. An apparatus comprising: a plastic valve; a copper pipe connected to the plastic valve; and an aluminum pipe connected to the plastic valve.

Which of the following claims, presented in the application, provide the basis for a proper rejection under 35 USC 112, second paragraph?

Claim 2. The apparatus of claim 1, wherein said pipe is statically charged.

Claim 3. The apparatus of claim 1, wherein the outer circumference of said copper pipe is statically charged.

Claim 4. The apparatus of claim 1, further comprising a thermostat connected to said plastic valve.

(A) Claim 2.

(B) Claim 3.

(C) Claim 4.

(D) Claims 2 and 3.

(E) Claims 3 and 4.

16. In which of the following situations, considered independently of each other, is the original, new, or amended claim supported in the application as filed?

(A) An amendment to the specification changing the definition of “holder” from “is a hook” to “is a hook, clasp, crimp, or tong” and no amendment is made of the claim, which uses the term “holder.” The amendment is filed one month after the application was filed. There was no previous supporting disclosure in the specification of the holder being a clasp, crimp, or tong.

(B) An amendment to the specification and claims changing the definition of “holder” from “is a hook” to “is a hook, clasp, crimp, or tong.” The amendment is filed one month after the application was filed. There was no previous supporting disclosure in the specification of the holder being a clasp, crimp, or tong.

(C) Original claim 1 in the application refers to “a holder,” and original claim 2 depends from and refers to claim 1 stating, “said holder is a hook, clasp, crimp, or tong.” There is no disclosure in the specification preceding the claims in the application as filed for the holder to be a clasp, crimp, or tong.

(D) An amendment is filed presenting a claim to an electrical insulating device, copied from a patent for the purpose of provoking an interference. The claim refers to “nonconductive plastic holder.” The application as filed contains a broad generic disclosure describing electrical insulating devices. The holder is described in the specification of the application as “conducting electricity.” There is no disclosure in the specification of the holder being “nonconductive.”

(E) All of the above.

17. Claims 1 and 2 in a patent application state the following:

Claim 1. An apparatus for sitting comprising:

- (i) a square shaped base member;
- (ii) four elongated members mounted to the bottom of the base member; and
- (iii) a circular back member mounted to the base member.

Claim 2. An apparatus as in claim 1, further comprising a spring connected to the back member and to the base member.

Which, if any, of the following claims fully supported by the specification and presented in the application, is in accordance with USPTO rules and procedure?

- (A) 3. An apparatus as in claim 1, wherein the base member is rectangularly shaped.
- (B) 3. An apparatus as in claim 2, wherein the wheels connected to each of the elongated members are plastic.
- (C) 3. An apparatus as in the preceding claims, further comprising a pressure-sensing device connected to the base member.
- (D) 3. An apparatus as in any of the preceding claims, in which the circular back member is wooden.
- (E) None of the above.

18. A U.S. patent application for inventor William Tull discloses a target-shooting gun for improved accuracy, and a bullet impregnated with a new chemical composition. The new chemical composition minimizes damage to a target struck by the bullet. In a non-final Office action, an examiner includes a restriction requirement between a group of claims drawn to the target-shooting gun (Group 1), and a group of claims drawn to the bullet (Group 2). Which of the following, included in a timely reply to the non-final Office action, preserves Tull's right to petition for review of the restriction requirement, if the requirement is made final?

- (A) A reply that distinctly points out supposed errors in the restriction requirement, and also states, "The restriction requirement is traversed, and no election is made, thereby preserving Applicant's right to petition for review of the restriction requirement."
- (B) A reply that states, "Applicant elects Group 2 and traverses the restriction requirement because the requirement for restriction between Group 1 and Group 2 is in error."
- (C) A reply that distinctly and specifically points out supposed errors in the restriction requirement, and states, "Applicant traverses the restriction requirement and elects Group 2."
- (D) A reply that states, "The restriction requirement between Group 1 and Group 2 is traversed because it is in error, and no election is made, thereby preserving Applicant's right to petition for review of the restriction requirement."
- (E) None of the above.

