

## OmniPrep Development Team Chapter Exam Introduction:

These chapter exam questions are taken from actual past exams and grouped by MPEP chapter. For each chapter, the questions are ordered from the most recent exam to the oldest exam. By looking at the number of questions in each chapter, you can see which chapters are more heavily tested than others. In some cases, questions are reused from year-to-year. Sometimes, the question is exactly the same or it is slightly changed, so be careful and read every question and every answer like it is a new question. Also, make sure that you know these questions, because reused questions are easy points on the exam. In addition, make sure that you know the topics that are tested in each question. The questions may change from year to year, but the core topics tested remain the same. We have excluded some of the reused questions in the review, but you will see them when you take the past exams. You will also notice that some questions accept all answers and some of these questions are reused. Even though all of the answers accepted, be sure to know the topics tested. In order to better focus your studies, we have omitted exam questions previous to 1999. Additionally, we have grouped the chapter exams into 100 - 700 and 2100, and then all of the rest, which focuses you on the most important chapters first.

# **Chapter 100**

## **Questions**

April 15, 2003 PM

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

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

April 15, 2003 PM

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

- (A) Joan may obtain status information for Application B that is a continuation of an Application A since Application A has been published under 35 USC 122(b).
- (B) Joan may be provided status information for Application D that includes the filing date if the eight-digit numerical identifier is not available and the last six

digits of the numerical identifier are available.

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

April 15, 2003 PM

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

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

October 16, 2002 AM

21. Which of the following documents is not open to public inspection?

- (A) The abandoned parent application of a divisional application. A patent was granted on the divisional application, which refers to the abandoned parent application.
- (B) Assignment document relating to both an issued patent and a patent application not published under 35 USC 122(b).
- (C) Assignment document relating to a pending reissue application.
- (D) Copy of assignment record relating to both a pending patent application and an abandoned patent application not published under 35 USC 122(b).
- (E) Assignment document relating to both an abandoned patent application not published under 35 USC 122(b) and a pending reissue application.

October 16, 2002 PM

45. In accordance with Chapter 100 of the Manual of Patent Examining Procedure and 35 USC 122, which of the following statements is not true?

- (A) All requests for reexamination and related patent files are available to the public subject to the availability of the reexamination file.
- (B) The Board of Patent Appeals and Interferences handles all petitions for access to applications involved in an interference.
- (C) An abandoned application referenced in a U.S. patent application publication, U.S. patent or a U.S. application that is open to public inspection may be ordered for inspection by any member of the public.
- (D) The assignee of record of a part interest in an application may always intervene in the prosecution of the application, appointing a registered attorney or agent of his or her own choice, without participation by any or all other assignees.
- (E) All provisional patent applications are screened upon receipt in the USPTO for subject matter that, if disclosed, might impact the national security, and such applications are referred to appropriate agencies for consideration of restrictions on disclosure of the subject matter.

April 17, 2002 AM

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 nonelected 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.

April 17, 2002 PM

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.

October 17, 2001 AM

4. Assuming a PCT international application has been filed by a resident of France designating the U.S., a written request for a copy of \_\_\_\_\_ will be honored upon a showing that the international application was published in accordance with PCT Article 21(2) and the appropriate fee was paid. Fill in the blank with the answer that accords with proper USPTO practice and procedure.

- (A) the home copy, where the international application was filed with the U.S. Receiving Office
- (B) the search copy, where the U.S. acted as the International Searching Authority
- (C) the examination copy, preliminary to issuance of the International Preliminary Examination Report, where the U.S. acted as the International Preliminary Examination Authority, and the U.S. was elected
- (D) the English language translation of the home copy, where the international application was filed with the U.S. Receiving Office
- (E) the English language translation of the examination copy, preliminary to issuance of the International Preliminary Examination Report, where the U.S. acted as the International Preliminary Examination Authority, and the U.S. was elected

October 17, 2001 PM

27. Mary, a legally competent adult inventor, filed provisional application A on January 3, 2000, a nonprovisional application B one year later on January 3, 2001, and nonprovisional application C on February 28, 2001. Nonprovisional application B was abandoned when nonprovisional application C was filed. The provisional application and both nonprovisional patent applications were in Mary's name only, but a declaration has not yet been filed. Mary is living on a remote island in the middle of the Arctic Ocean where the only communication is in the summer months. Sam, the father of Mary, has been authorized by Mary to sign Mary's name to the § 1.63 declaration and also Sam's name. Sam, unbeknownst to Mary, also wants access to all three application files at the USPTO before he files the declaration to make certain Mary has properly described her invention. Sam acknowledges he is not an inventor but insists he must sign as an inventor so that he may act on behalf of Mary. Which of the following is not in accordance with proper USPTO procedure in relation to applications filed on or after January 1, 2001?

- (A) Sam may not add his name as an inventor since a patent is applied for only in the name or names of the actual inventor or inventors.
- (B) Since no declaration was filed during the pendency of application B, Sam may not see the Application papers for application B since he has not been authorized by Mary to see the application A and Sam is not an inventor.
- (C) Sam is not entitled to access to the provisional application A since he has not been authorized by Mary to see the application A and Sam is not an inventor.
- (D) Sam is precluded from access to the Application B since his name does not appear on the application papers and Sam is not an inventor.
- (E) Sam may sign Mary's name to the declaration since he was authorized by Mary to do so.

April 18, 2001 PM

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

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

November 3, 1999 AM

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

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

November 3, 1999 PM

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

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



# **Chapter 100**

## **Answers**

April 15, 2003 PM

9. ANSWER: (C) is the most correct answer. MPEP § 106 states: “[t]he assignee of record of the entire interest in an application may intervene in the prosecution of the application, appointing an attorney or agent of his or her own choice. See 37 CFR § 3.71. Such intervention, however, does not exclude the applicant from access to the application to see that it is being prosecuted properly, unless the assignee makes specific request to that effect.” (A), (B), (D), and (E) are incorrect. MPEP § 409.03(i) is directly contrary to answer (A), and provides that a non-signing inventor cannot revoke or give a power of attorney without agreement of all named inventors or the 37 CFR § 1.47(b) applicant. (B) is incorrect. MPEP § 106 does not empower an inventor who has assigned his or her rights to exclude a non-signing joint inventor from accessing an application in which the latter party is named as a joint inventor. (E) is incorrect. MPEP § 106. Corporation D, as an assignee of a part interest, cannot exclude the non-signing joint inventor from access to the application. See also, MPEP § 106.01, which states “While it is only the assignee of record of the entire interest who can intervene in the prosecution of an application or interference to the exclusion of the applicant, an assignee of a part interest or a licensee of exclusive right is entitled to inspect the application.” (D) is incorrect because MPEP § 409.03(i) states that a nonsigning inventor is entitled to inspect any papers in the application, and order copies at the price set forth in 37 CFR § 1.19.

April 15, 2003 PM

30. ANSWER: Statement (E) is false, and is thus the most correct answer. Since a redacted copy of the application was used for publication purposes, 37 CFR § 1.14 (c)(2) provides that “(2) If a redacted copy of the application was used for the patent application publication, the copy of the specification, drawings, and papers may be limited to a redacted copy.” For (A) and (B), see 37 CFR § 1.14(b)(2). For (C) see 37 CFR §§ 1.14(b)(2) and (c)(1)(i). As to (D), a coinventor is entitled to access to the application independent of whether or not he or she signed the declaration. Note that as stated in 37 CFR § 1.41(a)(2), if a declaration or oath is not filed, the inventorship is that inventorship set forth in the application papers.

April 15, 2003 PM

33. ANSWER: (E) is the most correct answer. MPEP § 103, under the heading “Published U.S. Patent Applications” states that “If a patent application has been published pursuant to 35 U.S.C. 122(b), then a copy of the specification, drawings, and all papers relating to the file of that published application (whether abandoned or pending) may be provided to any person upon written request and payment of the fee.” (A) and (B) are not correct. 37 CFR § 1.14(c)(2). Once an application has been published, a copy is available to the public upon written request and payment of a fee. (C) and (D) are not correct. As stated in MPEP § 103, under the heading “Published U.S. Patent Applications,” if the published patent application is pending, the application file itself will not be available to the public for inspection.”

October 16, 2002 AM

21. ANSWER: (D) is correct. (A) is wrong. 37 C.F.R. § 1.14(e)(2); MPEP § 103, application files are available upon request because the divisional application refers to the abandoned parent application, and the division issued as a patent, causing the application to be open to inspection. (B), (C) and (E) are wrong and (D) is correct. MPEP § 301.01.

October 16, 2002 PM

45. ANSWER: The best choice is (D). Choices (A), (B), (C) and (E) are each TRUE statements. See MPEP at pp. 100-13, 100-12, 100-8 and 100-18, respectively. Choice (D) is NOT TRUE because only the assignee of record of the entire interest in an application may intervene in the prosecution of the application, appointing an attorney or agent of his or her own choice. MPEP at p. 100-16. An assignee of record of a part interest is, however, entitled to inspect the application. *Id.*

April 17, 2002 AM

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.

April 17, 2002 PM

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.

October 17, 2001 AM

4. All answers accepted.

October 17, 2001 PM

27. ANSWER: (E) is incorrect since an oath or declaration must be provided in accordance with 37 CFR 1.64. In 37 CFR 1.64(a) the use of word “made” implies signing or executing and is derived from §1.64. See 37 CFR 1.41(c). (A) contains the elements of 37 CFR 1.41(a). As to (B) the inventorship of a nonprovisional application is that inventorship set forth in the oath or declaration as prescribe by 37 CFR 1.63, except as provided for in 37 CFR§ 1.53(d)(4) and 1.63(d). If an oath or declaration as prescribed by § 1.63 is not filed during the pendency of a nonprovisional application, the inventorship is that inventorship set forth in the applications papers filed pursuant to § 1.53(b), unless applicant files a paper,

including the processing fee set forth in § 1.17(I), supplying or changing the name or names of the inventor or inventors. Mary has not authorized Sam to inspect application B. Statement (C) is in accordance with 37 CFR 1.41(a)(2). Mary has not given Sam power to inspect the provisional application. (D) is in accordance with 37 CFR 1.41(a)(3). Mary did not authorize Sam to inspect the provisional application.

April 18, 2001 PM

49. ANSWER: (E) is the most correct answer. Since a redacted copy of the application was used for publication purposes, 37 C.F.R. § 1.14 (c)(2) provides that “(2) If a redacted copy of the application was used for the patent application publication, the copy of the specification, drawings, and papers may be limited to a redacted copy.” As to (A), (A) contains the elements of 37 C.F.R. § 1.14(b)(2), which reads “When status information may be supplied. Status information of an application may be supplied by the Office to the public if any of the following apply: ... (2) The application is referred to by its numerical identifier in a published patent document (*e.g.*, a U.S. patent, a U.S. patent application publication, or an international application publication), or in a U.S. application open to public inspection (§ 1.11(b), or paragraph (e)(2)(i) or (e)(2)(ii) of this section).” As to (B), (B) is within the purview of 37 C.F.R. § 1.14(a)(1)(iii) which states: “(a)(1) Status information is: ... (iii) The application “numerical identifier” which may be: (A) The eight-digit application number (the two-digit series code plus the six-digit serial number); or (B) The six-digit serial number plus any one of the filing date of the national application, the international filing date, or date of entry into the national stage.” As to (C), (C) contains the elements of 37 C.F.R. § 1.14(c)(1)(i), which states “(c) *When copies may be supplied.* A copy of an application-as-filed or a file wrapper and contents may be supplied by the Office to the public, subject to paragraph (i) of this section (which addresses international applications), if any of the following apply: (1) *Application-as-filed.* (i) If a U.S. patent application publication or patent incorporates by reference, or includes a specific reference under 35 U.S.C. 119(e) or 120 to, a pending or abandoned application, a copy of that application-as-filed may be provided to any person upon written request including the fee set forth in § 1.19(b)(1).” As to (D), a coinventor is entitled to access to the application independent of whether or not he or she signed the declaration. Note that as stated in 37 C.F.R. § 1.41(a)(2), if a declaration or oath is not filed, the inventorship is that inventorship set forth in the application papers.

November 3, 1999 AM

38. ANSWER: (E). 35 U.S.C. § 184; 37 CFR § 5.25(a); MPEP § 140.

November 3, 1999 PM

21. ANSWER: (A). 37 CFR § 1.11; and MPEP §§ 103, and 201.09.

# **Chapter 200**

## **Questions**

April 15, 2003 PM

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

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

October 16, 2002 AM

39. Which of the following is not in accordance with the provisions in the MPEP?

- (A) A continuation-in-part is an application filed during the lifetime of an earlier nonprovisional application by the same applicant, which repeat either some substantial portion or all of the earlier nonprovisional application, and adds matter not disclosed in the said earlier nonprovisional application.
- (B) A continuation-in-part application may only be filed under 37 CFR 1.53(b).
- (C) A continuation-in-part application cannot be filed as a continued prosecution application (CPA) under 37 CFR 1.53(d).
- (D) An application claiming the benefits of a provisional application under 35 USC 119(e) should not be called a “continuation-in-part” of the provisional application.
- (E) One of the formal requirements of 35 USC 120 is that a continuation-in-part application must be “filed before a notice of allowance or abandonment is mailed in the prior application.”

October 16, 2002 PM

22. Which of the following is in accordance with the provisions in the MPEP?

- (A) In order to correct inventorship in a nonprovisional application where the statement of the lack of deceptive intent is not available from an inventor to be added, a petition under 37 CFR 1.181 may be properly filed.
- (B) If a person A learns that a patent application has been filed by person B without naming A as coinventor, A may file in the USPTO a petition that protests inventorship and directs B to add A's name as a coinventor to the patent application.
- (C) If the application is involved in an interference, and a petition under 37 CFR 1.48 is filed to correct inventorship, the Board of Patent Appeals and Interferences will remand the case to the primary examiner for consideration of the petition to ensure that a search of the relevant prior art is performed.
- (D) When a second conversion under 37 CFR 1.48(a) is attempted by the practitioner, the conversion decision will be decided by the Technology Center Director.
- (E) None of the above.

October 16, 2002 PM

24. A claim, as required by the second through fifth paragraphs of section 112, shall not be required in a \_\_\_\_\_ patent application.

- (A) reissue
- (B) design
- (C) continuation
- (D) provisional
- (E) plant

October 16, 2002 PM

44. The procedures in the MPEP do not require an applicant claiming foreign priority in a nonprovisional utility application to:

- (A) submit the processing fee set forth in 37 CFR 1.17(i) if the claim for priority or submission of the certified copy of the priority document is made after payment of the issue fee and before the patent is granted.
- (B) identify the foreign application for which priority is being claimed as well as any foreign application for the same subject matter having a filing date before that of the application for which priority is being claimed.
- (C) file the claim in the application.
- (D) have the same inventive entity listed in the foreign application as in the U.S. application in which the priority claim has been filed.
- (E) identify the intellectual property authority or country in or for which the foreign application was filed.

April 17, 2002 AM

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.

April 17, 2002 AM

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.

April 17, 2002 AM

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).

April 17, 2002 PM

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.

April 17, 2002 PM

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.

April 17, 2002 PM

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).

April 17, 2002 PM

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)

April 17, 2002 PM

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.

October 17, 2001 AM

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

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

April 18, 2001 AM

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

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

April 18, 2001 PM

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

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

April 18, 2001 PM

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

- (A) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed before the examiner allows the claims.
- (B) If the claim for priority or the certified copy of the foreign application is filed

after the date the issue fee is paid, it must be accompanied by the processing fee set forth in 37 CFR § 1.17(i), but the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and 37 CFR § 1.323.

- (C) In an application that entered the national stage from an international application after compliance with 35 U.S.C. § 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT.
- (D) If a U.S. patent application publication or patent incorporates by reference, or includes a specific reference under 35 U.S.C. §§ 119(e) or 120 to, a pending or abandoned application, a copy of that application-as-filed may be provided to any person upon written request including the fee set forth in 37 CFR § 1.19(b)(1).
- (E) If an international application, which designates the U.S. and which has been published in accordance with PCT Article 21(2), incorporates by reference or claims priority under PCT Article 8 to a pending or abandoned U.S. application, a copy of that application-as-filed may be provided to any person upon written request including a showing that the publication of the application in accordance with PCT Article 21(2) has occurred and that the U.S. was designated, and upon payment of the appropriate.

October 18, 2000 PM

14. The right of priority under 35 U.S.C. § 119 (a)-(d) may be obtained where, if all other requirements are met:

- (A) A is the inventor of the U.S. nonprovisional application, and B is the inventor of the foreign application, and the two applications are owned by the same party.
- (B) The United States nonprovisional application, or its earliest parent nonprovisional application under 35 U.S.C. § 120, was filed 18 months from the earliest, and only foreign filing.
- (C) The right is premised upon the second foreign filed application disclosing and claiming the same invention as is claimed in the earliest United States nonprovisional application, the first foreign application having been filed twenty-four months before said United States nonprovisional application.
- (D) The U.S. application contains only process claims, and the foreign application does not enable the disclosed process.
- (E) The claim for foreign priority includes the application number, and filing date of the foreign application, as well as the name of the treaty under which the application was filed, if appropriate, and the name and location of the national or intergovernmental authority which received such application.

