

Test Number 123
Test Series 101

Name _____

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

APRIL 18, 2001

Morning Session (50 Points)

Time: 3 Hours

DIRECTIONS

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

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

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

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

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO

This examination addresses provisions of the Patent Statute, regulations and MPEP which were not changed as a result of the enactment of the American Inventors Protection Act of 1999, Pub. L. No. 106-113 ("Act"). This examination also does address and test changes to the Patent Statute or regulations brought about by the enactment of the Act. Some, but not all, questions use the statute and rules, comments to the rules, and guidelines in place subsequent to November 28, 1999, including the following rule changes and guidelines in effect on or before January 20, 2001:

? Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule. 65 FR 50092 (Aug. 16, 2000) (including the adoption of changes set forth in Interim Rule, 65 FR 14865 (Mar. 20, 2000) to §§ 1.7, 1.17(e) and (i), 1.53(d)(1), 1.78(a)(3), 1.97(b), 1.104(c)(4), 1.113, 1.116, 1.198, 1.312, and 1.313(a), (b), (c)(1), (c)(3), and (d)).

? Changes to Permit Payment of Patent and Trademark Fees by Credit Card; Final Rule. 65 FR 33452 (May 24, 2000).

? Revision of Patent Fees for Fiscal Year 2001; Final Rule. 65 FR 49193 (Aug. 11, 2000).

? Changes To Implement the Patent Business Goals; Final Rules. 65 FR 54604 (Sept. 8, 2000).

? Changes to Implement the Patent Business Goals; Final Rule and corrections to final rules. 65 FR 78958 (Dec. 18, 2000).

? Changes to Implement Patent Business Goals; Final Rule, Correction. 65 Fed. Reg. 80755 (Dec. 22, 2000).

? Changes To Implement Patent Term Adjustment Under Twenty-Year Patent Term; Final Rules. 65 FR 56366, (Sept. 18, 2000).

? Changes to Implement Eighteen-Month Publication of Patent Applications; Final Rule. 65 FR 57024 (Sept. 20, 2000).

? Changes To Implement Eighteen-Month Publication of Patent Applications; Correction. Final Rule; correction. 65 FR 66502 (Nov. 6, 2000).

? Treatment of Unlocatable Patent Application and Patent Files; Final Rule. 65 FR 69446 (Nov. 17, 2000).

? Simplification of Certain Requirements in Patent Interference Practice; Final Rule. 65 FR 70489 (Nov. 24, 2000).

? Reestablishment of the Patent and Trademark Office as the United States Patent and Trademark Office, 65 Fed. Reg. 17858 (April 5, 2000).

? Guidelines Concerning the Implementation of Changes to 35 U.S.C. 102(g) and 103(c) and the Interpretation of the Term "Original Application" in the American Inventors

? Protection Act of 1999, 1233 O.G. 54-56 (April 11, 2000).

? Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, para. 6, 65 Fed. Reg. 38510-38516 (June 21, 2000); 1236 O.G. 98-104 (July 25, 2000).

? Guidelines Setting Forth a Modified Policy Concerning the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 U.S.C. 103(c), 1241 O.G. 96-97 (December 26, 2000).

? Assignment of Confirmation Number and Time Period for Filing a Copy of an Application by EFS for Eighteen-Month Publication Purposes, 1241 O.G. 97-98 (December 26, 2000).

? Utility Examination Guidelines, 66 F.R. 1092-1099 (January 5, 2001).

Guidelines for Examination of Patent Applications Under the 35 U.S.C. Sec. 112, para. 1

"Written Description" Requirement 66 F.R. 1099-1111 (January 5, 2001).

1. You are assigned by your firm to prosecute a patent application, which had been prepared and prosecuted by a former member of the firm. A Notice of Appeal had been filed and while in the process of preparing the Appeal Brief, you discover that data in the applicant's original notes would materially aid in persuading the Board as to the patentability of the appealed claims. Accordingly, you incorporate the data in an Affidavit and file the Affidavit with the USPTO together with the Appeal Brief. In light of this scenario, which of the following statements is true?

- (A) Since jurisdiction has not passed to the Board, the examiner may admit the Affidavit but require a showing of good and sufficient reasons why the Affidavit was not earlier presented.
- (B) Since jurisdiction has not passed to the Board, the Board will automatically remand the Affidavit for consideration by the examiner and hold consideration of the Appeal Brief in abeyance.
- (C) Since jurisdiction has passed to the Board, the Board may or may not consider the Affidavit as it sees fit.
- (D) Although authority from the Board is not necessary to consider the Affidavit, the examiner may not consider the Affidavit unless it is remanded to the examiner by the Board.
- (E) Since jurisdiction has passed to the Board, the Board will consider the Affidavit concurrently with the Appeal Brief.

2. You are deciding whether to file continued prosecution applications (CPA) for prior applications before the earliest of payment of any issue fee on the prior application (and absent any petition under 37 C.F.R. § 1.313(c)), abandonment of the prior application, or termination of proceedings on the prior application. In which of the following circumstances is it proper to use the CPA procedure to file the application?

- (A) To file a divisional application of a prior complete provisional application for a utility invention filed under 35 U.S.C. § 111(b). The provisional application has an actual filing date after June 8, 1995.
- (B) To file a continuation-in-part application of a prior complete nonprovisional utility application filed under 35 U.S.C. § 111(a). The nonprovisional application has an actual filing date prior to November 29, 1999.
- (C) To file a continuation utility application of a prior complete nonprovisional utility application filed under 35 U.S.C. § 111(a). The nonprovisional application has an actual filing date prior to May 29, 2000.
- (D) To file a continuation utility application of a prior complete CPA utility application. The prior CPA application has an actual filing date of June 1, 2000, and is a continuation application of a prior complete utility application filed under 35 U.S.C. § 111(a) having an actual filing date of November 28, 1999.
- (E) To file a divisional application of a prior complete nonprovisional plant application filed under 35 U.S.C. § 111(a). The nonprovisional application has an actual filing date after May 29, 2000.

3. Which of the following is not in accordance with proper USPTO practice and procedure regarding patent applications filed in March 2001?

- (A) If a non-English reference is submitted in an information disclosure statement, the applicant shall include a copy of the translation if a written English-language translation of the non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c).
- (B) Each U.S. patent listed in an information disclosure statement must be identified by inventor, application number, and issue date.
- (C) Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.
- (D) When the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications, provided that it is stated that these other patents or publications are cumulative.
- (E) A copy of any patent, publication, pending U.S. application or other information listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application, unless: (1) the earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120; and (2) the information disclosure statement submitted in the earlier application is in full compliance with appropriate regulations.

4. A maintenance fee in the correct amount is received by the USPTO on February 8, 2001, prior to the due date. The maintenance fee payment includes identification of a U.S. patent number. In accordance with proper USPTO rules and procedure, in which of the following situations may the USPTO return the maintenance fee payment?

- (A) The maintenance fee payment is submitted by the patentee's grandmother, without authorization by the patentee, and includes identification of the U.S. application number for patent.
- (B) The maintenance fee payment is submitted by the attorney of record in the application, without authorization by the patentee, and includes identification of the U.S. application number for the patent.
- (C) The maintenance fee payment is submitted by the attorney of record in the application, with authorization by the patentee, and does not include identification of the U.S. application number for the patent.
- (D) (A) and (B).
- (E) None of the above.

Please answer questions 5 and 6 based on the following information.

A patent issued to Joe Inventor on July 25, 2000 based on an application filed in January 1999. Larry Practitioner was the registered practitioner of record in the application, and all correspondence from the USPTO during prosecution was directed to Larry at his then-current address. At the time he paid the issue fee, Larry designated a “fee address” for payment of maintenance fees. Larry moved his office on September 1, 2000, and notified the Office of Enrollment and Discipline of his new address in accordance with 37 C.F.R. § 10.11. Larry did not, however, file a change of correspondence address in the patent file. An assignment of all rights in the patent from Joe Inventor to Big Corporation was made September 5, 2000 and was recorded in the USPTO on September 14, 2000.

5. Under standard USPTO practice and procedure, where will the USPTO send any Maintenance Fee Reminder?

- (A) Joe Inventor’s address as indicated on the inventor’s declaration, unless a change of address had been filed for Mr. Inventor.
- (B) Larry Practitioner’s address prior to September 2000.
- (C) Larry Practitioner’s address subsequent to September 1, 2000.
- (D) The fee address designated by Larry Practitioner at the time he paid the issue fee.
- (E) The address of the assignee as indicated on the assignment recorded in the USPTO.

6. Under standard USPTO practice and procedure, where will the USPTO send a communication for Big Corporation concerning a request for reexamination involving the patent?

- (A) Joe Inventor’s address as indicated on the inventor’s declaration, unless a change of address had been filed for Mr. Inventor.
- (B) Larry Practitioner’s address prior to September 2000.
- (C) Larry Practitioner’s address subsequent to September 1, 2000.
- (D) The fee address designated by Larry Practitioner at the time he paid the issue fee.
- (E) The address of the assignee as indicated on the assignment recorded in the USPTO.

7. For purposes of determining whether a request for continued examination is in accordance with proper USPTO rules and procedure, in which of the following situations will prosecution be considered closed?

- (A) The last Office action is a final rejection.
- (B) The last Office action is an Office action under *Ex Parte Quayle*.
- (C) A notice of allowance has issued following a reply to a first Office action.
- (D) The application is under appeal.
- (E) All of the above.

8. Which of the following is not in accord with proper USPTO practice and procedure regarding *ex parte* reexaminations filed in March 2001?

- (A) In every instance of an interview with an examiner in an *ex parte* reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner.
- (B) An interview does not remove the necessity for reply to Office actions as specified in 37 CFR § 1.111.
- (C) A patent owner's reply to an outstanding Office action after the interview does not remove the necessity for filing the written statement of the reasons presented at the interview as warranting favorable action.
- (D) The written statement must be filed as a separate part of a reply to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.
- (E) Third party requesters have the option of attending interviews, but their presence is not mandatory.

9. Which of the following is not in accord with proper USPTO practice and procedure?

- (A) A written description as filed in a nonprovisional patent application is presumed adequate under 35 U.S.C. § 112 in the absence of evidence or reasoning to the contrary.
- (B) An examiner may show that a written description as filed in a nonprovisional patent application is not adequate by presenting a preponderance of evidence why a person of ordinary skill in the art would not recognize in the applicant's disclosure a description of the invention defined by the claims.
- (C) A general allegation of "unpredictability in the art" is sufficient to support a rejection of a claim for lack of an adequate written description.
- (D) When filing an amendment, a practitioner should show support in the original disclosure for new or amended claims.
- (E) When there is substantial variation within a genus, an applicant must describe a sufficient variety of species to reflect the variation within the genus.

10. Independent claim 1, fully supported by the specification in a patent application states:

Claim 1. An apparatus comprising: a plastic valve; a copper pipe connected to the plastic valve; and an aluminum pipe connected to the plastic valve.

Which of the following claims, presented in the application, provide the basis for a proper rejection under 35 U.S.C. § 112, second paragraph?

Claim 2. The apparatus of claim 1, wherein said pipe is statically charged.

Claim 3. The apparatus of claim 1, wherein the outer surface of said copper pipe is statically charged.

Claim 4. The apparatus of claim 1, further comprising a thermostat connected to said plastic valve.

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

11. Registered practitioner Ethel prepares a utility patent application (not a CPA) for inventor Fred, using her only copy of a published article, "Engineering Design," published June 8, 1995, to draft the application. Thereafter, Ethel accidentally runs the copy of the article through her paper shredder. Ethel duly files the application in the USPTO on May 29, 1999. The examiner sends Ethel a non-final Office action dated December 7, 2000, setting a three-month period for reply, including a rejection of claim 1 and a requirement for information under 37 CFR § 1.105 requiring her to submit a copy of the article, "Engineering Design." Which of the following will properly be accepted by the USPTO as a complete reply to the requirement for information?

- (A) An information disclosure statement, filed by Ethel on Monday, January 15, 2001, that complies with the provisions of 37 CFR § 1.98, listing a foreign patent, and stating that each item of information contained in the information disclosure statement was first cited in a communication from a foreign patent office less than three months prior to the filing of the information disclosure statement.
- (B) A statement filed by Ethel on Wednesday, March 7, 2001, stating that Ethel is not an individual identified under 37 CFR § 1.56(c).
- (C) A statement filed by Ethel on Thursday, March 8, 2001, with the appropriate petition and fee for a one-month extension, that states that the information required to be submitted is not readily available to the party from which it was requested.
- (D) A statement filed by Ethel on Thursday, March 8, 2001, with the appropriate petition and fee for a one month extension, which states that Ethel has a good faith belief that the information required is not material to patentability.
- (E) None of the above.

12. In January 2000, Chris invents an electrical door stop for automatically stopping a door at any position by simply pressing the doorknob downward. The doorknob is such that when carrying a large package, one may rest the package on the doorknob to stop the motion of the door. During a lunch break before completing the writing of the application for the patent on the automatic door stop, Chris' patent agent, Sam, visits a local Shack restaurant and notices a door stop which is actuated by stepping with one's foot on a mechanical lever located at the bottom of the door. Sam makes a mental note to ask a colleague as to whether he needs to disclose the doorstop at the Shack restaurant to the USPTO in conjunction with Chris' application in an information disclosure statement, but ultimately neglects to do so. Sam knows that the restaurant (and doorstop) was in existence at least one year prior to Sam's visit. In the first Office action, the only prior art uncovered by the examiner relates to stopping a door using a lever that engages a channel in the ceiling upon being pressed upward. The examiner rejects the claim asserting it would have been obvious to have either upward or downward actuating motion. In the reply to the first Office action Sam argues that the downward motion is essential because it affords the ability to actuate when one is carrying a package and that the prior art does not disclose a downwardly actuated doorstop. Following Sam's argument, the case issues. Claim 1 reads as follows:

1. A door stop for automatically stopping the pivoting action of a door by pressing downward, said door stop comprising:
 - a) first means attached to a door for receiving a downward movement;
 - b) second means for actuating a mechanism for engaging the floor surface in response to the downward movement of the first means, said first and second means being operatively connected.

Which of the following is true?

- (A) Since Sam knew of the doorstop at the restaurant and not Chris, there is no duty to disclose the Shack restaurant doorstop. An attorney need not disclose that which is within his personal knowledge in an information disclosure statement.
- (B) Since Sam discovered the Shack restaurant device after he had started writing the application, the invention was fully disclosed to Sam. There is no need to disclose that which occurs after an inventor completes his application disclosure.
- (C) Sam needs to disclose only patents or printed publications to the USPTO to satisfy the duty of disclosure. Since Sam was unaware of any patent or printed publication for the Shack restaurant doorstop, Sam does not need to file an information disclosure in this regard.
- (D) Chris should file a request for reexamination seeking to have the Shack restaurant door stop considered.
- (E) None of the above.

13. The following statements relate to “multiple dependent claims.” Which statement is not in accord with proper USPTO practice and procedure?

- (A) A multiple dependent claim contains all the limitations of all the alternative claims to which it refers.
- (B) A multiple dependent claim contains in any one embodiment only those limitations of the particular claim referred to for the embodiment under consideration.
- (C) A multiple dependent claim must be considered in the same manner as a plurality of single dependent claims.
- (D) Restriction may be required between the embodiments of a multiple dependent claim.
- (E) The limitations or elements of each claim incorporated by reference into a multiple dependent claim must be considered separately.

14. Regarding claims, which of the following practices is not in accordance with proper USPTO practice and procedure?

- (A) A singular dependent claim 2 could read as follows:
2. The product of claim 1 in which...
- (B) An application may contain a series of singular dependent claims in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.
- (C) A dependent claim may refer back to any preceding independent claim.
- (D) A claim which depends from a dependent claim may be separated therefrom by any claim which does not also depend directly or indirectly from said “dependent claim.”
- (E) Each claim begins with a capital letter and ends with a period.

15. Which of the following is/are information which the USPTO may require an attorney of record in a reissue application to submit in a reply to a first Office action dated April 12, 2001?

- (A) Information used in invention process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.
- (B) The publication date of an undated document mentioned by applicant which may qualify as printed publication prior art.
- (C) Comments on a new decision by the Federal Circuit that appears on point in the examination of the application.
- (D) (A), (B), and (C).
- (E) None of the above.

16. Stan, through a registered practitioner, files an application for a patent. During the prosecution of Stan's patent, in an amendment, the practitioner admitted in his discussion as to "all the claims" of Stan's application, that "the most pertinent available prior art known to the Applicants and their representatives is the Acme Patent, cited by the examiner." Within one year after the patent issues, Stan comes to you and wants to file a reissue to broaden his claims, based on the fact that the Acme patent is not prior art. He has ample evidence to show that he conceived and reduced his invention to practice before the filing date of the Acme patent. Which of the following is true?

- (A) Stan should file a reissue application accompanied by a declaration under 37 C.F.R. 1.131 to swear behind the date of the Acme reference. The statement by the registered practitioner, who formerly represented Stan, that the Acme patent was prior art constituted error without deceptive intent and may be corrected by reissue.
- (B) The explicit admission by the registered practitioner, who formerly represented Stan, that the Acme patent constituted prior art is binding on Stan in any later proceeding involving the patent.
- (C) Stan should file a request for reexamination and submit the Acme patent along with evidence in the form of affidavits or declarations showing that the Acme patent is not prior art.
- (D) Since the Acme patent was cited by the examiner and not by the registered practitioner, who formerly represented Stan, Stan can not be held accountable for the error. Moreover, the statement by the registered practitioner was directed to the pertinence of the prior art and not to the issue of whether the date of the Acme patent could be sworn behind. Accordingly, the statement has no binding effect.
- (E) (A) and (D).

17. Which of the following statements involving an examiner's statement of reasons for allowance in a Notice of Allowance dated February 8, 2001, is in accordance with USPTO rules and procedure?

- (A) Failure by applicant or patent owner to file a statement commenting on the reasons for allowance cannot give rise to any implication that the applicant or patent owner agrees with or acquiesces in the reasoning of the examiner.
- (B) If applicant files a statement commenting on the reasons for allowance, failure by the examiner to respond to applicant's statement gives rise to the implication that the examiner agrees with applicant's statement.
- (C) If applicant files a statement commenting on the reasons for allowance, failure by the examiner to respond to applicant's statement does not give rise to any implication.
- (D) (A) and (C)
- (E) None of the above.

18. Registered practitioner Joe files a design patent application under 37 CFR § 1.53(b) having one claim on May 6, 1999. The USPTO sends Joe a notice of allowance dated November 10, 2000. Joe pays the issue fee on November 15, 2000. On November 23, 2000, Joe learns about a publication (the “Smith Reference”) which he knows to be material to patentability of the claim, but which was not considered by the examiner during prosecution of the application. Joe prepares an information disclosure statement that complies with the provisions of 37 CFR § 1.98, listing the Smith reference. Which of the following actions, if taken by Joe on November 24, 2000, will result in a request for continued examination of the application being granted in accordance with USPTO rules and procedure?

- (A) Filing a request for continued examination of the application with the information disclosure statement listing the Smith Reference, without the fee set forth in 37 CFR § 1.17(e).
- (B) Filing a request for continued examination of the application with the information disclosure statement listing the Smith Reference, and the fee set forth in 37 CFR § 1.17(e).
- (C) Filing a request for continued examination of the application with the information disclosure statement listing the Smith Reference, the fee set forth in 37 CFR § 1.17(e), and a petition under 37 CFR § 1.313 with the fee set forth in 37 CFR § 1.17(h).
- (D) (B) or (C) above.
- (E) None of the above.

19. In early 1999, at the request of MC Motors, Eve demonstrated her reverse automobile heating system at a testing facility in Germany. MC Motors signs a confidentiality agreement and agrees not to disclose the invention to anyone. The test is conducted in a secluded area and the persons involved are sworn to secrecy. Unbeknownst to Eve, MC Motors installs the reverse heating system on its MC cars and begins selling its cars with the reverse heating system in the United States in September 1999. In August 2000, MC files a patent application in the United States for the reverse automobile heating system. In December 2000, Eve files a patent application claiming the automobile heating system. The examiner rejects all the claims in Eve’s application based upon an MC Motors brochure advertising its cars in September 1999. Which of the following is true?

- (A) Eve is not entitled to a patent since the invention was on sale in this country, more than one year prior to the date of the application for patent in the United States.
- (B) Since the MC Motors misappropriated the invention and since Eve did not authorize the sale, the rejection may be overcome by showing that the sales by MC Motors were not authorized by Eve.
- (C) MC Motors is entitled to a patent since although it misappropriated the idea for the invention from Eve, the misappropriation was beyond the jurisdiction of the USPTO.
- (D) (A) and (C).
- (E) None of the above.

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

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

21. Which of the following is true?

- (A) For a nonprovisional utility patent application filed in the USPTO on January 10, 2001, formal drawings are required to overcome an objection issued during initial review that drawings in the application do not comply with 37 C.F.R. § 1.84(g) and (u)(1).
- (B) If the primary examiner requires formal drawings at the time a patent application is allowed and sets a three month period of time from the mail date of a notice of allowability within which to file the drawings to comply with 37 C.F.R. § 1.84, the applicant may obtain an extension of time to file the formal drawings by filing a petition for an extension of time under 37 CFR § 1.136(a) or (b) and the appropriate fee.
- (C) For a nonprovisional application filed on November 2, 2000, to claim the benefit under 35 U.S.C. § 119(e) of the filing date of a provisional application filed on November 6, 1999, the nonprovisional application must be copending with the provisional application.
- (D) In those instances in which an applicant seeks to add new matter to the disclosure of an application, a request for continued examination is not a proper procedure for adding the new matter.
- (E) A nonprovisional utility application in the name of inventor Smith filed on January 18, 2001, may properly claim the benefit of the filing date of a provisional utility application filed in Smith's name on January 24, 2000, where the provisional application is entitled to a filing date even though the basic filing fee for the provisional application was not paid.

22. Where the reference relied upon in a 35 U.S.C. § 103 rejection qualifies as prior art only under 35 U.S.C. § 102(f), or (g), which of the following represents the most comprehensive answer in accord with proper USPTO practice and procedure as to the action an applicant should take to overcome the rejection?

- (A) Present proof that the subject matter relied upon and the claimed invention are currently commonly owned.
- (B) Present proof that the subject matter relied upon and the claimed invention were commonly owned at the time the later invention was made.
- (C) Present proof that the subject matter relied upon and the claimed invention were subject to an obligation to assign to the same person at the time the later invention was made.
- (D) (A) and (B).
- (E) (C) and (D).

23. Mitch and Mac are named inventors on an international application that is filed in the USPTO Receiving Office, and designates the United States of America. Mac now indicates that he will not sign the Request for the international application. Mitch wishes to proceed with the Request and seeks the advice of their patent agent. Which of the following answers accords with the provisions of the Patent Cooperation Treaty?