19. In connection with the utility of an invention described in a patent application, which of the following conforms to proper USPTO practice and procedure?

- (A) A deficiency under 35 USC 101 also creates a deficiency under 35 USC 112, first paragraph.
- (B) To overcome a rejection under 35 USC 101, it must be shown that the claimed device is capable of achieving a useful result on all occasions and under all conditions.
- (C) A claimed invention is properly rejected under 35 USC 101 as lacking utility if the particular embodiment disclosed in the patent lacks perfection or performs crudely.
- (D) To overcome a rejection under 35 USC 101, it is essential to show that the claimed invention accomplishes all its intended functions.
- (E) A claimed invention lacks utility if it is not commercially successful.

20. The specification in your client's patent application has been objected to for lack of enablement. To overcome this objection, your client may do any of the following except:

- (A) traverse the objection and specifically argue how the specification is enabling.
- (B) traverse the objection and submit an additional drawing to make the specification enabling.
- (C) file a continuation-in-part application that has an enabling specification.
- (D) traverse the objection and file an amendment without adding new matter in an attempt to show enablement.
- (E) traverse the objection and refer to prior art cited in the specification that would demonstrate that the specification is enabling to one of ordinary skill.

21. In accordance with the MPEP and USPTO rules and procedure, an applicant for a patent dissatisfied with the primary examiner's decision may appeal to the Board of Patent Appeals and Interferences ("the Board") in certain situations. In which of the following situations may the applicant properly appeal to the Board?

- (A) Applicant's claims have been twice objected to, but have not been rejected.
- (B) Applicant's claims have been rejected once in a non-final Office action during examination of a parent application, and once in a non-final Office action during examination of a continuing application.
- (C) Applicant's claims in an original application have been rejected only once.
- (D) Applicant's claims have been objected to only once, and have been rejected only once in a non-final Office action.
- (E) All of the above.

22. Which of the following is in accordance with the provisions in the MPEP?

- (A) In order to correct inventorship in a nonprovisional application where the statement of the lack of deceptive intent is not available from an inventor to be added, a petition under 37 CFR 1.181 may be properly filed.
- (B) If a person A learns that a patent application has been filed by person B without naming A as coinventor, A may file in the USPTO a petition that protests inventorship and directs B to add A's name as a coinventor to the patent application.
- (C) If the application is involved in an interference, and a petition under 37 CFR 1.48 is filed to correct inventorship, the Board of Patent Appeals and Interferences will remand the case to the primary examiner for consideration of the petition to ensure that a search of the relevant prior art is performed.
- (D) When a second conversion under 37 CFR 1.48(a) is attempted by the practitioner, the conversion decision will be decided by the Technology Center Director.
- (E) None of the above.

23. Which of the following statements relating to design patents does not accord with proper USPTO practice and procedure?

- (A) Both design and utility patents may be obtained on an article if the invention resides both in its utility and ornamental appearance.
- (B) The design for an article consists of the visual characteristics embodied in or applied to an article.
- (C) Design patent applications are included in the Patent Cooperation Treaty (PCT), and the procedures followed for PCT international applications are to be followed for design patent applications.
- (D) A claim directed to a computer-generated icon shown on a computer screen complies with the "article of manufacture" requirement of 35 USC 171.
- (E) A claimed design may encompass multiple articles or multiple parts within an article.

24. A claim, as required by the second through fifth paragraphs of section 112, shall not be required in a _____ patent application.

- (A) reissue
- (B) design
- (C) continuation
- (D) provisional
- (E) plant

25. Applicant Jones filed a request for a first continued prosecution application (CPA) on December 29, 2000 in a utility application that was filed on April 28, 2000. Jones received a final Office action mailed on June 28, 2001. In response, Jones filed an amendment amending the claims in the first CPA. Jones received an advisory action on September 27, 2001 stating that the proposed amendment to the first CPA would not be entered because it raises new issues that would require further consideration. Additionally, the proposed amendment did not meet the requirements for a complete reply under 37 CFR 1.111. On December 28, 2001, Jones filed a petition for a 3-month extension of time with appropriate petition fee, a request for a second continued prosecution application, a request for suspension of action, and appropriate processing fee for the request for suspension of action. No application filing fee was filed with the request for the second CPA. Which of the following would be a proper communication mailed by the Office based on Jones' actions?

