

Test Number 100
Test Series 123

Name _____

**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 ½ 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.
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- (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 semi-conductor 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.

**Examination for Registration to Practice in Patent Cases
Before the U.S. Patent and Trademark Office
April 12, 2000**

Morning Session Model Answers

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Morning Session Answers

1. ANSWER: (A). 35 U.S.C. § 102. When a patent claims a composition in terms of ranges of element, any single prior art reference falling within each of the ranges anticipates the claim. *Atlas Powder Co. v. IRECO, Inc.*, 51 USPQ2d 1943 (Fed. Cir. 1999) (holding “[i]nherency is not necessarily coterminous with knowledge of those of ordinary skill in the art...Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art... . However, the discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art’s functioning, does not render the old composition new to the discoverer.” The court also held that “this same reasoning holds true when it is not a property, but an ingredient, which is inherently contained in the prior art.”). (B) is not the most correct answer because the prior art reference, to anticipate the claimed invention, is not required to recognize an inherent property. (C) is not the most correct answer because the prior art reference, to anticipate the claimed invention, is not required to recognize an inherent function of oxygen. (D) is not the most correct answer because the prior art reference, to anticipate the claimed invention, is not required to recognize an inherent ingredient, oxygen. (E) is not the most correct answer because (B), (C) and (D) are not correct, whereas (A) is correct.

2. ANSWER: (E) is the most correct answer. (A) and (C) can be corrected by a certificate of Correction. MPEP § 1481 [p. 1400-47]. (D) can be corrected by a Certificate of Correction. 37 C.F.R. § 1.324; MPEP § 1481 [p. 1400-44]. (B) is incorrect. Such a mistake, which affects the scope and meaning of the claims in a patent, is not considered to be of the “minor” character required for issuance of a Certificate of Correction. MPEP § 1481.

3. ANSWER: (E) is correct because (B) and (D) are correct. 37 C.F.R. § 1.75(c); MPEP § 608.01(n) [pp. 600-66,67]. (A) and (C) are incorrect. MPEP § 608.01(n) (“[A] multiple dependent claim may not serve as a basis for any other multiple dependent claim, either directly or indirectly”).

4. ANSWER: (C). *Moleculon Research Corp. v. CBS, Inc.*, 229 USPQ 805, 809 (Fed. Cir. 1986); MPEP § 2133.03(b). Although reexaminations are limited to prior art patents and printed publications, that limitation is not present in original prosecution. Thus (A) is incorrect. (B) and (D) are wrong because there is no requirement that on-sale activity be public. MPEP § 2133.03(b). (E) is wrong at least because an on-sale bar does not require an actual sale. A bar can also be based on an offer to sell.

5. ANSWER: (B). Answers (A) and (E) are incorrect because they improperly seek to broaden the parent claim. 37 C.F.R. 1.75(c). Answer (A) broadens the range by going below the

stated limit. Answer (E) broadens by trying to remove a member of the Markush group, and covering subject matter that is not covered by the parent claim. Answer (C) is incorrect because claim 1 uses the close ended claim term “consists” in connection with the second gas, which precludes the addition of further components to the second gas in claim 4. Answer (D) is incorrect because the use of the exemplary language “such as” is improper is improper under

35 U.S.C. § 112, second paragraph, and because it is inconsistent with claim 1. See MPEP § 2173.05(d).

6. ANSWER: (C). MPEP § 2113, page 2100-51, citing *In re Fessman*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). (A) and (E) are incorrect because “[t]he fact that it is necessary for an applicant to describe his product in product-by-process terms does not prevent him from presenting claims of varying scope.” MPEP § 2173.05(p), item (I). (D) is incorrect even if it is not necessary to describe the product in product-by-process form. (D) is incorrect because “determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process.” MPEP § 2113, [p.2100-51]. (B) is incorrect. “A claim to a device, apparatus, claim, or composition of matter may contain a reference to the process in which it is intended to be used...so long as it is clear that the claim is directed to the product and not the process.” MPEP § 2173.05(p), item (I) [p.2100-174].

7. ANSWER: (B). Answer (B) provides proper antecedent basis for “said mid-point” in part (iv) of Claim 1 and in Claim 2, and “said connector” in Claim 3. Answer (A) is incorrect at least because it does not provide antecedent basis for “said connector” in Claim 3. Answer (C) is narrower than Answer (B) because it includes the additional limitation of a reservoir and therefore does not “most broadly” complete claim 1. Answer (D) is incorrect because it does not provide proper antecedent basis for “said mid-point” in part (iv) of Claim 1 and in Claim 2. Answer (E) is incorrect because it does not provide antecedent basis for “said connector” in Claim 3.

8. ANSWER: (D). MPEP § 710.02(e), pages 700-82 and 83, under the heading “FINAL REJECTION – TIME FOR REPLY” states, “If an applicant initially replies within 2 months from the date of mailing of any final rejection setting a 3-month shortened statutory period for reply and the Office does not mail an advisory action until after the end of the 3-month shortened statutory period, the period for reply for purposes of determining the amount of any extension fee will be the date on which the Office mails the Advisory Action advising applicant of the status of the application...” Hence, since no extension fee was paid in the fact pattern, the time allowed applicant for reply to the action from which the appeal was taken is the mail date of the Advisory Action, i.e., May 31, 2000. 37 C.F.R. § 1.192(a) recites, in pertinent part, “Appellant must, within two months from the date of the notice of appeal under § 1.191 or within the time allowed for reply to the action from which the appeal was taken, if such time is later, file a brief in triplicate.” (A), (B), and (C) are wrong because they recite dates which are earlier than May 31, 2000, the last date for filing a Brief without an extension of time. (E) is wrong because it is after the last date for filing a Brief without an extension of time, and therefore an extension of time would be required.

9. ANSWER: (D). 37 C.F.R. § 1.111(b); MPEP §§ 818.03(a)-(c). (I) is incorrect since the traversal does not distinctly point out the supposed errors in the examiner’s action, and no election is made. 37 C.F.R. § 1.143. (II) is incorrect since the traversal does not distinctly point out the supposed errors in the examiner’s action. (III) is incorrect since no election is made. (E) is incorrect because (D) is correct.

10. ANSWER: (E). MPEP § 716.10. There is no requirement that a publication describe something that has actually been reduced to practice before the publication can act as a prior art reference. Thus, statement (A) is not correct. With regard to statement (B), there is no requirement under 35 U.S.C. § 102 that a publication be made with an inventor's knowledge or permission before it constitutes prior art. Statement (C) is incorrect at least because the Wing Cap was "described in a printed publication in...a foreign country" (35 U.S.C. § 102(a)) before Mario's filing date and is therefore presumptive prior art. (D) is incorrect because even if the promotional article constituted an offer to sell, it was not in this country and was made less than a year prior to Mario's filing date. 35 U.S.C. § 102(b).

11. ANSWER: (E). Mario may rely on activities in both Germany (a WTO member country) and Canada (a NAFTA country) in establishing a date of invention prior to publication of the Moose Jaw Monthly article or in establishing priority. 35 U.S.C. § 104; see also MPEP § 715.01(c).

12. ANSWER: (E). MPEP § 410 makes clear that the certification requirement set forth in 37 C.F.R. § 10.18(b) "has permitted the PTO to eliminate the separate verification requirement previously contained in 37 C.F.R. ...1.27 [small entity statements], ...1.52 [English translations of non-English documents], ...1.55 [claim for foreign priority], [and] ...1.102 [petition to make an application special]."