October 18, 2000 PM

32. Which of the following statements is not true?

- (A) The failure to perfect a claim to foreign priority benefit prior to issuance of the patent may be cured by filing a reissue application.
- (B) The failure to both express a desire to obtain the benefits of foreign priority and perfect a claim to foreign priority benefit prior to issuance of a parent patent may be cured by filing a Certificate of Correction request provided the requirements of 35 U.S.C. § 119(a)-(d) are satisfied in a continuation application.
- (C) The failure to perfect a claim to foreign priority benefit prior to issuance of a patent on a continuation application may be cured by filing a Certificate of Correction request provided the requirements of 35 U.S.C. § 119(a)-(d) are satisfied in the parent application prior to issuance, and the requirements of 35 U.S.C. § 120 and 37 C.F.R. § 1.55 are satisfied.
- (D) No renewal of previously made claims for foreign priority under 35 U.S.C. § 119 or continuation status of an application under 35 U.S.C. § 120 is necessary during reexamination.
- (E) A sole or joint applicant may rely on two or more different foreign applications and may be entitled to the filing date of one of them with respect to certain claims and to another with respect to other claims.

October 18, 2000 PM

49. A complete continuation application by the same inventors as those named in the prior application may be filed under 35 U.S.C. § 111(a) using the procedures of 37 C.F.R. § 1.53(b) by providing:

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

# **Chapter 200**

## **Answers**



April 15, 2003 PM

8. ANSWER: (B) is the most correct answer. See 37 CFR §§ 1.51(b), 1.53(b), and 1.63(d)(1)(iv); MPEP § 201.06(c), under the heading “Specification and Drawings,” and MPEP § 602.05(a). (A) is incorrect. As indicated by MPEP § 201.06(c), a continuation application may be filed under 35 U.S.C. § 111(a) by providing a copy of the prior application, including a copy of the signed declaration in the prior application, as filed. (C) is incorrect. As indicated by MPEP § 201.06(c), a continuation application may be filed under 35 U.S.C. § 111(a) by providing a new specification and drawings and a newly executed declaration provided the new specification and drawings do not contain any subject matter that would have been new matter in the prior application. (D) is incorrect. The oath or declaration is needed to name the same inventor in the continuation application. 37 CFR § 1.53(b); MPEP § 201.06(c). (E) is incorrect because (A), (C) and (D) are incorrect.

October 16, 2002 AM

39. ANSWER: (E). As to (E), it is not in accord with MPEP § 201.08 since the application need not be filed before a notice of allowance, but instead before patenting of the first application. (A) through (C) are found in MPEP § 201.08. As to (D), calling the patent application a continuation-in-part will result in the application having its patent term calculated from its filing date. An application filed under 35 U.S.C. §§ 120, 121, or 365(c) will have its patent term calculated from the date on which the earliest application was filed, provided a specific reference is made to the earlier filed application(s). 35 U.S.C. § 154(a)(2) and (a)(3).

October 16, 2002 PM

22. ANSWERS: (D) and (E) were accepted. As to (D), see MPEP § 201.03 at p. 200-4. The language in answer (D) is literally found in MPEP § 201.03, which states, “Requests under 37 CFR 1.48 are generally decided by the primary examiner except . . . (D) When a second conversion under 37 CFR 1.48(a) is attempted (decided by the Technology Center (TC) Director).” Answer (E) was accepted inasmuch as the word “conversion” in answer (D) and MPEP 201.03 at page 200-4 may be confusing. Although answer (D) references 37 CFR 1.48, which addresses correction of inventorship, answer (D) uses “conversion,” a word that is not typically used when addressing correction of inventorship. To the extent “conversion” in answer (D) and MPEP 201.03 at page 200-4 may be inaccurate terminology in the context in which it was used, it may have caused some candidates to select answer (E), none of the above. Answer (E) is dependent on answer (D). Inasmuch as answer (D) used inaccurate terminology, selection of answer (E) can be a reasonable alternative. Accordingly, answer (E) was accepted at this time. Answers (A), (B) and (C) are independent of the content of answer (D). Thus, selection of these answers, which are incorrect, was not accepted as a correct answer. As to (A) the petition to be filed would be under 37 C.F.R. § 1.183. As to (B), 35 U.S.C. § 116 provides that inventors may apply for a patent jointly. A person not named in the application could not file a petition under 37 C.F.R. § 1.48 as this would not be a joint filing. In accordance with MPEP 1901.05, unless a protestor has been granted access, the protestor is not entitled to any information including the fact that the application exists. MPEP at 1900-6. The patent application process is *ex parte*, and inventorship may only be contested *inter partes* (between opposing parties) in the USPTO through the interference process. MPEP § 1901.07 precludes the protestor from further participation beyond

submission of the protest. See also 37 C.F.R. § 1.291(c). (C) is incorrect at least for the reasons that if the application is involved in an interference the Board will decide the petition. See MPEP § 201.03.

October 16, 2002 PM

24. ANSWER: (D) is correct. (D) is correct because 35 U.S.C. § 111(b)(2) states, “A claim, as required by the second through fifth paragraphs of section 112, shall not be required in a provisional application.” MPEP § 201. (A) is wrong because an application for reissue must contain the entire specification, including the claims, and the drawings of the patent. 37 C.F.R. § 1.173(a). (B) is wrong because a design patent application contains a single claim. 37 C.F.R. § 1.53(b); MPEP § 1503.03. (C) is wrong because a continuation patent application is a second application for the same invention claimed in a prior nonprovisional application and filed before the original becomes abandoned or patented. MPEP § 201.07. (E) is wrong because 35 U.S.C. § 162 states, “The claim in the specification shall be in formal terms to the plant shown and described.” MPEP § 1605.

October 16, 2002 PM

44. ANSWER: (D). There is no requirement as to the inventive entity being the same. As to (A), see 37 C.F.R. § 1.55(a)(2). As to (E), see MPEP 201.14 at p. 200-82 (right column). As to (C), see MPEP 201.14(a). As to (B), see 37 C.F.R. § 1.55(a)(1)(i) and MPEP 201.14(a).

April 17, 2002 AM

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.

April 17, 2002 AM

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.

April 17, 2002 AM

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.

April 17, 2002 PM

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).

April 17, 2002 PM

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).

April 17, 2002 PM

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).

April 17, 2002 PM

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.

April 17, 2002 PM

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.

October 17, 2001 AM

3. ANSWER: (D) is the most correct answer. The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. § 119(b) or PCT Rule 17 must, in any event, be filed before the patent is granted, not before the examiner allows the claims, as is required by 37 CFR 1.55 (Claim for foreign priority), subparagraph (a)(2), which states “(2) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed before the patent is granted...” As to (B), (B) contains the elements of 37 CFR 1.55 (a)(2), which states “...If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by the processing fee set forth in § 1.17(i), but the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323.” As to (C), (C) contains the elements of 37 CFR 1.55 (a)(1)(ii), which provides “(ii) In an application that entered the national stage from an international application after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of

the application and within the time limit set forth in the PCT and the Regulations under the PCT.” As to (A), (A) contains the elements of 37 CFR 1.14(c)(1)(i), which states “[i]f a U.S. patent application publication or patent incorporates by reference, or includes a specific reference under 35 U.S.C. 119(e) or 120 to, a pending or abandoned application, a copy of that application-as-filed may be provided to any person upon written request including the fee set forth in § 1.19(b)(1).” As to (E), (E) contains all of the elements of 37 CFR 1.14(c)(1)(ii), which states “If an international application, which designates the U.S. and which has been published in accordance with PCT Article 21(2), incorporates by reference or claims priority under PCT Article 8 to a pending or abandoned U.S. application, a copy of that application-as-filed may be provided to any person upon written request including a showing that the publication of the application in accordance with PCT Article 21(2) has occurred and that the U.S. was designated, and upon payment of the appropriate fee set forth in § 1.19(b)(1).”

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

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

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

October 18, 2000 PM

14. ANSWER: (E). MPEP § 201.13 “The Priority Claim.” (A) is incorrect. 35 U.S.C. § 119; MPEP § 201.13. A right of priority does not exist in the case of an application of inventor B in the foreign country and inventor A in the United States, even though the two applications may be owned by the same party. The name of the treaty is appropriate if it is a bilateral treaty, as opposed to the Paris Convention, whereas naming the treaty is not appropriate if it is the Paris Convention. (B) is incorrect. 35 U.S.C. § 119; MPEP § 201.13. The United States nonprovisional application, or its earliest parent nonprovisional application under 35 U.S.C. § 120, must have been filed within twelve months of the earliest foreign filing. (C) is incorrect. 35 U.S.C. § 119; MPEP § 201.13. The twelve months is from earliest foreign filing except as provided in 35 U.S.C. § 119(c), which exception does not obtain in the given facts. (D) is incorrect. 35 U.S.C. § 119(a); MPEP § 201.13. The foreign application must be for the same invention as the application in the United States.

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32. ANSWER: (B). There must be a previously expressed desire by the applicant to receive benefits under a claim of priority before a Certificate of Correction request will be granted. While a continuation application can rely on a previously expressed desire to receive benefits

under a claim of priority in a parent case, a parent case has no prior application to look to. MPEP § 201.16. (A) is incorrect because it is a true statement. See *Brenner v. State of Israel*, 158 USPQ 584 (D.C. Cir. 1968). (C) and (D) are true statements. Hence, they are incorrect answers. *In re Van Esdonk*, 187 USPQ 671 (Comm'r Pat. 1975). MPEP § 201.16 and 2258, respectively. (E) is a true statement, and therefore, is a wrong answer. MPEP § 201.15 (last paragraph).

October 18, 2000 PM

49. ANSWER: (B). 37 C.F.R. §§ 1.51(b), 1.53(b), and 1.63(d)(1)(iv); MPEP § 201.06(c), subsection styled "Specification and Drawings," 602.05(a). (A) is incorrect. As indicated by MPEP § 201.06(c), a continuation application may be filed under 35 U.S.C. § 111(a) by providing a copy of the prior application, including a copy of the signed declaration in the prior application, as filed. (C) is incorrect. As indicated by MPEP § 201.06(c), a continuation application may be filed under 35 U.S.C. § 111(a) by providing a new specification and drawings and a newly executed declaration provided the new specification and drawings do not contain any subject matter that would have been new matter in the prior application. (D) is incorrect. The oath or declaration is needed to name the same inventor in the continuation application. 37 C.F.R. § 1.53(b); MPEP § 201.06(c). (E) is incorrect because (A), (C) and (D) are incorrect.

# **Chapter 300**

## **Questions**



October 16, 2002 AM

45. John filed a nonprovisional patent application in the USPTO claiming two distinct inventions, a combination and a subcombination. At the time of filing the nonprovisional application, he recorded an assignment of all right, title, and interest in the inventions claimed in the application to ABC Corporation. In the first Office action, the examiner required restriction, and John elected the combination. A year later, during the pendency of the nonprovisional application, John filed a divisional patent application claiming the subcombination. At the time of filing the divisional application, John assigned all right, title, and interest in the inventions claimed in the divisional application to XYZ Corporation, and the latter party recorded the assignment within three months of the assignment. Following recordation of the assignment to XYZ Corporation, which of the following statements is false?

- (A) The Office should treat John as having no ownership rights in the combination.
- (B) The Office should treat John as having no ownership rights in the subcombination.
- (C) ABC Corporation has no ownership rights in the subcombination.
- (D) XYZ Corporation has no ownership rights in the combination.
- (E) XYZ Corporation has no ownership rights in the subcombination.

October 16, 2002 PM

4. A patent examiner resigned from the USPTO on June 7, 2001, and returned to Sheboygan, Wisconsin. The next day, on June 8, 2001, the former examiner signed up for a one week seminar entitled, "How to Become Rich Without Really Working." During the seminar, the sponsors offered the former examiner a golden opportunity to purchase a 10% interest in a U.S. patent application that they stated is "guaranteed to produce significant royalties and give her a 1000% return on her investment." Soon after attending the seminar, the former examiner became a registered practitioner. Which of the following accords with proper practice and procedure?

- (A) The former examiner may accept the offer, but only if an ownership interest in the application is transferred to the former examiner by an instrument in writing.
- (B) The former examiner can accept the offer, but only if an ownership interest in the application is transferred to the former examiner by an instrument in writing, which is made of record in the assignment records of the USPTO.
- (C) The former examiner can accept the offer, but only if an ownership interest in the application is transferred to the former examiner by an instrument in writing, which is made of record in the file of the application.
- (D) The former examiner should accept the offer, but only if an ownership interest in the application is transferred to the former examiner by an instrument in writing, and the original or a true copy of the original instrument, in writing, is made of record in the assignment records of the USPTO and in the file of the application.
- (E) The former examiner cannot accept the offer because she is incapable of acquiring an interest in the application at that time under the circumstances.

October 16, 2002 PM

47. A registered practitioner's client, Apex Mfg. Corporation, bought the entire assets of Pinnacle Mfg. Corporation. Pinnacle gave Apex a list of its patent applications but did not maintain records of the patent assignments. Apex wishes to know which of the assignment documents, if any, of the pending patent applications in Pinnacle's patent portfolio were never recorded. In accordance with the MPEP, which of the following actions could the practitioner rely upon to most expeditiously answer this question?

- (A) Request certified copies of the patent applications as filed.
- (B) Request certified copies of the assignment documents of record of the patent applications.
- (C) Request certified copies of the patent applications as filed accompanied by the fees set forth in 37 CFR 1.19(b)(1)(i).
- (D) Request certified copies of the patent applications as filed accompanied by the fees set forth in 37 CFR 1.19(b)(1)(ii).
- (E) Request certified copies of the assignment documents of record of the patent applications accompanied by the fees set forth in 37 CFR 1.19(b)(5).

October 17, 2001 PM

12. Mike and Mary jointly invented a cornhusk peeler. Mary invented a wrap around handle for the peeler that keeps the hand protected. Mike invented the portion that engages the cornhusk and removes the cornhusk without damaging the kernels. An application is filed and eighteen months later the patent issues listing Mike and Mary as joint inventors with claims to a cornhusk peeler having the portions invented by both Mike and Mary. Mike and Mary have an argument and never speak or communicate in any way with each other again. Subsequently, Mary sells all of her ownership in the patent to Bird's Beak, who then records the assignment in the USPTO. Mike comes to you for advice as to what he can do. Which of the following is true?

- (A) Mike should file a reissue application in which he names only himself as inventor and claims only the cornhusk-removing portion. Mike can then sue Bird's Beak to prevent them from manufacturing a device with the cornhusk-removing portion.
- (B) Since Mary invented only the handle portion, she can assign only the rights in the invention concerning the handle. Consequently, Bird's Beak received only the right to manufacture the handles but not the cornhusk-removing portion.
- (C) Mike should attempt to void the assignment by Mary since the patent was jointly owned. It takes the consent of both parties to assign the rights in the invention.
- (D) Mike can file a reissue application, but only with the consent of Bird's Beak, because it takes both the remaining inventor (Mary) and the assignee (Bird's Beak) to consent to the filing of a reissue application.
- (E) Mike may void the assignment to Bird's Beak by filing a disclaimer signed only by Mike disclaiming all claims directed to the portion of the invention that Mary developed.

April 18, 2001 PM

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

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

October 18, 2000 AM

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

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

November 3, 1999 PM

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

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



# **Chapter 300**

## **Answers**

October 16, 2002 AM

45. ANSWER: (C) is a false statement and therefore the correct answer. Under 35 U.S.C. § 261, “An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent and Trademark Office within three months from its date or prior to the date of such subsequent purchase or mortgage.” (C) is correct because ABC Corporation acquired all of John’s ownership rights in the original patent application, including the subcombination claimed in the original nonprovisional and divisional patent applications. The assignment of the rights to ABC Corporation was recorded in the USPTO prior to the subsequent acquisition of the subcombination by XYZ Corporation. U.S.C. § 261. ABC Corporation’s recordation of its assignment gave constructive notice to XYZ Corporation. MPEP § 306 recites that in the case of a division...application, a prior assignment recorded against the original application is applied to the division...application because the assignment recorded against the original application gives the assignee rights to the subject matter common to both applications. (A) and (B) are true statements and therefore wrong answers. John gave up his ownership rights when he executed the assignment to ABC Corporation. The assignment to ABC Corporation carries with it the transfer of the bundle of rights associated with subject matter common to the original patent application, e.g., the divisional patent application. (D) and (E) are true statements and therefore wrong answers because XYZ Corporation acquired no rights in the original or divisional patent applications. MPEP § 306.

October 16, 2002 PM

4. ANSWER: (E) is correct and (A), (B), (C) and (D) are wrong. As a former employee of the USPTO, the former examiner is incapable of acquiring an interest, directly or indirectly, in a patent application in the manner described in the question during the period of appointment as an examiner, and for one year thereafter. 35 U.S.C. § 4; MPEP § 309. Inasmuch as the former examiner resigned from the USPTO on June 7, 2001, the former examiner is incapable of acquiring an interest in the application in said manner until June 8, 2002. Registration as a practitioner does not affect the restrictions on the former examiner.

October 16, 2002 PM

47. ANSWER: (E) is correct and (A), (B), (C) and (D) are incorrect. As MPEP § 303 states: “Certified copies of patent applications as filed do not include an indication of assignment documents. Applicants desiring an indication of assignment documents of record should request separately certified copies of assignment documents and submit the fees required by 37 C.F.R. § 1.19.” (B) is incorrect because the fee required by 37 C.F.R. § 1.19(b)(5) has not been paid for the requested certified copy of assignment records.

