

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

**APRIL 17, 2002**

**Morning Session (50 Points)**

**Time: 3 Hours**

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**DIRECTIONS**

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

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

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

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

**DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO**

This examination addresses statutes and rules that have been changed as a result of the enactment of the American Inventors Protection Act of 1999, Pub. L. No. 106-113 (“Act”). The 8<sup>th</sup> Edition of the Manual of Patent Examining Procedure should be used. The examination will apply rules that are in effect as April 1, 2002. The rule changes are posted under the heading “Recent Patent-Related Notices” on the USPTO web site ([www.uspto.gov/web/offices/pac/dapp/ogsheet.html](http://www.uspto.gov/web/offices/pac/dapp/ogsheet.html)). A group of rule changes, published in 67 Federal Regulations 520 (January 4, 2002) under the name “Revision of the Time Limit for National Stage Commencement in the United States for Patent Cooperation Treaty Applications,” will be in effect on April 1, 2002. This rule change is also available at the USPTO web site cited above under the heading “Recent Patent Related Notices.”

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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



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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

- (A) If a practitioner, "by mistake," files an application and basic filing fee, the submission of the filing fee with the application is treated by the Office as not a fee paid by mistake, and the fee will not be refunded.
- (B) If, in April 2001, a practitioner files an application, properly establishes the applicant's small entity status, and "by mistake" pays the filing fee by submitting a check drawn in the amount that is twice the amount of the small entity filing fee, a refund of the excess fee may be obtained upon request filed any time during pendency of the application and life of any patent granted on the application.
- (C) The paragraphs of the specification of an original utility patent application filed in January 2001 may, but are not required to be numbered at the time the application is filed.
- (D) If a provisional application is filed in a language other than English, an English language translation of the non-English language provisional application will not be required in the provisional application.
- (E) If a table having more than 50 pages of text is submitted on compact disc, the specification of a patent application must contain an incorporation-by-reference of the material on a compact disc in a separate paragraph, identifying each compact disc by the names of the files contained on each compact disc, their date of creation, and their sizes in bytes.

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

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



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

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

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

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

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

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

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

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

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

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

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

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

33. Which of the following may properly be required to submit information in reply to a requirement for information under 37 CFR 1.105 in a patent application filed in December 2002?

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

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

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

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

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

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

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

37. Select from the following an answer which completes the following statement, such that the completed statement accords with proper USPTO practice and procedure: “When the reference in question is a noncommonly owned U.S. patent claiming the same invention as applicant, and its issue date is \_\_\_\_\_”

- (A) less than one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of requesting an interference.
- (B) exactly one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of requesting an interference.
- (C) more than one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of requesting an interference.
- (D) less than one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of affidavit or declaration “swearing back” of reference.
- (E) less than one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of affidavit or declaration traversing the ground of rejection.

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

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



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

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

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

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

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

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

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

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

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

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

44. An amendment filed in January 8, 2002, in an unassigned nonprovisional application seeks to cancel claims so that fewer than all of the currently named inventors are the actual inventors of the invention being claimed. The amendment includes a request to delete the names of the persons who are not inventors. In accordance with proper USPTO rules and procedure, the request may be signed by which of the following?

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

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

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

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

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

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

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

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

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

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

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

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

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

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**United States Patent and Trademark Office**  
**Registration Examination for Patent Attorneys and Agents**  
**April 17, 2002**

**Morning Session Model Answers**

1. ANSWER: (C) is the most correct answer. MPEP § 2181 expressly requires that for a claim limitation to be interpreted in accordance with 35 U.S.C. § 112, paragraph 6, that limitation must (1) use the phrase “means for”, (2) the “means for” must be modified by functional language, and (3) the “means for” must not be modified by sufficient structure for achieving the specified function. In the above fact pattern, only answer choice (C) satisfies the above requirements. (A) is wrong because it does not use the phrase “means for” and recites structure for achieving the specified function (“printer”). (B) is wrong because it modifies the “means” with structure, and also fails to modify the “means” with functional language. (D) is wrong because it does not use the phrase “means for” and also recites structure modifying “mechanism.”

2. ANSWER: (C) is the correct answer. 37 C.F.R. § 1.704(d) provides that submission of an information disclosure statement under §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) under 37 C.F.R. § 1.704(c)(10) (submission of a paper after a notice of allowance) if the communication was not received by any individual designated in 37 C.F.R. § 1.56 more than thirty days prior to the filing of the information disclosure statement. Submission of the information disclosure statement to the USPTO within 30 days from mailing by the foreign office would inherently meet the 30 day requirement for submission to the USPTO from receipt by a 37 C.F.R. § 1.56 party of the information from the foreign office. Meeting the 30 day period for filing the information disclosure statement after allowance will prevent a reduction of the patent term adjustment already accumulated. Answer (A) is not the best answer. A request for continued examination will delay the issuance of the patent over permitting the original application to issue with the information disclosure statement filed, pursuant to answer (A), thereby causing loss of a portion of the 20 year term as the patent term is measured from the earliest priority date claimed, 35 U.S.C. § 154(a)(2). Answer (B) is not the best answer. Complying with the three month period requirements under 37 C.F.R. § 1.97(d) will permit the information disclosure statement to be considered in the allowed application without the need to withdraw from issue and refile. Answer (B) provides that the information disclosure statement can be submitted up to the end of the three month period, which means that the 30 day period of 37 C.F.R. § 1.704(d) may not be met and a reduction in the accumulated adjustment period may result. Answer (D) is not correct. 37 C.F.R. § 1.97(e) provides that the three month period is to be measured from when information submitted in an information disclosure statement was first cited by a foreign office. A later second cite by another foreign office cannot be used to measure the three month period. Answer (E) is not the best answer as answer (B) is not the best answer and answer (D) is not correct.

3. ANSWER: (D). This answer is correct because it would be the best option, as it would give Ms. Bordeaux the filing date of the PCT, specifically 1/10/01, as her U.S. filing date (for the purpose of determining whether information is prior art), it would give her a foreign priority date of 1/10/00, with no further need to provide the foreign priority document; it would also give her the full benefits of filing PCT applications, i.e., a search report and preliminary examination report on her invention(s) prior to filing a national application, so that she has an indication of which claims have the best chance of being determined to be patentable. (A) This answer is incorrect, as it would not give Belle Bordeaux the benefit of a preliminary examination report for

her international application, prior to filing the national application. (B) This answer is incorrect because the procedure would not achieve the objective of obtaining an international preliminary search report. It would give Belle Bordeaux a later U.S. filing date, the filing date of the national application, *e.g.*, 9/10/01; the invention(s) would be subject to U.S. restriction practice; and the applicant would have to provide a certified copy of the foreign priority document. (C) This answer is incorrect, as a provisional application is not entitled to the right of priority of any other application under 35 U.S.C. §§ 119 or 365(a), or to the benefit of an earlier filing date in the United States under 35 U.S.C. §§ 120, 121 or 365(c). (E) is not correct because (A), (B) and (C) are incorrect.

4. ANSWER: (B) is the most correct answer. 35 U.S.C. § 113 reads “Drawings submitted after the filing date of the application may not be used (i) to overcome any insufficiency of the specification due to lack of an enabling disclosure.” Since choice (A) may be done, 37 C.F.R. § 1.111, it is an incorrect answer to the above question. Since choice (C) may be done, 35 U.S.C. § 120, it is an incorrect answer to the above question. Since choice (D) may be done, 37 C.F.R. § 1.121, it is an incorrect answer to the above question. Since choice (E) may be done, 37 C.F.R. § 1.111, it also is an incorrect answer to the above question.

5. ANSWER: (E) is the correct answer. 37 C.F.R. § 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 C.F.R. § 1.114 do not apply to design patent applications. Therefore, choices (A) through (D) are incorrect.

6. ANSWER: The most correct answer is (D). See MPEP § 706.07(h), page 700-71, under “IV. IMPROPER CPA TREATED AS RCE.” The request for a second CPA filed on December 28, 2001 is improper because the application in which the CPA was filed in has a filing date of December 29, 2000 and is not eligible for the CPA practice. The CPA practice does not apply to applications that have a filing date on or after May 29, 2000. The Office will automatically treat the improper request for a CPA as a Request for Continued Examination under 37 C.F.R. § 1.114. However, the request for a CPA filed on December 28, 2001 does not satisfy the requirements of 37 C.F.R. § 1.114 to be a proper RCE because it lacks the filing fee required by 37 C.F.R. § 1.17, and the required submission under 37 C.F.R. § 1.114. Therefore, the improper CPA will be treated as an improper RCE and the time period set in the last Office action mailed on June 28, 2001 will continue to run. Since the time period expired on December 28, 2001, the application is abandoned. Answers (A), (B), and (C) are incorrect because the request for a second CPA filed on December 28, 2001 is improper and the amendment was not entered. Answer (E) is incorrect because a request for a suspension of action will not be granted if the CPA or the RCE is improper (*e.g.*, a filing date was not accorded in the CPA or the RCE was filed without a submission). See 37 C.F.R. § 1.103, MPEP § 709, page 700-113.