- (A) Mitch's agent should sign the Request and accompany it with a statement indicating why it is believed that Mac refuses to proceed with the Request.
- (B) Mitch should sign the request for himself and also sign on behalf of Mac.
- (C) Mitch should sign the request and seek a court order to obtain Mac's signature.
- (D) Mitch should sign the Request and Mitch's agent should sign on behalf of Mac, since he continues to represent Mac.
- (E) Mitch should sign the Request and accompany it with a statement providing a satisfactory explanation for the lack of Mac's signature.

24. An amendment filed January 8, 2001, in an unassigned nonprovisional application seeks to cancel claims so that fewer than all of the currently named inventors are the actual inventors of the invention being claimed. The amendment includes a request to delete the names of the persons who are not inventors. In accordance with proper USPTO rules and procedure, the request may be signed by which of the following?

- (A) A registered practitioner not of record who acts in a representative capacity under 37 CFR § 1.34(a).
- (B) All of the applicants (37 CFR § 1.41(b)) for patent.
- (C) A registered practitioner of record appointed pursuant to 37 CFR § 1.34(b).
- (D) (B) and (C).
- (E) (A), (B), and (C).

25. Which of the following is not in accordance with proper USPTO practice and procedure?
- (A) Conversion of a provisional application to a nonprovisional application will result in the term of any patent to issue from the application being measured from at least the filing date of the provisional application.
 - (B) Conversion of a provisional application to a nonprovisional application cannot adversely impact on the term of any patent to issue from the application.
 - (C) An applicant having filed a provisional application can avoid any adverse patent term impact resulting from converting the provisional application to a nonprovisional application by instead filing a nonprovisional application claiming the benefit of the provisional application under 35 U.S.C. § 119(e).
 - (D) An applicant filing a nonprovisional application claiming the benefit under 35 U.S.C. § 119(e) and 37 C.F.R. § 1.78 of an earlier provisional application, and not requesting conversion of the provisional to a nonprovisional application can avoid the fee required to convert a provisional application to a nonprovisional application, as well as an adverse patent term effect that would result from a conversion.
 - (E) The twelve month period of pendency of a provisional application extends to the next secular or business day which is not a Saturday, Sunday, or Federal holiday in the District of Columbia if the day that is twelve months after the filing date of the provisional application under 35 U.S.C. § 111(b) and 37 C.F.R. § 1.53(c) falls on a Saturday, Sunday, or a Federal holiday in the District of Columbia.
26. Which of the following is not in accord with proper USPTO practice and procedure?
- (A) If a practitioner, “by mistake,” files an application and basic filing fee, the submission of the filing fee with the application is treated by the Office as not a fee paid by mistake, and the fee will not be refunded.
 - (B) If, in April 2001, a practitioner files an application, properly establishes the applicant’s small entity status, and “by mistake” pays the filing fee by submitting a check drawn in the amount that is twice the amount of the small entity filing fee, a refund of the excess fee may be obtained upon request filed any time during pendency of the application and life of any patent granted on the application.
 - (C) The paragraphs of the specification of an original utility patent application filed in January 2001 may, but are not required to be numbered at the time the application is filed.
 - (D) If a provisional application is filed in a language other than English, an English language translation of the non-English language provisional application will not be required in the provisional application.
 - (E) If a table having more than 50 pages of text is submitted on compact disc, the specification of a patent application must contain an incorporation-by-reference of the material on a compact disc in a separate paragraph, identifying each compact disc by the names of the files contained on each compact disc, their date of creation, and their sizes in bytes.

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

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

28. Practitioner Smith filed a utility patent application on January 5, 2001, with informal drawings. Upon review of the drawings, the USPTO concluded that the drawings were not in compliance with 37 C.F.R. § 1.84(a)(1) and (k), and were not suitable for reproduction. In an Office communication, Smith was notified of the objection and given two months to correct the drawings in order to place the application in the files of a Technology Center for examination. Which of the following complies with USPTO practices and procedures for a complete *bona fide* attempt to advance the application to final action?

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

29. Which of the following do not represent prior art?

- (A) The preamble of a Jepson claim.
- (B) A technical journal as of its date of publication which is accessible to the public as of the date of its publication.
- (C) A disclosure publicly posted on the INTERNET, but containing no publication or retrieval date.
- (D) A doctoral thesis indexed, cataloged and shelved in a university library.
- (E) Applicant's labeling of one of the figures in the drawings submitted with his application as prior art.

30. Which of the following is in accord with proper USPTO practice and procedure?
- (A) A utility application was filed in October 1999. Following a restriction requirement, the applicant elected claims 1-5, and the examiner withdrew non-elected claims 6-10. After a final rejection of claims 1-5 in January 2001, the applicant may submit an amendment canceling previously examined claims and present claims to the previously non-elected invention of claims 6-10 when filing a request for continued examination under 37 CFR § 1.114.
 - (B) Claims in an allowed application may be amended as a matter of right after payment of the issue fee inasmuch as the Office may not rule on amendment filed after a notice of allowance until after the period for payment of the issue fee has expired.
 - (C) If, at the time an application is allowed in January 2001, a corrected drawing is required or formal drawing is needed, the applicant is given a three month period in the notice of allowability to file the same, and is permitted to file corrected or formal drawings after payment of the issue fee upon filing a request of an extension of time and payment of the requisite fee.
 - (D) Where, after a final rejection, a request for continued examination complying with 37 CFR § 1.114, is filed in April 2001 accompanied by a request to suspend action by the Office for a period not exceeding three months to provide time to submit an information disclosure statement, and the requisite fees, the Office may grant the requested suspension.
 - (E) Where an examiner has finally rejected all the claims in a utility application in January 2001, and sets a three month shortened statutory period for reply, the Office may grant a request to suspend action by the applicant for a period not exceeding six months to provide time to gather and submit evidence, if the request and requisite fees are filed within the three month reply period.
31. Which of the following statements is correct regarding an antedating declaration or affidavit being used in accordance with proper USPTO practice and procedure?
- (A) Where the reference publication date is more than one year before applicant's effective filing date.
 - (B) Where the reference is a prior U.S. patent to the same entity, claiming the same invention.
 - (C) Where the subject matter relied on in the reference is prior art under 35 U.S.C. § 102(g).
 - (D) Where the reference, a U.S. Patent, with a patent issue date less than one year prior to applicant's effective filing date, shows but does not claim the same patentable invention.
 - (E) Where the effective filing date of applicant's parent application or an International Convention-proved filing date is prior to the effective date of the reference.

32. Which of the following is in accordance with proper USPTO practice and procedure?

- (A) After issuance of a notice of allowance in November 2000, a petition to withdraw an application from issue and requisite fee are required if a request for continued examination, submission, and requisite fee are filed prior to the issuance of the patent.
- (B) After issuance of a notice of allowance in April 2001 for an application, an amendment of the claims in the application may be filed before, with, or after payment of the issue fee.
- (C) The Office ensures that any petition to withdraw an application from issue, filed after payment of the issue fee, will be acted upon prior to the scheduled date of patent grant.
- (D) If a request for continued examination under 37 CFR § 1.114, accompanied by the requisite fee, but not a submission, are filed in March 2001, after an application was allowed in January 2001, the Office will notify the applicant and set a time period within which the deficiency must be corrected.
- (E) An amendment filed in the Office in April 2001 in reply to a final rejection must comply with either the provisions of 37 CFR § 1.114 or the provisions of 37 CFR § 1.116(b) and (c).

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

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

34 – 36. The following facts apply to the following three questions. For purposes of these questions, it should be assumed that the statutes and regulations effective as of April 18, 2001 apply for all time periods covered by the questions.

Joseph, a citizen and resident of the United States, invented a new brake for in-line skates and filed a nonprovisional utility patent application in the USPTO on February 8, 2001. The application as filed included a specification and claims in compliance with 35 USC § 112, three sheets of publication quality drawings, an abstract of the disclosure, and an information sheet listing the name and address of the inventor. The application was initially filed without an executed inventor's oath or declaration and without the required filing fee. The Office issued a "Notice to File Missing Parts – Filing Date Granted" on April 2, 2001. The Notice informed Joseph that he must submit an executed oath or declaration by the inventor, pay the required filing fee, and pay a surcharge for late submission of these items within two (2) months of the date of the Notice. Joseph received the Notice on April 9, 2001.

Joseph brought the Notice with him when he left for an extended overseas business trip the next day, April 10, 2001. Unfortunately, the Notice was placed in luggage that was lost during the trip. Upon his return to the United States on July 26, 2001, Joseph obtained a copy of the Notice and, on August 2, 2001 filed a Reply in full compliance with the Notice. A Petition for a two-month extension of time and all required fees accompanied the Reply. Joseph also requested waiver and a refund of fees associated with the Petition for extension of time on the basis that the delay was a result of his lost luggage and his extended trip overseas. In Joseph's view, even though he could have replied within the two-month period, it was unfair to penalize him for lost luggage. The request for waiver of fees was denied.

A first substantive Office action on the merits of the application issued December 19, 2001 and set a three-month shortened statutory time for reply. All pending claims were rejected on the basis of prior art. Joseph filed a fully responsive Amendment on March 19, 2002, and a final Office action issued August 12, 2002 with a three-month shortened statutory period for reply. The final Office Action allowed certain claims and rejected other claims on substantially the same grounds set forth in the first Office action. Joseph filed a Notice of Appeal on September 19, 2002 and an Appeal Brief on March 18, 2003. A Petition for extension of time and proper authorization to charge a deposit account for any required fees accompanied the Appeal Brief.

An Examiner's Answer issued on April 2, 2003, and Joseph filed a Reply Brief on April 15, 2003. The Board of Patent Appeals and Interferences reversed the Examiner's rejections on August 19, 2003. A Notice of Allowance and Issue Fee Due was mailed September 3, 2003. Joseph paid the Issue Fee on September 15, 2003 and the patent issued March 9, 2004.

34. The Office determined that the applicant failed to engage in reasonable efforts to conclude prosecution of the application. Which of the following statements is most true?

- (A) Joseph is entitled to no patent term extension because neither the Uruguay Round Agreements Act nor the Patent Term Guarantee Act of 1999 applies to Joseph's patent application.

- (B) Although the Patent Term Guarantee Act of 1999 applies to Joseph's application, Joseph forfeited any patent term extension by failing to engage in reasonable efforts to conclude prosecution of the application.
- (C) Joseph is entitled to a total patent term extension of approximately two (2) months because the application was pending for more than three (3) years.
- (D) Joseph's successful appellate review adds approximately 11 months to any calculation of patent term extension.
- (E) By replying to the Notice to File Missing Parts approximately two (2) months after the deadline set by the USPTO, Joseph reduced any patent term extension by two (2) months.

35. In addition to the facts set forth in connection with the previous question, Joseph's application had not and would not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing. At the time he filed his application in the USPTO, Joseph submitted a nonpublication request and supporting materials that fully complied with all requirements for nonpublication of the application at 18 months. Which of the following statements is most correct?

- (A) By requesting nonpublication of the application, Joseph "opted out" of the statutory framework for patent term extension and, therefore, no patent term extension is available.
- (B) Submission of the nonpublication request does not affect any patent term extension that might be available to Joseph.
- (C) Joseph may rescind his nonpublication request at any time.
- (D) Statements (A) and (C) are true.
- (E) Statements (B) and (C) are true.

36. In the facts set forth in connection with the preceding two questions, what if any extension of time was required by Joseph for filing an Appeal Brief on March 18, 2003?

- (A) No extension of time was available and the Appeal Brief should have been rejected because it was filed more than six months after the final Office action issued.
- (B) No extension of time was available and the Appeal Brief should have been rejected because it was filed more than six months after the Notice of Appeal was filed.
- (C) A three-month extension of time was required.
- (D) A four-month extension of time was required.
- (E) A five-month extension of time was required.

37. In which of the following instances is the filing of a request for continued examination (RCE) of an application, together with a submission and payment of the appropriate fee, in accordance with proper USPTO practice and procedure?

- (A) The RCE, including an amendment to the written description, is filed on April 17, 2001, in a nonprovisional utility application having a filing date in July 1998. A Notice of Appeal to the Board of Patent Appeals and Interferences had been filed in November 2000, and as of April 17th the appeal is awaiting a decision.
- (B) The RCE, including an amendment to the written description, is filed on April 17, 2001, in a nonprovisional utility application having a filing date in July 1996. A Notice of Appeal to the United States Court of Appeals for the Federal Circuit was properly filed in January 2001, and the appeal has not terminated as of April 17th.
- (C) The RCE, including an amendment to the written description, is filed on April 17, 2001, in a nonprovisional utility application having a filing date in July 1999. The issue fee was filed in the Office on Friday, January 19, 2001, but a petition and fee to withdraw the application has not been filed.
- (D) The RCE, including an amendment to the written description, is filed on April 17, 2001, for a nonprovisional utility application having a filing date in July 1996. On Monday, April 2, 2001, Applicant withdrew a Notice of Appeal to the United States Court of Appeals for the Federal Circuit. There were no allowed claims in the application, and the Court's dismissal of the appeal did not indicate any further action to be taken by the Office.
- (E) The RCE, including an amendment to the written description, is filed on April 17, 2001, for a provisional utility application having a filing date in July 2000.

38. A registered practitioner filed a nonprovisional U.S. patent application in the USPTO on Monday, October 9, 2000. The full basic fee for other than a small entity accompanied the application. The practitioner later realized that a mistake had occurred because only the basic fee for a small entity should have been paid. On Thursday, November 9, 2000, the practitioner completed proper establishment of the applicant's small entity status by filing an assertion under 37 C.F.R. § 1.27(c) with the USPTO. On Monday, December 11, 2000, the practitioner filed a petition under 37 CFR 1.136, and the fee required by 37 CFR 1.17(a) for a one month extension of time to file a request for a refund of the excess amount paid based on establishment of small entity status. Absent any other action, which of the following is the latest date that the practitioner can properly file a request for refund and obtain the same in accordance with proper USPTO practice and procedure?

- (A) Thursday, November 9, 2000.
- (B) Friday, December 8, 2000.
- (C) Monday, December 11, 2000.
- (D) Tuesday, January 9, 2001.
- (E) Thursday, January 11, 2001.

39. Which of the following is/are required to be included in a request for reexamination submitted by a person other than the patent owner on January 12, 2001?

- (A) A statement pointing out each substantial question of patentability based on the arguments stated by the examiner in the first Office action.
- (B) A statement that, in the opinion of the requester, the application to which the request is directed meets the requirements of 35 U.S.C. 112.
- (C) A copy of the entire patent including the front face, drawings, and specification/claims, in double column format on single-sided sheets, for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent.
- (D) A certification that a copy of the request has been served in its entirety on “the patent owner at the address as provided for in § 1.33(c),” without indicating the name and address of the party served.
- (E) None of the above.

40. In June 1998, Jack and Jill, a married couple, are vacationing in Vietnam (not a WTO country) when they encounter a man selling bamboo knives for cleaning fish. The particular curvature of the bamboo both lends support to the knife to prevent it from bending and breaking and facilitates cleaning inside the fish. Jill takes a picture of Jack with the knife cleaning the fish. Subsequently, in November 1998, when Jack returns to the United States he begins to make and sell an identical knife to the one seen in Vietnam. In July 1999, he files a patent application claiming the nearly identical knife. Jack discloses no prior art during the prosecution of his application and fails to mention the knife he saw in Vietnam. The examiner finds no prior art similar to the claimed knife, and Jack is awarded a patent in December 2000. Meanwhile, Jill divorces Jack, and associates with Sam. Unfortunately, Sam is penniless. To raise cash, Sam and Jill begin selling a knife identical to the one Jack produces, only Sam and Jill make their knife out of plastic. The knives of Sam and Jill sell like hotcakes. Jack sues for infringement. Jill and Sam come to you for advice. Which of the following is not true?

- (A) Jack is entitled to patent protection since Vietnam is not a WTO country and evidence of the Vietnamese knife cannot be used against him to reject his patent claims.
- (B) Jack had a duty under 37 C.F.R. §1.56 to disclose his discovery of the bamboo knife in Vietnam to the examiner during the original patent prosecution.
- (C) Since the use in Vietnam was not in this country, it does not constitute a public use bar under 35 U.S.C. § 102(b).
- (D) If Jill’s attorney files a request for reexamination, it will be denied because the picture is not a patent or printed publication.
- (E) Although Jack marketed the invention before obtaining a patent, the patent claims cannot be invalidated under 35 U.S.C. § 102(a) since Jack’s making and selling of the knife cannot be used against him under 35 U.S.C. § 102(a).

41. Which of the following is not in accordance with proper USPTO practice and procedure regarding design patent applications filed in March 2001?

- (A) The expedited treatment available for design applications under 37 CFR § 1.155 expedites design application processing by, among other things, decreasing clerical processing time as well as the time spent routing the application between processing steps.
- (B) The “petition to make special” procedure is also available for designs and the petition fee is less than the fee for expedited examination.
- (C) To qualify for expedited examination: (1) the application must include drawings in compliance with 37 CFR § 1.84; (2) the applicant must have conducted a preexamination search; and (3) the applicant must file a request for expedited examination including: (i) The appropriate fee; and (ii) a statement that a preexamination search was conducted. The statement must also indicate the field of search and include an information disclosure statement in compliance with 37 CFR § 1.98.
- (D) If the design application is not effectively expedited by the Office, the fee for expediting the application will be refunded.
- (E) The Office will not examine an application that is not in condition for examination (*e.g.*, missing basic filing fee) even if the applicant files a request for expedited examination under this section.

42. Registered practitioner Rick files a utility patent application under 37 CFR § 1.53(b) in the USPTO having one claim on May 6, 1998. Following a proper final rejection dated June 28, 2000, of claim 1 Rick files a request for continued examination with the appropriate fee on September 12, 2000, and submits an amendment to claim 1 with the request. On October 7, 2000, Rick learns about a publication (the “Columbus reference”) which he knows to be material to patentability of claim 1, but which was not considered by the examiner during prosecution of the application. Rick prepares an information disclosure statement that complies with the provisions of 37 CFR § 1.98, listing the Columbus reference. The finality of the action dated June 28, 2000, is withdrawn in an Office action, dated November 20, 2000, which is after the filing of the request for continued examination. Which of the following actions, if taken by Rick, will properly result in the Columbus reference being considered by the Office during the pendency of the application?

- (A) Filing the information disclosure statement on November 15, 2000, without any further statement and without the fee set forth in § 1.17(p).
- (B) Filing the information disclosure statement on December 11, 2000, without any further statement and without the fee set forth in § 1.17(p).
- (C) Filing the information disclosure statement on December 13, 2000, without any further statement and without the fee set forth in § 1.17(p).
- (D) Choices (A) or (B) above.
- (E) None of the above.

43. As a new member of a law firm, you are assigned to continue the prosecution of a patent application that was prosecuted by Stewart, who recently joined another law firm. After reviewing the file, you note that Stewart's reply to a first Office included two amendments: Amendment #1 introduced a change to the specification which did not affect the claims; Amendment #2 introduced a change to the specification, which change was also introduced to all of the claims currently in the application. You also note that the examiner in a current Office action has taken the position that both amendments constituted new matter, required cancellation of the new matter, and rejected all the claims on the ground that they recited elements without support in the original disclosure under 35 U.S.C. 112, first paragraph. For the purpose of reviewing the examiner's requirement, which of the following statements accords with proper USPTO practice and procedure?

- (A) Both Amendment #1 and Amendment #2 give rise to appealable questions.
- (B) Review of the examiner's requirement for cancellation of both Amendment #1 and Amendment #2 is by way of petition.
- (C) Review of the examiner's requirement for cancellation of Amendment #1 is by way of petition, and review of the examiner's requirement for cancellation of Amendment #2 is by way of appeal.
- (D) Review of the examiner's requirement for cancellation of Amendment #1 is by way of appeal, and review of the examiner's requirement for cancellation of Amendment #2 is by way of petition.
- (E) Both Amendment #1 and Amendment #2 give rise to questions which may be reviewed either by petition or on appeal.

44. After filing a Notice of Appeal, an appeal brief is due. In accordance with proper USPTO practice and procedure:

- (A) The brief is due within two months of the date of appeal. The Office date of receipt of the Notice of Appeal is the date from which this two month period is measured.
- (B) The brief is due within two months of the date of appeal, the date indicated on any Certificate of Mailing under 37 C.F.R. § 1.8 attached to the Notice of Appeal is the date from which this two month period is measured.
- (C) Failure to file the appeal brief within the permissible time will result in dismissal of the appeal and abandonment of the application, including any allowed claims.
- (D) Failure to file the appeal brief within the permissible time will result in dismissal of the appeal and abandonment of the application containing no allowed claims, and an appeal brief will be due within two months after the date a petition is granted to revive the application and reinstate the appeal.
- (E) If the appellant is unable to file an appeal brief within the time allotted by the rules, appellant may file a petition, with fee, to the examining group, requesting additional time, and the time extended is added to the last day the appeal brief would have been due when said last day is a Saturday, Sunday, or Federal holiday.

45. In regard to patent application drawings, which of the following is in accord with proper USPTO practice and procedure?

- (A) Views in a drawing may be connected by projection lines, and views may contain center lines in patent applications filed in April 2001.
- (B) Photographs must be developed on paper that is DIN size A4 or 8½ by 11 inches, and meet margin requirements set by regulation in applications filed in April 2001.
- (C) Color drawings are permitted by regulation, and without further authorization, in an application submitted under the Office electronic filing system in April 2001.
- (D) The Office will accept black and white photographs in utility or design applications filed in April 2001 only if three copies of black and white photographs, and a petition and fee are filed to have such photographs accepted.
- (E) In applications filed in April 2001, the scale of a drawing must be properly indicated by statements such as “actual size” or “scale ½.”

46. Regarding a power of attorney or authorization of agent in a patent application, which of the following is in accordance with proper USPTO practice and procedure?

- (A) Powers of attorney to firms submitted in applications filed in the year 2001 are recognized by the United States Patent and Trademark Office.
- (B) The associate attorney may appoint another attorney.
- (C) The filing and recording of an assignment will operate as a revocation of a power or authorization previously given.
- (D) Revocation of the power of the principal attorney or agent does not revoke powers granted by him or her to other attorneys or agents.
- (E) All notices and official letters for the patent owner or owners in a reexamination proceeding will be directed to the attorney or agent of record in the patent file at the address listed on the register of patent attorneys and agents.

47. An examiner has properly established a prima facie showing of no specific and substantial credible utility for the claimed invention in a patent application filed in February 2001. An applicant can sustain the burden of rebutting and overcoming the showing by:

- (A) Providing reasoning or arguments rebutting the basis or logic of the prima facie showing.
- (B) Amending the claims.
- (C) Providing evidence in the form of a declaration under 37 C.F.R. § 1.132 rebutting the basis or logic of the prima facie showing.
- (D) Providing evidence in the form of a printed publication rebutting the basis or logic of the prima facie showing.
- (E) All of the above.