October 17, 2001 PM

12. ANSWER: (D). 35 U.S.C. §251. As to (A) and (D), 37 CFR 3.73(b)(2) requires the consent of all assignees or remaining inventors before any national (which includes reissue) application can be filed. Mike cannot alone file a reissue application. As to (E), under 35 U.S.C. § 253 the owner of a sectional interest in the patent may file a disclaimer, but disclaiming the claims of Mary would not void the assignment to Bird’s Beak. As to (B) and (C), 35 U.S.C. § 262 provides that for joint ownership, each inventor owns an undivided interest in the whole and 35 U.S.C. § 261 provides for assignment of the inventor’s interest.

April 18, 2001 PM

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

October 18, 2000 AM

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

November 3, 1999 PM

30. ANSWER: (D). 35 U.S.C. § 4; and MPEP § 309.





# **Chapter 400**

## **Questions**

April 15, 2003 AM

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

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

April 15, 2003 AM

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

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

October 16, 2002 AM

1. In accordance with the MPEP and USPTO rules and procedure, an application for patent may be made on behalf of a joint inventor in certain situations. Who, by petition, may make application on behalf of a joint inventor who has refused to sign the application (“nonsigning inventor”), if the other joint inventor (“signing inventor”) executes the application?

- (A) A person other than the signing inventor, to whom the nonsigning inventor has assigned the invention.
- (B) A person other than the signing inventor, with whom the nonsigning inventor has agreed in writing to assign the invention.
- (C) The signing inventor.
- (D) A person other than the signing inventor, who shows a strong proprietary interest in the invention.
- (E) All of the above.

October 16, 2002 PM

12. In accordance with the MPEP and USPTO rules and procedure, a joint inventor on behalf of himself or herself and a nonsigning joint inventor in certain circumstances may make a patent application. Which of the following is an acceptable reason for filing an application with a declaration signed by a joint inventor, who is not the legal guardian of the other joint inventor, on behalf of himself and the nonsigning joint inventor?

- (A) The nonsigning joint inventor refuses to join in the application.
- (B) The nonsigning joint inventor is on vacation and is temporarily unavailable to sign the declaration.
- (C) The nonsigning joint inventor is hospitalized and is temporarily unavailable to sign the declaration.
- (D) The nonsigning joint inventor is out of town and is temporarily unavailable to sign the declaration.
- (E) All of the above.

October 16, 2002 PM

48. In accordance with the MPEP and USPTO rules and procedure, a registered attorney or agent may be appointed to prosecute a patent application for an applicant. In which of the following situations will the USPTO not recognize the appointment of an attorney or agent to prosecute a patent application for an applicant?

- (A) The principal agent of record appoints a registered associate attorney to prosecute the application.
- (B) The applicant executes a power of attorney naming only a law firm to prosecute the application.
- (C) The applicant executes a power of attorney appointing more than one registered individual to prosecute the application.
- (D) The principal attorney of record appoints an associate registered agent to prosecute the application.
- (E) The assignee of the entire interest of record, who has established the right to prosecute the patent application, executes a power of attorney appointing a registered attorney to prosecute the patent application.

April 17, 2002 AM

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.

April 17, 2002 PM

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.

April 17, 2002 PM

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).

April 18, 2001 AM

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

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

April 18, 2001 PM

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

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

October 18, 2000 AM

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

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

October 18, 2000 PM

33. Mike and Jill are members of the Virginia Bar with a general law practice. Jill is registered to practice before the USPTO and is constantly poking fun at Mike for not being registered. Jake, one of Mike's former clients, owns a small tool shop and while attempting to remove a broken drill bit from a workpiece, invented a tool that easily extracts a broken bit. The tool is simple to make. Jake asked Mike if he could patent his invention, and Mike, desiring to impress Jill with his patent skills, said, "No problem." Using a "how to" book that he obtained from the INTERNET, Mike prepared an application on Jake's invention and filed it in the USPTO together with a power of attorney which Jake executed naming Jack as attorney of record. Shortly thereafter, the Mike and Jill firm hired Jim, a registered patent attorney, and Mike physically filed a document with the USPTO naming Jim as an associate attorney in Jake's application. Upon reviewing Jake's application, Jim discovered that the original claims omitted the recitation of a critical element which was disclosed in the specification. Assuming a preliminary amendment is filed with the USPTO adding the critical element to the claims, and explaining in the REMARKS that the critical element was inadvertently omitted at the time of filing the application, which of the following is the most comprehensive answer in identifying the individual(s), if any, who by signing the amendment will be recognized by the USPTO for representation?

- (A) Jake
- (B) Jim
- (C) Jill
- (D) All of the above
- (E) None of the above

April 12, 2000 AM

12. Which of the following documents, if any, must also contain a separate verification statement?

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

April 12, 2000 AM

41. On July 1, 1998, you file an application wherein the inventors are listed as Mae, Bea and Seya. The application is filed with an unexecuted declaration. On July 15, 1998, Mae and Bea sell their patent rights by assignment of the application to Seya. On July 25, 1998, Seya advises the practitioner that Bea has died, and Mae has moved to the West Indies. On July 27, 1998, you receive a notice from the PTO indicating that declaration was not executed and an executed declaration must be submitted. As a registered practitioner, what would you do in accordance with proper PTO practice and procedure to file a proper reply?

- (A) Find out who is the executor or administrator of the estate of Bea, and file a declaration (naming Mae, Bea, and Seya as inventors) executed by the executor or administrator in the signature block for Bea.
- (B) Since Bea and Mae assigned their rights in the patent application to Seya, only Seya needs to sign the declaration. A declaration should be filed with the PTO, which is signed only by Seya with the names of Bea, and Mae deleted, and with an explanation that they no longer have rights in the application and should no longer be listed as inventors.
- (C) Attempt to contact Mae and, if after a diligent effort, no response is forthcoming, file a statement executed by practitioner stating the diligent effort made to obtain the signature of Mae, and that she could not be located and no response ensued. File a declaration (naming Mae, Bea, and Seya as inventors) signed by Seya in the signature block for Seya's signature.
- (D) Have Seya sign the declaration on his own behalf and on behalf of the missing inventors.
- (E) Both (A) and (C) are required.

November 3, 1999 PM

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

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





# **Chapter 400**

## **Answers**

April 15, 2003 AM

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

April 15, 2003 AM

43. ANSWER: (A) is the most correct answer. See 37 CFR § 1.33(c). (B) is incorrect. See MPEP § 403. 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. (C) is incorrect. See MPEP §§ 402.02 and 406. The associate attorney may not appoint another attorney. (D) is incorrect. 37 CFR § 1.36. An assignment will not itself operate as a revocation of a power or authorization previously given. (E) is incorrect. See 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.

October 16, 2002 AM

1. ANSWER: Choice (C) is the correct answer. MPEP § 409.03(a), and 37 C.F.R. § 1.47(a). 37 C.F.R. § 1.47(a) provides, “If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.” Choices (A), (B), and (D) are each incorrect because they are not provided for by 37 C.F.R. § 1.47(a). MPEP § 409.03 (b), in pertinent part provides, “Where 37 C.F.R. § 1.47(a) is available, application cannot be made under 37 C.F.R. § 1.47(b).” Choice (E) is incorrect because choices (A), (B), and (D) are each incorrect.

October 16, 2002 PM

12. ANSWER: Choice (A) is the correct answer. MPEP § 409.03; MPEP § 09.03(d); and 37 C.F.R. § 1.47(a). (B) and (D) are each incorrect because MPEP § 409.03, subpart (d) states that “The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 C.F.R. § 1.47.” (C) is incorrect because MPEP § 409.03(d) further states that “the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under 37 C.F.R. § 1.47.” (E) is incorrect because each of (B), (C), and (D) are incorrect.

October 16, 2002 PM

48. ANSWER: Choice (B) is the correct answer. MPEP § 402; 37 C.F.R. § 1.34. MPEP § 402 states that “Powers of attorney or authorizations of agent naming firms of attorneys or agents filed in patent applications will not be recognized.” (A) and (D) are each incorrect because according to 37 C.F.R. § 1.34(b), “A principal registered attorney or agent, so appointed, may appoint an associate registered attorney or agent who shall also then be of

record.” (C) is incorrect. As stated in MPEP § 402, “Powers of attorney and authorizations of agent under 37 C.F.R. § 1.34(b) naming one or more registered individuals, or all registered practitioners associated with a Customer Number, may be made. See MPEP § 403 for Customer Number practice.” (E) is incorrect because, as set forth in MPEP § 402.07, “A power of attorney by the assignee of the entire interest revokes all powers given by the applicant and prior assignees if the assignee establishes their right to take action as provided in 37 C.F.R. § 3.73(b).”

April 17, 2002 AM

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.

April 17, 2002 PM

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.

April 17, 2002 PM

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.

April 18, 2001 AM

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

April 18, 2001 PM

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

October 18, 2000 AM

12. ANSWER: (A). 37 C.F.R. § 1.33(c). (B) 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. (C) is incorrect. MPEP § 402.02, and 406. The associate attorney may not appoint another attorney. (D) is incorrect. 37 C.F.R. § 1.36. An assignment will not itself operate as a revocation of a power or authorization previously given. (E) 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.

October 18, 2000 PM

33. ANSWER: (D). Jake is the applicant, and Jim and Jill are registered practitioners. "An applicant for patent may file and prosecute his or her own application..." MPEP § 401. The applicant, Jake, is not required to revoke Mike's power of attorney because Jack is unregistered, and therefore his appointment is void *ab initio*. MPEP § 402, Form Paragraph 4.09 (first paragraph). Jim and Jill's signature constitutes "a representation to the Patent and Trademark Office that...he or she is authorized to represent the particular party in whose behalf he or she acts." 37 C.F.R. § 1.34. This privilege applies whether or not the registered attorney is of record. 37 C.F.R. § 1.31; MPEP § 402. (A), (B), and (C) are wrong because they do not represent the "most comprehensive" answer. (E) is wrong because it is inconsistent with (D), which is correct.

April 12, 2000 AM

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

April 12, 2000 AM

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

November 3, 1999 PM

20. ANSWER: (D). MPEP § 402.10.



# **Chapter 500**

## **Questions**



April 15, 2003 AM

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

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

April 15, 2003 AM

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

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

April 15, 2003 AM

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

- (A) *Sam's Labs* is a small business concern for the purposes of claiming small entity status for fee reduction purposes.
- (B) If Sam grants a license to the Government resulting from a rights determination under Executive Order 10096, it will not constitute a license so as to prohibit claiming small entity status.
- (C) The establishment of small entity status permits the recipient to pay reduced fees for all patent application processing fees charged by the USPTO.
- (D) Sam may establish small entity status by a written assertion of entitlement to small entity status. A written assertion must: (i) be clearly identifiable; (ii) be signed; and (iii) convey the concept of entitlement to small entity status, such as by stating that applicant is a small entity, or that small entity status is

entitled to be asserted for the application or patent.

- (E) While no specific words or wording are required to assert small entity status, the intent to assert small entity status must be clearly indicated in order to comply with the assertion requirement.

April 15, 2003 AM

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

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

April 15, 2003 PM

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

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

April 15, 2003 PM

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

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

April 15, 2003 PM

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

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

April 15, 2003 PM

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

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

October 16, 2002 AM

49. In accordance with the MPEP and USPTO rules and procedure, correspondence transmitted to the USPTO by facsimile is not permitted in certain situations. Which of the following facsimile transmissions to the USPTO will be accorded a date of receipt by the USPTO?

- (A) Facsimile transmission of a request for reexamination under 37 CFR 1.510 or 1.913.
- (B) Facsimile transmission of drawings submitted under 37 CFR 1.81, 1.83 through 1.85, 1.152, 1.165, 1.174, or 1.437.
- (C) Facsimile transmission of a response to a Notice of Incomplete Nonprovisional Application for the purpose of obtaining an application filing date.
- (D) Facsimile transmission of a correspondence to be filed in a patent application subject to a secrecy order under 37 CFR 5.1 through 5.5 and directly related to the secrecy order content of the application.
- (E) Facsimile transmission of a continued prosecution application under 37 CFR 1.53(d) and an authorization to charge the basic filing fee to a deposit account.

October 16, 2002 PM

34. On Monday, May 13, 2002, John's secretary deposited in an "Express Mail" drop box prior to the last scheduled pick-up for that day, an envelope properly addressed to the USPTO for delivery to the USPTO by the "Express Mail Post Office to Addressee" service. The envelope was received by the USPTO on Wednesday, May 15, 2002, containing a reply to an Office action which set a shortened statutory period ("SSP") for reply ending on Tuesday, May 14, 2002. The reply was marked by the Office as being received on May 15, 2002. The number of the "Express Mail" mailing label had not been placed on the response papers, and upon receipt of the "Express Mail" mailing label John learned that the "date in" was not clearly marked. John promptly filed a petition requesting the filing date to be the date of deposit. The petition included a showing that the date of deposit accompanied by evidence of USPS corroboration of the deposit. Accordingly,

- (A) The reply will be regarded as timely filed in the USPTO on May 15, 2002.
- (B) The reply will be regarded as timely filed in the USPTO on May 14, 2002.
- (C) The reply will be regarded as timely filed in the USPTO on May 13, 2002.
- (D) The reply will be regarded as timely filed in the USPTO if a petition with proper fee for a one month extension of time is filed in the USPTO on or before June 14, 2002.
- (E) The reply will be regarded as timely filed in the USPTO if the number of the “Express Mail” mailing label is placed on each page of a copy of the original response and hand carried to the USPTO on May 15, 2002, rather than being sent by “Express Mail.”

October 16, 2002 PM

36. The USPTO notifies John, a registered patent agent who is representing applicant A, that after a reasonable search, the USPTO has been unable to locate applicant A’s patent application. By which of the following procedures may John avoid abandonment of applicant A’s application within the time period set by the USPTO?

- (A) Provide the USPTO with a copy of his record of all the correspondence between his office and the USPTO, assuming the existence of such record.
- (B) Provide the USPTO with a list of all the correspondence between his office and the USPTO, assuming the existence of such list, and a statement that the list is complete and accurate.
- (C) Provide the USPTO with a statement that he does not possess any record of the correspondence between his office and the USPTO because his files were destroyed.
- (D) Provide the USPTO with a record of all the correspondence between his office and the USPTO, and a statement that the papers produced are his complete record of all the correspondence between his office and the USPTO, assuming the existence of such record.
- (E) Provide the USPTO with a copy of his record of all the correspondence between his office and the USPTO, assuming the existence of such record, a list of all such correspondence, and a statement that he is not aware of any correspondence between his office and the USPTO that is not among his records.

April 17, 2002 AM

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.

April 17, 2002 AM

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.

April 17, 2002 AM

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.

April 17, 2002 AM

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 Telecom 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.

April 17, 2002 PM

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.

April 17, 2002 PM

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.

April 17, 2002 PM

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).

October 17, 2001 AM

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

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

October 17, 2001 PM

5. You are a registered patent agent with a busy patent practice in Arlington, Virginia. You are scheduled to leave for a long-awaited three-week trip to the Galapagos Islands on Friday, October 19, 2001. You recently completed a draft of a provisional patent application and forwarded it to the client for review and comment. On October 12 you left a message with the President of your client, a company, reminding her of your trip and inquiring about the status of her review. She returns your message on Wednesday, October 17 and informs you for the first time that the provisional patent application relates to an invention upon which the continued success of her business depends and that she first offered the invention for sale on October 21, 2000. She also informs you that the provisional application is ready for filing, but that she will be unable to forward to you a declaration signed by the inventors for at least four weeks. Understandably, you wish to make absolutely certain that the provisional application, having ten pages of specification, and three sheets of drawings, is properly filed with the USPTO and accorded a filing date before you leave for your trip, and that you are timely informed should anything be omitted. Which of the following scenarios provides the best evidence that the USPTO has received the provisional application with no missing parts, and the application is accorded a filing date?

- (A) You promptly hand-carry the provisional application, an application data sheet, and the appropriate filing fee to the USPTO Customer Service Window. You file these materials and have the attendant date stamp a card reciting that the deposited document is a new application and reciting the title of the invention and listing the names of the inventors.
- (B) You promptly mail the provisional application, an application data sheet, and the appropriate filing fee to the official USPTO address employing a proper Certificate of Mailing in accordance with 37 CFR 1.8.
- (C) You promptly mail the provisional application, an application data sheet and the appropriate filing fee to the official USPTO address employing Express Mail Post Office to Addressee service of the U.S. Postal Service in accordance with 37 CFR 1.10.
- (D) You promptly mail the provisional application to the official USPTO address accompanied by a Return Postcard identifying the type of deposited document as a new patent application and reciting the title of the invention and listing the names of the inventors.
- (E) You promptly hand-carry the provisional application and an application data sheet to the USPTO Customer Service Window. You file these materials and have the attendant date stamp a card reciting the title of the invention, the names of the inventors, and listing the number of pages of the cover sheet, the number of pages of specification, and the number of sheets of drawings.

October 17, 2001 PM

10. Harriet filed a nonprovisional patent application in the USPTO containing a written assertion of small entity status. Based upon proper USPTO practice and procedure, which of the following statements is correct?