- (A) A Notice of Allowability.
- (B) A Notice to File Missing Parts.
- (C) A first Office action on the merits.
- (D) A notice of improper Request for Continued Examination (RCE) and a notice of abandonment.
- (E) A letter granting the suspension of action.

26. A patent application filed in the USPTO contains the following three original claims, including product by process Claim 3:

- Claim 1. A method for making an Ethernet cable comprising the steps of A, B and C.
- Claim 2. The method of claim 1, further characterized by the step of D.
- Claim 3. The Ethernet cable as in any one of the preceding claims.

In the first Office action, the examiner objects to Claim 3 as being an improper dependent claim and requires cancellation of the claim. Following proper USPTO practices and procedures, which of the following replies best overcomes the examiner's objection and provides the client with the broadest patent protection?

- (A) Amend Claim 3 to read: "The Ethernet cable as made by the process set forth in claims 1-2."
- (B) Cancel Claim 3. Add Claim 4, which reads: "An Ethernet cable made by a process comprising the steps of A, B and C." Add Claim 5, which reads: "An Ethernet cable made by a process comprising the steps of A, B, C and D."
- (C) Cancel Claim 3 and add Claim 4, which reads: "An Ethernet cable made by a process comprising the steps of A, B and C."
- (D) Cancel Claim 3 and add Claim 4, which reads: "An Ethernet cable made by a process comprising the steps of A, B, C and D."
- (E) Cancel Claim 3.

27. Adams filed Application X on March 1, 2001. Beth filed application Y on May 1, 2001. Neither application has been published. Applications X and Y are copending and commonly assigned. Earlier filed application X claims the same invention as claimed in application Y using identical language. In accordance with the MPEP, which of the following actions should the examiner or assignee follow?

- (A) The claims to the same invention in application Y should be rejected under 35 USC 102(a) as being anticipated by application X.
- (B) The claims to the same invention in application Y should be rejected under 35 USC 102(b) as being anticipated by application X.
- (C) The claims to the same invention in application Y should be rejected under 35 USC 102(e) as being provisionally anticipated by application X.
- (D) The common assignee should file a terminal disclaimer in application Y to avoid any question of double patenting.
- (E) The claims to the same invention in application Y should be rejected under 35 USC 102(e) as being anticipated by application X.

28. Which of the following is not in accordance with the provisions of 35 USC 115 (Oath of applicant)?

- (A) The applicant shall make oath (or declaration) that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent.
- (B) In the oath or declaration, the applicant must state of what country he is a citizen.
- (C) An oath may be made before any person within the United States authorized by law to administer oaths.
- (D) An oath executed in a foreign country must be properly authenticated.
- (E) A declaration which accompanies a patent application must state on the document a warning that willful false statements and the like are punishable by fine or imprisonment or both under 18 USC 1001, and the declaration must be notarized.

29. For purposes of determining whether a request for continued examination is in accordance with proper USPTO rules and procedure, in which of the following situations will prosecution be considered closed?

- (A) The last Office action is a final rejection.
- (B) The last Office action is an Office action under *Ex Parte Quayle*.
- (C) A notice of allowance has issued following a reply to a first Office action.
- (D) The application is under appeal.
- (E) All of the above.

30. The MPEP sets forth a procedure whereby an examiner may contact an applicant to discuss election of claims after the examiner determines that a restriction requirement should be made. Assume that a primary examiner contacts a practitioner representing applicant by telephone prior to any Office action on the merits, and the examiner orally makes a restriction requirement. During the telephone conversation, the practitioner orally makes an election of claims without traverse. On examination, the examiner finds the elected claims to be allowable. Which of the following would be improper for the examiner to include in a letter to the practitioner attached to a Notice of Allowability?

- (A) A cancellation of the non-elected claims.
- (B) A statement that the prosecution is closed.
- (C) A statement that a Notice of Allowance will be sent in due course.
- (D) A statement that the applicant's election is not upheld because an election must only be made in writing, and cannot be made by telephone.
- (E) All of the above.