48. Your Canadian client, UpNorth Incorporated, came to you on February 11, 2001 with a valuable invention for pulping timber. UpNorth informed you it had been successfully using the invention commercially for the past fourteen months deep in the Canadian forests. The invention has not been used anywhere else by UpNorth, and the pulped timber from the UpNorth operations has not left Canada. At least one competitor, another Canadian company, lawfully observed the invention in operation during its first month of use with no restriction as to confidentiality or disclosure. UpNorth filed a Canadian patent application in December 1, 1999, prior to commercial use of the invention, but (in an effort to hold down expenses) chose not file a corresponding application in the United States. The Canadian patent application remains pending. UpNorth learned that two months ago, in December 2000, that its competitor began using the invention commercially in the United States. The invention was never disclosed or used in the United States prior to two months ago. UpNorth would like for you seek a United States patent on the invention to block the competitor from continued use of the invention. Which of the following would be reasonable advice from you to UpNorth?

- (A) Since Canada is a NAFTA country, UpNorth is precluded from getting a United States patent because the Canadian application was filed more than twelve months ago and the invention was in public use more than one year prior to any possible United States filing date for an UpNorth patent application.
- (B) UpNorth should promptly file an application in the United States claiming the benefit of the filing date of the Canadian application and should fully disclose the Canadian commercial activities, the observation of the invention in Canada by UpNorth's competitor, and the competitor's commercial activities in the United States.
- (C) UpNorth should abandon the pending Canadian application to avoid the possibility the Canadian application could be used as prior art against a United States patent application, and then file a patent application in the United States.
- (D) UpNorth should promptly file an application in the United States without claiming the benefit of the filing date of the Canadian application and should fully disclose the Canadian commercial activities, the observation of the invention in Canada by UpNorth's competitor, and the competitor's commercial activities in the United States.
- (E) Since UpNorth's activities concerning the invention all took place in Canada, the competitor's commercial use in the United States prior to any possible United States filing date for an UpNorth patent application precludes UpNorth from obtaining a United States patent.

49. In regard to disclosure of a utility in a nonprovisional utility patent application filed in the Office in April 2001, which of the following is not in accord with proper USPTO practice and procedure?

- (A) For each claimed invention an applicant need only provide one credible assertion of specific and substantial utility to satisfy the utility requirement.
- (B) A patent examiner can properly support a rejection based on lack of utility by providing documentary evidence regardless of the publication date to show a factual basis for the prima facie showing of no specific and substantial credible utility.
- (C) Using a complex claimed invention as landfill is an example of a specific and substantial utility for the claimed invention.
- (D) An invention has a well-established utility if a person of ordinary skill in the art would immediately appreciate why the invention is useful based on the characteristics of the invention, and the utility is specific, substantial, and credible.
- (E) Where the asserted specific and substantial utility is not credible, a prima facie showing of no specific and substantial utility must establish that it is more likely than not that a person skilled in the art would not consider credible any specific and substantial utility asserted by the applicant for the claimed invention.

50. An article in a popular scientific journal, dated January 13, 2000, fully discloses and teaches how to make a “Smart Shoe” wireless telecommunications device. The article discloses a shoe having a dialer in a rubber sole of the shoe. The article does not teach a metallic shoelace or suggest using the same as an antenna or for any other purpose. Which of the following claims in an application filed January 22, 2001 is/are anticipated by the journal article, and is/are not likely to be properly rejected under 35 U.S.C. § 112, second paragraph as indefinite?

Claim 1. A telecommunication device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and a metallic shoelace.

Claim 2. A telecommunications device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and optionally a metallic shoelace.

Claim 3. A telecommunication device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and optionally a random access memory for storing telephone numbers.

- (A) Claim 1.
- (B) Claim 2.
- (C) Claim 3.
- (D) Claims 2 and 3.
- (E) None of the above.

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United States Patent and Trademark Office
Registration Examination for Patent Attorneys and Agents
April 18, 2001

Morning Session Model Answers

1. ANSWER: (A) is the most correct answer because there is compliance with 37 C.F.R. § 1.195. MPEP § 1211.02. (E) and (C) are wrong because jurisdiction has not passed to the Board. MPEP § 1210. (B) and (D) are wrong because a remand is an action by the Board when it has jurisdiction of the case. MPEP § 1211. Under the present facts, jurisdiction has not passed to the Board. MPEP § 1210.

2. ANSWER. (C) is the most correct answer. Under 37 C.F.R. § 1.53(d), “(1) A continuation...application...of a prior nonprovisional application may be filed as a continued prosecution application provided that: (i) The prior nonprovisional application is either: a utility...application that was filed under 35 U.S.C. 111(a) before May 29, 2000, and is complete as defined by § 1.51(b);...and (ii) The application under this paragraph is filed before the earliest of payment of: (A) Payment of the issue fee on the prior application, unless a petition under 37 C.F.R. § 1.313(c) is granted in the prior application; (B) Abandonment of the prior application; or (C) Termination of proceedings on the prior application.” (A) is not the most correct answer. 37 C.F.R. § 1.53(d)(1) does not authorize filing a divisional application as a CPA of a prior provisional application. (B) is not the most correct answer. 37 C.F.R. § 1.53(d)(1) does not authorize filing of a continuation-in-part application as a CPA of a prior complete nonprovisional utility application. (D) is not the most correct answer. Pursuant to 37 C.F.R. § 1.53(d)(1)(i)(A), the prior application must be filed prior to May 29, 2000. Since the prior CPA was actually filed on June 1, 2000, a further CPA cannot be filed off that CPA. The filing date of the first application (November 28, 1999) is not relevant to 37 C.F.R. § 1.53(d)(1)(i)(A), and is only used for identification purposes in the first CPA. See, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50093, right column, second paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (E) is not the most correct answer. 37 C.F.R. § 1.53(d)(1)(i)(A) does not authorize the filing of a divisional or continuation application as a CPA of a prior complete nonprovisional utility application filed on or after May 29, 2000.

3. ANSWER: (B) is the most correct answer. Application number of each patent is not required to be listed by 37 CFR § 1.98(b)(1), which provides “(b)(1) Each U.S. patent listed in an information disclosure statement must be identified by inventor, patent number, and issue date.” As to (A), the elements of (A) are found in 37 CFR § 1.98 (a)(3)(ii), which provides “(ii) A copy of the translation if a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c).” As to (C), the elements of (C) are found in 37 CFR § 1.98 (b)(5), which provides “(5) Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.” As to (D), the elements of (D) are found in 37 CFR § 1.98(c), which provides “[w]hen the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications, provided that it is stated that these other patents or publications are cumulative.” As to (E), the elements of (E) are found in 37 CFR § 1.98(d), which provides “(d) A copy of any patent, publication, pending U.S. application or

other information, as specified in paragraph (a) of this section, listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application, unless: (1) The earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120; and (2) The information disclosure statement submitted in the earlier application complies with paragraphs (a) through (c) of this section.”

4. ANSWER: (C) is the most correct answer. 37 CFR § 1.366(c) (effective September 8, 2000), “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54649 (Sept. 8, 2000). Under 37 CFR § 1.366(a), any person or organization may pay maintenance fees and any necessary surcharges on behalf of a patentee. Authorization by the patentee is not required. 37 CFR § 1.366(c) states, “If the payment includes identification of only the patent number (i.e., does not identify the application number of the United States application for the patent on which the maintenance fee is being paid), the Office may apply the payment to the patent identified by patent number in the payment or may return the payment.” Only in (C) does the USPTO have the option of returning the maintenance fee. (A) and (B) are each incorrect. (D) is incorrect because (A) and (B) are incorrect. (E) is incorrect because (C) is correct.

5. ANSWER: (D) is the most correct answer. The Maintenance Fee Reminder is sent to the correspondence address used during prosecution unless a fee address has been designated. 37 C.F.R. § 1.363; MPEP § 2540.

6. ANSWER: (C) is the most correct answer. *See, e.g.*, 37 C.F.R. § 1.33(c); MPEP §§ 2222 and 403.

7. ANSWER: (E) is the correct answer. 37 CFR § 1.114 (effective August 16, 2000); “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 FR 50092, 50097 (August 16, 2000). (A) is a final action (§ 1.113). 65 FR 50097, column 1, states in pertinent part, “...an action that otherwise closes prosecution in the application (e.g., an Office action under *Ex Parte Quayle*, 1935 Comm’r Dec. 11 (1935)).” Thus (A), (B), (C) and (D) are individually correct, and (E), being the most inclusive, is the most correct answer.

8. ANSWER: (E) is the most correct answer. Third party requesters do not have the option of attending interviews. See 37 CFR § 1.560(a), which provides, in part, “[r]equests that reexamination requesters participate in interviews with examiners will not be granted.” As to (A) through (D), each item is founded on a portion of § 1.560(b), which states “(b) In every instance of an interview with an examiner in an *ex parte* reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111. Patent owner’s response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.”

9. ANSWER: (C), not being in accord with proper USPTO practice and procedure, is the most correct answer. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1107 (Jan. 5, 2001), middle column, “A general allegation of ‘unpredictability in the art’ is not a sufficient reason to support a rejection for lack of adequate written description.” (A), being in accord with proper USPTO practice and procedure, is not correct. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1107 (Jan. 5, 2001), left column, “A description as filed is presumed to be adequate... .” (B), being in accord with proper USPTO practice and procedure, is not correct. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1107 (Jan. 5, 2001), “A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption.⁶⁵ ...The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.⁶⁶” (footnotes not reproduced). (D), being in accord with proper USPTO practice and procedure, is not correct. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1107 (Jan. 5, 2001), left column, “[W]hen filing an amendment, applicant should show support in the original disclosure for new or amended claims.⁵⁹” Footnote 59 states, “See MPEP §§ 714.02 and 2163.06 (‘Applicant should... specifically point out the support for any amendments made to the disclosure.’).” (E), being in accord with proper USPTO practice and procedure, is not correct. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1106 (Jan. 5, 2001), right column, “[W]hen there is substantial variation within a genus, an applicant must describe a sufficient variety of species to reflect the variation within the genus.”

10. ANSWER: (A) or (D) are accepted as correct answers. MPEP § 2173.05(e). Claim 2 is indefinite because it is not clear which “said pipe” the claim is referring to since claim 1 recites a copper pipe and an aluminum pipe. Accordingly, claim 2 provides the basis for a proper rejection under 35 U.S.C. § 112, second paragraph. In (B), claim 3 can be construed as definite, inasmuch as “the outer surface,” e.g., the outer circumference, is an inherent part of the pipe and would not require antecedent recitation. Therefore, (B), would be incorrect. Alternatively, claim 3 in (B) could be properly construed as not being clear as to which outer surface is being referenced, i.e., “the outer surface” defined by the outer circumference of the pipe, or the external surface defined by the inner circumference of the pipe or the end(s) of the pipe inasmuch as the pipe is not defined as being closed and both the inner circumference and end(s) are external surfaces to the material of the pipe. However, recognizing claim 3 in (B) as being indefinite, but not claim 2, is incorrect because claim 2 is necessarily indefinite. Claim 2 must be recognized as being indefinite. Accordingly, selection of (D), which recognizes both (A) and (B) as providing the basis for a proper rejection under 35 U.S.C. § 112, second paragraph is also accepted. Selection of (B) alone is not accepted as a correct answer because it does not recognize claim 2 as being indefinite. Claim 4 is definite inasmuch as there is antecedent basis for “said plastic valve.” Therefore, (E) is incorrect.

11. ANSWER: (C) is the correct answer. 37 CFR § 1.105(a)(3) (effective November 7, 2000), “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54634 (September 8, 2000), and 37 CFR § 1.136(a)(1). (C) is correct pursuant to 37 CFR § 1.105(a)(3). (A) is incorrect because it is not responsive to the requirement for information. (B) is incorrect because “each attorney or agent who prepares or prosecutes the application,” is identified an individual under 37 CFR § 1.56(c). (D) is incorrect because information used to draft an application may be required under 37 CFR § 1.105(a)(1)(iv). (E) is incorrect because (C) is correct.

12. ANSWER: (E) is the most correct answer. Since the claim reads on a downward moving actuator and only a upward moving actuator was cited during the prosecution, the Shack restaurant device was material to the patentability of the invention. Moreover, Sam argued the significance of the downward motion feature. 37 C.F.R. § 1.56(b)(2)(i). Sam should have disclosed it under 37 C.F.R. § 1.56(c)(2). As to (A), the duty of disclosure extends to each practitioner who prepares or prosecutes the application. 37 C.F.R. § 1.56(c)(2). As to (B), even though Chris had completed the disclosure, the sighting of the Shack restaurant doorstep occurred prior to the filing date. Moreover, the restaurant (and doorstep) was in existence at least one year prior to Sam’s visit. MPEP § 2001.06. As to (C), information material to the invention is more than just patents and printed publications. 37 C.F.R. § 1.56; MPEP 2001.04, p.2000-3. As to (D), only patents and printed publication may be considered during a reexamination. 35 U.S.C. § 303(a); MPEP § 2209.

13. ANSWER: (A) is the most correct answer. The answer is inconsistent with 35 U.S.C. § 112 and MPEP § 608.01(n), subpart I.B.4. (B), (C), and (E) are wrong answers because they are consistent with 35 U.S.C. § 112 and MPEP § 608.01(n), subpart I.B.4. (D) is wrong because it is consistent with MPEP § 608.01(n), subpart I. C.

14. ANSWER: (D) is the most correct answer. MPEP § 608.01(n), part “IV. Claim Form and Arrangement.” A claim which depends from a dependent claim should not be separated therefrom by any claim which does not also depend from said “dependent claim.” (A), (B), and (C) are incorrect because they are practices encouraged by the MPEP §. MPEP § 608.01(n), subsection “IV. Claim Form and Arrangement.” (E) is incorrect because it represents a practice encouraged by MPEP § 608.01(m). See *Fressola v. Manbeck*, 36 USPQ2d 1211 (D.D.C. 1995).

15. ANSWER: (D) is the correct answer. 37 CFR § 1.105(a) (effective November 7, 2000); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54634 (September 8, 2000). (A) is specifically stated as an example in 37 CFR § 1.105(a)(1)(v). (B) and (C) are given as examples in 65 FR at 54634, left column, where the Office may require the submission of information. (E) is incorrect because (D) is correct.

16. ANSWER: (B) is the most correct answer. Admissions by applicant constitute prior art. 37 C.F.R. § 1.104(a)(3). As explained in *Tyler Refrigeration v. Kysor Industrial Corp.*, 777 F.2d 687, 227 USPQ 845 (Fed. Cir. 1985), the Fed. Circuit found that

the district court decided on two separate and independent grounds that the Aokage patent was such prior art. One basis was Tyler’s admission of the

Aokage reference as prior art before the PTO during the prosecution of the '922 Subera patent. The court found that, in a wrap-up amendment, the Tyler attorney admitted in his discussion as to "all the claims" of the three Subera applications, that "the most pertinent available prior art known to the Applicants and their representatives is the Aokage U.S. Patent 4,026,121 cited by the Examiner" (emphasis added). In view of this explicit admission, the district court's decision was proper and was sufficiently based on clear and convincing evidence. The controlling case law in this court recognizes this principle. See *Aktiebolaget Karlstads Mekaniska Werkstad v. ITC*, 705 F.2d 1565, 1574, 217 U.S.P.Q. (BNA) 865, 871 (Fed. Cir. 1983); *In re Fout*, 675 F.2d 297, 300, 213 U.S.P.Q. (BNA) 532, 536 (CCPA 1982), and *In re Nomiya*, 509 F.2d 566, 571, 184 U.S.P.Q. (BNA) 607, 612 (CCPA 1975). Thus, we must affirm the court's decision that the Aokage patent was prior art and as such binding on Tyler. (Here again, we do not pass on the other grounds on which the court concluded that the Aokage was prior art within the meaning of 35 U.S.C. § 102.)

Since (B) is true, (D) is not true. Answers (A), (C) and (D) also are not true since the Acme patent can not be sworn behind or otherwise removed as a result of the admission. (E) is not true because (A) and (D) are not true.

[Note re Question 16, choice (B), line 1: Examination proctors were instructed to direct examination candidates after the word "by," to insert the word --the--. Also in Question 16, choice (D), line 3, examination proctors were instructed to direct examination candidates after the word "by" to insert the words --the registered practitioner--. The question has been carefully reviewed to see if there is any alternative reasonable meaning to the question if any or all of the changes were not made. No such meaning was found. The Director of Enrollment and Discipline concluded that omission of the changes should have no material affect on the question, and should not inhibit an individual's ability to correctly answer the question.

17. ANSWER: (C) is the correct answer. 37 CFR § 1.104(e) (effective November 7, 2000); "Changes To Implement the Patent Business Goals; Final Rule," 65 FR 54604, 54633 (September 8, 2000). As stated in 65 FR at 54633, middle column, "In view of the recent case law dealing with prosecution history, the failure of an applicant to comment on damaging reasons for allowance would give rise to a presumption of acquiescence to those reasons..." Thus, (A) is incorrect. 65 FR at 54633, middle column, also provides, "That the examiner does not respond to a statement by the applicant commenting on reasons for allowance does not mean that the examiner agrees with or acquiesces in the reasoning of such statement." Thus (B) is incorrect. (D) is incorrect because (A) is incorrect. (E) is incorrect because (C) is correct.

18. ANSWER: (E) is the correct answer. 37 CFR § 1.114(e), effective date August 16, 2000; *see*, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 FR 50092, 50097 (Aug. 16, 2000). (E) is correct since the provisions of 37 CFR § 1.114 do not apply to design patent applications. Therefore, choices (A) through (D) are incorrect.

19. ANSWER: (A) is the most correct answer. In *Evans Cooling Systems, Inc. v. General Motors Corp.*, 125 F.3d 1448, 44 USPQ 2d 1037 (Fed. Cir. 1997) the Federal Circuit held that even though an invention is misappropriated by a third party, the public sale bar applies (35 U.S.C. § 102(b)). Accordingly, (A) is true and (B) is not. (C) is incorrect since the people at MC were not the true inventors, and therefore, the misappropriation is within the jurisdiction of the USPTO. 35 U.S.C. § 102(f). (D) is incorrect inasmuch as (C) is incorrect. (E) is incorrect inasmuch as (A) is correct.

20. ANSWER: (D) is the most correct answer. “It is not necessary in order to establish a prima facie case of obviousness...that there be a suggestion or expectation from the prior art that the claimed [invention] will have the same or a similar utility as one newly discovered by the applicant.” In *re Dillon*, 919 F.2d 688, 692, 16 USPQ2d 1897, 1900 (Fed. Cir. 1990) (emphasis in original). Thus, “[i]t is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant.” MPEP § 2144 (“Rationale Different from Applicant’s is Permissible”). Here, T suggests the combination with P to achieve a different advantage or result, i.e., waterproofing, from that discovered by applicant, i.e., reducing breakage. Answers (A) - (C) are incorrect because the suggestion to combine does not need to be for the same purpose as applicant discloses in the application. *Dillon*, 919 F.2d at 692, 16 USPQ2d at 1900; MPEP § 2144 (“Rationale Different from Applicant’s is Permissible”). Answer (E) is incorrect because an applicant is under no obligation to submit evidence of non-obviousness unless the examiner meets his or her initial burden to fully establish a prima facie case of obviousness. MPEP § 2142.

21. ANSWER: (D) is the most correct answer. 35 U.S.C. § 132(a); 37 C.F.R. § 1.114. “In those instances in which an applicant seeks to add new matter to the disclosure of an application, the procedure set forth in § 1.114 is not available, and the applicant must file a continuation-in-part application under § 1.53(b) containing such new matter.” See, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50095, right column (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (A) is not the most correct answer. At a minimum, corrected drawings suitable for reproduction are required. 37 C.F.R. § 1.85(b). (B) is not the most correct answer. As stated in 37 C.F.R. § 1.85(c), “If...a drawing does not comply with § 1.84 at the time an application is allowed, the Office may notify the applicant and set a three month period of time from the mail date of the notice of allowability within which the applicant must file a...formal drawing in compliance with § 1.84 to avoid abandonment. This time period is not extendable under § 1.136(a) or § 1.136(b).” See also 37 C.F.R. § 1.136(b). (C) is not the most correct answer. 35 U.S.C. § 119(e)(2) has been amended to eliminate the copendency requirement. (E) is not the most correct answer. 37 C.F.R. § 1.78(a)(4). For a nonprovisional application to properly claim the benefit of the filing date of a provisional application the provisional application must be entitled to a filing date and the basic filing fee set forth in 37 C.F.R. § 1.16(k) must be paid within the time period set forth in 37 C.F.R. § 1.53(g). See also, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50094, left column (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000).

22. All answers accepted.

23. ANSWER: (E) is the most correct answer because the advice is consistent with PCT Rule 4/15(b) and 37 C.F.R. § 1.425. (A), (B), (C), and (D) are wrong because the advice provided is not consistent with 37 C.F.R. § 1.425. MPEP § 1820, p.1800-16.

24. ANSWER: (E) is the correct answer. 37 CFR § 1.48(b) (effective November 7, 2000); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54619 (September 8, 2000). As stated in 65 FR at 54619, middle column, “Sections 1.48(b) and (d) are revised to indicate that a request to correct the inventorship thereunder must be signed by a party as set forth in § 1.33(b)...” (A), (B), and (C) are provided for in 37 CFR § 1.33(b). Thus (E), the most inclusive answer, is correct.

25. ANSWER. (B) is the most correct answer. As stated in “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092 (Aug. 16, 2000), 1238 O.G.13 (Sept. 5, 2000), “Section 4801 of the American Inventors Protection Act of 1999 contains no provision for according the resulting nonprovisional application a filing date other than the original filing date of the provisional application. Thus, under the patent term provisions of 35 U.S.C. 154, the term of a nonprovisional application resulting from the conversion of a provisional application pursuant to 35 U.S.C. § 111(b)(5) will be measured from the original filing date of the provisional application (which is the filing date accorded the nonprovisional application resulting from the conversion under § 4801 of the American Inventors Protection Act of 1999).” However, the pendency is counted against the patent term. (A), being in accord with USPTO practice and procedure, is not the most correct answer. 37 C.F.R. § 1.53(c)(3), third sentence. See also, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50093 (Aug. 16, 2000), 1238 O.G.13 (Sept. 5, 2000). (C), being in accord with USPTO practice and procedure, is not the most correct answer. 37 C.F.R. § 1.53(c)(3), fourth sentence. (D), being in accord with USPTO practice and procedure, is not the most correct answer. 37 C.F.R. § 1.53(c)(3). (E) is a correct statement, and there fore is not a correct answer. 35 U.S.C. § 119(e)(3).