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

October 17, 2001 PM

30. You file a nonprovisional patent application in the USPTO on December 27, 1999, on behalf of your client. On the basis of information provided to you, you assert entitlement to small entity status and pay the small entity status basic filing fee of \$345. On December 27, 2000, a first Office action is mailed. You file a reply to the Office action on February 2, 2001, accompanied by an Information Disclosure Statement (IDS) and the required fee of \$240 for filing the IDS at such time. You now learn that the small entity status was erroneous at the time it was established, although it was established in good faith, and the deficiency resulting from the previous erroneous payment must be paid and can be calculated from the following table:

Other than Small Entity		Small Entity
Basic Fee at time of payment	\$690.00	\$345.00
IDS Fee at time of payment	\$240.00	\$240.00
Current Basic Fee	\$710.00	\$355.00
Current IDS Fee	\$180.00	\$180.00

In accordance with USPTO proper practice and procedure, which of the following is the proper deficiency amount?

- (A) \$365.00
- (B) \$355.00
- (C) \$305.00
- (D) \$295.00
- (E) \$335.00

October 17, 2001 PM

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

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

April 18, 2001 AM

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

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

April 18, 2001 PM

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

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

April 18, 2001 PM

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

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

October 18, 2000 AM

42. In which of the following cases is the date of actual receipt by the USPTO not accorded as the application filing date?

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

October 18, 2000 PM

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

- (A) As “Express Mail Post Office to Addressee” without the Express Mail mailing label number being placed on the application and with the “date-in” entered by the USPS on Saturday, June 24, 2000, and the application being received in the USPTO on Tuesday, June 27, 2000.
- (B) As “Express Mail Post Office to Post Office” without the Express Mail mailing label number being placed on the application and with the “date-in” entered by the USPS on Friday, June 23, 2000, and the application being received in the USPTO on Monday, June 26, 2000.
- (C) As “Express Mail Post Office to Addressee” without the Express Mail mailing label number being placed on the application and with the “date-in” entered by the applicant on Thursday, June 29, 2000, and the application being received in the USPTO on Wednesday, July 5, 2000.
- (D) As “Express Mail Post Office to Addressee” with the Express Mail mailing label number being placed on the application and with the “date-in” entered by the applicant on Thursday, June 29, 2000, and the application being received in the USPTO on Monday, July 3, 2000.
- (E) As “Express Mail Post Office to Post Office” with the Express Mail mailing label number being placed on the application and with the “date-in” entered by the USPS on Saturday, July 1, 2000, and the application being received in the USPTO on Monday, July 3, 2000.

April 12, 2000 PM

14. A practitioner submitted a new patent application to the PTO using the Express Mail service of the U.S. Postal Service. The PTO never receives the new patent application. Which of the following is not necessary to comply with the requirements for receiving the date of deposit with the U.S. Postal Service as the filing date?

- (A) A petition showing that the number of the Express Mail mailing label was placed on the application before the application was sent.
- (B) A true copy of the new application showing certificate of mailing thereon signed by the practitioner’s secretary stating when the correspondence was deposited with the U.S. Postal Service as first class mail with sufficient postage in an envelope addressed to the Commissioner of Patents and Trademarks, Washington, DC 20231.
- (C) A true copy of the of the Express Mail mailing label showing the “date-in” or other official notation entered by the U.S. Postal Service.
- (D) A true copy of the new application showing the number of the Express Mail mailing label thereon.
- (E) A true copy of any returned postcard receipt.

April 12, 2000 PM

22. You, a registered practitioner, are responsible for filing a patent application on Thursday, February 3, 2000. The application has a foreign priority date of February 3, 1999. You prepare the application and place on the transmittal page (a) the Express Mail Label number and (b) a certificate of mailing pursuant to 37 C.F.R. § 1.8. At 5:10 p.m. on February 3, 2000, you place the Express Mail envelope with the application inside in an Express Mail Deposit box. The "Express Mail" drop box has a clear sign stating that the box will be cleared for the last time at 5:00 p.m. The box was cleared for the last time at 5:00 p.m. by a U.S. Postal Service employee. On February 4, 2000, the U.S. Postal Service picks up the envelope and clearly stamps the "date in" as 2/4/2000. What is the filing date that will be assigned to the application upon its receipt in the PTO?

- (A) February 3, 1999, since the envelope was mailed by Express Mail and was in the custody of the United States Postal Service on February 3, 2000.
- (B) February 4, 2000 since the operative date is the date stamped by the U.S. Postal Service.
- (C) February 3, 1999 since a certificate of mailing under 37 C.F.R. § 1.8 allows the applicant the benefit of the date on which the envelope was mailed.
- (D) February 3, 2000, since in order to be entitled to foreign priority the application had to have been deposited before 5:00 p.m., which is the time that the U.S. Patent & Trademark Office closed for business that day.
- (E) (A) and (C).

April 12, 2000 PM

30. Which of the following actions, if taken by a registered practitioner, comports with proper PTO rules and procedure?

- (A) Faxing a request for reexamination to the PTO on a weekday, during the period of enforceability of a patent, within two years of the patent's issue date.
- (B) Faxing an amendment under 37 C.F.R. § 1.111 to the PTO on the last day of the period for reply set by the examiner with a proper Certificate of Transmission.
- (C) Faxing a request for reexamination to the PTO on a weekday, during the period of enforceability of a patent, but more than two years after the patent's issue date.
- (D) Filing, by facsimile, a national patent application under 37 C.F.R. § 1.53(b) with a specification and drawings for the purpose of obtaining an application filing date.
- (E) None of the above.



November 3, 1999 AM

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

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

November 3, 1999 PM

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

- (A) A reply, mailed using the U.S. Postal Service, first class mail, on Friday, August 6, 1999, and received by the PTO on Monday, August 9, 1999 accompanied by a petition and appropriate fee for a three-month extension of time, and a certificate of mailing stating, "I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on August 6, 1999." The certificate of mailing was signed by and contained the printed name of one who reasonably expected the response to be mailed in the normal course of business by another no later than August 6, 1999.
- (B) A reply, mailed using the U.S. Postal Service, on Tuesday, May 4, 1999 and received by the PTO on Thursday, May 6, 1999 accompanied by a copy of a U.S. Postal Service certificate of mailing, which states "One piece of ordinary mail addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231." The certificate of mailing contained an official U.S. Postal Service date stamp of May 4, 1999, and the printed name of one who reasonably expected the response to be mailed in the normal course of business no later than May 4, 1999.

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

November 3, 1999 PM

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

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



# **Chapter 500**

## **Answers**

April 15, 2003 AM

5. ANSWER: (D) is the most correct answer. 37 CFR § 1.6(d)(3); MPEP § 502.01. MPEP § 501.01, under the heading “Correspondence Relative To Patents And Patent Applications Where Filing By Facsimile Transmission Is Not Permitted,” identifies among the correspondence not permitted to be filed by facsimile transmission “(B) A national patent application specification and drawing (provisional or nonprovisional) or other correspondence for the purpose of obtaining an application filing date, other than a continued prosecution application filed under 37 CFR 1.53(d)” (A), (B) and (C) are incorrect. See 37 CFR § 1.6(d)(3); MPEP §§ 201.06(d), 502.01, 706.07(h) and 714. A request for continued examination (RCE) under 37 CFR § 1.114, which is not a new application, a continued prosecution application (CPA) under 37 CFR § 1.53(d) and an amendment in reply to a non-final Office action may be filed by facsimile transmission.

April 15, 2003 AM

14. ANSWER: (A) is the most correct answer. See 37 CFR § 1.22(a); MPEP § 509. Answers (B) through (E) have no factual basis or foundation in the MPEP.

April 15, 2003 AM

24. ANSWER: (C) is the most correct answer. Not all fees are subject to the small entity reduction. See, for example, 37 CFR § 1.17(p). As to (A), a small business concern for the purposes of claiming small entity status for fee reduction purposes is any business concern that: (i) has not assigned, granted, conveyed, or licensed, and is under no obligation under contract or law to assign, grant, convey, or license, any rights in the invention to any person, concern, or organization which would not qualify for small entity status as a person, small business concern, or nonprofit organization. and (ii) meets the standards set forth in the appropriate section of the code of federal regulations to be eligible for reduced patent fees. Sam’s Labs meets all of the elements required by 37 CFR § 1.27 (a)(2). Statement (B) contains all of the elements required by 37 CFR § 1.27 (a)(4). Statement (D) contains all of the elements required by 37 CFR § 1.27 (c)(1). Statement (E) contains all of the elements required by 37 CFR § 1.27 (c)(1)(iii).

April 15, 2003 AM

29. ANSWER: (A) is the most correct answer. See MPEP § 512, which states “The Certificate of Mailing procedure does not apply to papers mailed in a foreign country.” (B) is not correct. See MPEP § 512. Certificate of transmission procedure applies to correspondence transmitted to the Office from a foreign country and an amendment is not prohibited from being transmitted by facsimile and is not precluded from receiving the benefits under 37 CFR § 1.8. (C) is not correct. See MPEP § 609, under the heading “Time for Filing.” An IDS will be considered to have been filed on the date of mailing if accompanied by a properly executed certificate of mailing or facsimile transmission under 37 CFR § 1.8. (D) is not correct. See MPEP § 706.07(h) Comparison Chart. An RCE is entitled to the benefit of a certificate of mailing or transmission under 37 CFR § 1.8. (E) is not correct. See MPEP § 1206. An appeal brief is entitled to the benefit of a certificate of mailing or transmission under 37 CFR § 1.8 because it is required to be filed in the Office within a set time period which is 2 months from the date of appeal.

April 15, 2003 PM

1. ANSWER: (B) is correct and (A), (C) and (D) are wrong. 37 CFR § 1.27(c)(4) (“The refiling of an application under § 1.53 as a continuation, divisional, or continuation-in-part application, including a continued prosecution application under § 1.53(d), or the filing of a reissue application, requires a new assertion as to continued entitlement to small entity status for the continuing or reissue application.”). (E) is also wrong. 37 CFR § 1.27(e)(1) (“Where an assignment of rights...to other parties who are small entities occurs subsequent to an assertion of small entity status, a second assertion is not required.”) MPEP 509.02

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13. ANSWER: (D) is the most correct answer. MPEP § 509.03, under the heading “Correcting Errors In Small Entity Status,” states “37 CFR 1.28(c) provides that if small entity status is established in good faith and the small entity fees are paid in good faith, and it is later discovered that such status as a small entity was established in error or through error the Office was not notified of a change of status, the error will be excused upon compliance with the separate submission and itemization requirements of 37 CFR 1.28(c)(1) and (c)(2), and the deficiency payment requirement of 37 CFR 1.28(c)(2).” (A), (B), (C), and (E) are not correct. Small entity status was not appropriate when the assertion of small entity status was filed with the application on November 1, 2002 and none of the actions recited in (A), (B), (C), and (E) would correct the error in claiming small entity status. The only mechanism for correcting a good faith error in claiming small entity status is by filing a request in compliance with 37 CFR § 1.28(c).

April 15, 2003 PM

18. ANSWER: (D) is the most correct answer. A non-provisional application filed without at least one claim is regarded as incomplete and will not be accorded a filing date. 35 U.S.C. § 111(a); 37 CFR § 1.53(b); MPEP § 506. (A) is wrong because the component parts of a provisional application necessary to obtain a filing date do not include claims. 35 U.S.C. § 111(b); 37 CFR § 1.53(c); MPEP § 506 under heading “Incomplete Provisional Applications.” (B) and (C) are wrong because “[a]n error in or failure to identify inventorship does not raise a filing date issue.” MPEP § 506.02. (E) is wrong. Under 37 CFR § 1.8(a)(2)(i)(A) no benefit is accorded to a certificate of mailing date. The effective date is the actual date of receipt, and not the certificate of mailing date.

April 15, 2003 PM

37. ANSWER: (D) is the most correct answer. See 35 U.S.C. § 41(h)(1); 37 CFR §§ 1.17(e) and 1.114; and MPEP § 509.02. (A) is incorrect because there is no support for (A) in 37 CFR § 1.102. (B) is incorrect because there is no support for (B) in 37 CFR § 1.8. (C) is incorrect because it is inconsistent with 35 U.S.C. § 42(d); 37 CFR § 1.26. *Miessner v. United States*, 228 F.2d 643, 644 (D.C. Cir. 1955). (E) is incorrect because (D) is correct.

October 16, 2002 AM

49. ANSWER: Choice (E) is the correct answer. MPEP § 502.01, and 37 C.F.R. § 1.6(d)(3). MPEP § 502.01 reads, “The date of receipt accorded to any correspondence permitted to be sent by facsimile transmission, including a continued prosecution application (CPA) filed under 37 C.F.R. § 1.53(d), is the date the complete transmission is received by an Office

facsimile unit...An applicant filing a CPA by facsimile transmission must include an authorization to charge the basic filing fee to a deposit account or to a credit card.” Choice (A) is incorrect because 37 C.F.R. § 1.6(d) states, “Facsimile transmissions are not permitted and, if submitted, will not be accorded a date of receipt in the following situations: ...(5) A request for reexamination under §1.510 or § 1.913.” Choice (B) is incorrect because 37 C.F.R. § 1.6(d) also states, “Facsimile transmissions are not permitted and, if submitted, will not be accorded a date of receipt in the following situations: ...(4) Drawings submitted under §§ 1.81, 1.83 through 1.85, 1.152, 1.165, 1.174, 1.437, 2.51, 2.52, or 2.72.” Choice (C) is incorrect because 37 C.F.R. § 1.6(d) also states, “Facsimile transmissions are not permitted and, if submitted, will not be accorded a date of receipt in the following situations: ...(3) Correspondence which cannot receive the benefit of the certificate of mailing or transmission as specified in 1.8(a)(2)(i)(A)...” 37 C.F.R. § 1.8(a)(2)(i)(A) reads, “The filing of a national patent application specification and drawing or other correspondence for the purpose of obtaining an application filing date...” Choice (D) is incorrect because 37 C.F.R. § 1.6(d) also states, “Facsimile transmissions are not permitted and, if submitted, will not be accorded a date of receipt in the following situations: ...(6) Correspondence to be filed in a patent application subject to a secrecy order under §§ 5.1 through 5.5 of this chapter and directly related to the secrecy order content of the application.”

October 16, 2002 PM

34. ANSWER: (D) is correct. 37 C.F.R. § 1.136(a). 37 C.F.R. § 1.136(a) states, “[A]pplicant may extend the time period for reply up to the earlier of the expiration of any maximum period set by statute or five months after the time period set for reply, if a petition for an extension of time and the fee set in § 1.17(a) are filed...” (A) is wrong because the response was not timely filed since it was received by the USPTO after the SSP expired. (B) and (C) are wrong. The reply was not filed on May 14, 2002, because the conditions of 37 C.F.R. § 1.10(b) were not satisfied. For example, the number of the “Express Mail” mailing label must have been placed on each page of the response prior to the original mailing by “Express Mail.” The petition should not be expected to be granted inasmuch as the papers did not include the number of the “Express Mail” mailing label on them. See § 1.10(c)(2), (d)(2), and (e)(2). (E) is wrong because 37 C.F.R. § 1.10(b) requires that “the number of the ‘Express Mail’ mailing label must have been placed on each page of the response prior to the original mailing by ‘Express Mail.’” Emphasis added. MPEP 513

October 16, 2002 PM

36. ANSWER: (C) is correct. 37 C.F.R. § 1.251(a)(3). (C) is correct because there is compliance with 37 C.F.R. § 1.251(a)(3). (A) is wrong because along with a copy of the record, he is required to provide a list of all correspondence, and a statement that the copy is complete and accurate and that he is not aware of any correspondence between his office and the USPTO that is not among his records. 37 C.F.R. § 1.251(a)(1)(ii). (B) is wrong because along with a list of all correspondence and a statement that the copy of his record of all the correspondence is complete and accurate, he is required to provide a copy of his record of all the correspondence, and the statement must recite that he is not aware of any correspondence between his office and the USPTO that is not among his records. 37 C.F.R. § 1.251(a)(1)(i). (D) is wrong because the statement omits the recitation that he is not aware of any correspondence between his office and the USPTO that is not among his records. 37 C.F.R.

§ 1.251(a)(2)(ii). (E) is wrong because the statement omits the recitation that the copy of his record of all the correspondence is complete and accurate. 37 C.F.R. § 1.251(a)(1)(iii).

April 17, 2002 AM

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.

April 17, 2002 AM

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 nonextendable 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.

April 17, 2002 AM

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.



April 17, 2002 AM

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.

April 17, 2002 PM

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.

April 17, 2002 PM

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.

April 17, 2002 PM

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).

October 17, 2001 AM

15. ANSWER: (C). Not all fees are subject to the small entity reduction. See, for example, 37 CFR 1.17(p). As to (A), a small business concern for the purposes of claiming small entity status for fee reduction purposes is any business concern that: (i) has not assigned, granted, conveyed, or licensed, and is under no obligation under contract or law to assign, grant, convey, or license, any rights in the invention to any person, concern, or organization which would not qualify for small entity status as a person, small business concern, or no nonprofit organization. and (ii) meets the standards set forth in the appropriate section of the code of federal regulations to be eligible for reduced patent fees. *Sam's Labs* meets all of the elements required by 37 CFR 1.27 (a)(2). Statement (B) contains all of the elements required by 37 CFR 1.27 (a)(4). Statement (D) contains all of the elements required by 37 CFR 1.27 (c)(1). Statement (E) contains all of the elements required by 37 CFR 1.27 (c)(1)(iii).