13. ANSWER: (A). 35 U.S.C. § 112, first paragraph. *Enzo Biochem, Inc. v. Calgene, Inc.*, 52 USPQ2d 1129 (Fed. Cir. 1999). As stated in MPEP § 2164.01, "The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term 'undue experimentation,' it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation." (B) is incorrect. As stated in MPEP 2107, part c. The requirement of 35 U.S.C. 101, for a "practical" utility or otherwise, is not a requirement that an applicant demonstrate that a utility is a safe or fully effective for human or animal consumption. *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995). (C) is incorrect. The disclosure is inconsistent with published information. 35 U.S.C. § 112, first paragraph. (D) is incorrect. Enablement for the claims in a utility application is found in the specification preceding the claims, as opposed to being in the claims. The claims do not provide their own enablement. 35 U.S.C. § 112, first paragraph. (E) is incorrect. The lack of necessity to theorize or explain the failures does not alleviate the inventor from complying with 35 U.S.C. § 112, first paragraph by providing an enabling disclosure that is commensurate in scope with the claims.

14. ANSWER: (B). MPEP 715.04. (A) is incorrect since it cannot be shown that less than all the inventors invented the subject matter of claim 2. (C) and (D) are incorrect since the assignee can make an affidavit under 37 C.F.R. § 1.131, only when it is not possible to produce the affidavit of the inventor. The facts indicate that all inventors were readily available produce the affidavit. (E) is incorrect since (B) is correct.

15. ANSWER: All answers accepted.

16. ANSWER: (E) is the most correct answer. Claim 9, though broad, is supported by the specification. The minimum memory recited in the claim as original disclosure, is self-supporting. 35 U.S.C. § 112, first paragraph. Claim 10 is a proper dependent claim because it depends from and further restricts the scope of a preceding claim. 37 C.F.R. § 1.75(c). Claim 11 is an improper dependent claim because it expands upon, as opposed to further restricts, the scope of claim 10. Claim 10, depending on Claim 9, has a 1 gigabyte memory minimum, whereas Claim 11 expands upon the minimum memory by setting a lower minimum of ½ gigabyte.

17. ANSWER: (E) is correct because (B) and (C) are correct. (A) does not overcome the prior art because the broad “comprising” language permits the laminate to include additional layers, such as an adhesive layer. MPEP 2111.03. (B) overcomes a 35 U.S.C. § 102 rejection because the claim requires a light-sensitive layer to be in continuous and direct contact with the transparent protective layer, whereas the prior art interposes an adhesive layer between the light-sensitive layer and transparent protective layer. (C) also avoids the prior art by using a negative limitation to particularly point out and distinctly claim that Smith does not claim any laminate including an adhesive layer. MPEP 2173.05(i).

18. ANSWER: (D). Extending patent term is not a policy underlying any section of 35 U.S.C. § 102. Answers (A), (B), (C) and (E) do state policies underlying the public use bar. *Lough v. Brunswick Corp.*, 86 F.3d 1113, 39 USPQ2d 1100 (Fed. Cir. 1996).

19. ANSWER: (B). 37 C.F.R. § 1.83(a); MPEP §§ 608.02(d) and 706.03(o). Choices (A), (C), and (D) are incorrect. As stated in MPEP § 706.03(o), “If subject matter capable of illustration is originally claimed and it is not shown in the drawing, the claim is not rejected but applicant is required to add it to the drawing.” See MPEP § 608.01(l). (D) is incorrect because the reply is not timely. (E) is incorrect because (B) is correct.

20. ANSWER: (E) is correct and (A), (B), (C), and (D) are wrong because MPEP § 710.02(e), right column of page 700-83, recites, “[I]f applicant initially replies within 2 months from the date of mailing of a final rejection and the examiner mails an advisory action before the end of 3 months from the date of mailing of the final rejection, the shortened statutory period will expire at the end of 3 months from the date of mailing of the final rejection. In such a case, any extension fee would then be calculated from the end of the 3-month period.”

21. ANSWER: (B) is the most correct answer. 37 C.F.R. § 1.72(b); MPEP § 608.01(b).

22. ANSWER: (E). MPEP §§ 715 and 804.02. (II) is incorrect since a 37 C.F.R. § 1.131 affidavit cannot be used to overcome a rejection under 35 U.S.C. § 102(b). MPEP 715. (III) is incorrect since a 37 C.F.R. § 1.131 affidavit cannot be used to overcome a statutory double patenting rejection. MPEP § 804.02. Thus (B) and (C) are incorrect.

23. ANSWER: (C). The original mistake in omitting Tommie from the list of inventors was automatically corrected by filing the oath executed by both Jo and Tommie. 37 C.F.R.

§1.48(f)(1). Under 37 C.F.R. §1.48(b), a change in inventive entity is thereafter required upon cancellation of the non-elected claims. (B) is wrong because inventorship was automatically corrected with the filing of the correct oath. (A) is wrong because Tommie was properly named as a co-inventor in the parent application, and 35 U.S.C. §120 requires, *inter alia*, only one common inventor. (D) is incorrect because an assignee's written consent is not required if an inventor is being deleted because the prosecution of the application results in the cancellation of claims so that fewer than all of the currently named inventors are the actual inventors of the inventions being claimed in the application. 37 C.F.R. §1.48(b). (E) is incorrect because the divisional application never named Jo as an inventor so there is no need to correct the inventorship.

24. ANSWER: (E). Statement (A) is incorrect at least because the parent application, which included claim 20, was incorporated by reference. Therefore, adding claim 20 does not constitute the addition of new matter. Statement (B) is wrong because at least claim 20 is properly viewed as a joint invention ("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"). MPEP §§ 605.07, item (E), and 2137.01. Under 35 U.S.C. § 116, inventors may apply for a patent jointly even if they did not make the same type or amount of contribution and did not each make a contribution to the subject matter of every claim of the patent. Statement (C) is wrong because 35 U.S.C. § 121 precludes such a rejection. Statement (D) is wrong at least because Tommie is entitled to the filing date of the parent application.

25. ANSWER: (E). (E) is correct because the patent does not become a statutory bar against the subject matter of claims 6-10 until the one year from the issuance of the patent. 35 U.S.C. § 102(b). As to (B) and (D), the deliberately cancelled claims cannot be recaptured by reissue. See *In re Watkinson*, 14 USPQ2d 1407 (Fed. Cir. 1990); and MPEP §§ 1412.02 and 1450. (A) is incorrect because (E) is correct. (C) is incorrect because there is no provision in 35 U.S.C. § 251 for filing a reissue application as a divisional application of an issued patent.

26. ANSWER: (C) is the most correct. *Corona v. Dovan* 273 U.S. 692, 1928 CD 252 (1928); MPEP 2138.05 (section styled "Requirements To Establish Actual Reduction To Practice"). (A) is incorrect. MPEP 2138.05, (section styled "Requirements To Establish Actual Reduction To Practice"). The same evidence sufficient to establish a constructive reduction to practice is not necessarily sufficient to establish actual reduction to practice, which requires a showing of the invention in a physical or tangible form containing every element of the count. *Wetmore v. Quick*, 536 F.2d 937, 942 190 USPQ 223 227 (CCPA 1976). (B) is incorrect. MPEP 2138.05 (section styled "Constructive Reduction To Practice Requires Compliance With 35 U.S.C. 112, First Paragraph"). *Kawai v. Metlesics*, 489 F.2d 880, 886, 178 USPQ 158, 163 (CCPA 1973). (D) is incorrect. *Keizer v. Bradley*, 270 F.2d 396, 397, 123 USPQ 215, 216 (CCPA 1959) (the diligence of 35 U.S.C. § 102(g) does not require "an inventor or his attorney to drop all other work and concentrate on the particular invention involved"); MPEP 2138.06. (E) is incorrect. The diligence of a practitioner in preparing and filing an application inures to the benefit of the inventor. See MPEP 2138.06 (section styled "Diligence Required In Preparing And Filing Patent Application"). *Haskell v. Coleburne*, 671 F.2d 1362, 213 USPQ 192,195 (CCPA 1982) (six days to execute and file application was acceptable).