7. ANSWER: (D) is the most correct answer because mere attorney argument, unsupported by factual evidence, is insufficient to establish unexpected results. *See In re Geisler*, 116 F.3d 1465, 1470-71, 43 USPQ2d 1362, 1365-66 (Fed. Cir. 1997). (A) is not the proper choice because such a comparison is required. *See In re Baxter Travenol Labs.*, 952 F.2d 388, 392, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991); *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir.

1984), and MPEP § 716.02(e). (B) is not the proper choice because evidence relied upon for overcoming a *prima facie* case of obviousness must be commensurate in scope with the claims. See *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983); *In re Clemens*, 622 F.2d 1029, 1035, 206 USPQ 289, 296 (CCPA 1980), and MPEP § 716.03(a). (C) is not the proper choice because the unobviousness of a broader range recited in a claim can be proven by a narrower range of data provided that one of ordinary skill in the art could ascertain a trend in the data which would allow that person to reasonably extend the probative value of the data to the broader range. See *In re Kollman*, 595 F.2d 48, 56, 201 USPQ 193, 199 (CCPA 1979), and MPEP § 717.02(d). (E) is not the proper choice because the relied-upon evidence can be in the specification. See *In re Soni*, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

8. ANSWER: The correct answer is (D). The prior art exception in 35 U.S.C. § 103(c) only applies to references that are only prior art under 35 U.S.C. § 102(e), (f), or (g). In this situation, the Jones patent qualifies as prior art under § 102(a) because it was issued prior to the filing of the Clark application. See MPEP § 706.02(l)(3). Also, evidence of common ownership must be, but has not been, presented. Mere argument or a statement alleging common ownership does not suffice to establish common ownership. Answer (A) is a proper reply in that it addresses the examiner's rejection by specifically pointing out why the examiner failed to make a *prima facie* showing of obviousness. See 37 C.F.R. § 1.111. Answer (B) is a proper reply. See MPEP § 715. Answer (C) is a proper reply. See MPEP § 716. Answer (E) is a proper reply because perfecting a claim of priority to an earlier filed German application disqualifies the Jones reference as prior art.

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."<sup>65</sup> ...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.<sup>66</sup>" (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."<sup>59</sup> 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: The correct answer is (A). See 37 C.F.R. § 1.48(f)(1) wherein the first submission of an executed oath or declaration under 37 C.F.R. § 1.63 by any of the inventors during the pendency of the application will act to correct the earlier identification of inventorship in the unexecuted declaration. Answer (B) is wrong because a new executed oath or declaration was not filed. Answer (C) is wrong because (1) a petition under § 1.48(a) is not required, (2) the petition is incomplete because it lacks a statement by the newly discovered inventor that the error occurred without deceptive intention on his part, and (3) the declaration fails to list the other two inventors. Answer (D) is wrong because (1) a petition under § 1.48(a) is not required and (2) the petition is incomplete because it lacks a new oath or declaration, which lists the newly discovered inventor in addition to the inventors already named. Answer (E) is incorrect because answers (B), (C) and (D) are incorrect.

11. ANSWER: (B) is the most correct answer. 35 U.S.C. § 102(e)(1) provides that a USPTO published application, based on an earlier international application, has prior art effect as of its international filing date, if the international application designated the United States, and was published in English. Because in the above fact pattern, the international application designated the United States and was published in English, the USPTO published application is entitled to its international filing date of February 27, 1997 for prior art purposes. (A) is wrong because the Japanese filing date is relevant under 35 U.S.C. § 119 only for priority, but not for prior art purposes. (C) and (E) are wrong because they recite prior art dates that are later than February 27, 1997. (D) is wrong because the amendments to § 102(e) by the American Inventors Protection Act of 1999 make the national stage entry date irrelevant for prior art purposes.

12. ANSWER: (E) is the most correct answer. 35 U.S.C. § 102(e)(2), as amended by the American Inventors Protection Act, provides that a United States patent is prior art as of its earliest filing date in the United States. Section 102(e)(2) also specifically notes that a patent is not entitled to any international application filing date for prior art purposes. Because in the above fact pattern, no application was ever filed in the United States, the patent is not entitled to any prior art date earlier than its issue date, December 1, 2001. (A) is wrong because the Japanese filing date is relevant under 35 U.S.C. § 119 only for priority and not prior art purposes. (B) is wrong because while a USPTO published application may be entitled to its international filing date under section 102(e)(1), a United States patent is not entitled to any international filing date under section 102(e)(2). (C) is wrong because while the publication of an international application in English has its own prior art effect as a reference, it is not relevant to the prior art effect of the United States patent. (D) is wrong because national stage entry of an international application is not to be confused with a United States filing date. While the version of section 102(e) that existed prior to the American Inventors Protection Act expressly provided for prior art effect as fulfillment of certain national stage requirements, the amended section 102(e) no longer provides for that prior art effect, thus making national stage entry irrelevant for 102(e) prior art purposes.

13. ANSWER: (C) is the most correct answer. 35 U.S.C. § 41(e) reads “The Director may waive the payment of any fee for any service or material related to patents in connection with an occasional or incidental request made by a department or agency of the Government, or any officer thereof.” The statute, however, does not make a government agency a small entity. Choices (A), (B), (D) and (E) are not correct because 37 C.F.R. § 1.27(a) recites these four items as qualifying for small entity status.

14. ANSWER: (B) is the most correct answer. Third party requesters do not have the option of attending interviews. See 37 C.F.R. § 1.560(a), which provides, in part, “[r]equests that reexamination requesters participate in interviews with examiners will not be granted.” As to (A) and (C) through (E), 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.”

15. ANSWER: (C). MPEP § 406. Answer (C) is a true statement because the Ben may appoint a registered practitioner to represent him. Answer (A) is incorrect because the power of a principal attorney will be revoked or terminated by his or her death. Such a revocation or termination of the power of the principal attorney will also terminate the power of those appointed by the principal attorney. Therefore, Chris’s associate power of attorney is revoked and Chris cannot continue representing Ben without a new power of attorney from Ben. Furthermore, the Office will send correspondence to both Chris and Ben in the event of notification of Able’s death. (B) is not the best answer because it suggests Ben may appoint a non-practitioner to prosecute the application and because it does not require the power of attorney to be executed (*cf.* answer (C)). (D) is not the best answer because it includes (B). (E) is false because (C) is true.

16. ANSWER: (E) is correct. A communication mailed within the time given for response in accordance with the procedure of 37 C.F.R. § 1.8 or 1.10 is considered timely filed even if it is received after the date a reply is due. In (E), the letter was not mail in accordance with 37 C.F.R. § 1.8 or 1.10. Therefore, the letter would be considered filed when it is received in the USPTO. 37 C.F.R. § 1.311(a) states, “This three month period is not extendable.” Without complying with 37 C.F.R. § 1.8 or 1.10, the filing date of the letter is the date it was received in the USPTO, i.e., February 15, 2002, which is after the due date for payment of the issue fee, February 13, 2002. (A) is wrong because the reason given for abandonment is incorrect. The application becomes abandoned for the reasons expressed in (E). Although 37 C.F.R. § 1.311(b) provides that the submission of an incorrect issue fee (or other post-allowance fees set forth in 37 C.F.R. § 1.18) operates as a request to charge the correct issue fee, it does not change the fact that Jill’s letter is received by the USPTO after expiration of the non-extendable statutory three month period for payment of the issue fee. (B) is wrong because the application will become abandoned because Jill’s letter will be received by the USPTO after expiration of the non-

extendable statutory three month period. (C) is wrong because the period for payment of the issue fee was not extendable by petition. The period is set by statute. 35 U.S.C. § 151. Abandonment occurred because Jill's letter was received by the USPTO after expiration of the non-extendable statutory three month period. A petition for an extension of time was not available in this case. (D) is wrong because the reason for abandonment is wrong. Filing the form is optional. Although 37 C.F.R. § 1.311(b) provides that the submission of a completed Office-provided issue fee transmittal form, PTOL-85B, operates as a request to charge the correct issue fee (or other post-allowance fees set forth in 37 C.F.R. § 1.18) to any deposit account identified in a previously filed authorization to charge fees, it does not change the fact that Jill's letter was received by the USPTO after expiration of the non-extendable statutory three month period.