October 17, 2001 PM

5. ANSWER: (E) is the most correct answer. (A) is not the best answer inasmuch as all the items, such as the number of pages of specification and sheets of drawings, are not itemized on the card. (B) and (C) are wrong because they do not provide for a receipt from the USPTO. (B) is also wrong because § 1.8 cannot be used for obtaining an early filing date when filing a new application. (D) will not provide the earliest possible filing date. (A) and (E) will both provide an early information showing a filing date. But (E) is the best answer because it provides the best evidence of the documents received in the USPTO. See MPEP § 503, under the heading "RETURN POSTCARD." ("A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO. \*\*\* The identifying data on the postcard should be so complete as to clearly identify the item for which receipt is requested.... If a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification...number of sheets of drawings, number of pages of oath/declaration, number of pages of cover sheet (provisional application), etc.").

October 17, 2001 PM

10. ANSWER: (B) is correct and (A), (C) and (D) are wrong. 37 CFR 1.27(c)(4) ("The refiling of an application under § 1.53 as a continuation, divisional, or continuation-in-part application, including a continued prosecution application under § 1.53(d), or the filing of a reissue application, requires a new assertion as to continued entitlement to small entity status

for the continuing or reissue application.”). (E) is also wrong. 37 CFR 1.27(e)(1) (“Where an assignment of rights...to other parties who are small entities occurs subsequent to an assertion of small entity status, a second assertion is not required.”)

October 17, 2001 PM

30. ANSWER: (A) is correct and (B), (C), (D), and (E) are wrong. 37 CFR 1.28(c)(2)(i) (“The deficiency owed for each previous fee erroneously paid as a small entity is the difference between the current fee amount (for other than a small entity) on the date the deficiency is paid in full and the amount of the previous erroneous (small entity) fee payment...Where a fee paid in error as a small entity was subject to a fee decrease between the time the fee was paid in error and the time the deficiency is paid in full, the deficiency owed is equal to the amount (previously) paid in error.”) The current basic fee of \$710 for other than a small entity less than the previously paid small entity basic fee of \$345 results in a deficiency of \$365. There was no error in the previously paid IDS fee since \$240 was the proper amount at the time of payment for either a small entity or other than a small entity. Therefore, the IDS fee did not enter into the deficiency calculation.

October 17, 2001 PM

39. ANSWER: (D) is the correct answer. 35 U.S.C. § 41(h)(1); 37 CFR 1.17(e) and § 1.114, and MPEP § 509.02. (A) is incorrect because there is no support for (A) in 37 CFR 1.102. (B) is incorrect because there is no support for (B) in 37 CFR 1.8. (C) is incorrect because it is inconsistent with 35 U.S.C. § 42(d); 37 CFR 1.26. *Miessner v. United States*, 228 F.2d 643, 644 (D.C. Cir. 1955). (E) is incorrect because (D) is correct.

April 18, 2001 AM

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

April 18, 2001 PM

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

Under 37 CFR 1.8, a person may state on certain papers directed to the Office... the date on which the paper will be...transmitted by facsimile. If the date stated is within the period of reply, the reply in most instances will be considered timely. This is true even if the paper

does not actually reach the Office until after the end of the period for reply.

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

April 18, 2001 PM

50. ANSWER: (B) is the correct answer because the application is properly deposited with the USPS as “Express Mail Post Office to Addressee” and the “date-in” is properly entered by the USPS. MPEP § 502, subpart styled “‘Express Mail’ Service” states, “The only type of service which can be used for ‘Express Mail’ directed to the Patent and Trademark Office is the ‘Post Office to Addressee’ service of the U.S. Postal Service. 37 C.F.R. 1.10.” MPEP § 513 under the heading “Date-In, Direct Deposit, ‘Express Mail’ Box Receptacles & Log Books” recites, “The ‘date-in’ on the ‘Express Mail’ mailing label must be completed by the USPS, not the applicant.” MPEP § 513 under the heading “‘Express Mail’ Mailing Label Number” recites, “Effective December 2, 1996, 37 C.F.R. 1.10(b) no longer requires...that the ‘Express Mail’ mailing label number be placed on the correspondence prior to mailing.” MPEP § 513, subpart styled “Effective Date, Weekends & Holidays” states, “Effective December 2, 1996, 37 C.F.R. 1.6(a)(2) provides that correspondence deposited as ‘Express Mail’ in accordance with 37 C.F.R.

1.10 will be stamped, and, therefore, considered as filed on the date of its deposit, regardless of whether that date is a Saturday, Sunday or Federal holiday within the District of Columbia.” Therefore, (B) provides a filing date of March 10, 2001. (A) is wrong because the receipt date of March 12, 2001, is the filing date, since the “Express Mail Post Office to Post Office” procedure is ruled out by 37 C.F.R. § 1.10 and MPEP § 502. (C) is wrong because the receipt date of March 14, 2001, is the filing date, since the “date-in” was not entered by the USPS as required by MPEP § 513. (D) is wrong because the effective receipt date is March 26, 2001, since the “date-in” was not entered by the USPS as required by MPEP § 513. (E) is wrong because the receipt date is March 26, 2001, since the “Express Mail Post Office to Post Office” procedure is ruled out by 37 C.F.R. § 1.10 and MPEP § 502.

October 18, 2000 AM

42. ANSWER: (D). A non-provisional application filed without at least one claim is regarded as incomplete and will not be accorded a filing date. 35 U.S.C. § 111(a); 37 C.F.R. § 1.53(b); MPEP § 506. (A) is wrong because the component parts of a provisional application necessary to obtain a filing date do not include claims. 35 U.S.C. 111(b); 37 C.F.R. § 1.53(c); MPEP § 506 under heading “Incomplete Provisional Applications.” (B) and (C) are wrong because “[a]n error in or failure to identify inventorship does not raise a filing date issue.” MPEP § 506.02. (E) is wrong. Under 37 C.F.R. § 1.8(a)(2)(i)(A) no benefit is accorded to a certificate of mailing date. The effective date is the actual date of receipt, and not the certificate of mailing date.

October 18, 2000 PM

45. ANSWER: (A) is the correct answer because the application is properly deposited with the USPS as “Express Mail Post Office to Addressee” and the “date-in” is properly entered by the USPS. MPEP § 502, subpart styled “‘Express Mail’ Service” states, “The only type of service which can be used for ‘Express Mail’ directed to the Patent and Trademark Office is

the ‘Post Office to Addressee’ service of the U.S. Postal Service. 37 C.F.R. 1.10.” MPEP § 513 under the heading “Date-In, Direct Deposit, ‘Express Mail’ Box Receptacles & Log Books” recites, “The ‘date-in’ on the ‘Express Mail’ mailing label must be completed by the USPS, not the applicant.” MPEP § 513 under the heading “‘Express Mail’ Mailing Label Number” recites, “Effective December 2, 1996, 37 C.F.R. 1.10(b) no longer requires...that the ‘Express Mail’ mailing label number be placed on the correspondence prior to mailing.” MPEP § 513, subpart styled “Effective Date, Weekends & Holidays” states, “Effective December 2, 1996, 37 C.F.R. 1.6(a)(2) provides that correspondence deposited as ‘Express Mail’ in accordance with 37 C.F.R. 1.10 will be stamped, and, therefore, considered as filed on the date of its deposit, regardless of whether that date is a Saturday, Sunday or Federal holiday within the District of Columbia.” Therefore, (A) provides a filing date of June 24, 2000. (B) is wrong because the receipt date of June 26, 2000, is the filing date, since the “Express Mail Post Office to Post Office” procedure is ruled out by MPEP § 502. (C) is wrong because the receipt date of July 5, 2000, is the filing date, since the “date-in” was not entered by the USPS as required by MPEP § 513. (D) is wrong because the effective receipt date is July 3, 2000, since the “date-in” was not entered by the USPS as required by MPEP § 513. (E) is wrong because the receipt date is July 3, 2000, since the “Express Mail Post Office to Post Office” procedure is ruled out by MPEP § 502.

April 12, 2000 PM

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

April 12, 2000 PM

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

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

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

Parties who do use drop boxes can protect themselves from uncertainty due to illegible mailing labels by routinely maintaining a log of "Express Mail" deposits in which notations are entered by the person who deposited the correspondence as "Express Mail" within one business day after deposit with the USPS. Such evidence could be useful to later support a petition filed under 37 C.F.R. 1.10(c),

(d) or (e). Evidence that came into being after deposit and within one day after the deposit of the correspondence as "Express Mail" may be in the form of a log book which contains information such as the "Express Mail" number; the application number, attorney docket number or other such file identification number; the place, date and time of deposit; the time of the last scheduled pick-up for that date and place of deposit; the depositor's initials or signature; and the date and time of entry in the log.

April 12, 2000 PM

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

November 3, 1999 AM

30. ANSWER: (D). 37 CFR § 1.16(a) and (e); and MPEP § 509.01, which states, "For applications filed after February 27, 1983, if there is an authorization to charge the filing fee to a deposit account which is overdrawn or has insufficient funds, a surcharge (37 CFR § 1.16(e)) is required in addition to payment of the filing fee. Failure to timely pay the filing fee and surcharge will result in abandonment of the application."

November 3, 1999 PM

11. ANSWER: (E). 37 CFR § 1.8(a); and MPEP § 512. (A) is incorrect because the response would not be timely, even if the August 6<sup>th</sup> date is given to the response. The six month statutory period for response is measured from the date of the Office action, not the date the action was received. The response was mailed beyond the six month statutory period for response. (B) is incorrect because the U.S. Postal Service certificate of mailing does not comply with 37 CFR § 1.8(a). (C) is incorrect. The date of the certificate of mailing is after the statutory six month period for response. Therefore the response is not shown by the certificate to be timely mailed. (D) is incorrect because (A) and (C) are incorrect. (E) is correct because (A), (B), (C) and (D) are not correct.

November 3, 1999 PM

25. ANSWER: (C). 37 CFR §§ 1.10(a), and 1.53(b). "The filing date of an application for patent filed under this section, is the date on which a specification as prescribed by 35 U.S.C. § 112 containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office."

# **Chapter 600**

## **Questions**

April 15, 2003 AM

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

- (A) Where joint inventors are named, the examiner should not inquire of the patent applicant concerning the inventors and the invention dates for the subject matter of the various claims until it becomes necessary to do so in order to properly examine the application.
- (B) Under 35 USC 119(a), the foreign priority benefit may be claimed to any foreign application that names a U.S. inventor as long as the U.S. named inventor was the inventor of the foreign application invention and 35 USC 119(a)-(d) requirements are met.
- (C) Where two or more foreign applications are combined in a single U.S. application, to take advantage of the changes to 35 USC 103 or 35 USC 116, the U.S. application may claim benefit under 35 USC 119(a) to each of the foreign applications provided all the requirements of 35 USC 119(a)-(d) are met.
- (D) One of the conditions for benefit under 35 USC 119(a) is that the foreign application must be for the same or a nonobvious improvement of the invention described in the United States application.
- (E) If a foreign application for which priority is being claimed under 35 USC 119 is filed in a country which does not afford similar privileges in the case of applications filed in the United States or to citizens of the United States and the foreign country is not a WTO member country, any claim for the foreign priority thereto by a U.S. application will not be effective.

April 15, 2003 AM

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

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



April 15, 2003 AM

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

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

April 15, 2003 AM

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

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

April 15, 2003 AM

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

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

April 15, 2003 AM

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

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

April 15, 2003 AM

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

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

April 15, 2003 PM

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

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

April 15, 2003 PM

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

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

April 15, 2003 PM

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

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

April 15, 2003 PM

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

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

April 15, 2003 PM

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

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

October 16, 2002 AM

3. Which of the following is not in accordance with the recommended format for a claim set forth in the provisions of the MPEP?

- (A) Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation.
- (B) A claim may include plural indentations to further segregate subcombinations or related steps.
- (C) The claim or claims must commence on a separate sheet after the detailed description of the invention.
- (D) Each claim should end with a period.
- (E) A claim should always begin with “A”, “An” or “In.”

October 16, 2002 AM

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

Claim 1. A doughnut making machine comprising:

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

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

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

October 16, 2002 AM

9. Which of the following is not in accordance with the provisions of the MPEP?

- (A) The title of the invention should be placed at the top of the first page of the specification unless it is provided in the application data sheet.
- (B) The title need not be technically accurate, but should be descriptive and should contain fewer than 10 words.
- (C) Inasmuch as the words “improved,” “improvement of,” and “improvement in” are not considered as part of the title of an invention, these words should not be included at the beginning of the title of the invention and will be deleted when the Office enters the title into the Office’s computer records, and when any patent issues.

- (D) If a satisfactory title is not supplied by the applicant the examiner may, at the time of allowance, change the title by examiner's amendment. If the change to the title is the only change being made by the examiner at the time of allowance, a separate examiner's amendment need not be prepared and the examiner is to indicate the change in title in the file.
- (E) A title in a U.S. application need not be identical to the corresponding foreign filed application.

October 16, 2002 AM

19. Which of the following is not in accordance with the provisions of the MPEP Chapter 600?

- (A) A request for a refund must be filed within two years from the date the fee was paid or, in the case of a fee paid by mistake, within one year from the time the error was discovered.
- (B) A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid, including an application, an appeal or a request for an oral hearing, will not entitle a party to a refund of such fee.
- (C) The Office will not refund amounts of twenty-five dollars or less, unless a refund is specifically requested.
- (D) Any refund of a fee paid by credit card will be by a credit to the credit card account to which the fee was charged.
- (E) When a fee is paid where no fee is required, this is considered to be a fee paid by mistake.

October 16, 2002 AM

22. Which of the following is not in accordance with provisions of the MPEP?

- (A) In return for a patent, the inventor gives a complete disclosure of the invention for which protection is sought.
- (B) Amendments filed after the filing date that lack descriptive basis in the original disclosure involve new matter.
- (C) If during the course of examination of a patent application, an examiner notes the use of language that could be deemed offensive to any race, religion, sex, ethnic group, or nationality, he or she should object to the use of the language as failing to comply with the Rules of Practice.
- (D) The examiner should object to application drawings that include depictions or caricatures that might reasonably be considered offensive to any race, religion, sex, ethnic group or nationality.
- (E) Where an amendment is filed with a patent application that has no signed oath or declaration, a subsequently filed oath or declaration must refer to both the application and amendment, but in any case the amendment will not be considered as part of the original disclosure and will be treated as new matter.

October 16, 2002 AM

24. Which of the following is not in accordance with Office practice under 35 USC 42?

- (A) The Director may refund any fee paid by mistake or any amount paid in excess of that required.
- (B) A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent for which the fee was paid, including an application, an appeal or a request for an oral hearing, will not entitle a party to a refund of such fee.
- (C) Even if an applicant specifically requests a refund, the Office will not refund amounts of twenty-five dollars or less.
- (D) Any refund of fee paid by credit card will be by a credit to the credit card account to which the fee was charged.
- (E) If an applicant mistakenly files an application, the filing fee is not considered a fee paid by mistake.

October 16, 2002 AM

26. Which of the following is not in accordance with the recommended form for an abstract of the disclosure as provided for in the MPEP?

- (A) A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains.
- (B) If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure.
- (C) If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement.
- (D) In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or a use thereof.
- (E) The abstract should compare the invention with the prior art.

October 16, 2002 AM

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

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



October 16, 2002 AM

34. Jane files a nonprovisional application with the USPTO containing at least one drawing figure under 35 USC 113 (first sentence) and at least one claim. Subsequently, Jane receives a “Notice of Omitted Items” from the USPTO indicating that the application which Jane filed lacks page 5 of the specification. Assuming that the application without page 5 satisfies 35 USC 112, which of the following statements is true based on proper USPTO practice and procedure?

- (A) If Jane is willing to accept the application as filed, she need not respond to the Notice, and the Office will accord the filing date of the original application. Jane will need to file an amendment renumbering the pages consecutively and canceling incomplete sentences caused by the missing page 5.
- (B) Jane must promptly submit the omitted page and accept an application filing date as of the date of submission of the omitted page.
- (C) Jane must promptly submit the omitted page and will be accorded a filing date as of the date of filing the original application.
- (D) Within 3 months of the Notice date, Jane must file an affidavit asserting that page 5 was in fact deposited in the USPTO with the original application. Jane will be accorded the filing date of the original application.
- (E) Within 3 months of the Notice date, Jane must file a proper petition asserting that page 5 was in fact deposited in the USPTO with the original application, accompanied by the proper petition fee and evidence that page 5 was in fact deposited as alleged. Jane will be accorded the original filing date of the application.

October 16, 2002 AM

35. Where subject matter for which there is an enabling disclosure, but is not shown in the drawing or described in the detailed description preceding the claim(s), which of the following is not in accordance with the provisions of the MPEP?

- (A) In establishing a disclosure, applicant may rely not only on the description and drawing as filed but also on the original claims to show compliance with the first paragraph of 35 USC 112.
- (B) Where subject matter not shown in the drawing or described in the description is claimed in the application as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits, and the applicant should be required to amend the drawing and description to show this subject matter.
- (C) If subject matter appearing in the original claim is not found in the drawing or detailed description, the claim should be rejected for noncompliance with the first paragraph of 35 USC 112.
- (D) If the subject matter found in the claim is lacking in the drawing or detailed description, it is the drawing and description that are defective, not the claim.
- (E) The subject matter found in the original claims, but lacking in the drawing or detailed description, must be sufficiently specific and detailed to support an amendment of the drawing and detailed description.