31. Regarding the specification of a nonprovisional patent application, which of the following practices is in accordance with proper USPTO practice and procedure?

- (A) The specification may include graphical illustrations or flowcharts.
- (B) The specification may include tables and chemical formulas.
- (C) The specification may include hyperlinks or other forms of browser-executable code embedded in the text.
- (D) The specification must begin with one or more claims.
- (E) The specification may include a reservation for a future application of subject matter disclosed but not claimed in the application.

32. Which of the following practices or procedures may be properly employed to overcome a rejection properly based on 35 USC 102(a)?

- (A) Perfecting a claim to priority under 35 USC 119(a)-(d) based on a foreign application having a foreign priority filing date that antedates the reference.
- (B) Filing a declaration under 37 CFR 1.131 showing that the cited prior art antedates the invention.
- (C) Filing a declaration under 37 CFR 1.132 showing that the reference invention is by "others."
- (D) Perfecting priority under 35 USC 119(e) or 120 by, in part, amending the declaration of the application to contain a specific reference to a prior application having a filing date prior to the reference.
- (E) (A), (B) (C), and (D).

33. Xavier files a complete first reply exactly 10 weeks after the mailing date of a final Office action that sets a 3 month shortened statutory period for reply. An Examiner's Amendment is necessary for the purpose of placing the application in condition for allowance. Which of the following statements is true?

- (A) If Xavier gives authorization for the Examiner's Amendment exactly 2 months after his reply, the application will be allowed.
- (B) Authorization for the Examiner's Amendment may be made at any time within 6 months of Xavier's reply to avoid abandonment of the application.
- (C) Unless Xavier gives authorization for the Examiner's Amendment within the 3 months shortened statutory period for reply, the application will be abandoned.
- (D) If Xavier gives authorization for the Examiner's Amendment exactly 2 months after his reply, the application will be abandoned unless accompanied by a proper petition and fee for an extension of time.
- (E) Abandonment of the application will be avoided if Xavier gives authorization for the Examiner's Amendment any time within 6 months of the mail date of a final Office action. No extension of time need be filed if Xavier gives the authorization between 3 months and 6 months after the Office action.

34. On Monday, May 13, 2002, John's secretary deposited in an "Express Mail" drop box prior to the last scheduled pick-up for that day, an envelope properly addressed to the USPTO for delivery to the USPTO by the "Express Mail Post Office to Addressee" service. The envelope was received by the USPTO on Wednesday, May 15, 2002, containing a reply to an Office action which set a shortened statutory period ("SSP") for reply ending on Tuesday, May 14, 2002. The reply was marked by the Office as being received on May 15, 2002. The number of the "Express Mail" mailing label had not been placed on the response papers, and upon receipt of the "Express Mail" mailing label John learned that the "date in" was not clearly marked. John promptly filed a petition requesting the filing date to be the date of deposit. The petition included a showing that the date of deposit accompanied by evidence of USPS corroboration of the deposit. Accordingly,

- (A) The reply will be regarded as timely filed in the USPTO on May 15, 2002.
- (B) The reply will be regarded as timely filed in the USPTO on May 14, 2002.
- (C) The reply will be regarded as timely filed in the USPTO on May 13, 2002.
- (D) The reply will be regarded as timely filed in the USPTO if a petition with proper fee for a one month extension of time is filed in the USPTO on or before June 14, 2002.
- (E) The reply will be regarded as timely filed in the USPTO if the number of the "Express Mail" mailing label is placed on each page of a copy of the original response and hand carried to the USPTO on May 15, 2002, rather than being sent by "Express Mail."