27. ANSWER: (C). MPEP § 2111.02. (A), (B), and (D) are incorrect since the “use” recited in the preamble in Claim 1 does not result in a structural difference between the claimed invention and the disclosure in the Gold patent. *In re Casey*, 370 F.2d 576 (CCPA 1967). (A) is further incorrect since the reply would not be filed within the statutory period. (D) is further incorrect since the rejection is not under 35 U.S.C. § 103, and any “teaching away” in the Gold patent is not applicable to the rejection under 35 U.S.C. § 102(a). (E) is incorrect since evidence of commercial success, relevant to secondary considerations concerning rejections under 35 U.S.C. § 103, is not relevant to overcoming rejections under 35 U.S.C. § 102(a). (C) is correct since the amendment is timely filed, supported by the disclosure, and renders the rejection under 35 U.S.C. § 102(a) inapplicable.

28. ANSWER: (B) is the most correct answer. MPEP 2164.05(a). Statement (i) is true because a later dated publication cannot be used to enable an earlier dated application. Statement (ii) is true since an examiner can look to later dated art if the art discloses the state of the art at the time of the invention. Statement (iii) is false since enablement is judged at the date of filing and later dated references cannot be used to establish enablement.

29. ANSWER: (E) is correct because the express abandonment was the result of a deliberative, intentional course of action. MPEP 711.01. Thus, (A), (B), (C), and (D) are wrong. (A) is wrong because an express abandonment is effective if signed by the attorney or agent of record. 37 C.F.R. § 1.138. (B) is wrong because the express abandonment was filed, not as a mistake, but as the result of a deliberative, intentional course of action, i.e., after careful review of the Office action and the Williams patent, and discussions with XYZ officials. The arrival by you at a different conclusion after reviewing the same facts a second time is not a mistake of fact. *In re Maldague*, 10 USPQ2d 1477, 1478 (Comm’r Pat. 1988). (C) and (D) are wrong because MPEP § 711.03(c) recites, “An intentional abandonment of an application...precludes a finding of unavoidable or unintentional delay pursuant to 37 C.F.R. § 1.137. See *Maldague*, 10 USPQ2d at 1478.”

30. ANSWER: (C). MPEP § 2173.05(c), section III. (I) and (II) are incorrect since the phrase “an effective amount of voltage” has two different functions, i.e., to “protect windshield glass from cracking” and “for defrosting windshields.” A claim has been held to be indefinite when the claim, as in this case, fails to state which of two disclosed functions is to be achieved. Thus, choices (A), (B), and (D) are incorrect. (C) is correct, since the amended claim would state the function that is to be achieved. (E) is incorrect since (C) is correct.

31. ANSWER: (D) is the most correct answer. See MPEP 2143.01, section styled, “The Prior Art Must Suggest The Desirability Of The Claimed Invention”), which states, “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).” (A) is incorrect because the location of the suggestion, teaching, or motivation to modify or combine the teachings is not limited to being found only in the references themselves. MPEP 2143.01. (B) is incorrect. See MPEP 2143.01, section styled “Fact That The Claimed Invention Is Within The Capabilities Of One Of Ordinary Skill In The

Art Is Not Sufficient By Itself To Establish *Prima Facie* Obviousness.” (C) is incorrect. See MPEP 2143.01, section styled “Fact That References Can Be Combined Or Modified Is Not Sufficient To Establish *Prima Facie* Obviousness.” (E) is incorrect inasmuch as (A), (B) and (C) are incorrect.

32. ANSWER: (B). See *Ex parte Mead Johnson & Co.*, 227 USPQ 78 (Bd. Pat. App. & Int. 1985); MPEP 716.02(a) page 700-155 (Absence of Expected Property is Evidence of Nonobviousness). (A) is incorrect. “Expected beneficial results are evidence of obviousness of the claimed invention.” *In re Gershon*, 372 F.2d 535, 538, 152 USPQ 602, 604 (CCPA 1967), MPEP 716.02(c). (C) is incorrect. Unexpected results must be commensurate in scope with the claimed invention. *In re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 298, 296 (CCPA 1980); MPEP 716.02(d). (D) is incorrect. Evidence not showing that the unexpected properties of a claimed invention have a significance equal to or greater than the expected properties may be insufficient to rebut the evidence of obviousness. *In re Nolan*, 553 F.2d 1261, 1267, 193 USPQ 641, 645 (CCPA 1977); MPEP 716.02(c). (E) is incorrect because (A), (C) and (D) are incorrect.

33. ANSWER: (B). 35 U.S.C. § 154(c)(1). Except for circumstances that do not obtain from the given facts, the term of a patent that is in force or that results from an application filed before the date that is 6 months (June 8, 1995) after the date of the enactment of the Uruguay Round Agreements Act (January 8, 1995) shall be the greater of the 20-year term or 17 years from grant. The 20 year term is the “greater” term. As explained in MPEP 1309.01, all patents that will issue on an application that is filed before June 8, 1995, will automatically have a term that is the greater of the twenty year term, which begins on the date the patent issues and ends twenty years from the earliest effective U.S. filing date, or seventeen years from the patent grant. Thus, (A), (C), (D), and (E) are wrong.

34. ANSWER: (C). As stated in MPEP § 707.05(f), “For the purpose of anticipation predicated upon prior knowledge under 35 U.S.C. 102(a), the above noted declassified material may be taken as *prima facie* evidence of such prior knowledge as of its printing date even though such material was classified at that time.” (A) is incorrect. The reference supports the rejection inasmuch as each element of the claimed invention is disclosed in the reference. (B), (D), and (E) are not the most correct. MPEP § 707.05(f).

35. ANSWER: (B). As to (A), (D) and (E), see MPEP §§ 716.07 and 2133.03 (b), page 2100-74 and *In re Epstein*, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994).

36. ANSWER: (B). (A) is wrong because MPEP § 708.02, IV, recites, “An application may be made special upon filing a petition including any evidence showing that the applicant is 65 years of age, or more, such as a birth certificate or applicant’s statement. No fee is required with such a petition.” (C), (D), and (E) are wrong because a fee is required with respect to each petition. MPEP § 708.02, II, VII, and X, respectively.

37. ANSWER: (A) is the most correct, being supported by the disclosure, and further limiting Claim 2. 35 U.S.C. § 112, first paragraph; 37 C.F.R. §§ 1.75(b), 1.75(c). (B) is not supported by the specification. 35 U.S.C. § 112, first paragraph. (C) is incorrect because it is identical to, and

does not differ substantially from Claim 3. MPEP § 706.03(k). (D) and (E) are incorrect because they are not supported by the disclosure in the specification. 35 U.S.C. § 112, first paragraph. Also, (D) is an improper multiple dependent claims because it depends on claims in the conjunctive (“and”), as opposed to the alternative (e.g., “or”). 37 C.F.R. 1.75(c); MPEP § 608.01(n), section I, subsection B, part 1. (E) is also an improper multiple dependent claim because it does not refer to a preceding claim. 37 C.F.R. 1.75(c); MPEP § 608.01(n), section I, subsection B, part 2.

38. ANSWER: (A). *Hester v. Stein*, 46 USPQ2d 1641 (Fed. Cir. 1998). (B) is wrong because arguments alone can cause a surrender of subject matter that may not be recaptured in reissue. *Id.* (C) is wrong because, even if a declaration from Roberts is needed to help establish error, the reissue application will receive a filing date without an oath or declaration. See, e.g., 37 C.F.R. § 1.53(f), MPEP § 1403. (D) is not correct because, although the recapture rule and prosecution history estoppel are similar, prosecution history estoppel relates to efforts by a patentee to expand the effective scope of an issued patent through the doctrine of equivalents. *Hester*. (E) is incorrect because “late claiming” was long ago discredited, particularly in the context of reissue applications. See, e.g., *Correge v. Murphy*, 217 USPQ 753 (Fed. Cir. 1983); *Railroad Dynamics, Inc. v. A. Stucki Company*, 220 USPQ 929.

39. ANSWER: (C) is the most correct. See MPEP 1412.02 Recapture. As to (A), recapture occurs when the claim is broadened. Adding a limitation would narrow the claim. As to (B), recapture does not apply to continuations. As to (D), the two-year date relates to broadening reissue applications, not to the issue of recapture. 35 U.S.C. 251 prescribes a 2-year limit for filing applications for broadening reissues: “No reissue patent shall be granted enlarging the scope of the original patent unless applied for within two years from the grant of the original patent.” (E) is incorrect because a (C) is correct.