October 16, 2002 AM

37. Which of the following is not in accordance with the provisions of the MPEP regarding an abstract of the disclosure?

- (A) The abstract of the disclosure has been interpreted to be a part of the specification for the purpose of compliance with paragraph 1 of 35 USC 112.
- (B) Any submission of a new abstract of the disclosure or amendment to an existing abstract should be carefully reviewed for introduction of new matter.
- (C) If an application is otherwise in condition for allowance except that the abstract of the disclosure does not comply with the guidelines, the examiner generally cannot make any necessary revisions by examiner's amendment, but should instead issue an *Ex parte Quayle* action requiring applicant to make the necessary revisions.
- (D) Under current practice, in all instances where the application contains an abstract of the disclosure when sent to issue, the abstract will be printed on the patent.
- (E) The content of a patent abstract should be such as to enable the reader thereof, regardless of his or her degree of familiarity with patent documents, to ascertain quickly the character of the subject matter covered by the technical disclosure and should include that which is new in the art to which the invention pertains.

October 16, 2002 AM

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

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

October 16, 2002 AM

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

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

claim.

- (E) The limitations or elements of each claim incorporated by reference into a multiple dependent claim must be considered separately.

October 16, 2002 AM

46. Which of the following statements relevant to a third party submission in a published patent application accords with proper USPTO practice and procedure?

- (A) A submission of patents by a member of the public must be made within 2 months of the date of publication of the application.
- (B) A submission of patents by a member of the public must be made prior to the mailing of a Notice of Allowance.
- (C) A submission of patents by a member of the public must be made within 2 months of the date of publication of the application or prior to the mailing of a Notice of Allowance, whichever is later.
- (D) A submission of patents by a member of the public must be made within 2 months of the date of publication of the application or prior to the mailing of a Notice of Allowance, whichever is earlier.
- (E) Any submission not filed within the period set forth in the patent rules will be accepted provided it is accompanied by the processing fee set forth in 37 CFR 1.17(i).

October 16, 2002 PM

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

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

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

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

October 16, 2002 PM

28. Which of the following is not in accordance with the provisions of 35 USC 115 (Oath of applicant)?

- (A) The applicant shall make oath (or declaration) that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent.
- (B) In the oath or declaration, the applicant must state of what country he is a citizen.
- (C) An oath may be made before any person within the United States authorized by law to administer oaths.
- (D) An oath executed in a foreign country must be properly authenticated.
- (E) A declaration which accompanies a patent application must state on the document a warning that willful false statements and the like are punishable by fine or imprisonment or both under 18 USC 1001, and the declaration must be notarized.

October 16, 2002 PM

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

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

October 16, 2002 PM

35. Which of the following is not in accordance with the provisions of the MPEP?

- (A) If there is a discrepancy between the information submitted in an application data sheet and the information submitted elsewhere in the application, the application data sheet will control except for the naming of the inventors and the citizenship of the inventors, which is governed by the oath or declaration.
- (B) A patent examiner should object to text of a patent application if it contains an embedded hyperlink and /or other form of browser-executable code.
- (C) All patent applicants should use the English units of measurement followed by the equivalent metric units when describing their inventions in the specifications of patent applications.
- (D) The paper used for patent applications must have a surface such that amendments may be written thereon in ink; so-called "Easily Erasable" paper having a special coating so that erasures can be made more easily may not provide a permanent copy as is required.
- (E) The following documents may be submitted to the Office on a compact disc: a computer program listing, a sequence listing, and a table that has more than 50 pages of text.

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37. Which of the following is not in accordance with the recommended characteristics set forth in the MPEP for the detailed description of the invention?

- (A) The detailed description of the invention must include a description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71.
- (B) The detailed description should be as short and specific as is necessary to describe the invention adequately and accurately.
- (C) Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described, and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail.
- (D) The detailed description of the invention may include reference characters to the parts of the invention that do not appear in the drawings.
- (E) Where particularly complicated nonessential subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, absent disclosure elsewhere in the application, the specification should refer to another patent or readily available publication that adequately describes the subject matter.

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39. Which of the following is not in accordance with the recommended characteristics set forth in the provisions of the MPEP for the summary of the invention?

- (A) The summary is separate and distinct from the abstract and is directed toward the disclosure as a whole, rather than just the invention.
- (B) The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention).
- (C) In chemical cases the summary should point out in general terms the utility of the invention.
- (D) If possible, the summary should set forth the nature and gist of the invention or the inventive concept should be set forth.
- (E) Any stated objects of the invention should be treated briefly in the summary and only to the extent that they contribute to an understanding of the invention.

April 17, 2002 AM

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.

April 17, 2002 AM

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.

April 17, 2002 AM

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.

April 17, 2002 PM

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.

April 17, 2002 PM

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.

April 17, 2002 PM

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.



April 17, 2002 PM

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.

April 17, 2002 PM

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.

April 17, 2002 PM

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.

April 17, 2002 PM

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.

April 17, 2002 PM

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.

October 17, 2001 AM

2. You are a registered practitioner. Earl, your new associate, has been assigned the task of filing information disclosure statements for patents and publications submitted by a client Tony, who is the named inventor on several patent applications, all of which were filed on or after January 1, 2001. Earl wants to know what information must be included on the information disclosure statements. Which of the following is not accurate with respect to proper USPTO procedure?

- (A) If a non-English reference is submitted in an information disclosure statement, the applicant shall include a copy of the translation if a written English-language translation of a non-English-language document, or portion thereof, if it is within the possession, custody, or control of, or is readily available to any individual designated in 37 CFR 1.56(c).
- (B) Each U.S. patent listed in an information disclosure statement must be identified by inventor, application number, and issue date.
- (C) Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.
- (D) When the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications, provided that it is stated that these other patents or publications are cumulative.
- (E) A copy of any patent, publication, pending U.S. application or other information listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application, unless: (1) the earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. § 120; and (2) the information disclosure statement submitted in the earlier application is in full compliance with appropriate regulations.

October 17, 2001 AM

5. You have agreed to represent an independent inventor in connection with a patent application that was filed in the USPTO by the inventor on a *pro se* basis. As filed, the application included a detailed written description that, when viewed together with four accompanying color photographs, enabled one of ordinary skill in the pertinent art to make and use the invention. The application was filed with an inventor's declaration in compliance with 37 CFR 1.63, a small entity statement (independent inventor) under 37 CFR 1.27, and all necessary small entity filing fees. MEGACORP, a very large multi-national corporation, licensed rights in the invention after the application was filed.

You have been asked to suggest steps to remove any formal objections that can be expected from the patent examiner, without incurring unnecessary government fees. You determine that the first color photograph is the only practical medium by which to disclose certain aspects of the claimed invention, but that the substance of the remaining photographs could readily be illustrated through ordinary ink drawings. You correctly recall that the Office announced in the Official Gazette in May 2001 (1246 OG 106) that it is *sua sponte* waiving 37 CFR 1.84(a)(2)(iii), and is no longer requiring a black and white photocopy of any color drawing or color photograph. Which of the following represents the most reasonable advice to the independent inventor?

- (A) Submit a request for approval of drawing changes wherein the first photograph is labeled "Figure 1" and the remaining photographs are cancelled in favor of corresponding ink drawings labeled Figures 2 through 4; and immediately withdraw the claim for small entity status because of the license to MEGACORP.
- (B) Submit a request for approval of drawing changes wherein the first photograph is labeled "Figure 1" and the remaining photographs are cancelled in favor of corresponding ink drawings labeled Figures 2 through 4; and submit a petition for acceptance of Figure 1 in the form of a color photograph along with three sets of the color photograph, a proposed amendment to insert language concerning the color photograph as the first paragraph of the specification and the required petition fee. The photographs must be sufficient quality that all details in the photographs are reproducible in a printed patent.
- (C) Submit a request for approval of drawing changes wherein the first photograph is labeled "Figure 1" and the remaining photographs are cancelled in favor of corresponding ink drawings labeled Figures 2 through 4.
- (D) Immediately withdraw the claim for small entity status because of the license to MEGACORP and submit to the USPTO the difference between the small entity filing fee and the large entity filing fee.
- (E) File a rewritten application as a continuation application including a color photograph as Figure 1, ink drawings as Figures 2-4, a new inventor's declaration and a small entity filing fee.

October 17, 2001 AM

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

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

October 17, 2001 AM

22. Tony, an inventor/client in several pending applications which you have filed, comes to you with several publications and patents which he has discovered for the first time while cleaning out his brother-in-law's attic last week. Tony's brother-in-law was not an individual within the scope of 37 CFR 1.56. Tony's brother-in-law has what appears to be material prior art for four of Tony's applications, A, B, C and D. Tony wants to know if it is too late to file information disclosure statements to have the examiner consider the information. Tony also wants to know if he does file an information disclosure statement, is he making a statement that a search has been conducted and that the items he discovered are material? Application A was filed two months ago and no Office action has issued. Application B was filed six

months ago and a first, non-final, action has issued. In Application C, a Notice of Allowability has issued and the issue fee has not been paid. In Application D, a Notice of Allowability has issued and the issue fee has been paid. Which of the following is not true with respect to the proper USPTO procedure in relation to Tony's applications, all of which were filed on or after January 1, 2001?

- (A) The USPTO would consider an information disclosure statement signed by Tony in regard to application B, if the statement signed by Tony is filed within three months of Tony knowing the information and before the mailing date of a final action under 37 CFR 1.113, a notice of allowance under 37 CFR 1.311, or an action that otherwise closes prosecution in the application. The information disclosure statement must be accompanied by one either (1) the appropriate fee or (2) a statement that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application. Further, the statement must include Tony's certification, after making reasonable inquiry, to his knowledge that no item of information contained in the information disclosure statement was known to any individual within the scope of 37 CFR 1.56(c) more than three months prior to the filing of the information disclosure statement.
- (B) For application C, an information disclosure statement must be considered by the Office if the statement, signed by Tony, is filed after Notice of Allowance was mailed and on or before payment of the issue fee, and is accompanied by both the appropriate fee, and a statement that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application. Further, the statement must include Tony's certification, after making reasonable inquiry, to his knowledge that that no item of information contained in the information disclosure statement was known to any individual within the scope of 37 CFR 1.56(c) more than three months prior to the filing of the information disclosure statement.
- (C) No extensions of time for filing an information disclosure statement are permitted under 37 CFR 1.136, however, if a *bona fide* attempt is made to comply with 37 CFR 1.98, but part of the required content is inadvertently omitted, additional time may be given to enable full compliance.
- (D) A properly filed information disclosure statement shall be construed as a representation that a diligent and thorough search has been made.
- (E) The filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in 37 CFR 1.56(b).

October 17, 2001 AM

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

- (A) Filing the information disclosure statement on November 15, 2000, without any further statement and without the fee set forth in 37 CFR 1.17(p).
- (B) Filing the information disclosure statement on December 11, 2000, without any further statement and without the fee set forth in 37 CFR 1.17(p).
- (C) Filing the information disclosure statement on December 13, 2000, without any further statement and without the fee set forth in 37 CFR 1.17(p).
- (D) (A) or (B) above.
- (E) None of the above.

October 17, 2001 AM

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

Claim 1. A doughnut making machine comprising:

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

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

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

October 17, 2001 AM

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

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



October 17, 2001 PM

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

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

October 17, 2001 PM

7. Izzy decides one day that the hydrogen fuel cell research in which he is engaged shows great potential and retains the services of a patent law firm. A patent application is promptly prepared and filed in the USPTO disclosing and claiming a hydrogen fuel cell wherein the electrodes employed to catalyze the hydrogen gas into positive ions and negative ions consist of a platinum catalyst. The original claims are fully supported by the application as filed. Two preliminary amendments are submitted after the original filing, but prior to initial examination. In the first preliminary amendment, the specification, but not the claims, is amended to recite that the electrodes may consist of a niobium catalyst. In the second preliminary amendment, the specification and the claims are amended to recite that the electrodes may consist of an iridium catalyst. In the first Office action, the examiner determined that both amendments involve new matter and required their cancellation. In addition, the examiner rejected all the claims under 35 U.S.C. §112, first paragraph on the ground that they recited elements without support in the original disclosure. Ultimately, the examiner issued a Final Rejection on the same basis. Based upon proper USPTO practice and procedure, which of the following is correct?

- (A) Review of the determination that both the first preliminary amendment and the second preliminary amendment contain new matter is by appeal.
- (B) Review of the determination that both the first preliminary amendment and the second preliminary amendment contain new matter is by petition.
- (C) Review of the determination that the first preliminary amendment contains new matter is by appeal, and review of the determination that the second preliminary amendment contains new matter is by petition.
- (D) Review of the determination that the first preliminary amendment contains new matter is by petition, and review of the determination that the second preliminary amendment contains new matter is by appeal.
- (E) (A), (B), (C), and (D).

October 17, 2001 PM

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

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

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

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

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

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

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

Claim 1. An apparatus for sitting comprising:

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

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

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

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

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

- (A) A Certificate of Mailing or Transmission under 37 CFR 1.8 is proper for filing a Continued Prosecution Application under 37 CFR 1.53(d) to obtain the date of the Certificate as the filing date for the application.
- (B) The fee an applicant must pay to request continued examination of an application is set in an amount equal to the basic filing fee the same applicant must pay for a utility patent application.
- (C) The Office does not charge a fee for processing a fee paid by a check that has been refused, *i.e.*, dishonored and returned, by a financial institution.
- (D) To first request conversion of a provisional application containing a claim to a nonprovisional application after the provisional application has become abandoned, a petition to revive, accompanied by the appropriate fees, a showing of unavoidable delay, and a request for the conversion must be filed within one year of the date of abandonment.
- (E) The conversion of a provisional application, for which a basic filing fee was properly paid, to a nonprovisional application will result in the savings of filing and other fees over the filing of a nonprovisional application claiming the benefit under 35 U.S.C. § 119(e) and 37 CFR 1.78 of the earlier provisional filing date.

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35. Tony, a client, comes to you with regard to a competitor's two published patent applications, A and B, which were published one month ago. Tony shows you several material prior art publications and patents that he discovered for the first time while cleaning out his brother-in-law's attic last week. Assume no Notice of Allowance has been mailed in application A and a Notice of Allowance has been mailed in application B. Tony wants to know if it is too late to submit the information to the USPTO for consideration by the examiner. He also wants to know how it is accomplished, if the applicant needs to be served a copy, whether a fee is required and whether an explanation is needed for each reference. Which of the following is not accurate with respect to proper USPTO procedure?

- (A) The submission by Tony of patents or publications relevant to pending published application A will be permitted without the necessity of paying the processing or petition fee required by 37 CFR 1.17(i) if the patents or publications are submitted within two months of the publication of the competitor's application.
- (B) Each submission must identify the application to which it is directed by application number and include: (1) the appropriate fee set forth in 37 CFR 1.17(p); (2) a list of the patents or publications submitted for consideration by the Office, including the date of publication of each patent or publication; (3) a copy of each listed patent or publication in written form or at least the pertinent portions; and (4) an English language translation of all the necessary and pertinent parts of any non-English language patent or publication in written form relied upon.
- (C) The submissions by Tony of patents or publications relevant to both of the pending published applications A and B need not be served upon the applicant.
- (D) The submissions by Tony of patents or publications relevant to the pending published applications A and B shall not include any explanation of the patents or publications, or any other information.
- (E) The submission by Tony of patents or publications relevant to pending published application B will be permitted only if accompanied by the processing fee as set forth in 37 CFR 1.17(i).

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

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

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45. You are prosecuting a patent application wherein an Office Action has been issued rejecting the claims as being obvious over the prior art and objecting to the drawings as failing to illustrate an item that is fully described in the specification and included in a dependent claim. The Examiner has required an amendment to Figure 1 to illustrate the item. In preparing a reply to the Office Action, you identify several errors in Figure 2 that also should be corrected. Assuming that you make a small amendment to the claims and develop persuasive arguments to overcome the obviousness rejection, and that the Examiner will not object to your desired changes to Figure 2, which of the following actions is likely to lead to the most favorable result?

- (A) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. Submit a separate cover letter for replacement Figures 1 and 2 that incorporate the amendments to the drawings.
- (B) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. In the Remarks portion of the reply, explain the proposed drawing changes and attach copies of Figures 1 and 2 with the changes marked in red for the Examiner's review and approval.
- (C) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. In a separate paper, explain the proposed drawing changes and attach copies of Figures 1 and 2 with the changes marked in red for the Examiner's review and approval.
- (D) Options (A), (B) and (C) are equally likely to lead to the most favorable result.
- (E) Options (B) and (C) are equally likely to lead to the most favorable result.

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

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

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

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

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

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

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

- (A) Conversion of a provisional application to a nonprovisional application will result in the term of any patent to issue from the application being measured from at least the filing date of the provisional application.
- (B) Conversion of a provisional application to a nonprovisional application cannot adversely impact on the term of any patent to issue from the application.
- (C) An applicant having filed a provisional application can avoid any adverse patent term impact resulting from converting the provisional application to a nonprovisional application by instead filing a nonprovisional application claiming the benefit of the provisional application under 35 U.S.C. § 119(e).
- (D) An applicant filing a nonprovisional application claiming the benefit under 35 U.S.C. § 119(e) and 37 C.F.R. § 1.78 of an earlier provisional application, and

not requesting conversion of the provisional to a nonprovisional application can avoid the fee required to convert a provisional application to a nonprovisional application, as well as an adverse patent term effect that would result from a conversion.