35. Which of the following is not in accordance with the provisions of the MPEP?

- (A) If there is a discrepancy between the information submitted in an application data sheet and the information submitted elsewhere in the application, the application data sheet will control except for the naming of the inventors and the citizenship of the inventors, which is governed by the oath or declaration.
- (B) A patent examiner should object to text of a patent application if it contains an embedded hyperlink and /or other form of browser-executable code.
- (C) All patent applicants should use the English units of measurement followed by the equivalent metric units when describing their inventions in the specifications of patent applications.
- (D) The paper used for patent applications must have a surface such that amendments may be written thereon in ink; so-called "Easily Erasable" paper having a special coating so that erasures can be made more easily may not provide a permanent copy as is required.
- (E) The following documents may be submitted to the Office on a compact disc: a computer program listing, a sequence listing, and a table that has more than 50 pages of text.

36. The USPTO notifies John, a registered patent agent who is representing applicant A, that after a reasonable search, the USPTO has been unable to locate applicant A's patent application. By which of the following procedures may John avoid abandonment of applicant A's application within the time period set by the USPTO?

- (A) Provide the USPTO with a copy of his record of all the correspondence between his office and the USPTO, assuming the existence of such record.
- (B) Provide the USPTO with a list of all the correspondence between his office and the USPTO, assuming the existence of such list, and a statement that the list is complete and accurate.
- (C) Provide the USPTO with a statement that he does not possess any record of the correspondence between his office and the USPTO because his files were destroyed.
- (D) Provide the USPTO with a record of all the correspondence between his office and the USPTO, and a statement that the papers produced are his complete record of all the correspondence between his office and the USPTO, assuming the existence of such record.
- (E) Provide the USPTO with a copy of his record of all the correspondence between his office and the USPTO, assuming the existence of such record, a list of all such correspondence, and a statement that he is not aware of any correspondence between his office and the USPTO that is not among his records.

37. Which of the following is not in accordance with the recommended characteristics set forth in the MPEP for the detailed description of the invention?

- (A) The detailed description of the invention must include a description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71.
- (B) The detailed description should be as short and specific as is necessary to describe the invention adequately and accurately.
- (C) Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described, and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail.
- (D) The detailed description of the invention may include reference characters to the parts of the invention that do not appear in the drawings.
- (E) Where particularly complicated nonessential subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, absent disclosure elsewhere in the application, the specification should refer to another patent or readily available publication that adequately describes the subject matter.

38. Which of the following is true?

- (A) A claim to a process omitting a step in a disclosed process, where the step is disclosed in the specification to be essential to the invention, may not be properly rejected under 35 USC 112, first paragraph, for lack of enablement where the specification provides an enabling disclosure only for the process which includes the essential step.
- (B) Failure to disclose the best mode must rise to the level of active concealment or grossly inequitable conduct in order to support a rejection under 35 USC 112, first paragraph.
- (C) A claim failing to interrelate essential elements of the invention, as defined by the applicant in the specification, where the interrelation is critical to the invention may be properly rejected under 35 USC 112, second paragraph, for failure to properly point out and distinctly claim the invention.
- (D) Where the best mode contemplated by the inventor at the time of filing the application is not disclosed, a proposed amendment adding a specific mode of practicing the invention would not be new matter.
- (E) The best mode requirement is the same as the enablement requirement of the first paragraph of 35 USC 112.

39. Which of the following is not in accordance with the recommended characteristics set forth in the provisions of the MPEP for the summary of the invention?

- (A) The summary is separate and distinct from the abstract and is directed toward the disclosure as a whole, rather than just the invention.
- (B) The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention).
- (C) In chemical cases the summary should point out in general terms the utility of the invention.
- (D) If possible, the summary should set forth the nature and gist of the invention or the inventive concept should be set forth.
- (E) Any stated objects of the invention should be treated briefly in the summary and only to the extent that they contribute to an understanding of the invention.

40. Which of the following does not represent prior art?

- (A) The preamble of a Jepson claim.
- (B) A technical journal as of its date of publication which is accessible to the public as of the date of its publication.
- (C) A disclosure publicly posted on the INTERNET, but containing no publication or retrieval date.
- (D) A doctoral thesis indexed, cataloged and shelved in a university library.
- (E) Applicant's labeling of one of the figures in the drawings submitted with his application as prior art.