17. ANSWER: (D) is correct. An original plant or utility application filed on or after May 29, 2000 is eligible for patent term adjustment. See 35 U.S.C. § 154(b), 37 C.F.R. § 1.702 and MPEP § 2730. Since a continued prosecution application (CPA) filed under 37 C.F.R. § 1.53(d) is a new (continuing) application, a CPA filed on or after May 29, 2000 is eligible for patent term adjustment. See MPEP § 2730. Applications filed on or after June 8, 1995 may accrue patent term extension under 35 U.S.C. § 154(b), but patent term extension is much more limited than PTA and should not be confused with PTA. Accordingly, Answers (A) and (B) are wrong. Answer (C) is wrong because design applications are not eligible for patent term adjustment. See 37 C.F.R. § 1.702 and MPEP § 2730. Answer (E) is wrong because a request for continued examination (RCE) under 35 U.S.C. § 132(b) and 37 C.F.R. § 1.114 is not a new application and filing an RCE in an application filed before May 29, 2000 will not cause the application to become eligible for patent term adjustment. See MPEP § 2730.

18. 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."

19. ANSWER: (B). 37 C.F.R. § 1.153(d)(I)(i)(B). A design application is eligible for continuing prosecution application procedures. 37 C.F.R. § 1.114 (e)(4) explains that RCE procedure is not available for design applications, therefore (A) and (C) are wrong. Answer (D) is wrong because under 37 C.F.R. § 1.53(d) the filing date of the application (A#1) must be before May 29, 2000. Answer (E) is wrong for the same reason.

20. ANSWER: The model answer is choice (E). 37 C.F.R. § 1.14(b)(4). MPEP § 102, “Information as to status of an Application.” Under 37 C.F.R. § 1.14, the Office may provide status information for pending patent applications that claim the benefit of the filing date of an application for which status information may be provided. Hence information will only be available on this basis for subsequently filed applications. Answer (A) is incorrect because information may be available for subsequently filed applications. Answers (B) and (C) are incorrect because only status information, not copies of the application, are provided. Answer (C) is also incorrect because a claim for benefit under 35 U.S.C. § 120 must be made before status information will be provided. Answer (D) is incorrect because status information is only given for subsequently filed applications.

21. ANSWER: (C) is the most correct answer. See 37 C.F.R. § 1.322(a)(2)(i) (“There is no obligation on the Office to act on or respond to a submission of information or request to issue a certificate of correction by a third party under paragraph (a)(1)(iii) of this section”). See MPEP § 1480. (A), (B) and (E) are incorrect because they indicate that the USPTO must take some mandatory action as a result of the third party notification, while 35 U.S.C. § 254 and 37 C.F.R. § 1.322(a)(2)(i) leave whether and how to respond to such a third party notification to the discretion of the USPTO Director. (D) is incorrect. See 37 C.F.R. § 1.322(a)(2)(ii) (“Papers submitted by a third party under this section will not be made of record in the file that they relate to nor be retained by the Office”).

22. ANSWER: (A) 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 (B) 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.

23. ANSWER: The correct answer is (E). PCT Article 22 was recently amended to permit applicant to delay entry into the national stage until 30 months from the earliest claimed priority date, regardless of whether a Demand was filed within 19 months from said date. The change is effective for international applications where the former Article 22 time limit of 20 months expired on or after 01 April 2002.

24. ANSWER: (B) is the correct answer. It is inappropriate and injudicious to disregard any admissible evidence in any judicial proceeding. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). The examiner has not analyzed the data in the declaration

nor provided an explanation as to why the declaration did not overcome the rejection. Furthermore, the rejection has not been reviewed anew in light of the declaration. The examiner should have reweighed the entire merits of the *prima facie* case of obviousness in light of the data. *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986). Accordingly, Block should ask that the rejection be reconsidered and file a Notice of Appeal to safeguard his interest for a review of the rejection by the Board of Patent Appeals and Interferences if the rejection is not reconsidered. 37 C.F.R. § 1.116. (A) is wrong because there is no evidence that the examiner made any review of the declaration. (C) is wrong because whether or not Reference X provides an enabling disclosure for Block's invention is immaterial to the question of obviousness. If there were to be a question of enabling disclosure for Reference X, it would be with respect to the "Q" ball relied upon by the examiner, not applicant's "Y" ball. (D) is wrong because whether or not Reference X provides a written description for Block's invention is immaterial to the question of obviousness raised by the examiner. (E) is wrong because the issue is one of obviousness under 35 U.S.C. § 103, not identity under 35 U.S.C. § 102. Given that the examiner has rejected the claim under 35 U.S.C. § 103 and not under § 102, the examiner has already conceded that the "Q" and "Y" balls are not the same.

25. ANSWER: (E) is correct. (A), (B), (C), and (D) are wrong because 35 U.S.C. § 154(a)(2), in pertinent part, provides that a patent "grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States... ." An adjustment of the patent term due to examination delay for original patent applications filed on or after June 8, 1995, and before May 29, 2000, is provided by 37 C.F.R. § 1.701. As to (D), the period of adjustment for the application involved in the interference is not adjusted by the period prosecution is suspended in an application related to the application in interference. The period of adjust for the application in interference is governed by the provisions of 37 C.F.R. § 1.701(c)(1)(i), as opposed to the provisions of 37 C.F.R. § 1.701(c)(1)(ii), which pertain to adjustment of the term of an application wherein prosecution is suspended due to an interference proceeding not involving that application. As to (E), the adjustment involves extending the patent term from the expiration date of the patent by the period of the delay. The manner of calculating the period of the delay is provided in subsection 701(c)(1)(i), which recites:

With respect to each interference in which the application was involved, the number of days...in the period beginning on the date the interference was declared...to involve the application in the interference and ending on the date that the interference was terminated with respect to the application...

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: The best answer is (E). The original deadline for responding to the Office action was one month from December 12, 2001, *i.e.* January 12, 2002. A one-month extension of time would be required for a response filed from January 12, 2002 to February 12, 2002. Answers (B) and (D) are incorrect because the responses are not timely. Answer (B) is also incorrect because a proper reply must include an election even if the restriction requirement is traversed (MPEP § 818.03(b)). Furthermore, although small entity status entitles an applicant to pay reduced fees, small entity status does not change the manner in which restriction requirements are considered. Answer (A) is incorrect because the reply must be in writing. See, *e.g.*, MPEP § 818.03(a). Answer (C) is incorrect because the Reply to Office Action does not make an election and because it does not specifically point out the supposed errors in the Examiner’s action. See MPEP § 818.03(a).

28. ANSWER: The best answer is (C). Answers (A) and (B) are incorrect because they attempt to distinguish the claim on the basis of a feature that is not recited in claim 6, *i.e.*, the substance is interspersed throughout the salt lick. *Cf.* claim 8. Answer D similarly relies on a feature that is not set forth in claim 6, *i.e.*, presence of substance XYZ. With regard to Answer (E), a mere conclusory statement that the claim was carefully drafted to distinguish over the prior art is unlikely to be persuasive without reference to distinguishing features set forth in the claim.

29. ANSWER: The best answer is (C). MPEP § 2141.01(a). Answer A is incorrect because under the facts of the question there is no teaching or suggestion to combine the teachings of Deere and Doe. Moreover, what is inherent is not necessarily obvious. Answer B is incorrect because the test under § 103 is whether the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. The test is not whether it would have been obvious to the inventor. Answer (D) is incorrect at least because the background facts specifically state that the specification is fully enabling. Similarly, Answer (E) is incorrect because the question specifically states that the specification provides adequate disclosure as to what constitutes an “effective amount” of XYZ.

30. 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.

31. ANSWER: (A). See MPEP § 706.02(b) page 700-23 (8<sup>th</sup> ed.), under the heading “Overcoming a 35 U.S.C. § 102 Rejection Based on a Printed Publication or Patent.” (B), and (C) are incorrect because they present showings that support the rejection. See MPEP § 706.02(b), *supra*. (D) are not correct because to perfect priority under 35 U.S.C. §§ 119(e) or 120 it is, *inter alia*, necessary to amend the specification of the application to contain a specific

reference to a prior application having a filing date prior to the reference. See MPEP § 706.02(b), *supra*. Furthermore, the declaration is not to be amended. (E) is incorrect because (B), (C) and (D) are incorrect.