- (E) The twelve month period of pendency of a provisional application extends to the next secular or business day which is not a Saturday, Sunday, or Federal holiday in the District of Columbia if the day that is twelve months after the filing date of the provisional application under 35 U.S.C. § 111(b) and 37 C.F.R. § 1.53(c) falls on a Saturday, Sunday, or a Federal holiday in the District of Columbia.

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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.

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

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



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

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

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

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

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

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

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

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

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1. Which of the following is in accord with proper USPTO practice and procedure?

- (A) Upon request to convert a provisional application to a nonprovisional utility application, the nonprovisional application is accorded a filing date as of the date on which the request to convert was filed, but the original filing date of the provisional application is preserved.
- (B) If a provisional application does not have a claim as filed, and a claim is not filed with a timely request to convert the provisional application to a nonprovisional utility application, the Office will notify the applicant and set a time period for submitting a claim for examination.
- (C) A provisional application filed in November 2000 is entitled to the right of priority under 35 U.S.C. § 119 of a copending utility application for patent filed in Great Britain in January 2000.
- (D) A request filed in January 2001, to convert a provisional application filed in the USPTO in April 2000, to a nonprovisional utility application is timely if filed after the abandonment of the provisional application, i.e., after the pendency of the provisional application, but within twelve months of the filing date of the provisional application provided no petition to revive has been filed and granted.
- (E) A nonprovisional utility application filed under the provisions of 37 CFR § 1.53(b) in January 2001, and claiming the benefit of the earlier filing date of a provisional application must be filed during the pendency of the provisional application.

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

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

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

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

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

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

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

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31. Assuming that each of the following claims is in a separate application, and there is no preceding multiple dependent claim in any of the applications, which claim is in acceptable multiple dependent claim form?
- (A) Claim 8. A machine according to any one of the preceding claims wherein...
  - (B) Claim 5. A device as in one of claims 1-4, wherein...
  - (C) Claim 10. A device as in any of claims 1-4 or 6-9, in which...
  - (D) Claim 4. A machine according to claim 2 or 3, also comprising...
  - (E) The claim form in (A), (B), (C) and (D) is acceptable.

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41. A nonprovisional patent application was filed on December 1, 2000, including a patent application declaration and an application data sheet. The application data sheet that includes the applicant's full name, residence, mailing address, and citizenship. The application data sheet does not include any foreign priority information. Which of the following must be identified in the declaration?
- (A) Applicant's mailing address.
  - (B) Applicant's citizenship.
  - (C) Any foreign application for patent for which a claim for priority is made by Applicant pursuant to 37 CFR § 1.55.
  - (D) (B) and (C).
  - (E) All of the above.

April 18, 2001 PM

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

Claim 1. An apparatus for sitting comprising:

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

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

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

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

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

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

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7. You, a registered patent practitioner, have agreed to represent an independent inventor in connection with a patent application that was filed in the United States Patent and Trademark Office by the inventor on a *pro se* basis. As filed, the application lacks an abstract of the disclosure, but included a detailed written description that contained numerous errors. However, when viewed together with four accompanying color photographs, the application disclosure was adequate to enable one of ordinary skill in the pertinent art to make and use the invention. The application also included three independent patent claims, an inventor's declaration in compliance with 37 C.F.R. § 1.63, a small entity statement (independent inventor) under 37 C.F.R. § 1.27, and all necessary small entity filing fees. The inventor has been granted a filing date and has received an official filing receipt. MEGACORP, a very

large multi-national corporation, licensed rights in the invention shortly after the application was filed and, therefore, the inventor wants to ensure that the application is properly handled.

The inventor has asked you to suggest steps to help expedite prosecution and to remove any formal objections that can be expected from the examiner, without incurring unnecessary government fees. You determine that the first color photograph is the only practical medium by which to disclose certain aspects of the claimed invention, but that the substance of the remaining photographs could readily be illustrated through ordinary ink drawings. Which of the following represents the most reasonable advice to the independent inventor?

- (A) Prepare a preliminary amendment to correct errors in the detailed description, add an abstract of the disclosure, revise the existing claims and present additional dependent claims to more fully protect the invention; submit a request for approval of drawing changes wherein the first photograph is labeled “Figure 1” and the remaining photographs are cancelled in favor of corresponding ink drawings labeled Figures 2 through 4; and immediately withdraw the claim for small entity status because of the license to MEGACORP.
- (B) Prepare a preliminary amendment to correct errors in the detailed description, add an abstract of the disclosure, revise the existing claims and present additional dependent claims to more fully protect the invention; submit a request for approval of drawing changes wherein the first photograph is labeled “Figure 1” and the remaining photographs are cancelled in favor of corresponding ink drawings labeled Figures 2 through 4; and submit a petition for acceptance of Figure 1 in the form of a color photograph along with a proposed amendment to insert language concerning the color photograph as the first paragraph of the specification and the required petition fee.
- (C) Prepare a preliminary amendment to correct errors in the detailed description and to present additional dependent claims to more fully protect the invention; and submit a request for approval of drawing changes wherein the first photograph is labeled “Figure 1” and the remaining photographs are cancelled in favor of corresponding ink drawings labeled Figures 2 through 4.
- (D) Prepare a preliminary amendment to correct errors in the detailed description and to present additional claims that more fully protect the invention; and immediately withdraw the claim for small entity status because of the license to MEGACORP and submit to the USPTO the difference between the small entity filing fee and the large entity filing fee.
- (E) Completely rewrite the written description and claims as part of a new application and file it as a continuation application, including a color photograph as Figure 1, ink drawings as Figures 2-4, a new inventor’s declaration and a small entity filing fee.

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15. Which of the following would not be permitted to be incorporated by reference in your client's U.S. utility patent application?

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

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

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

October 18, 2000 AM

35. You, a registered patent practitioner, receive a Notice of Allowance and Issue Fee Due in an application you know is very important to your client, Acme Incorporated. The application has been pending for several years. In accordance with standing instructions from Acme, you immediately pay the issue fee and then report to the client receipt of the Notice of Allowance and payment of the issue fee. One week later, you receive a call from Acme's CEO informing you that three weeks earlier a competitor, Zenith Manufacturing, had forwarded to her copies of several prior art patents. Although she had never seen these prior art patents before, she immediately recognized their materiality to the claims of the pending Acme application. However, she was very busy with other business and therefore did not previously inform you of the patents. Given the importance of the application to Acme, she wants you to ensure that the examiner officially considers the prior art patents during prosecution of the Acme application. Which of the following is likely to be your best course of action to ensure proper consideration of the prior art by the examiner, while minimizing unnecessary costs and delays in issuance of a patent to Acme?

- (A) Promptly file an Information Disclosure Statement ("IDS") signed by you that includes a statement that no item of information contained in the IDS was cited in a communication from a foreign patent office in a counterpart foreign application, and, to your knowledge after a reasonable inquiry, no item of information contained in the IDS was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of the IDS.

- (B) Promptly file an Information Disclosure Statement (“IDS”) signed by you that includes a statement that no item of information contained in the IDS was cited in a communication from a foreign patent office in a counterpart foreign application, and, to your knowledge after a reasonable inquiry, no item of information contained in the IDS was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of the IDS; and pay a fee for late submission of the IDS.
- (C) Promptly file an Information Disclosure Statement (“IDS”) along with payment of a fee for late submission of the IDS.
- (D) Promptly file an Information Disclosure Statement (“IDS”) signed by you that includes a statement that no item of information contained in the IDS was cited in a communication from a foreign patent office in a counterpart foreign application, and, to your knowledge after a reasonable inquiry, no item of information contained in the IDS was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of the IDS; and submit a petition requesting consideration of the IDS and payment.
- (E) Promptly petition to withdraw the application from issue, pay the necessary petition fee, and file continuation application along with an Information Disclosure Statement.

October 18, 2000 AM

43. Which of the following definitions does not accord with proper USPTO practice and procedure relating to drawings in patent applications?

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

October 18, 2000 AM

46. Which of the following statements regarding an applicant’s duty to submit a drawing in a U.S. patent application is true?

- I. The examiner may only require a drawing where the drawing is necessary for the understanding of the invention.
- II. If a drawing is not necessary for the understanding of the invention, but the case admits of illustration, the examiner may require the drawing, but the lack of a drawing in the application when filed will not affect the filing date of the application.
- III. If a drawing is necessary for the understanding of an invention, but is not submitted on filing, the application cannot be given a filing date until the drawing is received by the USPTO.



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

October 18, 2000 AM

48. A nonprovisional patent application is filed on June 3, 1999, and on September 3, 1999, an Office action is mailed setting a 3 month shortened statutory period for reply. On March 3, 2000, a proper reply is filed together with a petition for a 3 month extension of time accompanied by the appropriate petition fee. A proper petition for conversion of the nonprovisional patent application to a provisional patent application along with the appropriate petition fee is deposited with the U.S. Postal Service as Express Mail pursuant to 37 C.F.R. § 1.10 on Saturday, June 3, 2000. Assuming the petition for conversion is granted shortly thereafter, which of the following statements is true?

- (A) The provisional application is entitled to a filing date of June 3, 1999.
- (B) The provisional application is entitled to a filing date of September 3, 1999.
- (C) The provisional application is entitled to a filing date of March 3, 2000.
- (D) The provisional application is entitled to a filing date of June 3, 2000.
- (E) None of the above.

October 18, 2000 PM

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

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

October 18, 2000 PM

21. You are prosecuting a patent application wherein an Office action has been issued rejecting the claims as being obvious over the prior art and objecting to the drawings as failing to illustrate an item that is fully described in the specification and included in a dependent claim. The examiner has required an amendment to Figure 1 to illustrate the item. In preparing a reply to the Office action, you identify several errors in Figure 2 that should also be corrected. Assuming that you make an amendment to the claims and develop persuasive arguments to overcome the obviousness rejection and that the examiner will not object to your desired changes to Figure 2, which of the following actions is likely to lead to the most favorable result?

- (A) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. Submit a separate cover letter for replacement Figures 1 and 2 that incorporate the amendments to the drawings.
- (B) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. In the Remarks portion of the reply, explain the proposed drawing changes and attach copies of Figures 1 and 2 with the changes marked in red for the examiner's review and approval.
- (C) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. In a separate paper, explain the proposed drawing changes and attach copies of Figures 1 and 2 with the changes marked in red for the examiner's review and approval.
- (D) Options (A), (B) and (C) are equally likely to lead to the most favorable result.
- (E) Options (B) and (C) are equally likely to lead to the most favorable result.

October 18, 2000 PM

28. You filed an application on behalf of inventor Sam, obtaining an effective filing date of September 7, 1999. You received a non-final Office action dated August 7, 2000. On October 6, 2000, you timely filed a reply under 37 C.F.R. § 1.111. You received a Notice of Allowance dated October 12, 2000. On October 15, 2000, Sam showed you a journal article dated September 5, 1998, which is material to the patentability of Sam's invention as claimed. Which of the following actions, if taken by you, are in accordance with proper USPTO rules and procedure?

- I. Pay the issue fee on October 18, 2000 and do not file an information disclosure statement disclosing the article dated September 5, 1999, since after the issue fee has been paid on an application, it is impractical for the Office to attempt to consider newly submitted information.
  - II. Prior to paying the issue fee, file an information disclosure statement disclosing the article dated September 5, 1998, and the fee set forth in 37 C.F.R. § 1.17(p).
  - III. Prior to paying the issue fee, file an information disclosure statement disclosing the article dated September 5, 1998, a statement as specified in 37 C.F.R. § 1.97(e), a petition requesting consideration of the information disclosure statement, and the petition fee set forth in 37 C.F.R. § 1.17(i).
- (A) I
  - (B) II
  - (C) III
  - (D) I and III
  - (E) I, II, and III

October 18, 2000 PM

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

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

October 18, 2000 PM

37. You have taken over prosecution of a patent application in January 1998 that had previously been handled by another patent practitioner. The original application had been filed with all required fees, a preliminary amendment, and a signed inventor’s declaration referring to the original application. The original application contained independent claims 1 and 7 and dependent claims 2-6 and 8-14. The preliminary amendment added independent claim 15 and dependent claims 16-19, but made no changes to the specification. A first, nonfinal Office action issued wherein the examiner determined that claim 17 included new matter. The examiner rejected claim 17 on this basis and required cancellation of the claim. All other claims were allowed. You have been asked to respond to the Office action. Which of the following is the most reasonable reply?

- (A) File a Request for Reconsideration explaining that since the Preliminary Amendment was filed concurrently with the original application, the examiner should consider the Preliminary Amendment to be part of the original disclosure and the rejection should be removed.
- (B) File a Petition under 37 C.F.R. § 1.181 for a review of the examiner’s determination that claim 17 includes new matter along with any required fees.
- (C) File a Notice of Appeal along with any required fees.
- (D) Submit a new inventor’s declaration that refers to both the original application and the preliminary amendment along with a Request for Reconsideration explaining that since the Preliminary Amendment was filed concurrently with the original application, the examiner should consider the Preliminary Amendment to be part of the original disclosure and the rejection should be removed.
- (E) Submit a new inventor’s declaration that refers to both the original application and the preliminary amendment, file a Petition under 37 C.F.R. § 1.182 along with the petition fee, requesting that the original oath or declaration be disregarded and that the application be treated as an application filed without an oath or declaration, and pay the surcharge for missing parts.

October 18, 2000 PM

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

Claim 1. An apparatus for sitting comprising:

- (i) a square shaped base member;
- (ii) four elongated members mounted to the bottom of the base member; and
- (iii) a circular back member mounted to the base member. Claim 2. An apparatus as in claim 1, further comprising a spring connected to the back member and to the base member.

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

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

October 18, 2000 PM

39. Al files an application for a patent. After the Notice of Allowance is mailed and the issue fee has been paid Al discovers a prior art reference which is material to patentability. What should Al do?

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

October 18, 2000 PM

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

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

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

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

October 18, 2000 PM

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

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

October 18, 2000 PM

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

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

April 12, 2000 AM

3. A multiple dependent claim:

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

April 12, 2000 PM

13. Upon filing in the PTO, an original, nonprovisional patent application contains the following claims: Claim 1 is independent. Claim 2 depends from Claim 1. Claim 3 depends from Claim 2. Claim 4 depends from Claim 2 or 3. Claim 5 depends from Claim 3. Claim 6 depends from Claim 2, 3, or 5. The application contains only the foregoing claims. How many dependent claims are there for fee calculation purposes?

- (A) 4
- (B) 5
- (C) 7
- (D) 8
- (E) 9

April 12, 2000 PM

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

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

April 12, 2000 PM

26. The following three original claims in inventor Smith's regular utility patent application are fully supported by the disclosure in the specification:

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

The examiner properly rejected Claim 3 under 35 U.S.C. § 112, second paragraph, citing the claim's improper dependency. In the absence of issues of supporting disclosure, which of the following proposed amendments is presented in proper claim format?

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

April 12, 2000 PM

40. In which of the following situations is the Commissioner authorized to refund a fee?

- (A) After receiving a final rejection, a notice of appeal and appeal fee are filed. After the notice of appeal and correct appeal fee are filed, the examiner thereafter withdraws the final rejection.
- (B) Upon a showing of an extraordinary situation, when justice requires refund of a fee paid to the PTO where a practitioner paid the correct fee for an extension of time to provide the client with time to given instructions, and the client thereafter informs the practitioner that the client would not pay the fee and authorizes the practitioner to permit the application to become abandoned.
- (C) Upon a showing that the application, which had been filed in the PTO and for which the correct filing fee had been paid, has been withdrawn from examination and expressly abandoned.
- (D) Upon a petition to the Commissioner to exercise his supervision to refund a fee, though paid in the correct amount, when the practitioner no longer desired copies of patents ordered.
- (E) Upon a showing that the fee was paid by mistake or in excess of the amount required by law.

November 3, 1999 AM

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

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

November 3, 1999 AM

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

Claim 1. An industrial lubricant consisting essentially of equal parts of chemical W, chemical X, chemical Y and chemical Z.

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

Which of the following statements is/are correct?

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



November 3, 1999 AM

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

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

November 3, 1999 AM

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

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

November 3, 1999 AM

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

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

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

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

November 3, 1999 AM

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

Claim No.

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

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

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

November 3, 1999 AM

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

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

November 3, 1999 AM

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

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

November 3, 1999 PM

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

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

November 3, 1999 PM

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

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

November 3, 1999 PM

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

- (A) If a claim is cancelled by an amendment and a new claim is added in the amendment, then the new claim should be numbered using the number previously assigned to the canceled claim.
- (B) A claim which recites the best mode of carrying out the invention can only properly incorporate by reference the limitations having the essential material into the claim, for purposes of satisfying the requirements of 35 U.S.C. § 112, second paragraph, if the reference is made to a U.S. patent or U.S. patent application.
- (C) For fee calculation purposes, a multiple dependent claim which refers directly to independent claims and dependent claims will always be considered to be the number of independent claims to which direct reference is made therein.