26. ANSWER: (B) is the most correct answer. Under 37 C.F.R. § 1.26(b), “Any request for refund must be filed within two years from the date the fee was paid.” See, “Changes to Implement the Patent Business Goals, Final Rule,” 65 F.R. 54604, 54608, middle column (September 8, 2000), 1238 O.G. 77 (Sept. 19, 2000). (A) is not the most correct answer. 37 C.F.R. § 1.26(a). See, “Changes to Implement the Patent Business Goals, Final Rule,” 65 F.R. 54604, 54608, right column (September 8, 2000), 1238 O.G. 77 (Sept. 19, 2000). (C) is not the most correct answer. 37 C.F.R. § 1.52(b)(6) provides that other than in a reissue application, the paragraphs of the specification of an application may be numbered at the time the application is filed. See, “Changes to Implement the Patent Business Goals, Final Rule,” 65 F.R. 54604, 54620 (left column), 54621 (Comments 22, 23, 24, and 25, and responses) (September 8, 2000), 1238 O.G. 77 (Sept. 19, 2000). (D) is not the most correct answer. 37 C.F.R. § 1.52(d)(2) provides for that an English language translation of the non-English language provisional application will not be required in the provisional application. (E) is not the most correct answer. 37 C.F.R. § 1.52(e)(5). See, “Changes to Implement the Patent Business Goals, Final Rule,” 65 F.R. 54604, 54621, left column (September 8, 2000), 1238 O.G. 77 (Sept. 19, 2000).

27. ANSWER: (D) is the most correct answer. MPEP § 608.01, subsection “Illustrations In the Specification.” 37 C.F.R. § 1.58(a) permits tables and chemical formulas in the specification in lieu of formal drawings. (A) is incorrect. MPEP § 608.01, subsection “Illustrations In the Specification.” Graphical illustrations, diagrammatic views, flowcharts, and diagrams in the descriptive portion of the specification do not come within the purview of 37 C.F.R. § 1.58(a). The examiner should object to such descriptive illustrations in the specification and request formal drawings in accordance with 37 C.F.R. § 1.81 when an application contains graphs in the specification. (B) is incorrect. 37 C.F.R. § 1.75(a). The specification must conclude with one or more claims. (C) is incorrect. MPEP § 608.01, subsection “Hyperlinks And Other Forms Of Browser-Executable Code In The Specification.” USPTO policy does not permit the USPTO to link to any commercial sites since the USPTO exercises no control over the organization, views, or accuracy of the information contained on these outside sites. (E) is incorrect. 37 C.F.R. § 1.79. A reservation for a future application of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application.

28. ANSWER: (D) is the most correct answer. Under 37 C.F.R. § 1.85(a), correcting the drawings to comply with 37 C.F.R. § 1.84(a)(1) and (k), and making them suitable for reproduction is a *bona fide* response. (A), (B), and (C) are not the most correct answer. In each, Smith seeks to hold the requirement in abeyance. As stated in 37 C.F.R. § 1.85(a) (effective November 29, 2000), “Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a *bona fide* attempt to advance the application to final action.” See also, “Changes to Implement Eighteen-Month Publication of Patent Applications; Final Rule,” 65 F.R. 57024, 57032, “Section 1.85.” (E) is not the most correct answer inasmuch as (A), (B), and (C) are not the most correct answers.

29. ANSWER: (C) is the most correct answer. See MPEP § 2128 under the subheading “Date of Availability,” of the heading “Electronic Publications As Prior Art.” (A) is wrong. See MPEP § 2129 under the heading “A Jepson Claim Results In An Implied Admission That Preamble Is Prior Art.” (B) is wrong. See MPEP § 2128.02. A journal article or other publication becomes available as prior art on date it is received by at least one member of the public. (D) is wrong. See MPEP § 2128.01 under the heading “A Thesis Placed In A University Library May Be Prior Art If Sufficiently Accessible To The Public.” (E) is wrong. See *In re Nomiya*, 184 USPQ 607, 610 (CCPA 1975); MPEP § 2129 under the heading “Admissions By Applicant Constitute Prior Art.”

30. ANSWER: (D) is the most correct answer. 37 C.F.R. § 1.103(c). See, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50100, right column, Comment 11 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (A) is not the most correct answer. 37 C.F.R. § 1.114. “An applicant may not obtain examination of a different or non-elected invention (e.g., a divisional) in a request for continued examination under § 1.114.” See, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50102, left column, Comment 21 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (B) is not the most correct answer. 37 C.F.R. § 1.312. Amendments are not entered as a matter of right. Section 1.312 is not intended to be used for continued examination of applications. See MPEP 714.16.

Any amendments considered necessary by the applicant should be completed before the notice of allowance is issued.” *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50102, middle column, Comment 24 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (C) is not the most correct answer. 37 C.F.R. §§ 1.85(c) and 1.136(c)(2). The three-month period set in the notice of allowability for submission of any outstanding corrected or formal drawing is not extendable under 37 C.F.R. § 1.136(a) or (b). *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50102, middle column, Comment 23 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (E) is not the most correct answer. 37 C.F.R. § 1.103(a). The Office will not suspend action if a reply by the applicant is due. *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50101, left column, Comment 12 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000).

31. ANSWER: (D) is the most correct answer. 35 U.S.C. § 102(a); MPEP § 715, subsection styled “SITUATIONS WHERE 37 C.F.R. 1.131 AFFIDAVITS OR DECLARATIONS CAN BE USED.” (A) is incorrect. 35 U.S.C. 102(b), MPEP § 715. (B) is incorrect. The question involved is one of “double patenting.” 37 C.F.R. § 1.131, MPEP § 715. (C) is incorrect. 35 U.S.C. § 102(g); 37 C.F.R. § 1.131. As explained in MPEP § 715, subsection styled “SITUATIONS WHERE 37 C.F.R. 1.131 AFFIDAVITS OR DECLARATIONS ARE INAPPROPRIATE,” “i. ... 37 C.F.R. 1.131 is designed to permit an applicant to overcome rejections under 35 U.S.C. 102(a) and (e) based on patents and publications which are not statutory bars, but which have publication dates, or in the case of U.S. patents, effective filing dates, prior to the effective filing date of the application but subsequent to the applicant’s actual date of invention. However, when the subject matter relied on is also available under 35 U.S.C. 102(g), a 37 C.F.R. 1.131 affidavit or declaration cannot be used to overcome it. *In re Bass*, 474 F.2d 1276, 177 USPQ 178 (CCPA 1973). This is because subject matter which is available under 35 U.S.C. 102(g) by definition must have been made before the applicant made his invention. References under 35 U.S.C. 102(a) and (e), by contrast, merely establish a presumption that their subject matter was made before applicant’s invention date. It is this presumption which may be rebutted by evidence submitted under 37 C.F.R. 1.131.” (E) is incorrect. An affidavit or declaration under 37 C.F.R. 1.131 is unnecessary because the reference is not prior art and should not be used. MPEP § 715.

32. ANSWER: (E) is the most correct answer. 37 C.F.R. §§ 1.114 and 1.116(b) and (c). *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50097, middle column, second complete paragraph, 50101, Comment 19 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (A) is not the most correct answer. 37 C.F.R. § 1.313(a), third sentence. A petition under § 1.313 is not required if a request for continued examination is filed prior to payment of the issue fee. (B) is not the most correct answer. 37 C.F.R. § 1.312, in pertinent part, provides, “Any amendment filed pursuant to this section must be filed before or with the payment of the issue fee.” *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50097, middle column, fourth complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (C) is not correct. *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50097, right column,

second complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). *See also* 37 CFR § 1.313(d). (D) is not the most correct answer. “The Office will not suspend action in an application when a reply by the applicant is outstanding. 35 U.S.C. 133 requires the applicant to ‘prosecute the application’ within six months of an Office action (or a shorter period as set in the Office action) to avoid abandonment of the application. If an applicant files a request for continued examination but does not also provide any submission (in reply to the prior Office action) within the period for reply to the prior Office action, the application is abandoned by operation of law. (35 U.S.C. 133).” *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50102, left column, Comment 20 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000).

33. ANSWER: (C). MPEP 2163.03, item I. Original claims constitute their own description *In re Koller*, 613 F.2d 819, 204 USPQ 702 (CCPA 1980). (A) and (B) are incorrect. As stated in MPEP 2163.03, item I, “An amendment to the specification (e.g., a change in the definition of a term used both in the specification and claim) may indirectly affect a claim even though no actual amendment is made to the claim.” There is no supporting disclosure in the original description of the invention for the holder to a clasp, crimp, or tong. (D) is incorrect. MPEP 2163.03, item IV. A broad generic disclosure is not necessarily a sufficient written description of a specific embodiment, especially where the broad generic disclosure conflicts with the remainder of the disclosure. *Fields v. Conover*, 443 F.2d 1386, 170 USPQ 276 (CCPA 1970). (E) is not correct because (C) is correct.

34. ANSWER: (D) is the most correct answer. *See*, 37 CFR §§ 1.702(e) and 1.703(e). Answer (A) is incorrect at least because the Patent Term Guarantee Act of 1999 applies to Joseph’s application, which was filed after May 29, 2000. Answer (B) is incorrect because a failure to engage in reasonable efforts to conclude prosecution may reduce patent term extension, but is not a complete forfeiture of any extension. Answer (C) is incorrect because the three year period set forth in 37 CFR § 1.702(b) does not include time consumed by review by the Board of Appeals and Patent Interferences or any delay in processing of the application that was requested by the applicant. Answer (E) is incorrect because any reduction is based on an expected reply within three months of the Office action, regardless of the deadline set by the USPTO. *See*, 37 CFR § 1.704(b) and “37 CFR Part 1 Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term; Final Rule,” Federal Register Vol. 65, No. 181 at 56371.

35. ANSWER: (E) is the most correct answer. Nonpublication of the application does not affect the patent term extension provisions of the Patent Term Guarantee Act of 1999. Thus, statement (B) is true. The patent term extension provisions of 37 CFR §§ 1.702 *et seq.* are separate and independent of the eighteen-month publication provisions. There is no support for statement (A). An applicant may rescind a nonpublication request at any time. *See* “37 CFR Parts 1 and 5 -- Changes To Implement Eighteen-Month Publication of Patent Applications; Final Rule,” Federal Register Vol. 65, No. 183 (9/20/2000) at 57024, middle column. Thus, statement (C) is also true. Accordingly, the best answer is (E).

36. ANSWER: (D) is the most correct answer. In this case, an appeal brief was due two months after the filing of the Notice of Appeal. 37 CFR § 1.192. Joseph’s Notice of Appeal was filed September 19, 2002 and the Appeal Brief was initially due November 19, 2002. This non-

statutory time period could be extended under 37 CFR § 1.136(a). Since Joseph filed the Appeal Brief on March 18, 2003, a four-month extension of time was required. Answer (A) is incorrect because the two-month period for filing the appeal brief is measured from the time that Joseph filed the Notice of Appeal and the six month statutory time period does not apply. Answer (B) is incorrect at least because the premise that the Appeal Brief was filed more than six months after the Notice of Appeal was filed is incorrect.

37. ANSWER: (A) is the most correct answer. 37 C.F.R. § 1.114(a) and (d). The filing of a request for continued examination, including a submission, after the filing of a Notice of Appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal is considered a request to withdraw the appeal and reopen prosecution of the application before the examiner. The submission may be an amendment to the written description. 37 C.F.R. § 1.114(c). *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50095, left column, third complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (B) is not the most correct answer. 37 C.F.R. § 1.114(a)(3). The procedure of § 1.114 is not available in an application after the filing of a Notice of Appeal to the Federal Circuit unless the appeal is terminated and the application is still pending. *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50095, middle column, first complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (C) is not the most correct answer. The filing of an RCE (with a submission and fee) in an allowed application after the issue fee has been paid without a petition under 37 C.F.R. § 1.313 to withdraw the application from issue “will not operate to avoid issuance of the application as a patent.” *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50095, middle column, second complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (D) is not the most correct answer. The procedure of § 1.114 is not available in an application after the filing of a Notice of Appeal to the Federal Circuit unless the appeal is terminated and the application is still pending. *See*, MPEP 1216.01; and “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50095, middle column, first complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (E) is not the most correct answer. 37 C.F.R. § 1.114(e)(1). “The continued examination provisions of 35 U.S.C. 132(b) and § 1.114...will not be available for: (1) A provisional application (which is not examined under 35 U.S.C. chapter 12).” *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50095, left column, second complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000).

38. ANSWER: (D) is the most correct answer. 37 C.F.R. § 1.28(a) and (b) provides that a request for a refund based on the excess amount paid on establishment of small entity status must be filed within three (3) months of the date of the timely payment of the full fee. The date of the timely payment of the full fee in this case is Monday, October 9, 2000. Hence, the three month period ends on Tuesday, January 9, 2001. The filing of a request for a one month extension of time on Monday, December 11, 2000, does not extend the three-month time period from the date of the timely payment of the full fee because 37 C.F.R. § 1.28(a) states, “The three-month time period is not extendable under § 1.136.”

39. ANSWER: (C) is the correct answer. 37 CFR § 1.510(b) (effective November 7, 2000); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54649 (September 8, 2000). As stated in 65 FR at 54649, middle column, “Section 1.510(b)(4) now sets forth the requirement that a copy of the patent for which reexamination is requested must be submitted in double column format, on single-sided sheets only.” Thus (C) is correct. (A) is incorrect because 37 CFR § 1.510(b)(1) requires that each substantial new question of patentability be based on prior patents and publications. (B) is incorrect because the statement in (B) is required by 37 CFR § 1.293(b), not by 37 CFR § 1.510(b). (D) is incorrect because under 37 CFR § 1.510(b)(5), the name and address of the party served must be indicated if the request is by a person other than the patent owner.

40. ANSWER: (A) is the most correct answer. Answer (A) is not true since Jack did not invent the knife, therefore he is not entitled to a patent. Jack derived the invention from another, and the picture of Jack with the Vietnamese knife is evidence of derivation. 35 U.S.C. § 102(f); MPEP § 2137. Answer (B) is correct in that Jack should have disclosed “all information material to patentability,” including the existence of the Vietnamese knife, during the original patent prosecution. (C) is correct in that to qualify as prior under 35 U.S.C. § 102(b), the use must be in this country. (D) is correct in that a request for reexamination must be based upon patents and printed publications. (E) is correct in that public use derived from the inventor’s own work cannot be used against the inventor under 35 U.S.C. § 102(a). MPEP § 2132.

41. ANSWER: (D) is the most correct answer. There is no such refund permitted since 35 U.S.C. 42(d) only permits a refund of any fee “paid by mistake or any amount paid in excess of that required.” According to the statute, any refund of an “amount paid in excess” must be based upon an overpayment of a fee that was, in fact, required when the fee was paid. See “Changes to Implement the Patent Business Goals; Final Rule,” 65 F.R. 54604, 54642 (center column) (September 8, 2000), 1238 Official Gazette 77 (September 19, 2000). As to (A) and (B), see “Changes to Implement the Patent Business Goals; Final Rule,” 65 F.R. 54604, 54642 (center column) (September 8, 2000), 1238 Official Gazette 77 (September 19, 2000), which states: “[t]his procedure further expedites design application processing by decreasing clerical processing time as well as the time spent routing the application between processing steps... . Further, the ‘Petition to Make Special’ procedure will continue to be made available without any anticipated increase in the required petition fee.” As to (C), it contains all of the elements of 37 CFR § 1.155(a), which provides “(a) The applicant may request that the Office expedite the examination of a design application. To qualify for expedited examination: (1) The application must include drawings in compliance with § 1.84; (2) The applicant must have conducted a preexamination search; and (3) The applicant must file a request for expedited examination including: (i) The fee set forth in § 1.17(k); and (ii) A statement that a preexamination search was conducted. The statement must also indicate the field of search and include an information disclosure statement in compliance with § 1.98.” As to (E), it contains all of the elements of 37 CFR § 1.155(b), which provides “(b) The Office will not examine an application that is not in condition for examination (e.g., missing basic filing fee) even if the applicant files a request for expedited examination under this section.”

42. ANSWER: (A) is the most correct answer. 37 CFR § 1.97(b)(4) and (c), effective date November 7, 2000; *see*, “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR

54604, 54630 (September 8, 2000); and 37 CFR § 1.114, effective date August 16, 2000, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 FR 50092 (Aug. 16, 2000). (A) is correct since November 15, 2000, is “before the mailing of a first Office action after the filing of a request for continued examination under § 1.114” (37 CFR § 1.97(b)(4)). As stated in 65 FR 54630, column 2, “As the filing of a RCE under § 1.114 is not the filing of an application, but merely continuation of the prosecution in the current application, § 1.97(b)(4) does not provide a three-month window for submitting an IDS after the filing of a request for continued examination. Thus, choices (B) and (C) are each incorrect as they are subject to the requirements of 37 CFR § 1.97(c). (E) is incorrect since (A) is correct. (D) is incorrect because (B) is incorrect.

43. ANSWER: (C) is the correct answer. MPEP § 608.04(c) includes the following recitation:

Where the new matter is confined to amendments to the specification, review of the examiner’s requirement for cancellation is by way of petition. But where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one.

See, also, MPEP § 706.03(o), which includes the following recitation:

In amended cases, subject matter not disclosed in the original application is sometimes added and a claim directed thereto. Such a claim is rejected on the ground that it recites elements without support in the original disclosure under 35 U.S.C. 112, first paragraph.

[Note re Question 43, third line of factual background: Examination proctors were instructed to direct examination candidates to delete from the third line of the factual background the word -- in--. The question has been carefully reviewed to see if there is any alternative reasonable meaning to the question if the change was not made. No such meaning was found. The Director of Enrollment and Discipline concluded that omission of the change should have no material affect on the question, and should not inhibit an individual’s ability to correctly answer the question.

44. ANSWER: (A) is the most correct answer. 37 C.F.R. § 1.192(a); MPEP § 1206, “Time For Filing Appeal Brief.” (B) is incorrect. 37 C.F.R. § 1.192(a); MPEP § 1206, “Time For Filing Appeal Brief.” (C) is incorrect. MPEP § 1206, 1215.04. Although failure to file the brief within the permissible time will result in dismissal of the appeal, if any claims stand allowed, the application does not become abandoned by the dismissal, but is returned to the examiner for action on the allowed claims. (D) is incorrect. 37 C.F.R. § 1.137(a) or (b), MPEP § 1206, “Time For Filing Appeal Brief.” A proper brief must be filed before the petition to revive the application and reinstate the appeal will be considered on its merits. Alternatively, a continuing application or an RCE may be filed. 37 C.F.R. § 1.137(c). (E) is incorrect. MPEP § 1206, “Time For Filing Appeal Brief.” The time extended is added to the calendar day of the original period, as opposed to being added to the day it would have been due when said last day is a Saturday, Sunday, or Federal holiday.

45. ANSWER: (B) is the most correct answer. 37 C.F.R. § 1.84(e), (f) and(g). *See*, Changes to Implement Eighteen-Month Publication of Patent Applications, Final Rule, 65 F.R. 57024, 57031-57032 (September 20, 2000), 1239 O.G. 125 (Oct. 17, 2000). (A) is not the most correct answer. 37 CFR § 1.84(j) provides that views in a drawing must not be connected by projection lines, and views must not contain center lines. (C) is not the most correct answer. 37 C.F.R. § 1.84(a)(2) provides that “[c]olor drawings are not permitted in...an application, or copy thereof, submitted under the Office electronic filing system. The Office will accept color drawings in utility or design patent applications...only after granting a petition filed under this paragraph explaining why the color drawings are necessary.” Any such petition must include a fee and meet the certain requirements set forth in the last sentence of § 1.84(a)(2). *See*, Changes to Implement Eighteen-Month Publication of Patent Applications, Final Rule, 65 F.R. 57024, 57031 (September 20, 2000), 1239 O.G. 125 (Oct. 17, 2000). (D) is not the most correct answer. 37 C.F.R. § 1.84(b)(1) was “amended to eliminate the requirement for three copies of black and white photographs and a petition to accept such photographs.” *See*, Changes to Implement The Patent Business Goals, Final Rule, 65 F.R. 54604, 54628, middle column (September 8, 2000), 1238 O.G. 77 (Sept. 19, 2000). (E) is not the most correct answer. 37 C.F.R. § 1.84(k) provides that “Indications such as ‘actual size’ or ‘scale ½’ on the drawings are not permitted since these lose their meaning with reproduction in a different format.” *See*, Changes to Implement The Patent Business Goals, Final Rule, 65 F.R. 54604, 54628, right column (September 8, 2000), 1238 O.G. 77 (Sept. 19, 2000).

[Note re Question 45, choice (E), first line: Examination proctors were instructed to direct examination candidates to insert after “must,” the word --be--. The question has been carefully reviewed to see if there is any alternative reasonable meaning to the question if any or all of the change was not made. No such meaning was found. The Director of Enrollment and Discipline concluded that omission of the change should have no material affect on the question, and should not inhibit an individual’s ability to correctly answer the question.

46. ANSWER: (E) is the most correct answer. 37 C.F.R. § 1.33(c). (A) is incorrect. MPEP § 403, p.400-9. Powers of attorney to firms filed in executed applications filed after July 2, 1971, are not recognized by the Patent and Trademark Office. However, the firm’s address will be considered to be the correspondence address. (B) is incorrect. MPEP § 402.02, and 406. The associate attorney may not appoint another attorney. (C) is incorrect. 37 C.F.R. § 1.36. An assignment will not itself operate as a revocation of a power or authorization previously given. (D) is incorrect. MPEP § 402.05. Revocation of the power of the principal attorney or agent revokes powers granted by him or her to other attorneys or agents

47. ANSWER: (E) is the most correct answer. For (A) *see*, “Utility Examination Guidelines,” 66 F.R. 1092, 1099, left column (Jan. 5, 2001). “The applicant can do this by... providing reasoning or arguments... .” For (B), *see*, “Utility Examination Guidelines,” 66 F.R. 1092, 1099, left column (Jan. 5, 2001). “The applicant can do this by amending the claims... .” For (C) *see*, “Utility Examination Guidelines,” 66 F.R. 1092, 1099, left column (Jan. 5, 2001). “The applicant can do this by...providing evidence in the form of a declaration under 37 C.F.R. § 1.132...rebutting the basis or logic of the prima facie showing.” For (D), *see*, “Utility Examination Guidelines,” 66 F.R. 1092, 1099, left column (Jan. 5, 2001). “The applicant can do this by...providing evidence in the form of a...printed publication...rebutting the basis or logic

of the *prima facie* showing.” (A), (B), (C), and (D) alone are not the most correct answer inasmuch (E), referencing all of the above, is the most correct answer.