40. ANSWER: (E). Since independent claims are the broadest claims in an application, and dependent claims depend on the independent claims, broadening of a dependent claim can not broaden the scope of invention. This logical deduction was also noted in *In re Portola Packaging Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir.1997). As to (A) and (B), continuation applications may be filed before application pendency terminates. Moreover, since narrower claims may be patentable, even though the broader claims are determined to be unpatentable, the narrower claims are not barred. As to (C), obviousness-type double patenting prevents several patents from being based upon obvious improvements. As to (D), failure to claim a feature not found in a genus is of no consequence.

41. ANSWER: (E). 35 U.S.C. §§ 116 and 117; 37 C.F.R. § 1.47. (B) is incorrect because the assignment did not relieve each live inventor from the statutory requirements (35 U.S.C. §§ 115, and 116) to sign the declaration, and for the executor or administrator to sign the declaration. (35 U.S.C. § 117). (B) is also incorrect in deleting the names of Bea and Mae as inventors. (D) is incorrect because the deceased inventor is not missing. See MPEP § 409.03(c). Also, Seya has not shown that Mae could not be found or reached after diligent effort, or that Mae had refused to sign the declaration.

42. ANSWER: (E) is the correct answer. (A) is incorrect since admissions, including figures labeled “prior art” may be used. MPEP 2129. (B) is incorrect since canceled matter in the application file of a U.S. patent becomes available as prior art as of the date the application issues into a patent. See MPEP 2127, and *Ex parte Stalego*, 154 USPQ 52, 53 (Bd. App. 1966) cited therein. (C) is incorrect since an abandoned patent application may become evidence of prior art when it has been appropriately disclosed, as, for example, when it is referenced in a publication. See 37 C.F.R. § 1.14(a)(3)(iv); MPEP 2127; and *Lee Pharmaceutical v. Kreps*, 577 F.2d 610, 613, 198 USPQ 601, 605 (9th Cir. 1978) cited in MPEP 2127. (D) is incorrect because multiple reference rejections under 35 U.S.C. § 102 may be used where one reference is used to merely explain a term used in the primary reference. See MPEP 2131.01 and *In re Baxter Travenol Labs.*, 952 F.2d 388, 21 USPQ2d 1281 (Fed. Cir. 1991) cited therein. (E) is correct since the reference is not by “another.”

43. ANSWER: (E). 35 U.S.C. § 135(b) precludes an applicant from copying a claim from a patent that has been issued for more than one year. The Commissioner cannot waive a statutory requirement. Thus, (A) and (B) are wrong. Similarly, (D) is wrong because the examiner does not have discretionary power to accept claims barred by statute. (C) is wrong not only because Jones does not have an issued patent on which to base jurisdiction under 35 U.S.C. § 291, but also because the PTO is not a party to the suit. *In re McGrew*, 120 F.3d 1236, 43 USPQ2d 1632 (Fed. Cir. 1997); MPEP § 2307.

44. ANSWER: (B). See 37 C.F.R. § 10.87. As to (A), practitioner may not limit damages under 37 C.F.R. § 10.78. As to (C), see 37 C.F.R. § 10.89(b)(1). As to (D), see 37 C.F.R. § 10.89(c)(4). As to (E), see 37 C.F.R. § 10.112(a) where client funds advanced for legal services are required to be deposited in a bank account.

45. ANSWER: (B) is correct. MPEP § 2173.05(h). A Markush group is an acceptable form of alternative expression provided the introductory phrase “consisting of,” and the conjunctive “and” are used. (A) and (D) are incorrect because the conjunctive “or” is used. (C) and (D) are incorrect because the introductory phrase “comprising” is used. (E) is incorrect because R must simultaneously be A, B, C, and D, as opposed to being a single member of the group, i.e., no language provides for the selection of one of the members of the group of A, B, C, and D. MPEP § 2173.05(h).

46. ANSWER: (A) is the most correct answer. Hand entry of amendments is no longer permitted. 37 C.F.R. § 1.121(b)(2). Answers (B), (C) and (D) are all correct pursuant to the December 1, 1997, change. 37 C.F.R. §§ 1.121(b)(2)(ii), and 1.121(b)(2)(iii). Answer (E) is also a correct statement. 37 C.F.R. § 1.121(b)(2)(i)(A) and MPEP § 1453, page 1400-37 through 39.

47. ANSWER: (B). Any person at any time may file a request for reexamination. 35 U.S.C. § 302. As to (A) loser may appeal to District Court under 35 U.S.C. § 146. As to (C), there is no prohibition regarding spouses, family members, and other relatives. As to (D) according to 35 U.S.C. § 4, employees are prohibited during the period of their employment and one year thereafter. As to (E), (B) is true.

48. ANSWER: (C). 37 C.F.R. § 1.56; MPEP 2001.01. (A) is incorrect since both the inventor and registered practitioner have a duty to disclose under 37 CFR 1.56(c)(1) & (2). (B) is incorrect since the disclosure must be in writing. (D) is incorrect because the duty does not depend on the likelihood that an examiner would find the art independently. (E) is incorrect since the patent may be relied upon for a rejection under 35 U.S.C. § 102(a) and the patent therefore is material to patentability.

49. ANSWER: (A). 37 C.F.R. § 10.84(b)(2) specifies that a practitioner may refuse to aid or participate in conduct the practitioner believes to be unlawful, even though there is some support for an argument that the conduct is legal. Thus, statement (A) is FALSE. Statement (B) is TRUE. 37 C.F.R. § 10.49. Statement (C) is TRUE. 37 C.F.R. § 10.64(a)(3). Statement (D) is TRUE. 37 C.F.R. § 10.85(b)(1). Statement (E) is TRUE. 37 C.F.R. § 10.68(a)(1).

50. ANSWER: (E). MPEP 2133.03(e)(6) sets forth that while technological, developmental testing is permitted and is not a bar under 35 U.S.C. § 102(b), market testing is not permitted. Choice (A) is incorrect. Since Smith’s activities, as set forth by the facts given in the question, included market testing, choices (B) and (C) are incorrect. (C) is further incorrect since an affidavit under 37 C.F.R. § 1.131 is not applicable to rejections under 35 U.S.C. § 102(b). (D) is incorrect since secondary considerations, such as commercial success, are not applicable rejections under 35 U.S.C. § 102(b).

Test Number 100
Test Series 456

Name _____

**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 dispensing 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.
- (E) 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.

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 advise 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 advice 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. Smith refuses to revoke the power of attorney given to you, but Snix, president of 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.

**Examination for Registration to Practice in Patent Cases
Before the U.S. Patent and Trademark Office
April 12, 2000**

Afternoon Session Model Answers

**Examination for Registration to Practice in Patent Cases
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Afternoon Session Answers