32. ANSWER: (B). Since Johnnie developed the material and James thought of the idea to use it in microwave ovens, they rightfully could be considered coinventors of the new article of manufacture. As to (A) and (C), public use began on when the experimental use ended on January 30, 2001, and occurs even when the public is unaware that they were walking on the developed material since the material was used in a public place. As to (D), even though James only took a second to think of the idea, he is entitled to receive a patent unless it was obvious to one of ordinary skill in the art. Nothing in the prior art revealed that it was obvious to use the material in microwave ovens. As to (E), the article of manufacture is not barred even though the floor material itself cannot be patented. Johnnie conducted an experimental use of the article from December 31, 2000 through January 30, 2001. Thereafter, Johnnie had one year from the end date of the experimental use to file a patent application for the article. Johnnie may file a patent application before January 30, 2002.

33. ANSWER: (D) is the most correct answer. 37 C.F.R. § 1.105, and 37 C.F.R. § 1.56(c). A named inventor, and an attorney who prepares and prosecutes the application, are identified in 37 C.F.R. § 1.56(c), and an assignee is specified in 37 C.F.R. § 1.105(a)(1). Therefore (D) is correct. (E) is incorrect because (D) is correct.

34. ANSWER: (E) is the most correct answer. 37 C.F.R. § 1.121(c) and (d), and MPEP § 714, page 700-169 through 172 (8<sup>th</sup> Ed.) (*Amendments, Applicant's Action*). (A) is incorrect. MPEP § 714.22, page 700-196, 197 (8<sup>th</sup> Ed.) (*Entry of Amendments*). Applicant may resubmit the amendment within any remaining period of time (set in the final rejection). No further extension of time or new time periods which might serve to extend the six month statutory period will be set in the advisory action. If time remains in the period set in the final rejection, applicants may resubmit the amendment, or request an extension of time (with appropriate fee) in which to do so, but will not be able to obtain an extension beyond the six-month statutory deadline. (B) is incorrect. MPEP § 714.22(a), page 700-198, (*Amendments Consolidating All Claims*). Applicants have the opportunity to consolidate all previous versions of pending claims from a series of separate amendment papers into a single clean version in a single amendment paper. This may be done at any time during prosecution of the application, though the entire clean claim set is subject to the provisions of 37 C.F.R. §§ 1.116(b) and 1.312. (C) is incorrect. MPEP § 714, page 700-169 through 172 (8<sup>th</sup> Ed.) (*Amendments, Applicant's Action*) While the first portion of the answer is correct because amendments to the drawings must be submitted on a separate paper showing the proposed changes in red for to the specification including the claims must be made by replacement paragraph/section/claim in clean form. This requirement is regardless of the mailing date of the Office action.

35. ANSWER: The correct answer is (D). The practice is set out in MPEP §1450. (A) is incorrect since the CAFC decision of *In re Amos*, 21 USPQ 2d 1271, held that reissue applicants have a right to claim any disclosed subject matter satisfying the first paragraph of 35 U.S.C. § 112. MPEP §1412.01. (A) and (B) are incorrect because the Office cannot reissue original unamended patent claims (where no error under 35 U.S.C. § 251 is corrected). (C) is incorrect

because the original patent can only be surrendered once. USPTO has procedures for transferring the original patent grant from a reissue application to an divisional reissue application. USPTO procedures do not provide for surrendering a duplicate copy of an original patent grant. Reference may be made to the application in which it is surrendered. MPEP §1416(E) is incorrect since 37 C.F.R. § 1.176 only authorizes restriction between the originally claimed subject matter of the patent and previously unclaimed subject matter.

36. ANSWER: (C) 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). (A) is a USPTO recommendation. See MPEP § 608.01(m) (“Similarly, product and process claims should be separately grouped.”). (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.”). (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.”).

37. 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 C.F.R. § 1.608 instead of 37 C.F.R. § 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 C.F.R. § 1.132.

38. ANSWER: (D) is the most correct answer. A reference is a “printed publication” if one of ordinary skill in the art can locate it with reasonable diligence. Its availability as prior art under § 102(b) depends upon proof of when the reference was “published” or became publicly accessible. Here, (D) is the correct answer because the Japanese patent application was published, *i.e.*, “laid open,” more than 1 year before applicant’s filing date. (C) is incorrect

because it was posted or published less than one year after applicant's filing date. (B) is incorrect because (1) the database retrieval date is after applicant's filing date, (2) the printout does not include the date on which the MEDLINE abstract was publicly posted and (3) reliance is on the printout per se not the actual article (reliance on the actual article would require getting the article and an English translation as well as determining the date when the journal was publicly available). (A) is incorrect because there is no evidence when the journal was publicly available. The examiner was unable to determine the actual date of publication. (E) is incorrect because (A), (B) and (C) are incorrect

39. 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.

40. ANSWER: (D) is the most correct answer. (A) and (B) are incorrect because, pursuant to MPEP § 503, the return postcard itself must specifically itemize the component parts of the new application. (C) is incorrect because, pursuant to MPEP § 503, the number of pages of each of the component parts of an application must be specified to obtain prima facie evidence of what was filed. In light of (A), (B), and (C) being incorrect, (E) is also incorrect.

41. ANSWER: Answer (A) is the best answer because it is an incorrect statement. See 37 C.F.R. § 1.131, which reads in relevant part:

(a)(2) A date of completion of the invention may not be established under this section before December 8, 1993, in a NAFTA country, or before January 1, 1996, in a WTO member country other than a NAFTA country.

(D) is correct statement. MPEP § 715.07. (B), (C) and (E) are also correct. 37 C.F.R. § 1.131. 35 U.S.C. § 104 (see history).

42. ANSWER: (D) is the most correct answer. See MPEP § 714.03. Homer's reply is a *bona fide* attempt to advance the application to final action. The amendment will be considered as a non-responsive amendment because it does not comply with 37 C.F.R. § 1.121. The applicant will be given a new time period of one month or 30 days from the mailing date of the notice of non-compliance to correct the amendment. 37 C.F.R. § 1.135(c); MPEP § 714.03. Answer (A) is incorrect because the application filed on December 3, 2001 is not eligible for the CPA practice. See MPEP § 706.07(h), page 700-71. Answer (B) is incorrect because the prosecution in the application is not closed. A reply in compliance with 37 C.F.R. § 1.111 is missing. See 37 C.F.R. § 1.114(a); MPEP § 706.07(h). Answer (C) is incorrect because action cannot be suspended in an application which contains an outstanding Office action awaiting reply by the applicant. See 37 C.F.R. § 1.103; MPEP § 709. Answer (E) is incorrect because the reply does not meet the requirements of 37 C.F.R. § 1.111 and is not considered a *bona fide* attempt under 37 C.F.R. § 1.135(c). Also the response does not reply to the drawing objections.

43. ANSWER: (D) is the most correct answer. 37 U.S.C. § 254, 37 C.F.R. § 1.322(a)(1)(ii), and MPEP § 1480, pages 1400-63 and 64, (8<sup>th</sup> Ed.), (*Certificates of Correction – Office Mistake*). (A) is incorrect. 37 C.F.R. § 1.322(a)(2), and MPEP § 1480, pages 1400-63 and 64, (8<sup>th</sup> Ed.), (*Certificates of Correction – Office Mistake*). Third parties do not have standing to demand that the Office issue or refuse to issue a certificate of correction. (B) is incorrect. 37 C.F.R. § 1.322(a)(4), and MPEP § 1480, page 1400-63, (8<sup>th</sup> Ed.), (*Certificates of Correction – Office Mistake*). The Office will not issue a certificate of correction under 37 C.F.R. § 1.322 without first notifying the patentee (including any assignee of record) at the correspondence address of record as specified in § 1.33(a) and affording the patentee or an assignee an opportunity to be heard. Additionally, the Office has the discretion to decline to issue a certificate of correction even though an Office mistake exists if the Office mistakes are of a nature that the meaning intended is obvious from the context. (C) is incorrect. 37 C.F.R. § 1.322(a)(3) and MPEP § 1480, pages 1400-63 and 64, (8<sup>th</sup> Ed.), (*Certificates of Correction – Office Mistake*). A request for a certificate of correction to correct a mistake in a patent incurred through the fault of the Office may relate to any issued patent including those involved in interference. Where the request relates to a patent involved in an interference, the request must comply with the requirements of 37 C.F.R. § 1.322 and be accompanied by a motion under 37 C.F.R. § 1.635. (E) is incorrect. 37 C.F.R. § 1.322(a)(1), and MPEP § 1480, pages 1400-63 and 64, (8<sup>th</sup> Ed.), (*Certificates of Correction – Office Mistake*). The Commissioner may also issue a certificate of correction to correct a mistake in a patent, incurred through the fault of the Office, acting *sua sponte* for mistakes that the Office discovers or acting on information about a mistake supplied by a third party.

44. ANSWER: (E) is the correct answer. 37 C.F.R. § 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 C.F.R. § 1.33(b). Thus (E), the most inclusive answer, is correct.