48. ANSWER: (D) is the most correct answer. With regard to Statement (A), public use in Canada is not a statutory bar under 35 U.S.C. § 102(b) regardless of whether Canada is a NAFTA country. MPEP § 706.02(c). Thus, although UpNorth cannot claim priority to the Canadian application under 35 U.S.C. § 119(a), their commercial activity is not a bar. Statement (B) is incorrect because UpNorth cannot rely on the Canadian application for priority. 35 U.S.C. § 119(a). Under the given facts, the Canadian application would not be prior art against a U.S. application regardless of whether the Canadian application was abandoned. Thus, (C) is not reasonable advice. Under 35 U.S.C. § 104, UpNorth can rely on Canadian activities to establish a date of invention prior to the competitor’s commercial use in the United States. Statement (E) is therefore not reasonable advice.

49. ANSWER: (C) is the most correct answer. *See*, “Utility Examination Guidelines,” 66 F.R. 1092, 1098, left column (Jan. 5, 2001), “A claimed invention must have a specific and substantial utility. This requirement excludes ‘throw-away,’ ‘insubstantial,’ or ‘nonspecific’ utilities, such as the use of a complex invention as landfill, as a way of satisfying the utility requirement of 35 U.S.C. 101.” (A) is not the most correct answer. *See*, “Utility Examination Guidelines,” 66 F.R. 1092, 1097, middle column (Jan. 5, 2001), “An applicant need only provide one credible assertion of specific utility for each claimed invention to satisfy the utility requirement.” (B) is not the most correct answer. *See*, “Utility Examination Guidelines,” 66 F.R. 1092, 1098, middle column (Jan. 5, 2001), “Any rejection based on lack of utility should include a detailed explanation why the claimed invention has no specific and substantial credible utility. Whenever possible, the examiner should provide documentary evidence regardless of publication date (*e.g.*, scientific or technical journals, excerpts from treatises or books, or U.S. or foreign patents) to support a factual basis for the *prima facie* showing of no specific and substantial credible utility.” (D) is not the most correct answer. *See*, “Utility Examination Guidelines,” 66 F.R. 1092, 1098, left column (Jan. 5, 2001), wherein it states, “An invention has a well-established utility (1) if a person of ordinary skill in the art would immediately appreciate why the invention is useful based on the characteristics of the invention (*e.g.*, properties or applications of a produce or process), and (2) the utility is specific, substantial, and credible.” (E) is not the most correct answer. *See*, “Utility Examination Guidelines,” 66 F.R. 1092, 1098 right column (Jan. 5, 2001), which states what is recited in (E).

50. ANSWER: (D) is the most correct choice. MPEP § 2173.05(h), and *Ex Parte Cordova*, 10 USPQ2d 1949 (Bd. Pat. App. & Inter. 1989) and 35 U.S.C. § 102(b). (A) is incorrect since the article does not disclose a metallic shoelace, whereas Claim 1 requires a telecommunications device having a metallic shoelace. Since the “optional” element does not have to be disclosed in a reference for the claim to be anticipated, claims 2 and 3, which provide for inclusion of optional elements, are each anticipated by the article. Thus, (B), and (C), are incorrect. Inasmuch as (C) is correct, (E) is incorrect.

Test Number 456
Test Series 101

Name _____

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

APRIL 18, 2001

Afternoon Session (50 Points)

Time: 3 Hours

DIRECTIONS

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

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

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

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

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO

This examination addresses provisions of the Patent Statute, regulations and MPEP which were not changed as a result of the enactment of the American Inventors Protection Act of 1999, Pub. L. No. 106-113 ("Act"). This examination also does address and test changes to the Patent Statute or regulations brought about by the enactment of the Act. Some, but not all, questions use the statute and rules, comments to the rules, and guidelines in place subsequent to November 28, 1999, including the following rule changes and guidelines in effect on or before January 20, 2001:

? Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule. 65 FR 50092 (Aug. 16, 2000) (including the adoption of changes set forth in Interim Rule, 65 FR 14865 (Mar. 20, 2000) to §§ 1.7, 1.17(e) and (i), 1.53(d)(1), 1.78(a)(3), 1.97(b), 1.104(c)(4), 1.113, 1.116, 1.198, 1.312, and 1.313(a), (b), (c)(1), (c)(3), and (d)).

? Changes to Permit Payment of Patent and Trademark Fees by Credit Card; Final Rule. 65 FR 33452 (May 24, 2000).

? Revision of Patent Fees for Fiscal Year 2001; Final Rule. 65 FR 49193 (Aug. 11, 2000).

? Changes To Implement the Patent Business Goals; Final Rules. 65 FR 54604 (Sept. 8, 2000).

? Changes to Implement the Patent Business Goals; Final Rule and corrections to final rules. 65 FR 78958 (Dec. 18, 2000).

? Changes to Implement Patent Business Goals; Final Rule, Correction. 65 Fed. Reg. 80755 (Dec. 22, 2000).

? Changes To Implement Patent Term Adjustment Under Twenty-Year Patent Term; Final Rules. 65 FR 56366, (Sept. 18, 2000).

? Changes to Implement Eighteen-Month Publication of Patent Applications; Final Rule. 65 FR 57024 (Sept. 20, 2000).

? Changes To Implement Eighteen-Month Publication of Patent Applications; Correction. Final Rule; correction. 65 FR 66502 (Nov. 6, 2000).

? Treatment of Unlocatable Patent Application and Patent Files; Final Rule. 65 FR 69446 (Nov. 17, 2000).

? Simplification of Certain Requirements in Patent Interference Practice; Final Rule. 65 FR 70489 (Nov. 24, 2000).

? Reestablishment of the Patent and Trademark Office as the United States Patent and Trademark Office, 65 Fed. Reg. 17858 (April 5, 2000).

? Guidelines Concerning the Implementation of Changes to 35 U.S.C. 102(g) and 103(c) and the Interpretation of the Term "Original Application" in the American Inventors

? Protection Act of 1999, 1233 O.G. 54-56 (April 11, 2000).

? Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, para. 6, 65 Fed. Reg. 38510-38516 (June 21, 2000); 1236 O.G. 98-104 (July 25, 2000).

? Guidelines Setting Forth a Modified Policy Concerning the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 U.S.C. 103(c), 1241 O.G. 96-97 (December 26, 2000).

? Assignment of Confirmation Number and Time Period for Filing a Copy of an Application by EFS for Eighteen-Month Publication Purposes, 1241 O.G. 97-98 (December 26, 2000).

? Utility Examination Guidelines, 66 F.R. 1092-1099 (January 5, 2001).

Guidelines for Examination of Patent Applications Under the 35 U.S.C. Sec. 112, para. 1

"Written Description" Requirement 66 F.R. 1099-1111 (January 5, 2001).

1. Which of the following is in accord with proper USPTO practice and procedure?
- (A) Upon request to convert a provisional application to a nonprovisional utility application, the nonprovisional application is accorded a filing date as of the date on which the request to convert was filed, but the original filing date of the provisional application is preserved.
 - (B) If a provisional application does not have a claim as filed, and a claim is not filed with a timely request to convert the provisional application to a nonprovisional utility application, the Office will notify the applicant and set a time period for submitting a claim for examination.
 - (C) A provisional application filed in November 2000 is entitled to the right of priority under 35 U.S.C. § 119 of a copending utility application for patent filed in Great Britain in January 2000.
 - (D) A request filed in January 2001, to convert a provisional application filed in the USPTO in April 2000, to a nonprovisional utility application is timely if filed after the abandonment of the provisional application, i.e., after the pendency of the provisional application, but within twelve months of the filing date of the provisional application provided no petition to revive has been filed and granted.
 - (E) A nonprovisional utility application filed under the provisions of 37 CFR § 1.53(b) in January 2001, and claiming the benefit of the earlier filing date of a provisional application must be filed during the pendency of the provisional application.
2. Select from the following an answer which completes the following statement, such that the completed statement accords with proper USPTO practice and procedure: “When the reference in question is a noncommonly owned U.S. patent claiming the same invention as applicant, and its issue date is _____”
- (A) less than one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of requesting an interference.
 - (B) exactly one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of requesting an interference.
 - (C) more than one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of requesting an interference.
 - (D) less than one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of affidavit or declaration “swearing back” of reference.
 - (E) less than one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of affidavit or declaration traversing the ground of rejection.

3. Which of the following is an incorrect statement concerning the difference between the request for continued examination procedure under 37 CFR § 1.114 and the continued prosecution application (CPA) procedure under 37 CFR § 1.53(d)?

- (A) The filing of a CPA is the filing of a new application, whereas a request for continued examination under 37 CFR § 1.114 merely continues the examination of the same application.
- (B) The fee for a request for continued examination under 37 CFR § 1.114 does not have an additional claims fee component, but the filing fee for a CPA includes a fee based on the number of claims remaining in the application after entry of any amendment accompanying the request for CPA and entry of any amendments under 37 CFR § 1.116 unentered in the prior application which applicant has requested to be entered in the CPA.
- (C) A CPA may be filed before prosecution in the prior application is closed, but a request for continued examination under 37 CFR § 1.114 is not permitted unless prosecution in the application is closed.
- (D) None of the above are incorrect statements.
- (E) (B) and (C) are incorrect statements.

4. Which of the following may properly be required to submit information in reply to a requirement for information under 37 CFR § 1.105 in a patent application filed December 5, 2000?

- (A) A named inventor in the application.
- (B) An assignee of the entire interest in the application.
- (C) An attorney who prepares and prosecutes the application.
- (D) All of the above.
- (E) (A) or (C).

5. Which of the following is or are a factor that will be considered in disapproving a preliminary amendment in an application filed November 10, 2000?

- (A) The nature of any changes to the claims or specification that would result from entry of the preliminary amendment.
- (B) The state of preparation of a first Office action as of the date of receipt of the preliminary amendment by the Office.
- (C) The state of preparation of a first Office action as of the certificate of mailing date under 37 CFR § 1.8, of the preliminary amendment.
- (D) All of the above.
- (E) (A) and (B).

6. A patent application filed in the USPTO contains the following three original claims, including product by process Claim 3:

Claim 1. A method for making an Ethernet cable comprising the steps of A, B and C.

Claim 2. The method of claim 1, further characterized by the step of D.

Claim 3. The Ethernet cable as in any one of the preceding claims.

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

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

7. Which of the following is not in accordance with proper USPTO practice and procedure regarding design patent applications filed in March 2001?

- (A) The elements of the design application, if applicable, should appear in the following order: (1) design application transmittal form; (2) fee transmittal form; (3) application data sheet; (4) specification; (5) drawings or photographs; and (6) executed oath or declaration.
- (B) The specification should include the following sections in order: (1) preamble, stating the name of the applicant, title of the design, and a brief description of the nature and intended use of the article in which the design is embodied; (2) cross-reference to related applications (unless included in the application data sheet); (3) statement regarding federally sponsored research or development; (4) description of the figure or figures of the drawing; (5) feature description; and (6) a single claim.
- (C) The text of the specification sections, if applicable, should be preceded by a section heading in uppercase letters without underlining or bold type.
- (D) The elements of the design application, if applicable, should appear in the following order: (1) design application transmittal form; (2) fee transmittal form; (3) photographs; (4) application data sheet; (5) specification; (6) drawings; and (7) executed oath or declaration.
- (E) None of the above.

8 – 9. The following facts apply to the following two questions.

While travelling through Germany (a WTO member country) in December 1999, Thomas (a Canadian citizen) conceived of binoculars for use in bird watching. The binoculars included a pattern recognition device that recognized birds and would display pertinent information on a display. Upon Thomas' return to Canada (a NAFTA country) in January 2000, he enlisted his brothers Joseph and Roland to help him market the product under the tradename 'Birdoculars.' On February 1, 2000, without Thomas' knowledge or permission, Joseph anonymously published a promotional article written by Thomas and fully disclosing how the Birdoculars were made and used. The promotional article was published in the Saskatoon Times, a regional Canadian magazine that is also widely distributed in the United States. Thomas first reduced the Birdoculars to practice on March 17, 2000 in Canada. A United States patent application properly naming Thomas as the sole inventor was filed September 17, 2000. That application has now been rejected as being anticipated by the Saskatoon Times article.

8. Which of the following statements is most correct?

- (A) The promotional article in the Saskatoon Times constituted an offer to sell that operates as an absolute bar against Thomas' patent application.
- (B) Thomas, as the inventor, can overcome the rejection by establishing he is also the author of the promotional article.
- (C) The Saskatoon Times article is not *prima facie* prior art because it was published without Thomas' knowledge or permission.
- (D) The Saskatoon Times article is not *prima facie* prior art because it does not evidence knowledge or use in the United States.
- (E) The promotional article cannot be used as prior art because the Birdoculars had not been reduced to practice at the time the article appeared in the Saskatoon Times.

9. Which of the following statements is most correct?

- (A) Thomas can rely on his activities in Canada in establishing a date of invention prior to publication of the Saskatoon Times article.
- (B) In a priority contest against another inventor, Thomas can rely on his activities in Canada in establishing a date of invention.
- (C) In a priority contest against another inventor, Thomas can rely on his activities in Germany in establishing a date of invention.
- (D) Statements (A) and (B) are correct, but statement (C) is incorrect.
- (E) Statements (A), (B), and (C) are each correct.

10. Sally, an employee of Ted, conceived of and reduced to practice a spot remover for Ted on May 1, 1998. Sally's spot remover was made from water, chlorine, and lemon juice. On June 2, 1998, Sally filed a nonprovisional U.S. patent application for the spot remover, and assigned the entire rights in the application to Ted. Sally's assignment was not recorded in the USPTO, but was referenced in her application. On June 12, 1999, Jane, also an employee of Ted, having no knowledge of Sally's spot remover, conceived of and reduced to practice a spot remover for Ted. Jane's spot remover was made from carbonated water, chlorine, and lemon juice. On May 25, 1999, the USPTO granted Sally a patent. On November 5, 1998, Jane filed a nonprovisional U.S. patent application for the spot remover. As noted in Jane's application, Jane assigned the entire rights in her application to Ted. Jane's assignment was duly recorded in the USPTO. The examiner mailed a non-final Office action rejection under 35 U.S.C. § 103 to Jane in March 2001, citing the patent to Sally as prior art. Which of the following, if timely filed by Jane, would be effective in disqualifying Sally's patent?

- I. An affidavit by Jane stating that the application files of Sally and Jane both refer to assignments to Ted.
- II. A copy of Sally's assignment to Ted, clearly indicating that common ownership of Jane's and Sally's inventions existed at the time Jane's invention was made.
- III. An affidavit by Ted stating sufficient facts to show that there is common ownership of the Sally and Jane inventions and that common ownership existed at the time the Jane invention was made.

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

11. Which of the following is not in accord with proper USPTO practice and procedure?

- (A) If a claim limitation invokes the sixth paragraph of 35 U.S.C. § 112, it must be interpreted to cover the corresponding structure, material, or acts in the specification and "equivalents thereof."
- (B) If means-plus-function language is employed in a claim, the specification must set forth an adequate disclosure showing what that language means.
- (C) A means-plus-function claim limitation satisfies the second paragraph of 35 U.S.C. § 112 if the written description links or associates particular structure, material, or acts to the function recited in a means-plus-function claim limitation.
- (D) A step-plus-function claim limitation satisfies the second paragraph of 35 U.S.C. § 112 if it is clearly based on the disclosure in the application that one skilled in the art would have known what structure, material, or acts perform the function recited in a step-plus-function limitation.
- (E) The invocation of the sixth paragraph of 35 U.S.C. § 112 exempts an applicant from compliance with the first and second paragraphs of 35 U.S.C. § 112.

12. Which of the following is in accordance with proper USPTO practice and procedure regarding patent applications filed in March 2001?

- (A) An applicant in a nonprovisional application may only claim the benefit of the filing date of the earliest one of prior foreign applications under the conditions specified in 35 U.S.C. §§ 119(a) through (d) and (f), 172, and 365(a) and (b).
- (B) In an original application filed under 35 U.S.C. § 111(a), the claim for priority must be presented within either four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application, whichever occurs earlier.
- (C) Notwithstanding the fact that the claim for foreign priority was not filed within either four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application, if the claim for priority and the certified copy of the foreign application specified in 35 U.S.C. § 119(b) or PCT Rule 17 is filed before the patent is granted and the claim was unintentionally delayed, a petition to accept a delayed claim for priority, with the appropriate fee and statement, may be filed.
- (D) The claim for foreign priority need only identify foreign applications for which priority is claimed.
- (E) A claim for foreign priority may be based upon an inventor's certificate provided it is accompanied by a statement by the applicant that patent coverage was not available.

13. In August 2000, a recently registered patent agent, who is not an attorney, asked a registered patent attorney to help the agent establish a practice. Considering the additional facts in the following choices separately, which choice best comports with the professional responsibilities of both the agent and the attorney?

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

14. Which of the following statements concerning a restriction requirement in a reissue application filed January 10, 2001, is in accordance with proper USPTO rules and procedure?

- (A) The Office cannot properly make a restriction requirement in the reissue application between claims added in the reissue application and the original patent claims, where the added claims are directed to an invention which is separate and distinct from the invention defined by the original patent claims.
- (B) The Office cannot properly make a restriction requirement involving only subject matter of the original patent claims.
- (C) If restriction is required by the Office, the subject matter of the original patent claims will not be held to be constructively elected unless a disclaimer of all the patent claims is filed in the reissue application, which disclaimer cannot be withdrawn by applicant.
- (D) (A) and (B)
- (E) None of the above.

15. Joe and Jim, local businessmen, conceived the idea of an improved fishing pole. Thereafter, they had a prototype made, and after successfully testing the pole, they filed a patent application on their invention. Both men are widowers, Joe with a grown son, and Jim with a grown daughter. Joe and Jim invite their children to come to the next Lions Club social event, and it isn't long before the children are thinking in terms of wedding bells. Ecstatic at the thought of the upcoming marriage, Joe and Jim decide to assign their patent application to their children as a wedding present. Accordingly, they execute a document properly assigning their patent application to their children effective on the date of their marriage, and mail it to the USPTO with a cover letter requesting that the document be recorded. Shortly after the document is recorded, Joe's son meets another woman, and breaks off his engagement to Jim's daughter. In light of this scenario, which of the following statements is true?

- (A) Since the assignment was conditioned on the marriage of the children, and the condition was not fulfilled, the USPTO will regard the assignment as without effect for Office purposes.
- (B) Since the assignment was recorded, the USPTO will require the parties to certify that the marriage condition was fulfilled before the assignment will be effective for Office purposes.
- (C) Since the assignment was recorded, the USPTO will not determine whether the marriage condition was fulfilled and will regard the assignment as absolute.
- (D) Since the USPTO does not record conditional assignments, the recording of the assignment document will be regarded as inadvertent, and without effect for Office purposes.
- (E) Since the assignment was recorded, the USPTO will regard it as a determination of the validity of the document and the effect that the document has on the title to the patent application.

16. In June 1998 Michael buys a television set with a remote control for automatically changing channels on the television set. In June 2000, Michael moves to a new neighborhood and discovers while watching television that the remote control for his television not only changes the channels on his television set but also operates to open his neighbor's garage door. Michael, believing that people no longer need to have separate devices for operating their television and opening their garage doors, goes to a registered practitioner to seek patent protection on his new idea. The practitioner files a patent application in 2000. During the prosecution of the patent for the circuit board device, the practitioner files the following claims 11 and 12:

11. An electronic device comprising: circuitry; said circuitry operating to emit signals of a predetermined waveform; said signals being used to automatically change channels on a television set and automatically open the door of a garage.

12. A method for opening a garage door comprising using a television remote control device to emit signals, comprising the steps of:

- a) adapting a television remote control device to emit signals to open a garage door;
- b) pointing said television remote control device at said garage door; and
- c) actuating said television remote control to cause said garage door to open.

Which of the following is true?

- (A) Since the television and remote control were sold in June 1998, claims 11 and 12 are barred by 35 U.S.C. § 102(b) since the device was on sale more than one year prior to the invention by Michael.
- (B) Since the television remote control device was in public use more than one year prior to the filing date of the application, Michael may obtain the patent coverage for the method claim 12 but not the device of claim 11.
- (C) Although the device was bought in June 1998, Michael did not use it to open a garage door until 2000. Since claim 11 requires that the signals of the remote control operate to open the garage door, the limitations of claim 11 are not met by the device bought in 1998, and 35 U.S.C. § 102(b) does not apply.
- (D) Since Michael did not make the remote control himself and only inadvertently discovered that his neighbor's garage door opens when changing the channel on his television set, this is merely an inadvertent discovery and not entitled to patent protection.
- (E) Whether or not claim 11 is patentable is solely a question of obviousness. Michael need only produce evidence of commercial success to overcome an obviousness rejection.

17. To satisfy the written description requirement of the first paragraph of 35 U.S.C. § 112, an applicant must show possession of the invention. An applicant's lack of possession of the invention may be evidenced by:

- (A) Describing an actual reduction to practice of the claimed invention.
- (B) Describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.
- (C) Requiring an essential feature in the original claims, where the feature is not described in the specification or the claims, and is not conventional in the art or known to one of ordinary skill in the art.
- (D) Amending a claim to add a limitation that is supported in the specification through implicit or inherent disclosure.
- (E) Amending a claim to correct an obvious error by the appropriate correction.

18. Which of the following is not required in order for a foreign application that has matured into a foreign patent to qualify as a reference under 35 U.S.C. § 102(d)?

- (A) The foreign application must have actually been published before the filing of an application in the United States, but the patent rights granted need not be enforceable.
- (B) The foreign application must be filed more than 12 months before the effective filing date of the United States application.
- (C) The foreign and United States applications must be filed by the same applicant, his or her legal representatives or assigns.
- (D) The foreign application must have actually issued as a patent or inventor's certificate before the filing of an application in the United States. It need not be published but the patent rights granted must be enforceable.
- (E) The same invention must be involved.

19. An application is transmitted to the USPTO on January 12, 2001, without an oath or declaration by any of the inventors. Which of the following, prior to the filing of an oath or declaration, may properly change the address to which the Office will direct all notices, official letters, and other communications relating to the application?

- (A) A registered practitioner that filed the application.
- (B) Any registered practitioner named in the transmittal papers accompanying the original application, if the application was filed by a registered practitioner.
- (C) One inventor who solely filed the application, where two inventors are named in the transmittal papers accompanying the original application.
- (D) (A), (B), and (C).
- (E) (A) and (B).

20. In July 2000, Pete Practitioner files a reissue application for Sam's patent on a combination washing machine and dryer, which issued on August 4, 1998. The original 20 claims are filed in the reissue application along with two additional dependent claims. The declaration indicates that there was error without deceptive intent in that applicant failed to claim the subject matter of the two newly added dependent claims. Sam also indicates in the declaration that he has no intention doing anything other than adding the two dependent claims. In September 1999 the examiner allows claims 1-10 of the reissue but rejects claims 11-22. Sam is eager to enforce claims 1-10 against a competitor but does not want to give up prosecuting claims 11-22. Sam also wants to add additional claims 23-30 directed to an entirely different invention, which was disclosed in the patent but not claimed. To claim the new invention, Sam must file new independent claims, which claim subject matter not previously claimed. Pete practitioner has retired and Sam comes to you for advice. Which of the following is true?