1. ANSWER: (D) is correct because gross sales figures must be measured against a logical standard in order to determine whether or not there is commercial success. The recitations of accompanying evidence in (A), (B), and (C) are logical in that they provide a comparative basis for determining commercial success. (D), on the other hand, recites accompanying evidence which is illogical in that it does not provide a comparative basis for determining commercial success. (E) is wrong because it provides a logical basis for attributing commercial success to the design of the device, rather than the utilitarian function of the device. MPEP 716.03(b).
2. ANSWER: (E). *In re Tiffin and Erdman*, 171 USPQ 294 (CCPA 1971). MPEP § 716.03(a). (A), (B), (C), and (D) are wrong. *In re Tiffin and Erdman*, 170 USPQ 88, 91, 92 (CCPA 1971). MPEP § 716.03(a).
3. ANSWER: (D). MPEP § 2292. As to (A) see 37 C.F.R. § 1.602(a). As to (B) see 37 C.F.R. § 1.601(m), which provides that the senior party has earliest effective filing date. As to (C), see MPEP § 2285 regarding merger of reissues and reexamination proceedings. As to (E), (D) is true.
4. ANSWER: (D). Answer (A) does not provide proper antecedent basis for “said first end” in part (ii) of the claim and “said second end” in part (iv) of the claim. Answer (B) fails to provide proper antecedent basis for “said dispensing chamber” in part (iii) of the claim, and “said second end” in part (iv) of the claim. Answer (C) fails to provide proper antecedent basis for “said second end” in part (iv) of the claim and “said longitudinal sides of said channel” in part (v) of the claim. Answer (E) fails to provide proper antecedent basis for “said dispensing chamber” in part (iii) and subsequent parts of the claim.
5. ANSWER: (E) is the most correct reply. Beverly’s thesis constitutes a printed publication as of January 29, 1999. *In re Hall*, 228 USPQ 453 (Fed. Cir. 1986). Since (B) and (C) are both correct statements, the most correct response is (E). (A) is incorrect. To 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, the published thesis must have been published more than one year before the application for patent. The publication of Beverly’s thesis on January 29, 1999, is less than one year before the filing of the application on January 15, 2000.
6. ANSWER: (C) is correct because it sets forth the modified showing discussed in MPEP § 711.03(c), item subsection II, and complies with the fact noted in MPEP § 711.03(c), subsection

I, that a petition to withdraw holding of abandonment does not require a fee. (A) and (B) are wrong because they fail to recite that each petition must be accompanied by a petition fee as set forth in 37 C.F.R. §§ 1.17(l) and (m), respectively. MPEP § 711.03(c), item subsection III. (A) is also incorrect because a mere statement that the delay was unavoidable is insufficient. Evidence is necessary showing the delay was unavoidable.

7. ANSWER: (A). 37 C.F.R. § 10.66(a). If not an actual conflict of interest, clearly there is a potential conflict of interest between a present and prospective client. The partner practitioner already represents ANY Corp. The prospective client is being accused by the practitioner's present client of infringing its about-to-be issued patent. Acceptance of the proffered employment would be likely to involve the practitioner in representing differing interests. (B), (C), (D), and (E) are not the most correct answers. Even in potential conflict of interest situations, the practitioner must obtain the consent of ANY Corp., after full disclosure, before acting on behalf of XYZ Corp. 37 C.F.R. § 10.66(c). There are no given facts showing that informed consent of ANY Corp. has been obtained.

8. ANSWER: (A). 35 U.S.C. § 305; 37 C.F.R. § 1.530(d)(3); MPEP § 2250, 2258, subsection III ("A broadened claim: A claim is broader than another claim if it is broader (greater in scope) 'in any respect,' even though it may be narrower in other respects. *In re Freeman*, 30 F.3d 1459, 1464, 32 USPQ2d 1444, 1447 (Fed. Cir. 1994)."). The claim is broadened by changing "knife" to "cutting means," which is not limited to a knife, but may be a blade, scissors, etc.

9. ANSWER: (C) is the most correct answer. As explained in MPEP § 710.02(e), pages 700-82 and 83, if an applicant initially replies within 2 months from the date of mailing of a final rejection, and the examiner, however, does not mail an Advisory Action until after the end of 3 months, the shortened statutory period will expire on the date the examiner mails the Advisory Action and any extension fee may be calculated from that date. (A), (B), (D), and (E) are contrary to MPEP § 710.02(e), and therefore are incorrect.

10. ANSWER: (B). See MPEP §§ 2287 and 2288. As to (E), Sam must request to withdraw and obtain permission from the PTO in accordance with 37 C.F.R. § 10.40 and MPEP § 402.06. As to (A), bankruptcy will not stay a reexamination. As to (C), false representations are prohibited by the rules. As to (D), there are no divisional reexaminations.

11. ANSWER: (E). As to (A) continuation need only have one inventor in common. MPEP 201.07. As to (B), failure to timely file a divisional application is not considered "error" and proper grounds for filing a reissue application. MPEP 1402. As to (C), "since in a patent it is presumed that a process if used by one skilled in the art will produce the product or result described therein, such presumption is not overcome by a mere showing that it is possible to operate within the disclosure without obtaining the alleged product. *In re Weber*, 405 F.2d 1403, 160 USPQ 549 (CCPA 1969)." MPEP 716.07. As to (D), the application is not abandoned. MPEP 1215, page 1200-36.

12. ANSWER: (E). Protests may be filed pursuant to 37 C.F.R. § 1.291. See MPEP § 1901.02. However, since protester may not be advised as to the outcome of protest, it behooves him to file a patent application listing both parties as co-inventors in accordance with 35 U.S.C. § 116. As to (D), since the inventorship is not correct, and was deceptively filed, the issued patent is likely to be declared invalid and he would not recover any royalties. (A) is incorrect because Clem is misrepresenting that he believes himself to be the sole inventor, whereas he has admitted that the invention "was partly Tine's idea." 37 C.F.R. § 1.56.

13. ANSWER: (D). 35 U.S.C. § 41(a). For fee calculation purposes, MPEP § 608.01(n), subsection G.2, states that “claims in proper multiple dependent form may not be considered as single dependent claims for the purpose of calculating fees. Thus, a multiple dependent claim is considered to be that number of dependent claims to which it refers. Any proper claim depending directly or indirectly from a multiple dependent claim is also considered as the number of dependent claims as referred to in the multiple dependent claim from which it depends.”

14. ANSWER: (B). Certificate of mailing is not required for Express Mail. See 37 C.F.R. § 1.10(e); MPEP 513 at 500-47. As to the others see 1.10(e) or MPEP 513 at 500-49. (A), (C), (D) and (E) are necessary to comply with the provisions of 37 C.F.R. § 1.10(e).

15. ANSWER: (E) is correct because 35 U.S.C. § 112 authorizes multiple dependent claims as long as they are in the alternative form. MPEP § 608.01(n), subsection I A.

16. ANSWER: (B). *In re Merck & Co.*, 231 USPQ 375 (Fed. Cir. 1986); *Newell Cos. v. Kenney Mfg.*, 9 USPQ2d 1417 (Fed. Cir. 1988). Statement (A) is not correct because, although nearly simultaneous invention may be a factor in making an obviousness determination, it does not in itself preclude patentability. *Environmental Designs, Ltd. v. Union Oil Co.*, 218 USPQ 865 (Fed. Cir. 1983). Statements (C) and (D) are incorrect because nearly simultaneous invention bears on neither long-felt need nor commercial success. Statement (E) is incorrect because statement (B) is correct.

17. ANSWER: (B). 35 U.S.C. § 102(g); MPEP § 2138.01; *Mahurkar v. C.R. Bard, Inc.*, 38 USPQ2d 1288 (Fed. Cir. 1996). If statement (A) was correct, there would be no need for interference proceedings. Statement (C) is incorrect because Debbie need not establish diligence for the period from February 1999 until just before Billie’s conception on May 15, 1999. Statement (D) is incorrect. Debbie needs to show diligence only from May 14th to her actual reduction to practice in June. Debbie is not required to show diligence between actual reduction to practice and her subsequent constructive reduction to practice in December 1999, so long as she has not abandoned, suppressed or concealed the invention. 35 U.S.C. § 102(g). Statement (E) is inconsistent with 35 U.S.C. § 102(g).

18. ANSWER: (E) is the most correct answer because each statement, (A), (B), (C) and (D) is correct. (A) is correct. See MPEP 2141.02 (subsection styled, “Applicants Alleging Discovery Of A Source Of A Problem Must Provide Substantiating Evidence”); *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979). (B) and (C) are correct. See MPEP 716.01(c); *In re Knowlton*, 500 F.2d 566, 572, 183 USPQ 33, 37 (CCPA 1974) (where the record consisted substantially of arguments and opinions of applicant's attorney, the court indicated that factual affidavits could have provided important evidence on the issue of enablement). Arguments of counsel alone cannot take the place of evidence in the record once an examiner has advanced a reasonable basis for questioning the disclosure. See *In re Budnick*, 537 F.2d at 538, 190 USPQ at 424; *In re Schulze*, 346 F.2d 600, 145 USPQ 716 (CCPA 1965); and *In re Cole*, 326 F.2d 769, 140 USPQ 230 (CCPA 1964). (D) is correct. MPEP 716.01(c) and 2145.