45. ANSWER: (E). See MPEP § 706.02(b) page 700-23 (8<sup>th</sup> ed.), under the heading “Overcoming a 35 U.S.C. § 102 Rejection Based on a Printed Publication or Patent.” (A), (B), and (C) alone, as well as (D) are not correct because they are not the most inclusive.

46. ANSWER: (A) is the most correct answer. The patentability of a product-by-process claim is determined based on the product itself, not on the process of making it. See *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985), and MPEP § 2113. (B) and (D) are not proper choices because when evidence indicates that the applicant’s product and that of the prior art are identical or substantially identical, the burden shifts to the applicant to overcome the rejection by providing evidence that the prior art product does not necessarily or inherently possess a relied-upon characteristic of the applicant’s claimed product. See *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980); *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977), and MPEP § 2112. (C) is not the proper choice because evidence of unexpected results is not relevant to anticipation. See *In re Malagari*, 499 F.2d 1297, 1302, 182 USPQ 549, 553 (CCPA 1974), and MPEP § 711.03(c). (E) is not the proper choice because a rejection under 35 U.S.C. § 102(b) is a statutory bar to patentability, and 37 C.F.R. § 1.131(a)(2) states that § 131 cannot be used to establish prior invention when the rejection is based upon a statutory bar.

47. ANSWER: (C). 35 U.S.C. §§ 111(b)(7), 119(e); 37 C.F.R. § 1.55, 1.78(a)(4); MPEP § 201.04(b) – page 200-16, and 201.15. (C) is true because X is not entitled to the Canadian application priority date because the nonprovisional application was filed more than one year from the filing date of the Canadian application. Furthermore, a provisional application is not entitled to claim priority based on any other application under 35 U.S.C. §§ 119, 120, 121, and 365. The earliest date that the nonprovisional application is entitled to claim is the January 19, 2001 date. Where applicant is not entitled to a priority date, MPEP § 201.15 states that an examiner may make a rejection based on an intervening reference. (A) is false because priority may not be claimed to the Canadian application because over 12 months elapsed between the filing of the Canadian application and the filing of the non-provisional US application and no priority claim is available via the provisional application. (B) is false. The patent term will be measured from the filing date of the provisional application. See MPEP § 201.04(b), page 200-16. (D) is false because (A) and (B) are false. (E) is false because (C) is true.

48. ANSWER: (B) is the most correct answer. 37 C.F.R. § 1.27 (a)(3)(i) & (ii) which prohibits claiming of small entity status if the nonprofit organization (a university) has assigned, granted, conveyed, or licensed any rights in the invention to any person, concern, or organization which would not qualify as a person, small business concern, or a nonprofit organization. In the example above, the licensee, ATC, does not qualify for small entity status. See also MPEP § 509.02 at pp. 500-32 to 500-34. Answer (A) is incorrect, because it does not matter that the university has over 500 students. A university can still qualify for small entity status even though it has more than 500 students. 37 C.F.R. § 1.27(a)(3)(ii)(A). Answer (C) is incorrect because the invention has been licensed to a large entity, and the size of the student body does not determine whether a university qualifies as a small entity. Answer (D) is incorrect because although PTI is an institution of higher education, there has been a license to an organization that does not qualify for small entity status. Answer (E) is incorrect because answer (B) is correct.

49. ANSWER: All answers accepted.

50. 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).

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

**APRIL 17, 2002**

**Afternoon Session (50 Points)**

**Time: 3 Hours**

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**DIRECTIONS**

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

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

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

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

**DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO**



This examination addresses statutes and rules that have been changed as a result of the enactment of the American Inventors Protection Act of 1999, Pub. L. No. 106-113 (“Act”). The 8<sup>th</sup> Edition of the Manual of Patent Examining Procedure should be used. The examination will apply rules that are in effect as April 1, 2002. The rule changes are posted under the heading “Recent Patent-Related Notices” on the USPTO web site ([www.uspto.gov/web/offices/pac/dapp/ogsheet.html](http://www.uspto.gov/web/offices/pac/dapp/ogsheet.html)). A group of rule changes, published in 67 Federal Regulations 520 (January 4, 2002) under the name “Revision of the Time Limit for National Stage Commencement in the United States for Patent Cooperation Treaty Applications,” will be in effect on April 1, 2002. This rule change is also available at the USPTO web site cited above under the heading “Recent Patent Related Notices.”

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

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

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

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

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

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

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

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

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

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

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

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

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

7. Which of the following is not in accordance with proper USPTO practice and procedure?

- (A) Conversion of a provisional application to a nonprovisional application will result in the term of any patent to issue from the application being measured from at least the filing date of the provisional application.
- (B) Conversion of a provisional application to a nonprovisional application cannot adversely impact on the term of any patent to issue from the application.
- (C) An applicant having filed a provisional application can avoid any adverse patent term impact resulting from converting the provisional application to a nonprovisional application by instead filing a nonprovisional application claiming the benefit of the provisional application under 35 U.S.C. § 119(e).
- (D) An applicant filing a nonprovisional application claiming the benefit under 35 U.S.C. § 119(e) and 37 CFR 1.78 of an earlier provisional application, and not requesting conversion of the provisional to a nonprovisional application can avoid the fee required to convert a provisional application to a nonprovisional application, as well as an adverse patent term effect that would result from a conversion.
- (E) The twelve month period of pendency of a provisional application extends to the next secular or business day which is not a Saturday, Sunday, or Federal holiday in the District of Columbia if the day that is twelve months after the filing date of the provisional application under 35 U.S.C. § 111(b) and 37 CFR 1.53(c) falls on a Saturday, Sunday, or a Federal holiday in the District of Columbia.

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

- (A) Applicant can pay a fee to file an information disclosure statement pursuant to 37 CFR 1.97(c) that is less than the fee required to be paid by other than a small entity.
- (B) Applicant can file a Continued Prosecution Application (“CPA”) using a certificate of mailing under 37 CFR 1.8 to obtain a U.S. filing date that is earlier than the actual USPTO receipt date of the CPA.
- (C) Applicant can pay a fee to file a petition for revival of an unavoidably abandoned application under 35 U.S.C. § 111 that is less than the fee required to be paid by other than a small entity.
- (D) After issuance of a non-final first action, but before the close of the prosecution in a patent application, applicant may properly file a Request for Continued Examination and pay a fee that is less than the fee required to be paid by other than a small entity.
- (E) None of the above.

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

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

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

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

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

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

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

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

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

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

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

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



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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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



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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

Claim 1. An apparatus for sitting comprising:

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

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

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

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



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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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**United States Patent and Trademark Office**  
**Registration Examination for Patent Attorneys and Agents**  
**April 17, 2002**

**Afternoon Session Model Answers**

1. ANSWER: (C) is the correct answer. MPEP § 2133.03(e). The issue is whether the invention was in “public use” more than one year prior to the filing of the application. The crux of the issue is whether the agreement, which is the only evidence the examiner relied upon, indicates that a “public” use has occurred. Issues arising under the public use bar of 35 U.S.C. § 102(b) are determined by considering the totality of the circumstances. In re Brigrance, 792 F.2d 1103, 1107, 229 USPQ 988, 991 (Fed. Cir. 1986). The circumstances are that: 1) Even if Cone received the ball, she was limited to using it for experimental, not public, uses. And, finally, 2) even though Cone can conduct experiments with the ball, control of the ball remains with Block. In view of all these facts, the totality of the circumstances leads to the conclusion that a “public use” more than one year prior to the filing of the application did not occur. In view of this response, and assuming no other evidence of a public use is available, the rejection under 35 U.S.C. § 102(b) under these grounds should be withdrawn. (A) is wrong because it is not enough that a document is dated more than one year prior to the filing date of an application for it to constitute a statutory bar under 35 U.S.C. § 102(b). The issue to be addressed by Block is whether the examiner appropriately rejected the claim over the “public use” clause of 35 U.S.C. § 102(b), not the “printed publication” clause. (B) is wrong because whether or not the agreement is a printed publication is irrelevant. The rejection is on the grounds of “public use”, not “printed publication”. (D) is wrong because the issue of whether an invention was “known or used by others in this country” is relevant to a rejection under 35 U.S.C. § 102(a), not § 102(b) which is at issue here. Furthermore, the fact that Cone also signed the agreement suggests “others” were associated with the use of the invention which would mean this response is incorrect even if the issue was the propriety of a rejection under 35 U.S.C. § 102(a). In that situation, the issue would not be whether it was used by others, since it plainly was, but rather whether the use was a “public” one. (E) is wrong because it assumes that the issue is whether the invention was “on sale”. While the rejection was under 35 U.S.C. § 102(b), the “public use” clause, not the “on sale” clause is at issue. Whether or not the ball was on sale or not is irrelevant to overcoming the rejection.