- (A) Although Sam's reissue application was filed within two years, Sam did not indicate his intention to broaden the claims until after the two year period had expired. Sam may not now file broader reissue claims.
- (B) Sam may file a second continuing reissue application with claims 11-20 as well as new claims 23-30. Sam would then cancel claims 11-20 from the first reissue application. The second reissue application would then issue and Sam could file a Notice of Appeal to the Board of Patent Appeals and Interferences in the first reissue application. Since the first application was filed within the two year time limit, Sam would not be subjected to a rejection for broadening his claims.
- (C) Since Sam's reissue application was filed within the two-year statutory time limit on broadening, Sam may add the additional claims 23 -30 to the reissue application.
- (D) Since Sam had only one patent and all reissue applications for the same patent must issue simultaneously, it would not be advantageous to file two reissue applications since they must issue at the same time.
- (E) Since the new invention was disclosed but not claimed in the original application, Sam may file claims directed to this new invention at any time during the life of the patent since claiming entirely different subject matter in entirely new claims does not constitute broadening as long as the original claims are not broadened.

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

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

22. A rejection based on 35 U.S.C. § 102(a) cannot be overcome by:

- (A) Filing an affidavit under 37 C.F.R. § 1.131 “swearing back” of a U.S. patent which substantially shows or describes, and claims the same patentable invention as the rejected invention.
- (B) Filing an affidavit under 37 C.F.R. § 1.132 showing that the reference invention is not by “another.”
- (C) Perfecting a claim to priority under 35 U.S.C. § 119(a)-(d).
- (D) Amending the claims to patentably distinguish over the prior art.
- (E) Persuasively arguing that the claims are patentably distinguishable from the prior art.

23. Mr. and Mrs. Noteworthy (Henry and Alice) are registered patent practitioners maintaining an office. After completing their busiest year since opening their practice, the Notworthys decide to take a break from their hectic business routine and embark on a two week vacation in Acapulco, Mexico. On the third day of their vacation, Henry fell ill, and was laid up in bed for two days. Feeling somewhat better on the second day of his illness, and bored while Alice was on the beach, Henry phoned his office and learned from his secretary that an Office action in a case that he had overlooked contained a shortened statutory period (SSP) which expires on the very same day. He immediately had the Office action faxed to him, and upon receipt, he worked feverishly to prepare a reply. Upon completion of the reply, Henry prepared a certificate of mailing in accordance with the suggested format set forth in MPEP § 512 and deposited the reply accompanied by the certificate of mailing, properly addressed to the USPTO, in the local post office on the very same day before the post office closed. On the 5th day of their vacation, Alice became ill and required bed rest. While Henry was on the beach, Alice called her office and learned that one of her cases had a SSP expiring on the same day. Alice immediately had the Office action faxed to her. Upon receipt of the fax, Alice prepared a proper response and forwarded same to the USPTO by facsimile accompanied by a certificate of transmission in accordance with the suggested format set forth in MPEP § 512 and in compliance with 37 C.F.R. § 1.6(d). Assume the certificate of mailing and the certificate of transmission recite deposit and transmission dates that are the same as their respective SSP expiration dates. Also assume that both communications are received in the USPTO after their respective SSP expiration dates and are stamped with the actual date of receipt. Which of the following statements is true?

- (A) The application wherein Henry filed a reply is abandoned because the USPTO stamped date is controlling.
- (B) The application wherein Henry filed a reply is not abandoned because the certificate of mailing date is controlling.
- (C) The application wherein Alice filed a reply is abandoned because the USPTO stamped date is controlling.
- (D) Both the application wherein Henry filed a reply and the application wherein Alice filed a reply are abandoned.
- (E) Neither the application wherein Henry filed a reply nor the application wherein Alice filed a reply is abandoned.

24. Which of the following is entitled to the benefit of a certificate of mailing under 37 CFR § 1.8?

- (A) Filing a request for continued examination under 37 CFR § 1.114.
- (B) Filing a request for a continued prosecution application under 37 CFR § 1.53(d).
- (C) Filing a reply under 37 CFR § 1.111 in a non-provisional patent application.
- (D) (A) and (C).
- (E) All of the above.

25. Which of the following is in accordance with proper USPTO practice and procedure?

- (A) The filing of a request for continued examination and payment of the fee for the request in a nonprovisional utility application that was filed in January 2000, is sufficient to toll the running of any time period set in a final rejection for reply to avoid abandonment of the application.
- (B) Where a request for continued examination, a submission, and requisite fee are filed in April 2001 for a nonprovisional utility application that was filed in January 2000, the submission will be considered though it was filed after the application became abandoned in February 2001.
- (C) An applicant in a utility application originally filed on or after June 8, 1995, and before May 29, 2000, may obtain further examination either by timely filing a request for continued examination, a proper submission, and requisite fee, or by timely filing a continued prosecution application.
- (D) An applicant in a utility application originally filed on or after June 8, 1995, and before May 29, 2000, may obtain further examination by timely filing in April 2001 a request for continued examination, a proper submission, and requisite fee, and the application is entitled to patent term adjustment provisions of the Patent Statute.
- (E) An applicant in a utility application originally filed on or after June 8, 1995, and before May 29, 2000, may obtain further examination by timely filing in April 2001 a continued prosecution application under 37 C.F.R. § 1.53(d), but the CPA application is not entitled to patent term adjustment provisions of the Patent Statute.

26. In accordance with proper USPTO practice and procedure, a submission for a request for continued examination does not include:

- (A) An appeal brief or reply brief (or related papers).
- (B) New arguments in support of patentability.
- (C) New evidence in support of patentability.
- (D) An amendment of the drawings.
- (E) An amendment of the claims.

27. Which of the following properly creates a statutory bar to patentability of applicant's claimed invention?

- I. Applicant's invention was sold in Tokyo and New York more than one year prior to the effective U.S. filing date, but the sales were merely attempts at market penetration.
 - II. Applicant's invention was experimented with and tested to further develop the invention more than one year prior to the effective U.S. filing date, but important modifications resulted from the experimentation causing the invention to be reduced to practice after the effective U.S. filing date.
 - III. Applicant's invention was sold in Tokyo more than one year prior to the effective U.S. filing date, but the sale was merely market testing of the invention to determine product acceptance.
- (A) I.
 - (B) II.
 - (C) III.
 - (D) I and III.
 - (E) None of the above.

28. In December 1988, Molly invents a new potato cutter that cuts the potatoes into shapes having a star cross section. Because of the proximity of the star outer surface to the inter core of the potato, the shape achieves optimal cooking of the potato when fried without resulting in an overly cooked outer surface. Molly, thinking that the invention is important, has two people, Sue and Tom, both sworn to secrecy, witness a drawing of the invention. Molly then locks the drawing in a safe deposit box where it remains for the next twelve years. Neither Molly, Sue, or Tom discloses the invention to anyone for the next twelve years. In December 2000, Troy invents a new potato cutter which produces potatoes having a star cross section, and the potatoes are then fried. The invention becomes an overnight success. Troy files a patent application on February 1, 2001. Molly, after seeing the success of Troy's invention in the marketplace, decides to file an application, also on February 1, 2001. The examiner is unable to find any prior art and no other prior art is cited by either applicant. Which of the following is true?

- (A) Since Molly effectively concealed her invention, Troy is entitled to a patent since although Molly conceived of the idea prior to Troy, she effectively abandoned the invention by not filing for twelve years.
- (B) Since Troy conceived of the idea after Molly and because Troy did not file a patent application before Molly, he is not entitled to priority over Molly.
- (C) Since Molly disclosed the invention to Sue and Tom, the invention was known by others prior to the invention by Troy. Therefore, Troy is precluded by 35 U.S.C. § 102(a) from obtaining a patent on his idea.
- (D) Since Molly invented the cutter before Troy, she is entitled to a patent and not Troy.
- (E) None of the above.

29. Which of the following is true?

- (A) The statement, “Whether claims 1 and 2 are unpatentable,” complies with the requirement of 37 C.F.R. § 1.192(c)(6) for a concise statement in the appeal brief of the issues presented for review.
- (B) Following a new ground of rejection raised by the Board of Patent Appeals and Interferences, the applicant may request a rehearing, or submit an appropriate amendment of the rejected claims or a showing of facts relating to the rejected claims.
- (C) A reissue application may be filed in order to broaden claims back to their original form where the claims were mistakenly narrowed during the original prosecution to avoid the prior art provided that the narrowing of the claims was made without deceptive intent on the part of the applicant.
- (D) If the Board of Patent Appeals and Interferences decides to require an appellant to address a particular matter, and the appellant cannot respond within the time period set, he may obtain an extension of time by paying the requisite fee.
- (E) In an ex parte reexamination proceeding of a patent that arises from an application filed in the United States before November 29, 1999, a third party requester who is dissatisfied with a decision of the Board of Patent Appeals and Interferences may seek judicial review by appeal to either the U.S. Court of Appeals for the Federal Circuit or by civil action in the U.S. District Court for the District of Columbia.

30. Assume that conception of applicant’s complex invention occurred prior to the date of the reference, but reduction to practice occurred after the date of the reference. Which of the following is sufficient to overcome the reference in accordance with proper USPTO practice and procedure?

- (A) In a 37 C.F.R. 1.131 affidavit or declaration, it is sufficient to allege that applicant or patent owner has been diligent.
- (B) In a 37 C.F.R. 1.131 affidavit or declaration, it is sufficient to clearly establish conception of the invention prior to the effective date of the reference, and diligence from just prior to the effective date of the reference to actual reduction to practice. The presence of a lapse of time between the reduction to practice of an invention and the filing of an application thereon is not relevant.
- (C) In a 37 C.F.R. 1.131 affidavit or declaration, it is sufficient to clearly establish conception of the invention prior to the effective date of the reference. Diligence need not be considered.
- (D) In a 37 C.F.R. 1.131 affidavit or declaration, it is sufficient to show conception and reduction to practice in any country.
- (E) In a 37 C.F.R. 1.131 affidavit or declaration, it is always sufficient to prove actual reduction to practice for all mechanical inventions by showing plans for the construction of the claimed apparatus.

31. Assuming that each of the following claims is in a separate application, and there is no preceding multiple dependent claim in any of the applications, which claim is in acceptable multiple dependent claim form?

- (A) Claim 8. A machine according to any one of the preceding claims wherein...
- (B) Claim 5. A device as in one of claims 1-4, wherein...
- (C) Claim 10. A device as in any of claims 1-4 or 6-9, in which...
- (D) Claim 4. A machine according to claim 2 or 3, also comprising...
- (E) The claim form in (A), (B), (C) and (D) is acceptable.

32. Your client, Bill, disclosed to you the following. While hiking, he found a natural specimen of tree sap that had bonded rock material to a log, and was impervious to water. Bill realized that the sap would be an excellent roofing material for bonding asphalt shingles to wooden sheathing. Bill performed a chemical analysis of the sap and determined it was 10% A, 30% B, and 60% C. Bill experimented and found that he could synthetically produce the sap by mixing one part A by weight and three parts B by weight at 20 degrees Celsius, heating the mixture of A and B to 100 degrees Celsius, adding six parts C by weight, and cooling the mixture of A, B, and C to 20 degrees Celsius. Bill further experimented and found that if he added an effective amount of D to the mixture of A, B, and C, prior to cooling, the viscosity of the product would decrease, making it easier for roofers to apply it to wooden sheathing. You draft a patent application with a specification having all the information disclosed to you by Bill, including guidelines that explained that an effective amount of D for decreasing the viscosity is between 1% to 2% of the total weight of the mixture of A, B, and C, after cooling. The guidelines also explained that an effective amount of D for brightening the color of the composition is between 3% to 4% of the total weight of the mixture of A, B, and C, after cooling. Which if any of the following claims, included in Bill's application, would not be properly rejected pursuant to 35 U.S.C. § 101?

Claim 1. A composition for bonding asphalt shingles to wood sheathing and a method, comprising: a mixture of 10%A, 30%B, and 60%C, and adding an effective amount of D to decrease the viscosity of the mixture.

Claim 2. A composition produced by the steps of: mixing one part A by weight with three parts B by weight at 20 degrees Celsius to form a mixture of A and B; heating the mixture of A and B to 100 degrees Celsius; adding six parts C by weight to form a mixture of A, B, and C; cooling the mixture of A, B, and C to 20 degrees Celsius; and adding an effective amount of D to decrease the viscosity of the composition.

Claim 3. A composition for bonding asphalt shingles to wood sheathing, comprising 10% A, 30% B, and 60% C.

- (A) Claim 1.
- (B) Claim 2.
- (C) Claim 3.
- (D) Claims 2 and 3.
- (E) None of the above.

33. Which of the following statements concerning reliance by an examiner on common knowledge in the art, in a rejection under 35 U.S.C. § 103 is correct?

- I. An examiner's statement of common knowledge in the art is taken as admitted prior art, if applicant does not seasonably traverse the well known statement during examination.
- II. Applicant can traverse an examiner's statement of common knowledge in the art, at any time during the prosecution of an application to properly rebut the statement.
- III. If applicant rebuts an examiner's statement of common knowledge in the art in the next reply after the Office action in which the statement was made, the examiner can never provide a reference to support the statement of common knowledge in the next Office action and make the next Office action final.

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

34. Registered practitioner Mike files a utility patent application in the USPTO having one claim on May 6, 1998. Following a proper final rejection dated June 28, 2000, of claim 1, Mike files a notice of appeal with the appropriate fee on September 12, 2000, and an appeal brief with the appropriate fee on October 12, 2000. On February 14, 2001, Mike learns about a publication (the "Valentine reference") which he knows to be material to patentability of claim 1. The Valentine reference was not considered by the examiner during prosecution of the application. According to proper USPTO rules and procedure, which of the following actions if taken by Mike on February 16, 2001, prior to a decision on the appeal, will be treated by the USPTO as a request to withdraw the appeal?

- (A) Filing a request for continued examination of the application with an information disclosure statement that complies with the provisions of 37 CFR § 1.98, listing the Valentine reference, submitting the fee set forth in 37 CFR § 1.17(e), and notifying the Board of Patent Appeals and Interferences of the same.
- (B) Filing a request for continued examination of the application, and submitting the fee set forth in 37 CFR § 1.17(e), without filing any other submission, and notifying the Board of Patent Appeals and Interferences of the same.
- (C) Filing a request for continued examination of the application, and filing an information disclosure statement that complies with the provisions of 37 CFR § 1.98, listing the Valentine reference, without submitting the fee set forth in 37 CFR § 1.17(e), and notifying the Board of Patent Appeals and Interferences of the same.
- (D) Filing a request for continued examination of the application, without submitting the fee set forth in 37 CFR § 1.17(e), and without filing any other submission, and notifying the Board of Patent Appeals and Interferences of the same.
- (E) All of the above.

35. A patent application filed in the USPTO contains the following dependent claim:

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

Following proper USPTO practices and procedures, from which of the following claims does Claim 2 not properly depend?

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

36. A member of the public submits a protest under 37 CFR § 1.291 relating to a public sale of the subject matter of a patent application (effective filing date June 1, 1999). The protest includes submission of a business circular authored by the assignee of the invention. In a first Office action dated January 10, 2001, the examiner includes a requirement for information requesting the date of publication of the business circular. The reply to the requirement for information states that the publication date is “approximately June 1, 2000.” Which of the following would be proper for the examiner to include in the next Office action?

- (A) A requirement that the date in the reply be made more specific.
- (B) A holding that the previous reply is incomplete.
- (C) A requirement seeking confirmation that “approximately June 1, 2000” is the most specific date that was obtained or can be obtained based on a reasonable inquiry if that is not already clear from the reply.
- (D) (A) and (C).
- (E) None of the above.

37. Which of the following is not in accordance with proper USPTO practice and procedure regarding patent applications filed in March 2001?

- (A) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed before the examiner allows the claims.
- (B) If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by the processing fee set forth in 37 CFR § 1.17(i), but the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and 37 CFR § 1.323.
- (C) In an application that entered the national stage from an international application after compliance with 35 U.S.C. § 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT.
- (D) If a U.S. patent application publication or patent incorporates by reference, or includes a specific reference under 35 U.S.C. §§ 119(e) or 120 to, a pending or abandoned application, a copy of that application-as-filed may be provided to any person upon written request including the fee set forth in 37 CFR § 1.19(b)(1).
- (E) If an international application, which designates the U.S. and which has been published in accordance with PCT Article 21(2), incorporates by reference or claims priority under PCT Article 8 to a pending or abandoned U.S. application, a copy of that application-as-filed may be provided to any person upon written request including a showing that the publication of the application in accordance with PCT Article 21(2) has occurred and that the U.S. was designated, and upon payment of the appropriate.

38. Which of the following statements concerning preliminary amendments is/are in accordance with proper USPTO rules and procedure?

- (A) A preliminary amendment filed in a continuation-in-part application cannot be disapproved if it is filed within three months from the December 7, 2000, filing date.
- (B) A preliminary amendment filed in a continued prosecution application cannot be disapproved if it is filed four months from the December 7, 2000, filing date with a petition for a one month extension of time.
- (C) A preliminary amendment filed in a continued prosecution application cannot be disapproved if it is filed four months from the December 7, 2000, filing date with a petition for a one month extension of time and the appropriate fee for the extension.
- (D) A preliminary amendment filed in a continuation prosecution application after the filing date of the application cannot be disapproved.
- (E) None of the above.

39. Which of the following requests by the registered practitioner of record for an interview with an examiner concerning an application will be granted in accordance with proper USPTO rules and procedure?

- (A) A request for an interview in a substitute application prior to the first Office action, for the examiner and attorney of record to meet in the practitioner's office without the authority of the Commissioner.
- (B) A request for an interview in a continued prosecution application prior to the first Office action, to be held in the examiner's office.
- (C) A request for an interview in a non-continuing and non-substitute application, prior to the first Office action to be held in the examiner's office.
- (D) None of the above.
- (E) All of the above.

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

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

41. A nonprovisional patent application was filed on December 1, 2000, including a patent application declaration and an application data sheet. The application data sheet that includes the applicant's full name, residence, mailing address, and citizenship. The application data sheet does not include any foreign priority information. Which of the following must be identified in the declaration?

- (A) Applicant's mailing address.
- (B) Applicant's citizenship.
- (C) Any foreign application for patent for which a claim for priority is made by Applicant pursuant to 37 CFR § 1.55.
- (D) (B) and (C).
- (E) All of the above.

42. You prepare and file a patent application directed to an invention for improving the safety of research in the field of recombinant DNA. Your client, Inventor Joe, informs you he has licensed exclusive rights to his invention to a major pharmaceutical company. Inventor Joe also informs you that he is aware that another pharmaceutical company, Titan Pharmaceuticals, learned of the invention from a paper he presented at a technical conference, and is preparing to use the technology in its commercial research labs in the United States. Inventor Joe demonstrates that Titan is about to begin practicing the invention by showing you a rigid comparison of Titan's intended activities and the claims of the application. He also informs you that although he is currently in very good health, he is 67 years old and fears he will not be in good health when the invention reaches its peak commercial value. Accordingly, if possible he would like for you to expedite prosecution in the simplest, most inexpensive way. Given the foregoing circumstances, which of the following statements is most correct?

- (A) You should recommend filing a petition to make special on the basis of Inventor Joe's age.
- (B) Since the invention relates to improving the safety of research in the field of recombinant DNA, you should recommend filing a petition to make special on that basis.
- (C) Since Titan is actually practicing the invention set forth in the pending claims, you should recommend filing a petition to make special on that basis.
- (D) Statements (A), (B) and (C) are equally correct.
- (E) Statements (A), (B) and (C) are each incorrect.

43. Claims 1 and 2 in a patent application state the following:

Claim 1. An apparatus for sitting comprising:

- (i) a square shaped base member;
- (ii) four elongated members mounted to the bottom of the base member; and
- (iii) a circular back member mounted to the base member.

Claim 2. An apparatus as in claim 1, further comprising a spring connected to the back member and to the base member.

Which, if any, of the following claims fully supported by the specification and presented in the application, is in accordance with USPTO rules and procedure?

- (A) 3. An apparatus as in claim 1, wherein the base member is rectangularly shaped.
- (B) 3. An apparatus as in claim 2, wherein the wheels connected to each of the elongated members are plastic.
- (C) 3. An apparatus as in any of the preceding claims, in which the circular back member is wooden.
- (D) 3. An apparatus as in the preceding claims, further comprising a pressure-sensing device connected to the base member.
- (E) None of the above.

44. Which of the following is true?

- (A) A claim to a process omitting a step in a process, where the step is disclosed in the specification to be essential to the invention, may not be properly rejected under 35 U.S.C. 112, first paragraph, for lack of enablement where the specification provides an enabling disclosure only for the process which includes the essential step.
- (B) Failure to disclose the best mode must rise to the level of active concealment or grossly inequitable conduct in order to support a rejection under 35 U.S.C. 112, first paragraph.
- (C) The best mode requirement is the same as the enablement requirement of the first paragraph of 35 U.S.C. 112.
- (D) If the best mode contemplated by the inventor at the time of filing the application is not disclosed, a proposed amendment adding a specific mode of practicing the invention would not be new matter.
- (E) A claim failing to interrelate essential elements of the invention as defined by the applicant in the specification, where the interrelation is critical to the invention may be properly rejected under 35 U.S.C. 112, second paragraph, for failure to properly point out and distinctly claim the invention.

45. The USPTO mails a final Office action dated November 8, 2000, in a utility patent application filed May 5, 1999, to registered practitioner Ted. The final Office action includes claim rejections and objections. Which of the following, with a request for continued examination along with the required fee filed by Ted on January 8, 2001, is a proper submission in accordance with the provisions of 37 CFR § 1.114?

- (A) A telephone call from Ted to the examiner on January 8, 2001, wherein Ted distinctly and specifically points out the supposed errors in the examiner's action, and wherein Ted presents arguments addressing each ground of objection and rejection in the Office action dated November 8, 2000.
- (B) A written reply to the Office action dated November 8, 2000, with no amendments or new claims, which distinctly and specifically points out the supposed errors in the examiner's action, addresses each ground of objection and rejection in the Office action, and presents arguments pointing out the specific distinctions believed to render the claims patentable over the references applied by the examiner.
- (C) A written reply to the Office action dated November 8, 2000, which does not present arguments pointing out the specific distinctions believed to render the claims patentable over the references applied by the examiner, and which requests that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated.
- (D) All of the above.
- (E) None of the above.