19. ANSWER: (B) is the most correct answer. As to (A) and (B) see MPEP 2286, page 2200-97, stating, “[t]he issuance of a final district court decision upholding validity during a reexamination also will have no binding effect on the examination of the reexamination.” Thus, (A) is incorrect because a final holding of invalidity is binding on the PTO. As to (C), the PTO may discover new art and find claims unpatentable as that art would raise a substantial new question. MPEP §§ 2216 and 2286. As to (D), the patentee could file a prior art statement under 35 U.S.C. § 301, or disclose prior art in reissue application if the original patent (through error without deceptive intent) is defective or claims more or less than should be claimed. As to (E), preponderance of evidence standard does not change in reexamination proceedings. MPEP 2286.

20. ANSWER: (C) is the most correct answer. MPEP § 710.06. (I) is incorrect since this does not constitute error by the examiner. (II) is incorrect, since a reply would be due by the reply date, regardless of whether the rejection was traversed. Thus (A), (B), and (D) are incorrect. (E) is incorrect because C is correct.

21. ANSWER: (E). Roberts is not entitled to a patent because he did not himself invent the subject matter sought to be patented. 35 U.S.C. § 102(f). Therefore, statement (C) cannot be correct. Statement (A) is incorrect because, although the machine was known by others, it was not known by others in this country as required under 35 U.S.C. § 102(a). Similarly, statements (B) and (D) are incorrect because, even if there was a sale or public use more than a year before Roberts’ filing date, it was not “in this country” as required by 35 U.S.C. § 102(b).

22. ANSWER: (B). See 37 C.F.R. § 1.10. Parties using “Express Mail” drop boxes do so at their own risk. As explained in MPEP § 513:

37 C.F.R. 1.10(b) further provides that correspondence should be deposited directly with an employee of the USPS to ensure that the person depositing the correspondence receives a legible copy of the "Express Mail" mailing label with the "date - in" clearly marked, and that persons dealing indirectly with the employees of the USPS (such as by depositing correspondence in an "Express Mail" drop box) do so at the risk of not receiving a copy of the "Express Mail" mailing label with the desired "date - in" clearly marked. On petition, the failure to obtain an "Express Mail" receipt with the "date - in" clearly marked may be considered an omission that could have been avoided by the exercise of due care, as discussed below. While the Office strongly urges direct deposit of "Express Mail" correspondence in order to obtain a legible copy of the "Express Mail" mailing label, parties are not precluded from using "Express Mail" drop boxes, but do so at their own risk.

A paper or fee placed in an "Express Mail" box receptacle after the box has been cleared for the last time on a given day will be considered to be deposited as of the date of receipt ("date-in") indicated on the "Express Mail" mailing label by the Postal Service "Express Mail" acceptance clerk. 37 C.F.R. 1.10(d) permits the Office to correct a USPS "date - in" error when the correspondence is deposited in an "Express Mail" drop box prior to last scheduled pick up of the day, that is, the time clearly marked on the "Express Mail" drop box indicating when the box will

be cleared for the last time on the date of deposit. 37 C.F.R. 1.10(d) sets forth the procedures to be followed to be entitled to such a correction.

Parties who do use drop boxes can protect themselves from uncertainty due to illegible mailing labels by routinely maintaining a log of "Express Mail" deposits in which notations are entered by the person who deposited the correspondence as "Express Mail" within one business day after deposit with the USPS. Such evidence could be useful to later support a petition filed under 37 C.F.R. 1.10(c), (d) or (e). Evidence that came into being after deposit and within one day after the deposit of the correspondence as "Express Mail" may be in the form of a log book which contains information such as the "Express Mail" number; the application number, attorney docket number or other such file identification number; the place, date and time of deposit; the time of the last scheduled pick-up for that date and place of deposit; the depositor's initials or signature; and the date and time of entry in the log.

23. ANSWER: (C). As to answer (A), the publication in Popular Scientist was not enabling. Unless it is a statutory bar, a rejection based on a publication may be overcome by a showing that it was published either by applicant himself/herself on his/her behalf. MPEP § 715.01(c). The level of disclosure required within a reference to make it an "enabling disclosure" is the same no matter what type of prior art is at issue. It does not matter whether the prior art reference is a U.S. patent, foreign patent, a printed publication or other. *Cf.* MPEP § 2121. "In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure'..." *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). MPEP § 2121.01. As to answer (B), 35 U.S.C. 132 states that "[n]o amendment shall introduce new matter into the disclosure of the invention." As to (C), statutory bars of 35 USC 102(b) are applicable even though public use is by a third party. MPEP § 2133.03(e)(7). The statutory bar would apply to the modification by Ajax to use the windshield wiper device on trucks. As to (E), it is not necessary that the applicant be aware of the public use by the third party Ajax. As to (D), Chris would be barred by the public use of the truck embodiment by Ajax on September 1, 1998 as the C-I-P would not receive the benefit of the earlier filing date with respect to the truck embodiment since the original disclosure did not include the truck embodiment.

24. ANSWER: (E). An applicant dissatisfied with a decision by the Board of Patent Appeals and Interferences may appeal the decision to the United States Court of Appeals for the Federal Circuit (35 U.S.C. § 141) or may have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia (35 U.S.C. § 145). MPEP § 1216.

25. ANSWER: (B). MPEP 324, and 402.07. The submission may be signed by a person in the organization having apparent authority to sign on behalf of the organization – an officer. In (B), the submission is signed by the President, an office having apparent authority. (I) and (III) are incorrect since Joe is neither a registered practitioner nor an officer of the company. (III) also is incorrect since the assignment by Smith to Fix does not automatically operate as a revocation of

the power of attorney. 37 C.F.R. § 1.36. Thus, (A), (C), and (D) are incorrect. (E) is incorrect since (B) is correct.

26. ANSWER: (A) is the most correct answer. 37 C.F.R. § 1.121(a)(2)(ii); MPEP § 608.01(n). (B) and (C) are incorrect because the claim does not refer back in the alternative only. MPEP § 608.01(n). (D) is incorrect because it combines procedures for adding a claim (claim 4), and amending an existing claim (claim 3). For example, a newly added claim would not contain underlined words. 37 C.F.R. § 1.121(a)(2)(ii). (E) is incorrect because the claim number is underlined as are all the words in the claim even though no matter is added. 37 C.F.R. § 1.121(a)(2)(ii).

27. ANSWER: (B) is the most correct answer. 37 C.F.R. § 1.121; MPEP § 714.22. The amendment in (B) specifies the exact matter to be inserted, the exact point where the insertion is to be made, and is limited to five words or less. (A) is incorrect because there are two occurrences of “steam” in line 4, and the exact location where the insertion is to occur is unspecified. (C) is incorrect because the amendment does not specify the exact point where the insertion of “two” is to occur. (D) is incorrect because the amendment would insert more than five words. (E) is incorrect because it fails to identify the correct point where the deletion and insertion is to made.

28. ANSWER: (E). See MPEP 1414 Content of Reissue Oath/Declaration and 37 CFR 1.175(a) which states that reissue oaths/declarations must meet the requirements of 37 CFR 1.63, including 1.63(c) relating to a claim for foreign priority. As to (A), 37 CFR 1.192(c)(7) requires appellant to state that the claims do not stand or fall together. Appellant must present appropriate argument under 37 CFR 1.192(c)(8) why each claim is separately patentable. Merely pointing out differences in what the claims cover is not argument why the claims are separately patentable. MPEP 1206, pages 1200-8 and 9. As to (B), see MPEP 1002 and the sentence bridging pages 1000-2 and 1000-3. As to (C), 37 CFR 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner’s answer. As to (D), continuation may be filed during pendency of parent.