2. ANSWER: (E) is the correct answer. 37 C.F.R. § 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.

3. ANSWER: The correct answer is (C). 37 C.F.R. § 1.173 and MPEP § 1453 both provide for making amendments in reissue applications. 37 C.F.R. § 1.121(h) refers reissue applicants to § 1.173 for making amendments in reissues. (A), (B), and (D) present proper USPTO procedures, and are therefore incorrect answers. (A) is incorrect as it is consistent with current filing requirements of 37 C.F.R. § 1.173 and MPEP § 1411. (B) is incorrect because it is consistent with the holding in *In re Graff*, 42 USPQ2d 1471, and MPEP § 1412.03. (D) is incorrect because 35 U.S.C. § 251 sets a two-year limit for filing broadened reissue applications. MPEP § 1414. (E) is incorrect because (C) is correct.



4. 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.).

5. ANSWER: (A) is the most correct answer. See 37 C.F.R. § 1.48(b) (where the claims covering that inventor’s invention are cancelled, a statement regarding lack of deceptive intent is not required). (B) is incorrect. See 37 C.F.R. § 1.48(e)(2). (C) is incorrect. See 37 C.F.R. § 1.48(c)(5). (D) is incorrect. See 37 C.F.R. § 1.48(d)(1). (E) is incorrect. See 37 C.F.R. § 1.48(a), (b) & (c).

6. ANSWER: (C) is the most correct answer. MPEP § 715.04 pages 700-207 and 208 (8<sup>th</sup> ed.), under the heading “WHO MAY MAKE AFFIDAVIT OR DECLARATION” states “[t]he following parties may make an affidavit or declaration under 37 C.F.R. [§] 1.131: ... (B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.” In addition, 37 C.F.R. § 1.131(a) states “... the inventor of the subject matter of the rejected claim ... or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration...” Accordingly, answer (A) is incorrect because a declaration with less than all named inventors is acceptable when it is shown that less than all named inventors of an application invented the subject matter of the claim under rejection. Answer (B) is incorrect because the declaration was properly signed. Answer (D) is incorrect because 37 C.F.R.

§ 1.131(a) expressly provides for who must sign the declaration. Answer (E) is incorrect because it is the inventor of the subject matter of the claim under rejection who must sign the declaration, not any inventor named on the application.

7. 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).

8. ANSWER: (C) is the correct answer. 35 U.S.C. § 41(h), 37 C.F.R. §§ 1.17(l) and 1.27(b). (A) is incorrect because 37 C.F.R. § 1.17(p) provides for only one fee for filing an IDS all parties must pay that fee. There is no support in 37 C.F.R. § 1.17(p) for a small entity paying a reduced fee for filing an IDS. (B) is incorrect because it is inconsistent with 37 C.F.R. § 1.8(a)(2)(i)(A). (D) is incorrect because it is inconsistent with 37 C.F.R. § 1.114(a), inasmuch as prosecution is not closed. (E) is incorrect because (C) is correct.

9. ANSWER: (D) is correct. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP § 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). Here, the examiner fails to show that substituting Larry’s device for another type of device in Morris would have been desirable. (A) is incorrect. The test of obviousness is not whether the features or elements of the references are physically combinable. *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981); *In re Sneed*, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983). (B) is incorrect. “The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law.” MPEP § 2144 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)). Here, the argument overlooks the fact that a suggestion to combine Larry and Morris may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. (C) is incorrect. “The fact that a

combination would not be made by businessmen for economic reasons does not mean that a person of ordinary skill in the art would not make the combination because of some technological incompatibility.” MPEP § 2145 (citing *In re Farrenkopf*, 713 F.2d 714, 718, 219 USPQ 1, 4 (Fed. Cir. 1983)). Here, the high cost of Barry’s device does not teach away from a person of ordinary skill in the art combining it with Lance’s device.

10. ANSWER: (C) is the most correct answer. 37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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.

11. ANSWER: (A). As to (B) and (E), an actual reduction to practice is not a necessary requirement for filing an application so long as the specification enables one of ordinary skill in the art to make and use the invention. However, (D) is incorrect, as a reduction to practice may not be established since the camera leaked. As to (C), a second provisional is not entitled to the benefit of the filing date of the first provisional application. 35 U.S.C. § 111(h)(7).

12. ANSWER: (C) is correct. “If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). Here, the combination would render Lance’s device unsatisfactory for its intended purpose. (A) is incorrect. “The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference .... Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art.” MPEP §2145, paragraph III (quoting *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)). Here, the argument fails to address what the combined teachings of the references would or would not have suggested to those of ordinary skill in the art. (B) is incorrect. “In order to rely on a reference as a basis for rejection of the applicant’s invention, the reference must either be in the field of the applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” MPEP § 2141.01(a) (quoting *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)). Here, Barry’s art could still be analogous if it was reasonably pertinent to the particular problem with which the applicant was concerned. (D) is incorrect. The argument addresses a rejection under 35 U.S.C. § 102, as opposed to the rejection that was made, under 35 U.S.C. § 103, which raises obviousness, not anticipation, issues. (E) is not correct because (A), (B) and (D) are incorrect.

13. ANSWER: (E) is the correct answer. 37 C.F.R. § 1.115(b)(1). 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.

14. ANSWER: (D) is the correct answer. 37 C.F.R. § 1.97(c). (A) and (B) are each incorrect at least because the Office action is non-final and the RCE is improper. 37 C.F.R. § 1.114(b) and MPEP § 706.07(h). According to MPEP § 706.07(h)(III)(A)(1), “If prosecution in the application is not closed, applicant will be notified of the improper RCE and any amendment/reply will be entered.” However, since the submission of the IDS in (A) and (B) is after the mailing of a first Office action, either the fee set forth in 37 C.F.R. § 1.17(p) or a statement as specified in 37 C.F.R. § 1.97(e) is required. 37 C.F.R. § 1.97(c). (C) is incorrect at least because the submission of the IDS is after the mailing of a first Office action, and either the fee set forth in 37 C.F.R. § 1.17(p) or a statement as specified in 37 C.F.R. § 1.97(e) is required. 37 C.F.R. § 1.97(c). (E) is incorrect because (D) is correct.

15. ANSWER: (B) is the most correct answer. 37 C.F.R. § 1.121(b), and MPEP § 714, page 700-169 through 172 (8<sup>th</sup> ed.) (*Amendments, Applicant’s Action*). (A) is incorrect. MPEP § 714, page 700-171 (8<sup>th</sup> Ed.) (*Amendments, Applicant’s Action*) “After March 1, 2001, all amendments to the specification including the claims must be made by replacement paragraph/section/claim in clean form.” This requirement is regardless of the filing date of the application.” (C) is incorrect. 37 C.F.R. § 1.121(c)(1), and MPEP § 714, page 700-172 (8<sup>th</sup> ed.) (*Amendments, Applicant’s Action*) “A marked up version does not have to be supplied for any added or cancelled claims.” (D) is incorrect. MPEP § 714, page 700-171 and 172 (8<sup>th</sup> Ed.) (*Amendments, Applicant’s Action*) all amendments to the specification including the claims must be made by replacement paragraph/section/claim in clean form. Exceptions are not made for inserting priority information. Additionally, the use of replacement pages is not accepted in amending U.S. applications under 37 C.F.R. § 1.121. See Patent Business Goals – Final Rule, 65 *Fed. Reg.* 54639, Response to Comment 61. (E) is incorrect. MPEP § 714.01(e) page 700-174 (8<sup>th</sup> Ed.) (*Amendments Before First office Action*) A one-month non-extendable time period is given to applicants in which they are to bring the amendment into compliance with 37 C.F.R. § 1.121.

16. ANSWER: (B) 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 (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. Answer (E) 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.

17. ANSWER: The correct answer is (C). Inter partes reexaminations are available only for patents that issued from an original application filed on or after November 29, 1999. 37 C.F.R. § 1.913. An original application is any application other than a reissue application. MPEP § 201.04(a). (A) is incorrect because R2 is a reissue that is based on a patent, which in turn, issued from a patent application that was filed in 1993 (which is before the November 29, 1999 date); and because P3 issued from an application filed before November 29, 1999. (B) is incorrect because R2 is a reissue, and did not issue from an original application, and because an ex parte reexamination of P1 would not permit Mr. Flash to participate in the reexamination. (D) is not the most correct answer because ex parte reexamination of P1 would not permit Mr. Gordon to participate to the same extent as in inter partes reexamination. (E) is incorrect because P3 did not issue from an application filed on or after November 29, 1999.