46. Which of the following is in accordance with proper USPTO practice and procedure?
- (A) The fee an applicant must pay to request continued examination of an application is set in an amount equal to the basic filing fee the same applicant must pay for a utility patent application.
 - (B) A Certificate of Mailing or Transmission under 37 C.F.R. § 1.8 is proper for filing a Continued Prosecution Application under 37 C.F.R. § 1.53(d) to obtain the date of the Certificate as the filing date for the application.
 - (C) The Office does not charge a fee for processing a fee paid by a check that has been refused, i.e., dishonored and returned, by a financial institution.
 - (D) To first request conversion of a provisional application containing a claim to a nonprovisional application after the provisional application has become abandoned, a petition to revive, accompanied by the appropriate fees, a showing of unavoidable delay, and a request for the conversion must be filed within one year of the date of abandonment.
 - (E) The conversion of a provisional application, for which a basic filing fee was properly paid, to a nonprovisional application will result in the savings of filing and other fees over the filing of a nonprovisional application claiming the benefit under 35 U.S.C. § 119(e) and 37 C.F.R. § 1.78 of the earlier provisional filing date.
47. Applicant receives a rejection and objection in a non-final Office action dated December 12, 2000. Applicant timely files a reply dated February 12, 2001, that distinctly and specifically points out the supposed errors in the examiner's action. The reply addresses every ground of objection and rejection in the Office action dated December 12, 2000, by presenting arguments pointing out specific distinctions believed to render the claims, including any newly presented claims, patentable over the applied references. Applicant mails a second reply. Thereafter, Applicant mails a third reply to the USPTO, which would result in a change to the specification only, if entered. In accordance with proper USPTO rules and procedure, which of the following are factors that will be considered in deciding whether to disapprove Applicant's third reply?
- (A) Whether Applicant's reply dated February 12, 2001, includes a request that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated.
 - (B) The state of preparation of an Office action responsive to the Applicant's reply dated February 12, 2001, as of the date of receipt of Applicant's third reply.
 - (C) The nature of any changes to the specification that would result from entry of Applicant's second reply.
 - (D) (A), (B), and (C).
 - (E) (B) and (C).

48. Which of the following is in accord with proper USPTO practice and procedure for filing a reissue application in April 2001?

- (A) The specification, including the claims, of the patent for which reissue is requested must be furnished in the form of a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper.
- (B) The specification, including the claims, of the patent for which reissue is requested must be furnished in the form of cut-up soft copies of the printed patent, with only a single column of the printed patent securely mounted on a separate sheet of paper.
- (C) The specification, including the claims, of the patent for which reissue is requested must be furnished in the form of a copy of the printed patent, in single column format, each page on only one side of a single sheet of paper.
- (D) The specification, including the claims, of the patent for which reissue is requested must be furnished in the form of a copy of the printed patent, in double column format, each page on both sides of a single sheet of paper.
- (E) The specification, including the claims, of the patent for which reissue is requested must be furnished in the form of cut-up soft copies of the printed patent, with only a single column of the printed patent securely mounted on both sides of a single sheet of paper.

49. Which of the following is not in accordance with proper USPTO practice and procedure regarding patent applications filed in March 2001?

- (A) Status information is available for Application B, that is a continuation of an application A, when application A has been published under 35 U.S.C. § 122(b).
- (B) A person requesting status information may be provided the filing date if the eight-digit numerical identifier is not available and the last six digits of the numerical identifier is available.
- (C) If a U.S. patent application publication or patent incorporates by reference, or includes a specific reference under 35 U.S.C. §§ 119(e) or 120 to, a pending or abandoned application, a copy of that application-as-filed may be provided to any person upon written request including the fee set forth in 37 CFR § 1.19(b)(1).
- (D) A coinventor in a pending application may gain access to the application if his name appears as an inventor in the application, even if he did not sign the oath or declaration.
- (E) Notwithstanding the fact that only a redacted copy of an application has been published, a member of the public is entitled to see the entire application upon written request.

50. If an application is deposited with the U.S. Postal Service in the manner recited in each of the following answers, and there is a dispute as the filing date of the application, which will result in the earliest filing date?

- (A) As “Express Mail Post Office to Post Office” without the Express Mail mailing label number being placed on the application and with the “date-in” entered by the USPS on Friday, March 9, 2001, and the application being received in the USPTO on Monday, March 12, 2001.
- (B) As “Express Mail Post Office to Addressee” without the Express Mail mailing label number being placed on the application and with the “date-in” entered by the USPS on Saturday, March 10, 2001, and the application being received in the USPTO on Tuesday, March 13, 2001.
- (C) As “Express Mail Post Office to Addressee” without the Express Mail mailing label number being placed on the application and with the “date-in” entered by the applicant on Thursday, March 8, 2001, and the application being received in the USPTO on Wednesday, March 14, 2001.
- (D) As “Express Mail Post Office to Addressee” with the Express Mail mailing label number being placed on the application and with the “date-in” entered by the applicant on Thursday, March 22, 2001, and the application being received in the USPTO on Monday, March 26, 2001.
- (E) As “Express Mail Post Office to Post Office” with the Express Mail mailing label number being placed on the application and with the “date-in” entered by the USPS on Saturday, March 24, 2001, and the application being received in the USPTO on Monday, March 26, 2001.

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United States Patent and Trademark Office
Registration Examination for Patent Attorneys and Agents
April 18, 2001

Afternoon Session Model Answers

1. ANSWER: (B) is the most correct answer. 37 C.F.R. § 1.53(c)(3) requires the presence of a claim to convert a provisional application to a nonprovisional application. The Office will set a time period within which a claim must be submitted for the Office to grant the request if the provisional application does not have a claim and a claim is not filed with the request. *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50099, middle column, (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (A) is not the most correct answer. 37 C.F.R. § 1.53(c)(3). There is only one application, and that application has a single filing date, the filing date of the provisional application. *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50099, left column (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (C) is not the most correct answer. 35 U.S.C. § 111(b)(7); 37 C.F.R. § 1.53(c)(4). (D) is not the most correct answer. 37 C.F.R. § 1.53(c)(3) requires that any request to convert a provisional application to a nonprovisional application be filed prior to abandonment of the provisional application. *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50098, left and middle columns (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (E) is not the most correct answer. The provisions of 35 U.S.C. § 119(e)(2) were amended to eliminate the requirement that a nonprovisional application claiming the benefit of a provisional application must have been filed during the pendency of the provisional. *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50098, left and middle columns (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000).

2. ANSWER: (A) is the most correct answer, while (D) is not the most correct answer. *See* MPEP § 715.05, which, in pertinent part, states:

When the reference in question is a noncommonly owned U.S. patent claiming the same invention as applicant and its issue date is less than 1 year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, must be by way of 37 CFR 1.608 instead of 37 CFR 1.131... . The reference patent can then be overcome only by way of interference.

(B) and (C) are not the most correct answers. *See* MPEP § 715.05, which, in pertinent part, states:

If the patent is claiming the same invention as the application and its issue date is 1 year or more prior to the presentation of claims to that invention in the application, a rejection of the claims of the application under 35 U.S.C. 135(b) should be made. *See In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632, 1635 (Fed.Cir. 1997) (The court holding that application of 35 U.S.C. 135(b) is not limited to inter partes interference proceedings, but may be used as a basis for ex parte rejections.).

(E) is a wrong answer because an affidavit or declaration traversing a ground of rejection may be received only where the reference “substantially shows or describes but does not claim the same patentable invention.” 37 CFR § 1.132.

3. ANSWER: All answers accepted.

4. ANSWER: (D) is the most correct answer. 37 CFR § 1.105 (effective November 7, 2000), “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54633 (September 8, 2000), and 37 CFR § 1.56(c). A named inventor, and an attorney who prepares and prosecutes the application, are identified in 37 CFR § 1.56(c), and an assignee is specified in 37 CFR § 1.105(a)(1). Therefore (D) is correct. (E) is incorrect because (D) is correct.

5. ANSWER: (E) is the correct answer. 37 CFR § 1.115(b)(1) (effective November 7, 2000); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54636 (September 8, 2000). As stated in 65 FR at 54636, middle and right columns, “Factors that will be considered in disapproving a preliminary amendment include: the state of preparation of a first Office action as of the date of receipt (§ 1.6, which does not include § 1.8 certificate of mailing dates) of the preliminary amendment by the Office...” Thus, choices (C) and (D) are incorrect.

6. ANSWER: (E) is the most correct answer. The cancellation of Claim 3 overcomes the examiner’s objection. The addition of Claims 4 and 5 provide the client with patent protection in product by process format for the cable by both methods of manufacture. Thus, if Claim 4 is invalid, Claim 5 may remain valid. Answer (A) is incorrect because it is an improper multiple dependent claim. 35 U.S.C. § 112 ¶ 5; 37 C.F.R. § 1.75(c); MPEP § 608.01(n), part (I)(B)(1). Answer (B) alone is incorrect because, even though canceling the claim will overcome the rejection, it will also leave the application without a claim to the Ethernet cable made using the processes set forth in either Claim 1 or Claim 2. Answer (C) alone is not the most correct answer because even though canceling Claim 3 will overcome the rejection and provides protection for the Ethernet cable made by the process comprising the steps A, B and C, it will also leave the application without a claim to the Ethernet cable made using the processes comprising the steps of A, B, C, and D. Answer (D) alone is not the most correct answer because even though canceling Claim 3 will overcome the rejection and provides protection for the Ethernet cable made by the process comprising the steps A, B, C, and D, it will also leave the application without a claim to the Ethernet cable made using the processes comprising the steps of A, B, and C.

7. ANSWER: (D), not being in accord with proper USPTO practice and procedure, is the most correct answer. Photographs and ink drawings may not appear in the same application. See § 1.152 Design drawings. Moreover, the order is not that appearing in 37 CFR § 1.154. As to (A), (A) contains the elements set forth in 37 CFR § 1.154 (a), which provides “(a) The elements of the design application, if applicable, should appear in the following order: (1) Design application transmittal form. (2) Fee transmittal form. (3) Application data sheet (see § 1.76). (4) Specification. (5) Drawings or photographs. (6) Executed oath or declaration (see § 1.153(b)).” As to (B), (B) contains the elements set forth in 37 CFR § 1.154 (b), which provides: “(b) The specification should include the following sections in order: (1) Preamble, stating the name of

the applicant, title of the design, and a brief description of the nature and intended use of the article in which the design is embodied. (2) Cross-reference to related applications (unless included in the application data sheet). (3) Statement regarding federally sponsored research or development. (4) Description of the figure or figures of the drawing. (5) Feature description. (6) A single claim.” As to (C), (C) contains the elements set forth in 37 CFR § 1.154 (c), which provides “(c) The text of the specification sections defined in paragraph (b) of this section, if applicable, should be preceded by a section heading in uppercase letters without underlining or bold type.” Since (D) is incorrect, (E) is not the right answer.

8. ANSWER: (B) is the most correct answer. *See, e.g., Ex parte Lemieux*, 115 USPQ 148 (Bd. Pat. App. & Int. 1957); MPEP 715.01(c). (A) is incorrect because even if the promotional article constituted an offer to sell in the United States, it was made less than a year prior to Thomas' filing date. 35 USC § 102(b). With regard to statement (C), there is no requirement under 35 USC § 102 that a publication be made with an inventor's knowledge or permission before it constitutes prior art. Statement (D) is incorrect at least because the Birdoculars were “described in a printed publication in...a foreign country” (35 USC § 102(a)) before Thomas' filing date and is therefore presumptive prior art. 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 (E) is not correct.

9. ANSWER: (E) is the most correct answer. Thomas 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 Saskatoon Times article or in establishing priority. 35 U.S.C. § 104; see also MPEP 715.01(c).

10. ANSWER: All answers accepted.

11. ANSWER: (E) is the most correct answer. Invocation of the sixth paragraph of 35 U.S.C. § 112 does not exempt an applicant from compliance with the first and second paragraphs of 35 U.S.C. § 112. 35 U.S.C. § 112, paragraph 6; *See*, “Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, para. 6,” 65 F.R. 38510, 38514 (June 21, 2000), 1236 O.G. 98 (July 25, 2000) (middle column). (A), being in conformity with proper USPTO practice and procedure, is not correct. *See*, “Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, para. 6,” 65 F.R. 38510, 38514 (June 21, 2000), 1236 O.G. 98 (July 25, 2000) (middle column). (B), being in conformity with proper USPTO practice and procedure, is not correct. 35 U.S.C. § 112, ¶ 1; *In re Donaldson*, 16 F.3rd 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994); *B. Braun Medical, Inc. v. Abbott Lab.*, 124 F.3d 1419, 1425, 43 USP2d 1896, 1900 (Fed. Cir. 1997); *In re Dossel*, 115 F.3d 942, 946, 42 USPQ2d 1881, 18840185 (Fed. Cir. 1997); *See*, “Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, para. 6,” 65 F.R. 38510, 38514 (June 21, 2000), 1236 O.G. 98 (July 25, 2000) (middle column). (C) and (D), being in conformity with proper USPTO practice and procedure, are not correct. *See*, “Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, para. 6,” 65 F.R. 38510, 38514 (June 21, 2000), 1236 O.G. 98 (July 25, 2000) (right column).

[Note re Question 11, choice (D), second line: Examination proctors were instructed to direct examination candidates in choice (D), line 2, to change the word “clear” to –clearly–. The question has been carefully reviewed to see if there is any alternative reasonable meaning to the question if the change was not made. No such meaning was found. The Director of Enrollment and Discipline concluded that omission of the change should have no material affect on the question, and should not inhibit an individual’s ability to correctly answer the question.

12. ANSWER: (C) is the most correct answer. See “Changes to Implement Eighteen-Month Publication of Patent Applications; Final Rule,” 65 F.R. 57024, 57030, right column, which provides “Section 1.55(c) provides that any claim for priority under 35 U.S.C. 119(a) - (d) or 365(a) not presented within the time provided by §1.55(a) is considered to have been waived. Section 1.55(c) also provides that if a claim to priority under 35 U.S.C. 119(a)-(d) or 365(a) is presented after the time period provided by §1.55(a), the claim may be accepted if the claim identifying the prior foreign application by specifying its application number, country, and the day, month and year of its filing was unintentionally delayed.” As to (A), (A) is incorrect in that § 1.55(a) states that an applicant “may claim the benefit of the filing date of one or more prior foreign applications” and an applicant may want to claim priority to several applications and not just the earliest, since different priority applications may relate to different embodiments. As to (D), the claim for foreign priority must identify the foreign application for which priority is claimed, *as well as* any foreign application for the same subject matter and having an earlier filing date than the application for which priority is claimed. 37 C.F.R. § 1.55(a)(1)(i). As to (E), see 37 C.F.R. § 1.55(b) wherein it is stated: “[t]he affidavit or declaration must include a specific statement that, upon an investigation, he or she is satisfied that to the best of his or her knowledge, the applicant, when filing the application for the inventor’s certificate, had the option to file an application for either a patent or an inventor’s certificate as to the subject matter of the identified claim or claims forming the basis for the claim of priority.”

13. ANSWER: (D) is the most correct answer. The question is directed to the proper conduct by patent attorneys and agents. Practitioners, including registered patent agents, (37 C.F.R. § 10.1(r)), may advertise on television and radio. 37 C.F.R. § 10.32(a). Additionally, a registered patent agent may accept cases on a contingent fee basis. 37 C.F.R. § 10.36(b)(8) (permits contingent and fixed fees that are not clearly excessive or illegal). (A) and (B) are incorrect. The patent agent is not authorized to practice in trademark cases. 37 C.F.R. § 10.14(b). (C) is incorrect. Practitioners are proscribed from entering into partnership agreements restricting their right to practice before the USPTO. 37 C.F.R. § 10.38(a). The agreement in choice (C) provides “that after termination of the partnership, the agent and the attorney will not practice in each other’s neighborhoods or accept each other’s established clients,” which is contrary to 37 C.F.R. § 10.38(a). (E) is incorrect. A patent agent is proscribed from misrepresenting himself or herself as being a registered patent attorney. 37 C.F.R. §§ 10.23(b)(4) and 10.34(b).

14. ANSWER: (B) is the correct answer. 37 CFR § 1.176(b) (effective November 7, 2000); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54644 (September 8, 2000). As stated in 65 FR at 54644, left column, “Section 1.176(b) now allows the Office to make a restriction requirement in a reissue application between claims added in a reissue application and the original patent claims, where the added claims are directed to an invention which is separate and distinct from the invention(s) defined by the original patent

claims.” Thus (A) is incorrect. (C) is incorrect because the original patent claims “will be held to be constructively elected...” 37 CFR § 1.176(b). (D) is incorrect because (A) is incorrect. (E) is incorrect because (B) is correct.

15. ANSWER: (C) is the most correct answer. 37 C.F.R. § 3.56 recites, “Assignments which are made conditional...are regarded as absolute assignments for Office purposes... . The Office does not determine whether such conditions have been fulfilled.” MPEP § 317.03. (A), (B), (D), and (E) are incorrect because they are false statements. Regarding (B), MPEP § 317.03 recites, “Since the Office will not determine whether a condition has been fulfilled, the Office will treat the submission of such an assignment for recordation as signifying that the act or event has occurred.” Regarding (E), MPEP § 317.03 recites, “[T]he recording of a document is not a determination by the Office of the validity of the document or the effect that document has on the title to an application or patent.”

16. ANSWER: (B) is the most correct answer. When the article is preexisting, one may only secure patent protection of the method of using the article. Since claim 11 is defined in terms of circuitry and this circuitry was preexisting, claim 11 is not allowable. *Cf. Monsanto Co. v. Rohm & Haas Co.*, 312 F.Supp. 778, 164 USPQ 556 (ED Pa. 1970), *aff’d*, 456 F.2d 592, 172 USPQ 324 (CA 3), *cert. denied*, 407 U.S. 934, 172 USPQ 323 (1972) (new use of preexisting chemical as herbicide entitles applicant to method claims). (A) is incorrect because claim 12 is not barred by 35 U.S.C. § 102(b). As to (C), the remote control device was preexisting and claim 11 reads on the circuitry as it existed in 1995. (D) is incorrect. The manner of invention, whether it be by painstaking research or an inadvertent discovery of a new use is without significance. As to (E), claim 11 is not patentable based upon previous public use. The evidence of commercial success, which may be relevant for overcoming a rejection under 35 U.S.C. § 103, cannot overcome a rejection under 35 U.S.C. § 102.

17. ANSWER: (C) is the most correct answer. *See*, “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1105 (Jan. 5, 2001) left column, first paragraph. “The claimed invention as a whole may not be adequately described if the claims require an essential or critical feature that is not described in the specification and is not conventional in the art or known to one of ordinary skill in the art.” (A) is not the most correct answer. *See*, “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1104 (Jan. 5, 2001) right column, last paragraph. Describing an actual reduction to practice of the claimed invention is a means of showing possession of the invention. (B) is not the most correct answer. *See*, “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1104 (Jan. 5, 2001) right column, last paragraph. (D) is not the most correct answer. *See*, “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1105 (Jan. 5, 2001), left column, second paragraph, which states, “While there is no *in haec verba* requirement, newly added claim limitations must be supported by in the specification through express, implicit, or inherent disclosure.” (E) is not the most correct answer. *See*, “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1105 (Jan. 5, 2001), left column, second paragraph, which states, “An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not

only recognize the existence of the error in the specification, but also recognize the appropriate correction.”

18. ANSWER: (A) is the most correct answer. 35 U.S.C. § 102(d). The foreign application need not be published, but the patent rights granted must be enforceable. MPEP § 706.02(e). (B), (C), (D) and (E) are required by 35 U.S.C. § 102(d).

19. ANSWER: (D) is the correct answer. 37 CFR § 1.33(a)(1) (effective November 7, 2000) “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54617 (September 8, 2000). 37 CFR § 1.33(a)(1), in pertinent part provides, “Thus, the inventor(s), any registered practitioner named in the transmittal papers accompanying the original application, or a party that will be the assignee who filed the application, may change the correspondence address in that application under this paragraph.” As stated in 65 FR at 54617, middle column, “The parties who may so change the correspondence address would include only the one inventor filing the application, even if more than one inventor was identified on the application transmittal letter.” Since (A), (B), and (C) are provided for in 37 CFR § 1.33(a)(1), (D) is correct. (E) is incorrect because (D) is correct.

20. ANSWER: All answers accepted.

21. ANSWER: (A) is the most correct answer. The USPTO does not require or recommend a minimum or maximum number of dependent claims. 37 C.F.R. § 1.75(c). (B) is a USPTO recommendation. See MPEP 608.01(m) (“Claims should preferably be arranged in order of scope so that the first claim presented is the least restrictive.”). (C) is a USPTO recommendation. See MPEP 608.01(m) (“Similarly, product and process claims should be separately grouped.”). (D) is a PTO recommendation. See MPEP 608.01(n), part IV. (E) is a USPTO requirement. See MPEP 608.01(m) (“Each claim begins with a capital letter and ends with a period.”).

22. ANSWER: (A) is the most correct answer because 37 C.F.R. § 1.131(a)(1) requires that the reference not claim the same patentable invention as the rejected invention. (B), (C), (D), and (E) are wrong because MPEP § 706.02(b) identifies these answers as actions that can be taken to overcome a 35 U.S.C. § 102(a) rejection.

23. (A) is the correct answer. 37 C.F.R. § 1.8(a)(1)(i)(A). MPEP § 512 states, “The Certificate of Mailing procedure does not apply to papers mailed in a foreign country.” Since the Henry application was mailed in Mexico, the stamped date of receipt in the USPTO is controlling. (B) and (E) are wrong because the Henry application is abandoned. (C) and (D) are wrong because the Alice application was transmitted to the USPTO by facsimile. 37 C.F.R. §§ 1.6(d) and 1.8(a)(1)(i)(B). In such case, a Certificate of Transmission serves to avoid abandonment even though the transmission is from a foreign country. In this regard, MPEP § 512 states:

Under 37 CFR 1.8, a person may state on certain papers directed to the Office... the date on which the paper will be...transmitted by facsimile. If the date stated is within the period of reply, the reply in most instances will be considered timely. This is true even if the paper does not actually reach the Office until after the end of the period for reply.

The Certificate of Transmission procedure, however, also applies to papers transmitted to the Office from a foreign country... .

24. ANSWER: (D) is the most correct answer. 37 CFR § 1.114 (effective August 16, 2000), *see*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 FR 50092, 50096 (Aug. 16, 2000); and 37 CFR § 1.8. As stated in 65 FR 50096, column 3, “(4) a request for continued examination under § 1.114 is entitled to the benefit of a certificate of mailing under § 1.8 (*cf.* 1.8(a)(2)(i)(A))...” (A) is correct. The filing of a reply under 37 CFR § 1.111 in a national patent application is not a case enumerated in 37 CFR § 1.8(a)(2). (C) is included in 37 CFR § 1.8(a)(1), and thus (D) is correct. (B) is incorrect. 37 CFR § 1.8(a)(2)(i)(A). (E) is incorrect because (B) is incorrect.