29. ANSWER: (A) is the most correct answer. 35 U.S.C. § 102(d), and MPEP § 2135 expressly list (B), (C), (D) and (E) as the four conditions which, if all are present, establish a bar against the granting of a patent in this country. The foreign patent or inventor’s certificate described in (A) need not be published to establish a 35 U.S.C. § 102(d) bar. MPEP § 2135.01(III)(E).

30. ANSWER: (B). 37 C.F.R. § 1.6(d); MPEP § 502. Choices (A) and (C) are incorrect since a request for reexamination may not be properly transmitted by facsimile. 37 C.F.R. § 1.6(d)(5). Choice (D) is incorrect because a filing date for a national patent application filed under 37 C.F.R. § 1.53(b) may not be obtained by filing through facsimile. 37 C.F.R. §§ 1.6(d)(3) and 1.8(a)(2)(i)(A). (E) is incorrect since (B) is correct.

31. ANSWER: (E). 35 U.S.C. §§ 112, fourth paragraph, and 251. The claim is not a proper dependent claim because it is broader than the claim from which it depends. The expression “up to 300 amps” would include 0 to 300 amps, which is outside the 100-300 amp range disclosed in

the specification, and recited in Claim 1. (A) is a proper dependent claim because the wattage is within the range limitation set out in Claim 1. (B) is a proper dependent claim because the wattage and voltage are within the range limitations set out in Claim 1. (C) and (D) are proper dependent claims because the wattage and voltage are within the range limitations set out in Claim 1.

32. ANSWER: (C) is the most correct answer. The method of use is neither disclosed nor suggested by the prior art. 35 U.S.C. §§ 102(b) and 103. (A) is incorrect because the process of using the composition as a fishing lure is not disclosed in the prior art, and the PTO guidelines support such a claim in these circumstances. MPEP § 2112.02. (B) is incorrect because the claim is anticipated. 35 U.S.C. § 102(b). (D) is incorrect because the composition is anticipated. 35 U.S.C. § 102(b). (E) is incorrect because filing a Disclosure Document does not provide the invention with protection afforded by the PTO. The Disclosure Document may be relied on only as evidence of its content, and is not a patent application. MPEP § 1706.

33. ANSWER: (A) is correct. MPEP § 2173.05, part (c) indicates that a preferred narrower range set forth within a broader range may render the claim indefinite if the boundaries of the claim are not discernable. (B), (C) and (D) are incorrect. MPEP § 2173.05(c), part (I) indicates that reciting in a single claim both a broad range and a preferred narrower range within the broad range may render the claim indefinite. (E) is incorrect. The doctrine of equivalents operates to expand claim coverage beyond the literal scope of the claim language.

34. ANSWER: (C) is correct. 35 U.S.C. § 151; 37 C.F.R. § 1.311; MPEP §§ 505 and 1306. (A) is incorrect. The procedure complies with 35 U.S.C. §§ 21(b) and 151. (B) is incorrect. The procedure complies with 35 U.S.C. § 151, and 37 C.F.R. § 1.7. (D) is not correct. The procedure complies with 35 U.S.C. §§ 21(b) and 151, and 37 C.F.R. § 1.8. (E) is incorrect because (B) and (D) are incorrect.

35. ANSWER: (B) is the most correct answer because different embodiments or modifications must be shown in the drawings. MPEP § 1503.01. Answer (A) is a proper statement. MPEP § 1503.01, page 1500-3. Answer (C) is a correct statement. 37 C.F.R. § 1.152(a)(2). Answer (D) is a correct statement. A design application may only contain a single claim. MPEP § 1503.03 and 37 C.F.R. § 1.153(a). Answer (E) is a correct statement which states how designs are evaluated. MPEP § 1504.

36. ANSWER: (B). As to (B), see 37 C.F.R. § 10.11(b), where “the names of individuals so removed will be published in the Official Gazette.” The rule does not require notice to be published before the names of individuals are removed. As to (A), a practitioner must notify the Director as set forth in 37 C.F.R. § 10.11 (a). As to (C), see 37 C.F.R. § 10.84(b)(2). As to (D) registration only entitles one to practice before the USPTO in patent cases. 37 C.F.R. §§ 10.5 and 10.14(a). As to (E), see 37 C.F.R. § 10.23(c)(4)(iii) regarding improperly bestowing of any gift, favor or thing of value.

37. ANSWER: (A). 37 C.F.R. § 1.111; MPEP § 714.02. (B) is incorrect because the fee must be paid when the request for extension of time is made. 37 C.F.R. § 1.136(a); MPEP 710.02(e). (C) is incorrect. The client did not give instructions to file the amendment today. Further, an

amendment canceling all claims is non-responsive to the non-final rejection. As stated in 37 C.F.R. § 1.111(b), “In order to be entitled to reconsideration..., the applicant...must reply to the Office action. The reply...must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner’s action and must reply to every ground of objection and rejection in the prior Office action.” MPEP § 714.19, item (H). (D) is incorrect. “A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.” 37 C.F.R. § 1.111(b). (E) is incorrect inasmuch as it does not comply with 37 C.F.R. § 1.111(b).

38. ANSWER: (B) is the most correct answer. *Ex parte Utschig*, 156 USPQ 156, 157 (Bd. App. 1966); MPEP § 2137.01 (section styled “Inventorship Is Generally ‘To Another’ Where There Are Different Inventive Entities With At Least One Inventor In Common”). (A) is incorrect. The same inventive entity obtains, regardless of the order in which the inventors are listed, inasmuch as the same inventors are recited. (C) is incorrect. The presence of a common inventor in a reference patent and application does not preclude determination that the inventive entity in the reference is to another within the meaning of 35 U.S.C. § 102(e). *Ex parte DesOrmeaus*, 25 USPQ2d 2040 (Bd. Pat. App. & Inter. 1992). (D) is incorrect. Merely the fact that the inventive entities differ does not cause the patent to necessarily be prior art. *Applied Materials Inc. v. Gemini Research Corp.*, 835 F.2d 279, 281, 15 USPQ2d 1816, 1818 (Fed. Cir. 1988); MPEP § 2137.01. (E) is incorrect because (A) and (C) are incorrect.

39. ANSWER: (B). When, as here, a broadening reissue is applied for within the two-year time limit set forth in 35 U.S.C. § 251, an amendment presenting further broadened claims after the two-year period is appropriate if the later-presented claims are supported by the original reissue oath. *In re Doll*, 419 F.2d 925, 928, 164 USPQ 218 (CCPA 1970); MPEP § 1412.03. Thus, answers (A), (C) and (D) are not correct. Answer (E) is not correct because a broadening reissue application does not preclude presentation of narrower claims. 37 C.F.R. § 1.175(a)(1) “more or less than patentee had a right to claim”; MPEP § 1444.

40. ANSWER: (E). Under 35 U.S.C. § 42(d) the Commissioner may refund any fee paid by mistake or in excess of the fee required by law. Where the fee is not paid by mistake or in excess of the fee required by law, the Commissioner is not obligated to make the refund. *Miessner v. United States*, 228 F.2d 643, 108 USPQ 6 (D.C. Cir. 1955). (A), (B), (C) and (D) are incorrect inasmuch as fees were not paid by mistake or in excess of the fee required. 37 C.F.R. § 1.26.

41. ANSWER: (A). MPEP 706.02(a). (B) is incorrect since the foreign patent, published more than one year before the effective filing date of the application, would serve as a bar regardless of the attempt to claim priority. 35 U.S.C. § 102(b). (C) is incorrect since market testing is not a proper exception to a statutory bar under 35 U.S.C. § 102(b). MPEP 2133.03(e)(6). Also, the facts do not involve testing the invention, but only the packaging. (D) is incorrect since a reference may be used to reject claims under both 35 U.S.C. § 102 and 35 U.S.C. § 103. MPEP 2141.01. (E) is incorrect since only (A) may not properly be used.