18. ANSWER: (B) is the correct answer. 35 U.S.C. § 116 states that “[w]hen an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath,” 37 C.F.R. § 1.63(a)(4) states that the oath “must state that the person making the oath or declaration (2) believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought,” 37 C.F.R. § 1.64(a) states that “[t]he oath or declaration...must be made by all of the actual inventors.” Rocket invented all the claimed elements except for the Y-shaped laces. Torpedo’s contribution to the baseball was the Y-shaped laces. Therefore, Rocket and Torpedo must execute the oath. (A) is incorrect because Rocket is not the sole inventor. (C), (D), and (E) are incorrect because neither Cannon nor Missile contributed to any portion of the claim for which a patent is sought.

19. ANSWER: (D) is the most correct answer. 37 C.F.R. § 1.42 states that “[I]n case of the death of the inventor, the legal representative...of the deceased inventor may make the necessary oath.” (A), (B), and (C) are incorrect because the facts do not reveal an assignment to Paper America. Inasmuch as the given facts show that the officers and employees are not related to the Rocket, they may not act as Rocket’s legal representative.

20. ANSWER: (D) is the correct answer. 37 C.F.R. § 1.10 states that “[a]ny correspondence received by the Patent and Trademark Office (Office) that was delivered by the ‘Express Mail Post Office to Addressee’ service of the United States Postal Service (USPS) will be considered filed in the Office on the date of deposit in with the USPS.” Although the Rocket application could have been deposited in the USPS as early as October 13, 2001, the facts indicate that the application was not actually deposited until October 22, 2001. MPEP § 573. Therefore, the only filing date that the USPTO will accord the application is October 22, 2001. (A), (B), (C) and (E) are incorrect because the application was not deposited in the USPS on any of these dates.

21. 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.

22. ANSWER: (E) is the correct answer. 35 U.S.C. §251. The reissue permits Smarter to broaden the claimed subject (A) is incorrect. There must be copendency between the divisional application and the original application. 35 U.S.C. § 120. (B) This is incorrect, as an applicant's failure to timely file a divisional application while the original application is still pending is not considered to be an error correctable via reissue, *In re Orita*, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977). (C) This is incorrect, as an applicant's failure to timely file a divisional application while the original application is still pending is not considered to be an error correctable via reissue, *Id.*, including a divisional reissue application. MPEP § 1402. (D) This is incorrect, as an applicant's failure to timely file a divisional application while the original application is still pending is not considered to be an error correctable via reissue, *Id.*

23. ANSWER: (A). As to (A) see 37 C.F.R. § 1.10(a), which provides, "Any correspondence received by the [USPTO] that was delivered by the 'Express Mail Post Office to Addressee' service of the United States Postal Service (USPS) will be considered filed in the [USPTO] on the date of deposit with the USPS. The date of Deposit with the USPS is shown by the 'date-in' on the 'Express Mail' mailing label or other official USPS notation.". As to (B), (C) and (D), no such procedures are available in the USPTO. (C) is wrong since the claims of the application of Mike and Millie may read on the invention of Jill and Jack in which case an interference would be declared to determine priority and only one application would issue. As to (E), see 37 C.F.R. § 1.10(a), which does not require Mike and Millie to certify when they mailed the application for the USPTO to accord them a filing date of September 15, 2001. Mike and Millie followed to the procedures of § 1.10(a) to be accorded a September 15, 2001 filing date.

24. ANSWER: (E) is the most correct answer. MPEP § 706.02 page 700-20 (8<sup>th</sup> ed.), under the heading "DETERMINING THE EFFECTIVE FILING DATE OF THE APPLICATION" states "[t]he effective filing date of a U.S. application may be determined as follows: ... (B) If the application is a continuation-in-part of an earlier U.S. application, any claims in the new application not supported by the specification and claims of the parent application have an effective filing date equal to the filing date of the new application. Any claims which are fully supported under 35 U.S.C. § 112 by the earlier parent application have the effective filing date of that earlier parent application." Accordingly, the effective filing date of claims 1-10 is 1995 and the effective filing date of claims 11-15 is 2000. Answers (A) and (B) are incorrect because they do not account for the two different effective filing dates. Answers (C) and (D) are both correct, therefore answer (E) which includes both (C) and (D) is the most correct answer.

25. 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).

26. ANSWER: The best answer is (B), because, under the facts as stated, the Wicks and Sticks article “shows a drawing of a dissimilar candle that would nevertheless *raise a question of patentability*” (italics added). Although the published article might not be anticipatory, it can raise a substantial new question of patentability under 37 C.F.R. § 1.515. (A) is incorrect because it is not error to fail to claim restricted inventions that were not elected and that were not claimed in divisional applications. In re *Orita* 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977); MPEP § 1450. (C) is not the best answer because there is no copendency between the new nonprovisional application and parent application that issued as patent P2. 35 U.S.C. § 120. (D) is not correct because broadened claims may not be filed in a reexamination. (E) is not the best answer because it is not clear there is an “error” under 35 U.S.C. § 251 with respect to the claims for the reflective housing. MPEP §§ 1402, 1450.

27. ANSWER: The correct answer is (C) because (1) the declaration identified the application and the full name and citizenship of both inventors and (2) a copy of the application was sent to inventor B to review and understand. Answer (A) is incorrect because inventor B never reviewed and understood the application prior to signing the declaration form. Answer (B) is incorrect because (1) each declaration form failed to identify all the inventors (e.g. both inventors A and B) and (2) a copy of the application was not sent to inventor B to review and understand. Answer (D) is incorrect because inventor B never signed the declaration. Answer (E) is incorrect because petitions for nonsigning inventors must be filed under 37 C.F.R. § 1.47, not § 1.48.

Even if the petition is treated under § 1.47 a statement, that B's signature could not be obtained at this time, is insufficient.

28. 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).

29. ANSWER: The model answer is choice (E). 37 C.F.R. §§ 1.217(d), 1.14(c)(2), and MPEP § 103, subsection "Published U.S. Patent Applications." 37 C.F.R. § 1.14 provides that while a published application is still pending the file itself will not be available to the public but copies of the application may be ordered. If a redacted copy of the application was published, copies of the redacted application and redacted materials will be provided under 37 C.F.R. § 1.217(d). Answer (A) is incorrect because at least the redacted portion of any subsequent prosecution history can be ordered. Answer (B) is incorrect. Access is not provided to inspect the application file of pending published applications, MPEP § 103. Only copies of the application file may be ordered. Answers (C) and (D) are incorrect because inspection of the application file of a pending published application is not permitted. MPEP § 103. A member of the public may request only copies of the application file.

30. ANSWER: (A) 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. (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. (D) 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. (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.

31. ANSWER: The most correct answer is (E). The application will not be published and the continuing application will have an effective filing date of January 3, 2000. Answer (A) is incorrect because the nonpublication request under 35 U.S.C. § 122(b)(2)(B)(i) must be made upon filing. See 35 U.S.C. § 122(b)(2)(B)(i). Answer (B) is incorrect because the provisional application that resulted from the conversion cannot claim the benefit of the first provisional application filed on January 3, 2000. See 37 C.F.R. § 1.53(c)(4). Answer (C) is incorrect because the application will be abandoned and Smith's right in claiming the benefit of the provisional application will be lost. Answer (D) is incorrect because the nonprovisional application filed on January 2, 2001 is not eligible for the CPA practice. See MPEP § 706.07(h), page 700-71.



32. ANSWER: (E) is the most correct answer. 37 C.F.R. § 1.194(b) reads “If appellant desires an oral hearing, appellant must file, in a separate paper, a written request for such hearing accompanied by the fee set forth in § 1.17(d) within two months from the date of the examiner’s answer.” Choices (A), (B), (C) and (D) are not required by 37 C.F.R. § 1.194, and are therefore incorrect answers to the above question. Further, communications with the Office are to be conducted in writing. 37 C.F.R. § 1.4(d).

33. 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.

34. ANSWER: (B). See 37 C.F.R. § 1.114(e)(1). Answer (A) is wrong because the issue fee has been paid and § 1.114(a)(1) prohibits an RCE unless a petition under § 1.313 is granted. Answer (C) is wrong for the same reason and further if the application had been abandoned an RCE could not be filed. Answer (D) is wrong because RCE practice does not apply to provisional applications under 37 C.F.R. § 1.114(e)(5). (E) is wrong because, as explained in (B), after the issue fee is paid, you cannot file an RCE unless you have successfully withdrawn the case from issue by petition under 37 C.F.R. § 1.313.

35. ANSWER: (D) is correct and (A), (B), (C), and (E) are wrong. Under 37 C.F.R. § 1.211:

(b) Provisional applications under 35 U.S.C. § 111(b) shall not be published, and design applications under 35 U.S.C. chapter 16 and reissue applications under 35 U.S.C. chapter 25 shall not be published under this section.