25. ANSWER: (C) is the most correct answer. 37 C.F.R. § 1.114 and 1.53(d). “An applicant in a utility application filed on or after June 8, 1995, and before May 29, 2000, may obtain further examination either by timely filing a request for continued examination under § 1.114, or by timely filing a continued prosecution application under § 1.53(d).” *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50096, middle column, first complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (A) is not the most correct answer. 37 C.F.R. § 1.114(a) and (c). The filing of a request for continued examination and payment of the fee for the request is not sufficient to toll the running of any time period set in the final rejection for reply to avoid abandonment of the application. If a reply to an Office action is due, a submission meeting the requirements of 37 C.F.R. § 1.111 must be timely received to continue examination of an application. *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50095, middle column, second complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (B) is not the most correct answer. 37 C.F.R. § 1.114(a)(2). “Under the request for continued examination procedure..., a submission will be considered if the submission and the requisite fee is filed prior to the abandonment of the application.” *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50096, left column, second complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (D) is not the most correct answer. 35 U.S.C. § 154, Pub. Law 106-113, § 4405. The application is not entitled to patent term adjustment. “If...an applicant in a utility...application filed before May 29, 2000 (but on or after June 8, 1995) files a request for continued examination under § 1.114, the application being prosecuted is not an application filed on or after May 29, 2000, and is not entitled to the patent term adjustment provisions of Pub. L. 106-113.” *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50096, middle column, first complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (E) is not the most correct answer. 35 U.S.C. § 154, Pub. Law 106-113, § 4405. The CPA application is entitled to patent term adjustment. “If...an applicant in a utility...application filed before May 29, 2000, files a CPA under § 1.53(d) after May 29, 2000, the application being prosecuted (now a CPA) is an application filed on or after May 29, 2000, and is entitled to the patent term adjustment provisions of Pub. L. 106-113.” *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50096, middle column, first complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000).

26. ANSWER: (A) is the most correct answer. 37 C.F.R. § 1.114(d), last sentence. (B), (C), (D), and (E) are not the most correct answers. Each is recognized as being a “submission” within the scope of 37 C.F.R. § 1.114(c).

27. ANSWER: (A) is the most correct answer. MPEP § 2133.03(e)(1) and 35 U.S.C. § 102(b). II does not create a statutory bar because it is permitted experimental testing. MPEP § 2133.03(e)(3) and 2133.03(e). Therefore (B) is incorrect. III does not create a statutory bar because the sale did not occur in the United States. MPEP § 2133.03(d). Therefore, (C) and (D) are incorrect. (E) is incorrect because (A) is correct.

28. ANSWER: (A) is the most correct answer. 35 U.S.C. § 102(g) applies only when another inventor has not abandoned, suppressed or concealed the invention. In this case, Molly concealed the invention for 12 years. It was not until she saw the popularity of Troy’s device that she filed a patent application. (A) is not true because Molly concealed the invention. (B) is not true since the invention of Molly was concealed for 12 years and effectively abandoned. (C) is not true since §102(a) applies only when the invention is publicly known by others. Since (A) is true, (E) is not.

29. ANSWER: (B) is the most correct answer. See 37 C.F.R. § 1.196(b); MPEP § 1214.01. As to (A) see MPEP §1206, p.1200-8, “(6) Issues.” As to (C), the recapture doctrine prevents claims from being recaptured. See MPEP § 1412.02. As to (D) see 37 C.F.R. § 1.196(d) and MPEP § 1212 where it states that failure to respond in time will result in dismissal of the appeal. As to (E), third party may not appeal 37 C.F.R. §§1.310 and 1.303(a). *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 11 USPQ2d 1866, 1869 (Fed. Cir. 1989) (a reexamination under 35 U.S.C. § 302 is conducted *ex parte* after it is instituted); *In re Opprecht*, 10 USPQ2d 1718 (Fed. Cir. 1989) (third parties do not participate in *ex parte* reexamination before the USPTO).

30. ANSWER: (B) is the most correct answer. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947) (holding that the “lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon” is not relevant to an affidavit or declaration under 37 C.F.R. 1.131(b)); MPEP § 715.07(a). (A) is incorrect. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm’r Pat. 1889); MPEP § 715.07(a). Applicant must show evidence of facts establishing diligence. (C) is incorrect. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958) (after conception has been clearly established, diligence must be considered prior to the effective date is clearly established, since diligence then comes into question); MPEP § 715.07(a). (D) is incorrect. MPEP § 715.07(c). 37 C.F.R. 1.131(a) provides for the establishment of a date of completion of the invention in a NAFTA or WTO member country, as well as in the United States, an applicant can establish a date of completion in a NAFTA member country on or after December 8, 1993, the effective date of section 331 of Public Law 103 - 182, the North American Free Trade Agreement Act, and can establish a date of completion in a WTO member country other than a NAFTA member country on or after January 1, 1996, the effective date of section 531 of Public Law 103 - 465, the Uruguay Round Agreements Act. Not all countries are members of NAFTA or WTO, and prior invention in a foreign country cannot be shown without regard for when the reduction to practice occurred. (E) is incorrect. MPEP § 715.07. Actual reduction to practice generally, but not always, requires a showing that the apparatus actually

existed and worked, “There are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice. *In re Asahi/America Inc.*, 68 F.3d 442, 37 USPQ2d 1204 (Fed. Cir. 1995) (citing *Newkirk v. Lulegian*, 825 F.2d 1581, 3USPQ2d 1793 (Fed. Cir. 1987) and *Sachs v. Wadsworth*, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931). The claimed restraint coupling held to be so simple a device that mere construction of it was sufficient to constitute reduction to practice. Photographs, coupled with articles and a technical report describing the coupling in detail were sufficient to show reduction to practice.).

31. ANSWER: (E) is the most correct answer 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.

32. ANSWER: (B) is the most correct answer because patentability of a product claimed by a product-by-process claim is based on the product itself, and the claimed subject matter in claim 2 is not naturally occurring. MPEP § 2105. (A) is incorrect because claim 1 recites both a product and a process in the same claim and is therefore not within one of the statutory classes set forth by 35 U.S.C. 101. MPEP § 2173.05(p), subpart (II). (C) and (D) are incorrect because claim 3 is drawn to a naturally occurring composition. MPEP § 2105. (E) is incorrect because (B) is correct.

33. ANSWER: (A) is the most correct answer. MPEP § 2144.03. I is incorrect because an applicant must seasonably traverse the well-known statement or the object of the well-known statement is taken to be admitted prior art. *In re Chevenard*, 60 USPQ 239 (CCPA 1943). Therefore (B) and (D) are incorrect. III is incorrect because the action can potentially be made final. Therefore (C) is incorrect. (E) is incorrect because (A) is correct.

34. ANSWER: All answers accepted.

35. ANSWER: (B) is the correct answer. The phrase “consisting of” excludes any step not specified in the claim. MPEP § 2111.03. Thus, a claim that depends from a claim which “consists of” the recited steps cannot add a step. *Id.* Here, the dependent claim adds the step of cooling. Answer (A) is incorrect because the transitional term “comprising” is inclusive or open-ended and does not exclude additional, unrecited steps. MPEP § 2111.03. Answers (C) and (D) are incorrect because the terms “including” and “characterized by” are synonymous with the term “comprising.” MPEP § 2111.03. Answer (E) is incorrect because Answer (C) and Answer (D) are incorrect.

36. ANSWER: (C) is the correct answer. 37 CFR § 1.105 (effective November 7, 2000); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54634 (September 8, 2000). The example at 65 FR 54634, column 2, states, “The examiner cannot require that the reply be more specific or hold the reply to be incomplete based on such information. The examiner can, however, in the next Office action seek confirmation that this is the most specific date that was obtained or can be obtained based on a reasonable inquiry being made if that is not already clear from the reply.” Thus (A) and (B) are incorrect and (C) is correct. (D) is incorrect because (A) is incorrect. (E) is incorrect because (C) is correct.

37. ANSWER: (A) is the most correct answer. The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed before the patent is granted, not before the examiner allows the claims, as is required by 37 CFR § 1.55 (Claim for foreign priority), subparagraph (a)(2), which states “(2) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed before the patent is granted...” As to (B), (B) contains the elements of 37 CFR § 1.55 (a)(2), which states “...If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by the processing fee set forth in § 1.17(i), but the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323.” As to (C), (C) contains the elements of 37 CFR § 1.55 (a)(1)(ii), which provides “(ii) In an application that entered the national stage from an international application after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT.” As to (D), (D) contains the elements of 37 CFR § 1.14(c)(1)(i), which states “[i]f a U.S. patent application publication or patent incorporates by reference, or includes a specific reference under 35 U.S.C. 119(e) or 120 to, a pending or abandoned application, a copy of that application-as-filed may be provided to any person upon written request including the fee set forth in § 1.19(b)(1).” As to (E), (E) contains all of the elements of 37 CFR § 1.14(c)(1)(ii), which states “If an international application, which designates the U.S. and which has been published in accordance with PCT Article 21(2), incorporates by reference or claims priority under PCT Article 8 to a pending or abandoned U.S. application, a copy of that application-as-filed may be provided to any person upon written request including a showing that the publication of the application in accordance with PCT Article 21(2) has occurred and that the U.S. was designated, and upon payment of the appropriate fee set forth in § 1.19(b)(1).”

38. ANSWER: (A) is the correct answer. 37 CFR § 1.115(b)(2) and (c) (effective November 7, 2000); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54636 (September 8, 2000). (A) is correct because a continuation-in-part application is filed under 37 CFR § 1.53(b) and will not be disapproved according to 37 CFR § 1.115(b)(2)(i). (B), (C) and (D) are incorrect because a preliminary amendment will be disapproved if it is not filed on the filing date of the CPA. See, 37 CFR § 1.115(b)(2)(ii). (E) is incorrect because (A) is correct.

39. ANSWER: (B) is the correct answer. 37 CFR § 1.133 (effective November 7, 2000); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54640-54641 (September 8, 2000). As stated in 65 FR at 54641, left column, “Comment 65: One comment urged that interviews be allowed in a CPA prior to a first action. Response: The comment has been adopted in a broader manner to apply to all continuations and substitute applications that conform to practice set forth in the MPEP.” Thus, (B) is correct. (A) is incorrect because interview will not be permitted off Office premises without the authority of the Commissioner. 37 CFR § 1.133(a)(1). (C) is incorrect because an interview for the discussion of the patentability of a pending application will not occur before the first Office action, unless the application is a continuing or substitute application. 37 CFR § 1.133(a)(2). (D) is incorrect because (B) is correct. (E) is incorrect because (A) and (C) are incorrect.

40. ANSWER: (B) is the most correct answer. 35 U.S.C. § 102(b); MPEP § 2173.05(h). Deletion of the anticipated element from the claim leaves an invention that is no longer anticipated by the reference. (A), (D), and (E) are incorrect despite the amendments because the claim remains anticipated since the claim is still directed to the invention described in the reference wherein X is element A. For example, in (D) and (E), element A would still be a member of the group and the claim would still be anticipated by the prior art. (C) is incorrect because the argument does not change the fact that the claim remains anticipated by the same invention described in the reference wherein X is element A. (E) is incorrect because “comprising” cannot be used in a proper Markush group.

41. ANSWER: (C) or (D) are accepted as correct answers. 37 CFR § 1.76(d) (effective November 7, 2000); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54624-25 (Sept. 8, 2000); and 37 CFR § 1.63 (effective November 7, 2000). Under 37 CFR § 1.63(c)(1), Applicant’s mailing address need not be identified in the declaration if it is included in the application data sheet. Thus, (A) is incorrect. The foreign priority information must be included in the declaration because it was not included in the application data sheet. 37 CFR § 1.63(c)(2). Thus, (C) is correct. Applicant’s citizenship in (B) must be included in the declaration under 37 CFR § 1.63(a)(3), if “applicant” in (B) is construed as a person or party, e.g., 37 CFR § 1.42, other than the inventor, and no exception is made for citizenship under 37 CFR § 1.63(c). In the latter instance, where both (B) and (C) are correct, and (D) is the most correct answer because it is inclusive of (B) and (C). (B) alone is not accepted because the foreign priority document must be included in the declaration. (E) is incorrect because (A) is incorrect.

42. ANSWER: (A) is the most correct answer. A petition to make special may be made simply by filing a petition including any evidence showing that the applicant is 65 years of age or more, such as a birth certificate or a statement from the applicant. No fee is required. MPEP § 708.02. Although a petition to make special as indicated in statement (B) is likely available, it would require a petition fee. *Id.* A petition to make special as indicated in statement (B) is likely not available because such a petition may not be based on prospective infringement. *Id.* Also, even if a petition as indicated in statement (C) were available, it would require a petition fee. Thus, neither of these options would be the most inexpensive. (B) also requires a statement explaining the relationship of the invention to safety of research in the field of recombinant DNA research.

43. ANSWER: (C) is the most correct answer. MPEP § 608.01(n). (A) is incorrect because a dependent claim must further limit the subject matter of a previous claim. 37 C.F.R. § 1.75(c). The claim in (B) is actually inconsistent with claim 1. (B) is incorrect because there is no antecedent basis for the wheels. MPEP § 2173.05(e). (D) is incorrect because it does not refer back in the alternative only. MPEP § 608.01(n). (E) is incorrect because (C) is correct.

44. ANSWER: (E) is the most correct answer. As stated in MPEP § 2172.01, “a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968).” (A) is incorrect. As stated in MPEP § 2172.01, “A claim which omits matter disclosed to be essential to the invention as

described in the specification or in other statements of record may be rejected under 35 U.S.C. 112, first paragraph, as not enabling. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976)”; MPEP § 2164.08(c). (B) is incorrect. As stated in MPEP § 2165, “Failure to disclose the best mode need not rise to the level of active concealment or grossly inequitable conduct in order to support a rejection or invalidate a patent. Where an inventor knows of a specific material that will make possible the successful reproduction of the effects claimed by the patent, but does not disclose it, speaking instead in terms of broad categories, the best mode requirement has not been satisfied. *Union Carbide Corp. v. Borg - Warner*, 550 F.2d 555, 193 USPQ 1 (6th Cir. 1977).” (C) is incorrect. As stated in MPEP § 2165.02, “The best mode requirement is a separate and distinct requirement from the enablement requirement of the first paragraph of 35 U.S.C. 112. *In re Newton*, 414 F.2d 1400, 163 USPQ 34 (CCPA 1969). (D) is incorrect. MPEP § 2165.01, part V indicates that if there is no disclosure of the best mode contemplated by the inventor at the time the application is filed, such a defect cannot be cured by submitting an amendment seeking to put into the specification something required to be there when the patent application was originally filed. *In re Hay*, 534 F.2d 917, 189 USPQ 790 (CCPA 1976). Any proposed amendment of this type should be treated as new matter. MPEP § 2165.01.

45. ANSWER: (B) is the most correct answer. 37 CFR § 1.114(c) (effective August 16, 2000), “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 FR 50092, 50097 (Aug. 16, 2000), and 37 CFR § 1.111(b). As stated in 65 FR 50097, column 1, “Section 1.114(c) also provides that if reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111.” (B) is correct because the reply complies with 37 CFR § 1.111(b). (A) is incorrect because a reply under 37 CFR § 1.111(b) must be reduced to writing. 37 CFR § 1.2. (C) is incorrect because a reply under 37 CFR § 1.111(b) must present arguments pointing out the specific distinctions believed to render the claims patentable over the applied references. (D) is incorrect because (A) and (C) are incorrect. (E) is incorrect because (B) is correct.

46. ANSWER. (A) is the most correct answer. 37 C.F.R. §§ 1.16(a) and 1.17(e). The fee to request continued examination of an application is currently \$355.00 for a small entity, and \$710.00 for other than a small entity. The fee for filing each application for an original patent, except provisional, design, or plant applications is currently \$355.00 for a small entity, and \$710.00 for other than a small entity. See “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50093 (Aug. 16, 2000), 1238 O.G.13 (Sept. 5, 2000). (B) is not the most correct answer. 37 C.F.R. § 1.8(a)(2) provides, in pertinent part, “The procedure described in paragraph (a)(1) of this section does not apply to, and no benefit will be given to a Certificate of Mailing or Transmission on the following: (i) Relative to Patents and Patent Applications – (A) The filing of a national patent application specification and drawing or other correspondence for the purpose of obtaining an application filing date, including a request for a continued prosecution application under § 1.53(d).” (C) is not the most correct answer. 37 C.F.R. § 1.21(m). See “Changes to Permit Payment of Patent and Trademark Fees by Credit Card,” 65 F.R. 33452-33455 (May 24, 2000), 1235 O.G. 38 (June 13, 2000). (D) is not the most correct answer. 37 C.F.R. § 1.53(c)(3) requires the petition to convert be filed prior to the earliest of the abandonment of the provisional application or the expiration of twelve months after the filing date of the provisional application. (E) is not the most correct answer. Under 37 C.F.R. § 1.53, a nonprovisional application based on conversion

of a provisional application must include the filing fee for a nonprovisional application. The conversion request must be accompanied by the fee set forth in 37 C.F.R. § 1.17(i). In addition, the surcharge required by 37 C.F.R. § 1.16(e) if either the basic filing fee for a nonprovisional application, or the oath or declaration was not present on the filing date accorded the resulting nonprovisional application. A properly paid basic filing fee for a provisional application is not applied to the filing or other fees due for a nonprovisional application resulting from conversion of a provisional application. 37 C.F.R. § 1.53(c)(3), second sentence.

47. ANSWER: (E) is the correct answer. 37 CFR § 1.111(a)(2) (effective November 7, 2000F); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54635 (September 8, 2000). (C) and (B) are factors that are specified in 37 CFR § 1.111(a)(2)(i) and (ii). (A) is incorrect because although the request set forth in (A) may be included in a reply under 37 CFR § 1.111(b), it is not set forth as a factor in disapproving a third reply under 37 CFR § 1.111(a)(2). (D) is incorrect because (A) is incorrect.

48. ANSWER: (A) is the most correct answer. 37 C.F.R. § 1.173(a)(1). (C) and (D) are not most correct answers. 37 C.F.R. § 1.173(a)(1). 65 FR 54604 (Sept. 8, 2000) (effective Nov. 7, 2000). (C) is not the most correct answer because it would furnish a copy of the patent in single column format, instead of the required double column format. (D) is not the most correct answer because it would furnish a copy of the patent on both sides of a single sheet of paper, as opposed to the required single side of a sheet of paper. (B) is wrong because it represents a format for submitting a reissue application which was formerly set out as an option in MPEP § 1411, but which was changed by the new rule. Id. (E) is wrong because it mimics (B), with the exception that the columns of the cut-up soft copies of the printed patent are mounted on both sides, rather than one side, of each page. (B) and (E) are also incorrect because they indicate that the copies of the patent must be “cut-up soft copies,” whereas the rules no longer require the same.

49. ANSWER: (E) is the most correct answer. Since a redacted copy of the application was used for publication purposes, 37 C.F.R. § 1.14 (c)(2) provides that “(2) If a redacted copy of the application was used for the patent application publication, the copy of the specification, drawings, and papers may be limited to a redacted copy.” As to (A), (A) contains the elements of 37 C.F.R. § 1.14(b)(2), which reads “When status information may be supplied. Status information of an application may be supplied by the Office to the public if any of the following apply: ... (2) The application is referred to by its numerical identifier in a published patent document (*e.g.*, a U.S. patent, a U.S. patent application publication, or an international application publication), or in a U.S. application open to public inspection (§ 1.11(b), or paragraph (e)(2)(i) or (e)(2)(ii) of this section).” As to (B), (B) is within the purview of 37 C.F.R. § 1.14(a)(1)(iii) which states: “(a)(1) Status information is: ... (iii) The application “numerical identifier” which may be: (A) The eight-digit application number (the two-digit series code plus the six-digit serial number); or (B) The six-digit serial number plus any one of the filing date of the national application, the international filing date, or date of entry into the national stage.” As to (C), (C) contains the elements of 37 C.F.R. § 1.14(c)(1)(i), which states “(c) *When copies may be supplied.* A copy of an application-as-filed or a file wrapper and contents may be supplied by the Office to the public, subject to paragraph (i) of this section (which addresses international applications), if any of the following apply: (1) *Application-as-filed.* (i) If a U.S. patent application publication or patent incorporates by reference, or includes

a specific reference under 35 U.S.C. 119(e) or 120 to, a pending or abandoned application, a copy of that application-as-filed may be provided to any person upon written request including the fee set forth in § 1.19(b)(1).” As to (D), a coinventor is entitled to access to the application independent of whether or not he or she signed the declaration. Note that as stated in 37 C.F.R. § 1.41(a)(2), if a declaration or oath is not filed, the inventorship is that inventorship set forth in the application papers.

50. ANSWER: (B) is the correct answer because the application is properly deposited with the USPS as “Express Mail Post Office to Addressee” and the “date-in” is properly entered by the USPS. MPEP § 502, subpart styled “‘Express Mail’ Service” states, “The only type of service which can be used for ‘Express Mail’ directed to the Patent and Trademark Office is the ‘Post Office to Addressee’ service of the U.S. Postal Service. 37 C.F.R. 1.10.” MPEP § 513 under the heading “Date-In, Direct Deposit, ‘Express Mail’ Box Receptacles & Log Books” recites, “The ‘date-in’ on the ‘Express Mail’ mailing label must be completed by the USPS, not the applicant.” MPEP § 513 under the heading “‘Express Mail’ Mailing Label Number” recites, “Effective December 2, 1996, 37 C.F.R. 1.10(b) no longer requires...that the ‘Express Mail’ mailing label number be placed on the correspondence prior to mailing.” MPEP § 513, subpart styled “Effective Date, Weekends & Holidays” states, “Effective December 2, 1996, 37 C.F.R. 1.6(a)(2) provides that correspondence deposited as ‘Express Mail’ in accordance with 37 C.F.R. 1.10 will be stamped, and, therefore, considered as filed on the date of its deposit, regardless of whether that date is a Saturday, Sunday or Federal holiday within the District of Columbia.” Therefore, (B) provides a filing date of March 10, 2001. (A) is wrong because the receipt date of March 12, 2001, is the filing date, since the “Express Mail Post Office to Post Office” procedure is ruled out by 37 C.F.R. § 1.10 and MPEP § 502. (C) is wrong because the receipt date of March 14, 2001, is the filing date, since the “date-in” was not entered by the USPS as required by MPEP § 513. (D) is wrong because the effective receipt date is March 26, 2001, since the “date-in” was not entered by the USPS as required by MPEP § 513. (E) is wrong because the receipt date is March 26, 2001, since the “Express Mail Post Office to Post Office” procedure is ruled out by 37 C.F.R. § 1.10 and MPEP § 502.