41. In 1995 Patent Agent filed a U.S. patent application containing five claims (Application 1). All five claims are fully supported under 35 USC 112 by the disclosure of Application 1. In 2000, Patent Agent filed a U.S. patent application (Application 2) that was a continuation-in-part of Application 1. Application 2 adds new subject matter to the disclosure of Application 1, and ten additional claims. Of the fifteen claims in Application 2, claims 1-5 are exactly the same as Application 1, claims 6-10 are fully supported under 35 USC 112 by the disclosure of Application 1, and claims 11-15 are fully supported under 35 USC 112 only by the newly added subject matter of Application 2. The effective filing date for claims in Application 2 is:

- (A) 1-15 is 2000.
- (B) 1-15 is 1995.
- (C) 1-10 is 1995.
- (D) 11-15 is 2000.
- (E) (C) and (D).

42. Evidence of unexpected results is relied upon to overcome a *prima facie* case of obviousness. Which of the following is incorrect?

- (A) The evidence must compare the claimed invention to the closest prior art.
- (B) The evidence must be commensurate in scope with the claims.
- (C) Data relied upon to show unexpected results need not cover the full range of the claims if one of ordinary skill in the art could ascertain a trend in the data that would allow that person to reasonably extend the probative value of the data to the full scope of the claims.
- (D) Unexpected results can be shown by factual evidence or, if no factual evidence is available to the applicant, by sound argument by the applicant's agent or attorney.
- (E) The evidence need not be in an affidavit or declaration under 37 CFR 1.132 if the evidence is presented in the specification of an application to which the applicant has attested.

43. A patent application filed in the USPTO claims a nylon rope coated with element E for the purpose of preventing breakage of the rope. In the first Office action, the examiner rejects the claim as obvious over P in view of a trade journal publication, T. P teaches a nylon rope coated with resin for the purpose of making the rope waterproof. T teaches a nylon tent fabric coated with element E for the purpose of making the tent waterproof, and suggests the use of element E for making other nylon products waterproof. Following proper USPTO practices and procedures, the combination of P and T:

- (A) cannot support a prima facie case of obviousness because T lacks a suggestion to combine with P for the purpose of preventing breakage in nylon rope.
- (B) cannot support a prima facie case of obviousness because P lacks a suggestion to combine with T for the purpose of preventing breakage in nylon rope.
- (C) cannot support a prima facie case of obviousness because T only contains a suggestion to combine with P for the purpose of waterproofing nylon rope.
- (D) can support a prima facie case of obviousness, even though T only contains a suggestion to combine with P for the purpose of waterproofing nylon rope.
- (E) can support a prima facie case of obviousness because the applicant is always under an obligation to submit evidence of non-obviousness regardless of whether the examiner fully establishes a prima facie case of obviousness.

44. The procedures in the MPEP do not require an applicant claiming foreign priority in a nonprovisional utility application to:

- (A) submit the processing fee set forth in 37 CFR 1.17(i) if the claim for priority or submission of the certified copy of the priority document is made after payment of the issue fee and before the patent is granted.
- (B) identify the foreign application for which priority is being claimed as well as any foreign application for the same subject matter having a filing date before that of the application for which priority is being claimed.
- (C) file the claim in the application.
- (D) have the same inventive entity listed in the foreign application as in the U.S. application in which the priority claim has been filed.
- (E) identify the intellectual property authority or country in or for which the foreign application was filed.

45. In accordance with Chapter 100 of the Manual of Patent Examining Procedure and 35 USC 122, which of the following statements is not true?

- (A) All requests for reexamination and related patent files are available to the public subject to the availability of the reexamination file.
- (B) The Board of Patent Appeals and Interferences handles all petitions for access to applications involved in an interference.
- (C) An abandoned application referenced in a U.S. patent application publication, U.S. patent or a U.S. application that is open to public inspection may be ordered for inspection by any member of the public.
- (D) The assignee of record of a part interest in an application may always intervene in the prosecution of the application, appointing a registered attorney or agent of his or her own choice, without participation by any or all other assignees.
- (E) All provisional patent applications are screened upon receipt in the USPTO for subject matter that, if disclosed, might impact the national security, and such applications are referred to appropriate agencies for consideration of restrictions on disclosure of the subject matter.