42. ANSWER: (E). The claim in (A) recites sufficient acts performed on subject matter, e.g., passing the signals through the filter. See MPEP 2173.05(q), and *Ex parte Porter*, 25 USPQ2d

1144 (Bd. Pat. App. & Int. 1992) cited therein. Thus, (A) is a proper process claim. The claim in (B) recites the act of polymerizing an organic compound by sufficient acts. Therefore, (B) appropriately claims a process. The claim in (C) is not a proper process claim because it does not recite an act specifying how a use or process is accomplished. Therefore, the claim is indefinite, 35 U.S.C. § 112, and/or an improper definition of a process under 35 U.S.C. § 101. See MPEP 2173.05(q); *Ex parte Erlich*, 3 USPQ2d 1011 (Bd. Pat. App. & Int. 1986) (a claim to “A process for using monoclonal antibodies of claim 4 to isolate and purify human fibroblast interferon” was held to be indefinite because it merely recites a use without any active, positive steps delimiting how this use is actually practiced); *Clinical Products Ltd., v. Brenner*, 255 F.Supp. 131, 149 USPQ 475 (D.D.C. 1996) (claim to “The use of a sustained release therapeutic agent in the body of ephedrine absorbed upon polystyrene sulfonic acid” is not a proper process claim under 35 U.S.C. § 101). (D) is incorrect because (C) is incorrect.

43. ANSWER: (D). See 37 CFR § 10.40 where it states: “(b) Mandatory withdrawal. A practitioner representing a client before the Office shall withdraw from employment if:... (4) The practitioner is discharged by the client.” As to (A), practitioner may not enter into a partnership with a nonpractitioner where any of the practice of the partnership consists of patent, trademark or other law before the PTO. 37 C.F.R. § 10.49. As to (B), see 37 C.F.R. § 10.23(c)(7) regarding knowingly withholding from the Office information identifying a patent of another from which one or more claims have been copied. As to (C), a practitioner is proscribed from neglecting an entrusted legal matter. 37 C.F.R. § 10.77(c). The practitioner must file a request to withdraw and avoid foreseeable prejudice to the client’s rights where a client refuses to pay a practitioner. 37 C.F.R. § 10.40. As to (E), practitioner may not accept compensation from someone other than his or her client. 37 CFR § 10.68.

44. ANSWER: (A) is the most correct answer. See MPEP § 2137, p.2100-89. (B) is incorrect. The mere fact that the claim recites components, all of which can be argumentatively assumed to be old, does not provide a basis for rejection under 35 U.S.C. § 102(f). *Ex parte Billottet*, 192 USPQ 413, 415 (Bd. App. 1976); MPEP§ 2137. (C) is incorrect. One must contribute to the conception to be an inventor. *In re Hardee*, 223 USPQ 1122, 1123 (Comm’r Pat. 1984). Unless a person contributes to the conception of the invention, the person cannot be an inventor. *Fiers v. Revel*, 984 F.2d 1164, 1168, 25 USPQ2d 1601, 1604-05 (Fed. Cir. 1993); MPEP § 2137.01 (section styled “An Inventor Must Contribute To The Conception of the Invention”). (D) is incorrect. An inventor may consider and adopt suggestions from many sources. *Morse v. Porter*, 155 USPQ 280, 283 (Bd. Pat. Inter. 1965); *New England Braiding Co. v. A.W. Cheterton Co.*, 970 F.2d. 878, 883, 23 USPQ2d 1622, 1626 (Fed. Cir. 1992); MPEP § 2137.01 (section styled “As Long As The Inventor Maintains Intellectual Domination Over Making The Invention, Ideas, Suggestions, And Materials May Be Adopted From Others”). (E) is incorrect. *In re DeBaun*, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982) (“there is no requirement that the inventor be the one to reduce the invention to practice so long as the reduction to practice was done on his behalf”); MPEP § 2137.01 (section styled “The Inventor Is Not Required To Reduce The Invention To Practice”).

45. ANSWER: (C). MPEP § 1411.02. (A) is incorrect because a rejection for new matter in a reissue application must be made under 35 U.S.C. § 251, and not 35 U.S.C. § 132. (B) is incorrect because patent complied with 35 U.S.C. § 101 inasmuch as the patent disclosed a use

for the invention, and Jones is not required by the Patent Statute to disclose the best mode for achieving commercial success. (D) is incorrect because the embodiment was not disclosed in the original patent. (E) is incorrect because (B) and (D) are incorrect.

46. ANSWER: (A). 35 U.S.C. § 41(h); 37 C.F.R. § 1.9; and MPEP § 509.02. Choices (B) and (C), although raising issues involving a “Petition to make special” MPEP § 708.02, are not provided for regarding small entity status. Choice (D) is incorrect. (E) is incorrect since (A) is correct.

47. ANSWER: (A). MPEP 706.07(c) and (d) set forth that prematureness of a final rejection may not be advanced as a ground for appeal. (II) is therefore improper. (II) is also improper because required fees have not been paid. 37 C.F.R. §§ 1.191 and 1.192. (III) is improper because the filing of the petition does not stay the period for reply. MPEP 1002. Thus, choices (B), (C), and (D) are incorrect. (E) is incorrect because (A) is correct.

48. ANSWER: (D) is the most correct answer. 35 U.S.C. § 103(a); *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977) (“In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question...but also to those properties of the subject matter which are inherent in the subject matter *and* are disclosed in the specification...”); MPEP 2141.02 (section styled, “Disclosed Inherent Properties Art Part of ‘As A Whole’ Inquiry”). (A) is incorrect. MPEP 2141.01(a). PTO classification is some evidence of analogy/non-analogy, but structure and function carry more weight. *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973). (B) is incorrect. MPEP 2141.02. The question under 35 U.S.C. § 103 is whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). (C) is incorrect. MPEP 2141.02 (section styled, “Distilling The Invention Down To a ‘Gist’ or ‘Thrust’ Of An Invention Disregards ‘As A Whole’ Requirement”). *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987), *cert. denied*, 481 U.S. 1052 (1987) (district court improperly distilled claims down to a one word solution to a problem). (E) is incorrect. As stated in MPEP 2141.02 (section styled, “Disclosed Inherent Properties Are Part Of ‘As A Whole’ Inquiry”), “Obviousness cannot be predicated on what is not known at the time an invention is made, even if the inherency of a certain feature is later established. *In re Rijckaert*, 9 F.2d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993).”

49. ANSWER: (E). The applications C and D were abandoned after midnight of July 21, 1999, therefore they are technically not abandoned on July 21, 1999. There is no copendency between applications E and any prior application. MPEP § 201.11 (“If the first application is abandoned, the second application must be filed before the abandonment in order for it to be co-pending with the first.”). See MPEP § 710.01(a), fourth paragraph.

50. ANSWER: (A),(B), or (E). As to (A) it is true that reissues may be filed within two years to correct errors made without deceptive intent. 35 U.S.C. § 251. Regarding (B), there is no limit on the number of parties or countries or winners. A given inventor may have reduced to practice certain counts without having reduced to practice others. As to (E), it too is true inasmuch as no

facts are given that the request is filed for purposes of harassment. As has been stated in the see MPEP § 2240 regarding harassment of the patent owner wherein it states:

SECOND OR SUBSEQUENT REQUEST FILED DURING REEXAMINATION

If a second or subsequent request for reexamination is filed (by any party) while a reexamination is pending, the presence of a substantial new question of patentability depends on the prior art cited by the second or subsequent requester. If the requester includes in the second or subsequent request prior art which raised a substantial new question in the pending reexamination, reexamination should generally be ordered. This is because the prior art which raised a substantial new question of patentability resulting in an order for reexamination continues to raise a substantial new question of patentability until the pending reexamination is concluded. However, in aggravated situations, upon petition by the patent owner under 37 CFR 1.182, where it appears clear that the second or subsequent request was filed for purposes of harassment of the patent owner, the request should be denied.

As to (C) see 37 C.F.R. § 3.56. As to (D), see 37 C.F.R. § 3.81.