Emphasis added.

36. 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 C.F.R. § 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 C.F.R. § 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.”

37. ANSWER: (D) is correct. It is the only answer that proposes to use a practice and procedure that is available to Einstein. 35 U.S.C. § 302. (A) This is incorrect because a statement by the currently named inventor as required by 37 C.F.R. § 1.324(b)(2) and the fee required by 37 C.F.R. § 1.20(b) have not been filed. (B) This is incorrect, as in *A.F. Stoddard & Co. v. Dann*, 564 F.2d 556, 567 n.16, 195 USPQ 97, 106 n.16 (D.C. Cir. 1977) wherein correction of inventorship from sole inventor A to sole inventor B was permitted in a reissue application, does not apply here, as a reissue application can only be filed by the inventor(s) or assignee(s). See MPEP § 1412.04. (C) This answer is incorrect because it refers to sales, as opposed to patents or printed publications. (E) The option of requesting *inter partes* reexamination is not available in this scenario, as the patent in question issued from an original application which was filed prior to the critical date of November 29, 1999. Only patents which issued from original applications filed in the United States on or after November 29, 1999, are eligible for *inter partes* reexamination (37 C.F.R. § 1.913).

38. ANSWER: (E), which includes answers (A) and (D), is the correct answer. Answer (A) is correct. Where an application is filed identifying the inventorship but an executed declaration under 37 C.F.R. § 1.63 has not been filed, the first submission of an executed declaration under 37 C.F.R. § 1.63 will automatically act to correct the earlier identification of the inventorship. 37 C.F.R. § 1.48(f)(1). Answer (D) is correct. A continuation using a copy of a declaration under 37 C.F.R. § 1.63 from a prior application may be filed naming fewer than all the named inventors in the prior application provided a request for deletion of an inventor accompanies the declaration copy. 37 C.F.R. § 1.53(b)(1), 37 C.F.R. § 1.63(d)(1)(iv), and 1.63(d)(2). Answer (B) is incorrect. Where a declaration under 37 C.F.R. § 1.63, signed by at least one of the inventors, has been submitted to the Office, submission of a second executed declaration under 37 C.F.R. § 1.63 setting forth a different inventive entity will not act to correct the inventorship absent a petition under 37 C.F.R. § 1.48(a). 37 C.F.R. § 1.48(f)(1). Answer (C) is incorrect. Inventorship cannot be corrected by adding an inventor through the filing of a continued prosecution application, rather a petition under 37 C.F.R. § 1.48 is required. 37 C.F.R. § 1.53(d)(4).

39. ANSWER: (E) is the correct answer as both answers (A) and (C) are in accordance with Office practice. Answer (A) is a correct answer as the payment of the small entity filing fee will be treated as a written assertion of entitlement to small entity status pursuant to 37 C.F.R. § 1.27(c)(3). Answer (C) is a correct answer as once small entity status is properly established on filing of the application small entity fees may continue to be paid without regard to a change in status, such as for a claim fee, until the issue fee is due pursuant to 37 C.F.R. § 1.27(g)(1). Answer (B) is not a correct answer. Although a new determination of entitlement to small entity status is made upon payment of the issue fee, a written assertion of entitlement to small entity

status is not required at this time. Once established, small entity status remains in effect unless the facts change. . Answer (D) is not a correct answer. At the time of payment of the issue fee the registered practitioner cannot rely upon the previous written assertion of small entity status completed at the time of filing the application. Applicant must conduct a new investigation as to entitlement to small entity status at the time of payment of the issue fee pursuant to 37 C.F.R. § 1.27(g)(1). If small entity status is determined to continue to be appropriate at the time of payment of the issue fee, a small entity issue fee can be paid based on such determination and a written assertion need not be presented at that time pursuant to 37 C.F.R. § 1.27(e)(1).

40. ANSWER: (D) 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). (C) is incorrect because it does not refer back in the alternative only. MPEP § 608.01(n). (E) is incorrect because (D) is correct.

41. ANSWER: All answers accepted.

42. 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.

43. ANSWER: The correct answer is (B). See MPEP § 201.13. An application must be filed in the U.S. within 12 months from the earliest foreign filing, except as provided in 35 U.S.C. § 119(c). Therefore, you would have one year from December 28, 2000 to file in the U.S. because invention X was first filed in Germany on December 28, 2000. Thus, you have until December 28, 2001 and the USPTO is open for business. The exception in 35 U.S.C. § 119(c) does not apply because the German application was abandoned after the filing of the second foreign application, the French application. Further, the subsequently filed application must be filed in the same country. Answer (A) is not the latest date to file.. See 35 U.S.C. § 21 and MPEP § 201.13, Part D. Answer (C) is too late to obtain the right of priority for invention X inasmuch as the USPTO was open for business on December 28, 2001. Answers (D) and (E) are also too late to obtain the right of priority for invention X as it was disclosed in a foreign application more than a year prior to those dates.

44. ANSWER: (B) is the correct answer. 35 U.S.C. § 112, second paragraph, 35 U.S.C. § 101, and MPEP § 2173.05(h)(II). (A) is incorrect because the claim presented in (A) attempts to claim a process without setting forth any steps involved in the process. MPEP § 2173.05(q). (C) is incorrect because the claim presented in (C) recites "an effective amount" without stating the function that is to be achieved, and more than one effect can be implied from the specification. *In re Frederickson* 213 F.2d 547, 102 USPQ 35 (CCPA 1954). It is unclear whether "an effective amount" in (C) is an effective amount to increase stickiness or an effective amount to

increase hardness. MPEP § 2173.05(c)(III). (D) is incorrect because it is unclear whether “preferably between 15 and 20 degrees Celsius” is a limitation on the scope of the claim presented in (D). MPEP § 2173.05(c)(I). (E) is incorrect at least because the claim presented in (E) claims both a composition and a process of using it. MPEP § 2173.05(p)(II). Further, the portion of the claim in (E) drawn to a process of using the composition does not set forth any steps involved in the process. MPEP § 2173.05(q).

45. ANSWER: (D) is the correct answer. 37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 1.33(a)(1), (D) is correct. (E) is incorrect because (D) is correct.

46. ANSWER: (D) is the correct answer. 37 C.F.R. § 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 C.F.R. § 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.

47. ANSWER: The model answer is choice (A). MPEP § 608.05 and § 608.05(a) and (b), computer program listing of more than 300 lines (up to 72 characters per line) must be submitted on a compact discs. See 37 C.F.R. §§ 1.96(c) and 1.52(e). Tables over 50 pages and computer program listings of any size under 300 lines (up to 72 characters per line) may be submitted on compact disc. If the table and/or computer program listing is submitted on compact disc then a duplicate copy of each compact disc must also be submitted. Answer B is incorrect since only CD-R and CD-ROM are acceptable media for submitting computer program listing not floppy discs; and it is applicant’s option to file the table on CD-R/CD-ROM media rather than paper. Answer C is incorrect since only CD-R and CD-ROM are acceptable media for submitting computer program listings of over 300 lines, not floppy discs, magnetic tape or paper. Answer D is incorrect because it is not mandatory to submit tables over 50 pages on compact disc while it is mandatory to submit computer program listings over 300 lines (up to 72 characters per line) on compact disc. Also, only CD-R and CD-ROM are acceptable media for submitting computer program listings and tables, not floppy discs, magnetic tape or paper. Answer E is incorrect because only tables over 50 pages, computer program listings and genomic sequence information may be filed on compact disc. 37 C.F.R. § 1.52(e). Also, the compact disc must be provided in duplicate.

48. ANSWER: The correction answer is (B). No extensions of time under 37 C.F.R. § 1.136 are permitted. See 37 C.F.R. § 1.85(c). Therefore, the drawings must be filed three months from the mailing date of the Notice of Allowability, which is June 26, 2002. Answer (A) is not the latest date. Answers (C), (D) and (E) are incorrect as no extensions of time are permitted.

49. ANSWER: (D) is the correct answer. In addition to the surcharge, only what was required in the notice, an executed declaration should be filed. 37 C.F.R. § 1.48(f)(1). As to (A), it is improper to continue to represent that Stripe is an inventor when it is recognized that Stripe is not an inventor. 35 U.S.C. § 116, third paragraph. As to (B), a request to delete an inventor is not necessary because the inventors are not considered named until an executed declaration has been filed. As to (C), a petition under 37 C.F.R. § 1.47 would only be appropriate if Stripe was an inventor. Since he is not, then no declaration naming him should be submitted. As to (E), to avoid abandonment of the application, the missing parts must be filed within the time period set forth in the notice, or as extended by applicant.

50. 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 permitted by the MPEP. See 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).