46. Which of the following statements does not accord with proper USPTO practice and procedure?

- (A) A protest may be filed by an attorney or other representative on behalf of an unnamed principal.
- (B) Information which may be relied on in a protest includes information indicating violation of the duty of disclosure under 37 CFR 1.56.
- (C) While a protest must be complete and contain a copy of every document relied on by the protestor, a protest without copies of prior art documents will not necessarily be ignored.
- (D) A protest must be submitted prior to the date the application was published or the mailing of a notice of allowance, whichever occurs later, provided the application is pending.
- (E) Since a protestor is not authorized to participate in the prosecution of a pending application, the examiner must not communicate in any manner with the protestor.

47. A registered practitioner's client, Apex Mfg. Corporation, bought the entire assets of Pinnacle Mfg. Corporation. Pinnacle gave Apex a list of its patent applications but did not maintain records of the patent assignments. Apex wishes to know which of the assignment documents, if any, of the pending patent applications in Pinnacle's patent portfolio were never recorded. In accordance with the MPEP, which of the following actions could the practitioner rely upon to most expeditiously answer this question?

- (A) Request certified copies of the patent applications as filed.
- (B) Request certified copies of the assignment documents of record of the patent applications.
- (C) Request certified copies of the patent applications as filed accompanied by the fees set forth in 37 CFR 1.19(b)(1)(i).
- (D) Request certified copies of the patent applications as filed accompanied by the fees set forth in 37 CFR 1.19(b)(1)(ii).
- (E) Request certified copies of the assignment documents of record of the patent applications accompanied by the fees set forth in 37 CFR 1.19(b)(5).

48. In accordance with the MPEP and USPTO rules and procedure, a registered attorney or agent may be appointed to prosecute a patent application for an applicant. In which of the following situations will the USPTO not recognize the appointment of an attorney or agent to prosecute a patent application for an applicant?

- (A) The principal agent of record appoints a registered associate attorney to prosecute the application.
- (B) The applicant executes a power of attorney naming only a law firm to prosecute the application.
- (C) The applicant executes a power of attorney appointing more than one registered individual to prosecute the application.
- (D) The principal attorney of record appoints an associate registered agent to prosecute the application.
- (E) The assignee of the entire interest of record, who has established the right to prosecute the patent application, executes a power of attorney appointing a registered attorney to prosecute the patent application.

49. Roberto files a U.S. patent application fourteen months after he perfects an invention in Europe. Which of the following would establish a statutory bar against the granting of a U.S. patent to Roberto?

- (A) A foreign patent issued to Roberto 11 months prior to the filing date of Roberto's U.S. patent application. The foreign patent was granted on an application that was filed 23 months prior to the effective filing date of Roberto's U.S. patent application. The foreign patent application and the U.S. patent application claim the same invention.
- (B) The invention was described in a printed publication in the United States, 11 months prior to the filing date of the U.S. patent application.
- (C) The invention was in public use in the United States, less than one year prior to the filing date of the U.S. patent application.
- (D) The invention was on sale in a foreign (NAFTA member) country, more than one year prior to the filing date of the U.S. patent application.
- (E) None of the above.

50. An applicant's claim stands rejected under 35 USC 103 as being obvious over Larry in view of Morris. Larry and Morris are references published more than one year before applicant's effective filing. Although the examiner cites no suggestion or motivation for combining the references, they are, in fact, combinable. Which of the following arguments could properly show that the claim is not obvious?

- (A) The inventions disclosed by Larry and Morris cannot be physically combined.
- (B) Neither Larry nor Morris provides an express suggestion to combine the references.
- (C) As recognized by businessmen, the high cost of Larry's device teaches away from combining it with the simpler device of Morris.
- (D) Absent a suggestion or motivation, the examiner has not shown that combining Larry's with Morris's device would have been within the level of ordinary skill of the art.
- (E) None of the above.

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**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:

- I. 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 the 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 references 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 photocopyier.
- (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 photocopyier 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 USPTO.
- (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 that 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 “l” 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 allege 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 prematurity 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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