- (D) The subject matter disclosed in a first claim which is part of the original disclosure in a nonprovisional patent application may be relied upon for purposes of enabling a second claim in the application in order to satisfy the requirements of 35 U.S.C. § 112, first paragraph, even if the detailed description and drawings, taken alone, are inadequate to satisfy the requirements of 35 U.S.C. § 112, first paragraph, with respect to the second claim.
- (E) None of the above.

November 3, 1999 PM

42. A multiple dependent claim may not properly depend upon \_\_\_\_\_.

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

November 3, 1999 PM

49. In preparing an application claiming only apparatus to be filed in the PTO, you inadvertently forgot to include a figure in the drawings. While, you did include a brief description of the figure in the written description of the invention in the specification nevertheless the invention of Claim 10 cannot be understood without the omitted figure in the drawings. Only after the application had been filed in the PTO did you realize that the figure was omitted. The application as filed included a proper declaration under 37 CFR § 1.63 signed by the inventor. What document(s), if any, must be filed in the PTO to obtain the original filing date in accordance with proper PTO practice and procedure?

- (A) An amendment deleting the description of the figure and Claim 10, and a petition with the proper fee to have the application accepted without the omitted figure.
- (B) An amendment filed before the first Office action deleting all references to the omitted figure and Claim 10 to have the application accepted without the omitted figure.
- (C) A petition and an amendment to add the figure to the application as soon as possible, and a supplemental declaration stating the omitted figure accurately illustrates and is part of the applicant's invention.
- (D) The omitted figure along with a supplemental oath or declaration stating that the omitted figure accurately illustrates and is part of the applicant's invention.
- (E) An amendment adding the figure to the application.



# **Chapter 600**

## **Answers**

April 15, 2003 AM

9. ANSWER: (D) is the best answer as the inventions must be the same in the foreign and U.S. applications. 35 U.S.C. § 119(a). As to (A) through (C), see MPEP § 605.07. As to (E), see 35 U.S.C. § 119, which provides that the previously filed application must have been filed in a country that affords similar privileges in the case of applications filed in the United States or to citizens of the United States or in a WTO member country.

April 15, 2003 AM

16. ANSWER: (A) is the most correct answer. See 35 U.S.C. § 111; 37 CFR § 1.53; MPEP § 601.01. As provided in MPEP § 601.01(a), the filing fee for an application filed under 37 CFR 1.53(b) can be submitted after the filing date. Answers (B), (C), (D) and (E) are incorrect. See 37 CFR § 53(b); MPEP § 601.01. 37 CFR § 1.53(b) provides that a filing date is granted on the date on which a specification as prescribed by 35 U.S.C. § 112 containing a description pursuant to 37 CFR § 1.71 and at least one claim pursuant to 37 CFR § 1.75, and any drawing required by 37 CFR § 1.81(a) are filed in the Office. Thus, (B), (C), (D) and (E) are needed to obtain a filing date.

April 15, 2003 AM

26. ANSWER: Answer (A), describing a procedure that is not in accordance with the USPTO rules and the procedures set forth in the MPEP, is the most correct answer. See MPEP § 609, under the heading “Minimum Requirements for an Information Disclosure Statement,” and subheading “B(3). Information Disclosure Statement Filed After B(2), but Prior to Payment of Issue Fee 37 CFR 1.97 (d)”, and subheading “B(5) Statement Under 37 CFR 1.97(e).” The statement specified in 37 CFR § 1.97(e) requires that the practitioner certify, after reasonable inquiry, that no item of information contained in the IDS was known to any individual designated in 37 CFR § 1.56(c) more than three months prior to the filing of the information disclosure statement. The practitioner cannot certify this because the reference was known to the client before February 11, 2002, the time of filing of the utility application, which was more than three months prior to the filing of the information disclosure statement. Answer (B), stating a procedure that conforms with the USPTO rules and the procedures set forth in the MPEP, is an incorrect answer. Under 37 CFR § 1.313(a), a petition to withdraw the application from issue is not required if a proper RCE is filed before payment of the issue fee. Answer (C), stating a procedure that conforms with the USPTO rules and the procedures set forth in the MPEP, is an incorrect answer. A practitioner can file a continuing application on or before the date that the issue fee is due and permit the parent application to become abandoned for failure to pay the issue fee. Answer (D), stating a procedure that conforms with the USPTO rules and the procedures set forth in the MPEP, is an incorrect answer. Under 37 CFR § 1.313(c)(3), a petition to withdraw the application from issue can be filed after payment of the issue fee to permit the express abandonment of the application in favor of a continuing application. Answer (E), stating a procedure that conforms with the USPTO rules and the procedures set forth in the MPEP, is an incorrect answer. Under 37 CFR § 1.313(c)(2), a petition to withdraw the application from issue can be filed after payment of the issue fee to permit consideration of a Request for Continued Examination (RCE) under 37 CFR § 1.114. See also MPEP § 1308.



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32. ANSWER: (C) is the most correct answer. This is not true since 37 CFR § 1.76(d)(4) provides, in part, “(4)...Captured bibliographic information derived from an application data sheet containing errors may be recaptured by a request therefor and the submission of a supplemental application data sheet, an oath or declaration under 37 CFR § 1.63 or § 1.67, or a letter pursuant to 37 CFR 1.33(b).” (A) is in accordance with 37 CFR § 1.76(a). (B) is in accordance with 37 CFR § 1.76(b). (D) is in accordance with 37 CFR § 1.76(c). (E) is in accordance with 37 CFR § 1.76 (d)(4).

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40. ANSWER: (D) is the most correct answer. See 35 U.S.C. § 111(b)(2); 37 CFR § 1.51(c); MPEP §§ 601 and 601.01(b). 35 U.S.C. § 111(b)(2) states that “[a] claim, as required by the second through fifth paragraphs of section 112, shall not be required in a provisional application.” The documents and other components recited in answers (A) through (C) and (E) are required in a provisional application. See 35 U.S.C. § 111(b); 37 CFR § 1.51(c).

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46. ANSWER: (D) is the most correct answer. Under 37 CFR § 1.85(a), correcting the drawings to comply with 37 CFR § 1.84(a)(1) and (k), and making them suitable for reproduction is a bona fide response. (A), (B), and (C) are not the most correct answer. In each, Smith seeks to hold the requirement in abeyance. As stated in 37 CFR § 1.85(a), “Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a bona fide attempt to advance the application to final action.” See also, MPEP § 608.02(b), under the heading “Informal Drawings,” which states “[u]nless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance. A request to hold objections to the drawings in abeyance will not be considered a bona fide attempt to advance the application to final action (37 CFR 1.135(c)).” (E) is not the most correct answer inasmuch as (A), (B), and (C) are not the most correct answers.

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47. ANSWER: (C) is the most correct answer. MPEP § 608.01, under the heading “Illustrations In The Specification,” states “[t]he specification, including any claims...may not contain drawings or flow diagrams.” With respect to answers (A) and (B), see MPEP § 608.01, under the heading “Illustrations In The Specification,” states, “[t]he specification, including any claims, may contain chemical formulas and mathematical equations...” As to answer (D), see MPEP § 608.01(m), which states that periods may not be used elsewhere in the claim except for abbreviations and that each claim begins with a capital letter and ends with a period. As to (E), see MPEP § 608.01, which states, “The...claims may contain tables only if necessary to conform to 35 U.S.C. 112.”

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7. ANSWER: (A) is the most correct answer. See 35 U.S.C. § 111; 37 CFR § 1.53; MPEP § 601.01. As provided in MPEP § 601.01(a), the oath or declaration for an application filed under 37 CFR § 1.53(b) can be submitted after the filing date. Answers (B), (C), (D) and (E)

are incorrect. 37 CFR § 1.53(b); MPEP § 601.01. 37 CFR § 1.53(b) provides that a filing date is granted on the date on which a specification as prescribed by 35 U.S.C. § 112 containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Office. Thus, (B), (C), (D) and (E) are needed to obtain a filing date.

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24. ANSWER: (A) is the most correct answer. 37 CFR 1.114, MPEP § 609, paragraph III. B(1)(b), under the heading “RCE and CPA,” and MPEP 706.07(h), under the heading “II. Submission Requirement.” In (A), the information disclosure statement, is a submission under 37 CFR § 1.114(c), and the RCE was filed before the payment of the issue fee. 37 CFR § 1.114(a)(1). (B) is incorrect because the request for continued examination was filed after payment of the issue fee, and is filed without a petition under 37 CFR § 1.313 being granted. Therefore (B) does not satisfy the provision of 37 CFR § 1.114(a)(1). (C) is incorrect because the application becomes abandoned on February 14, 2001 for failure to pay the issue fee. Therefore the request for continued examination does not satisfy the provision of 37 CFR § 1.114(a)(2). (D) is incorrect because a petition under 37 CFR § 1.313 will not be effective to withdraw the application from issue unless it is actually received and granted by the appropriate officials before the date of issue. 37 CFR § 1.313(d). Thus, the request for continued examination in (D) does not satisfy the provision of 37 CFR § 1.114(a)(1). (E) is incorrect because (A) is correct.

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25. 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 CFR § 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 CFR § 1.121, it is an incorrect answer to the above question. Since choice (E) may be done, 37 CFR § 1.111, it also is an incorrect answer to the above question.

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28. ANSWER: (D) is the most correct answer. 37 CFR § 1.75; MPEP § 608.01(n). As explained in MPEP § 608.01(n), under the heading “Multiple Dependent Claims,” subheading “Acceptable Multiple Dependent Claim Wording” the multiple dependent claim wording of new claims 16-27 is proper. See, for example, “any one of the preceding claims,” and “in any of claims 1-3 or 7-9.” 37 CFR § 1.75(c) states “For fee calculation purposes under § 1.16, a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein.” Therefore, claims 16-27 would each have a claim value of eleven and the total number of claims for fee calculation is one hundred forty-seven ( $12 \times 11 = 132 + 15 = 147$ ). Answers (A) and (B) are incorrect because they are not the correct total. Answer (C) is incorrect because the multiple dependent claims have not been calculated in accordance with 37 CFR § 1.75. Answer (E) is incorrect because the question asks for the total after the amendment adding claims 16-27 has been entered.

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40. ANSWER: (D) is the correct answer. See MPEP § 608.01(p). (A) is incorrect because abandoned applications less than 20 years old can be incorporated by reference to the same extent as copending applications. (B) is incorrect because non-essential material may be incorporated by reference to patents or applications published by the United States. (C) is incorrect because material necessary to provide an enabling disclosure is essential material, which may be incorporated by reference to a U.S. patent. (E) is incorrect because non-essential material may be incorporated by reference to a U.S. patent which incorporates essential material.

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3. ANSWER: (E). There is no such requirement. As to (C), see 37 C.F.R. § 1.52(b). As to (A) through (D) see MPEP § 608.01(m). 37 C.F.R. § 1.75(i).

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4. ANSWER: The most correct answer is (E). A dependent claim must further limit the claim from which it depends. 35 U.S.C. § 112, ¶4; 37 C.F.R. § 1.75(c). Dependent claim 6 (Answer E) improperly seeks to broaden Claim 1 by omitting an element set forth in the parent claim.

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9. ANSWER: (B) is the most correct answer inasmuch as the title needs to be technically accurate and the limitation is 500 characters, not 10 words. See MPEP § 606. As to (A), (C) and (D), see MPEP §§ 606 and 606.01 on p. 600-50. As to (E), the title can be amended by the examiner.

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19. ANSWER: (A) is the best answer as there is no provision regarding one year from discovery in 37 C.F.R. § 1.26. As to (B) through (E) see MPEP § 607.02. The Office will refund amounts of twenty-five dollars or less if requested to do so by the applicant. See MPEP § 607.02 at p. 600-51. As to (A), (B), (D) and (E), see MPEP § 607.02 at p. 600-51.

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22. ANSWER: (E) is incorrect as a preliminary amendment may be filed with the original disclosure and will be treated as part of the original disclosure in accordance with MPEP § 608.04(b) (A) through (D) are all correct. See MPEP § 608 at p. 600-53.

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24. ANSWER: (C) is incorrect as the Office will refund amounts of twenty-five dollars or less if requested to do so by the applicant. See MPEP § 607.02 at p. 600-51. As to (A), (B), (D) and (E), see MPEP § 607.02.

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26. ANSWER: (E). The abstract should not compare the invention with the prior art. MPEP § 608.01(b). As to (A) through (C), see MPEP § 608.01(b). As to (D), when the process for making is not obvious, the process should be set forth in the abstract. See MPEP §

608.01(b).

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

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34. ANSWER: (A) is correct and (B), (C), (D) and (E) are wrong. MPEP § 601.01(d).

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35. ANSWER: (C). According to MPEP § 608.01(l), “[t]he claim should not be attacked either by objection or rejection because this subject matter is lacking in the drawing and description.” As to (A), (B), (D), and (E), see MPEP § 608.01(l).

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37. ANSWER: (C). As indicated in MPEP § 608.01(b), if an application is otherwise in condition for allowance except that the abstract does not comply with the guidelines, the examiner generally should make any necessary revisions by examiner’s amendment rather than issuing an *Ex parte Quayle* action requiring applicant to make the necessary revisions. As to (A), (B), (D), and (E), see MPEP § 608.01(b).

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40. 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.”).

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41. 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.

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46. ANSWER: (D) is correct. 37 C.F.R. § 1.99(e). (D) is correct because 37 C.F.R. § 1.99(e) provides, “A submission under this section must be filed within two months from the date of publication of the application (§ 1.215(a)) or prior to the mailing of a notice of allowance (§ 1.311), whichever is earlier.” Therefore, answer (D) is correct and answers (A), (B), and (C) are incorrect. (E) is wrong because 37 C.F.R. § 1.99(e) recites, “A submission by a member of the public to a pending published application that does not comply with the requirements of this section will be returned or discarded.”

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26. 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.

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28. ANSWER: (E) is the best answer. The declaration need not be notarized. See 37 C.F.R. § 1.63(a). A declaration may be used in lieu of an oath. 37 C.F.R. § 1.68, MPEP 602. As to (A) through (C) see 35 U.S.C. § 115. As to (D), see MPEP § 602.04 at p. 600-34, left column.

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31. ANSWER: (B). MPEP § 608.01, subsection "Illustrations In the Specification." 37 C.F.R. § 1.58(a) permits tables and chemical formulas in the specification in lieu of formal drawings. (A) is incorrect. MPEP § 608.01, subsection "Illustrations In the Specification." Graphical illustrations, diagrammatic views, flowcharts, and diagrams in the descriptive portion of the specification do not come within the purview of 37 C.F.R. § 1.58(a). The examiner should object to such descriptive illustrations in the specification and request formal drawings in accordance with 37 C.F.R. § 1.81 when an application contains graphs in the specification. (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. 37 C.F.R. § 1.75(a). The specification must conclude with one or more claims. (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.

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35. ANSWER: (C). As to (C), according to MPEP § 608.01 at p. 600-58, "In order to minimize the necessity in the future for converting dimensions given in the English system of measurements to the metric system of measurements when using printed patents as research and prior art search documents, all patent applicants should use the metric units (SI) followed

by the equivalent English units when describing their inventions in the specifications of patent applications.” As to (A), see MPEP § 601.05 at p. 600-21 and 37 C.F.R. § 1.76 (d)(3), regarding the oath or declaration controlling over the application data sheet. See also MPEP § 608.01(a) at p. 600-61. As to (B), see MPEP § 608.01(a) at p. 600-60 regarding hyperlinks. As to (D), see 37 C.F.R. § 1.52(a); and MPEP § 608.01. As to (E) see MPEP § 608.01 at p. 600-56 and 37 C.F.R. § 1.52.

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37. ANSWER: (D) is the most correct answer. Reference characteristics mentioned in the detailed description must appear in the drawings. 37 C.F.R. §§ 1.83(a) and 1.84(p)(5); MPEP § 608.02. As to (A), (B), (C), and (E), see MPEP § 608.01(a).

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39. ANSWER: (A). Item (A) should read, “The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole.” As to (B) through (E), see 37 C.F.R. § 1.73; MPEP § 608.01(a) and (d).

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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).

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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.

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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.”).

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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).

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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.

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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.

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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.

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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.

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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.



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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.

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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).

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2. ANSWER: (B) is the most correct answer. The application number of each U.S. patent is not required to be listed by 37 CFR 1.98(b)(1), which provides "(b)(1) Each U.S. patent listed in an information disclosure statement must be identified by inventor, patent number, and issue date." The elements of (A) are found in 37 CFR 1.98 (a)(3)(ii). The elements of (C) are found in 37 CFR 1.98 (b)(5). The elements of (D) are found in 37 CFR 1.98(c). The elements of (E) are found in 37 CFR 1.98(d).

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5. ANSWER: The most correct answer is (B). 37 CFR 1.84(a)(2), MPEP § 608.02; Notice (Interim Waiver of Parts of 37 CFR 1.84 and 1.165, and Delay in the Enforcement of the Change in 37 CFR 1.84(e) to No Longer Permit Mounting of Photographs) in Official Gazette May 22, 2001, 1246 OG 106 ("In summary, the USPTO has *sua sponte* waived 37 CFR 1.84(a)(2)(iii) and 1.165(b) and is no longer requiring a black and white photocopy of any color drawing or photograph"). (A) is wrong because a petition under 37 CFR 1.84 is required to avoid an objection to the color photographs. Also, since small entity status was properly established at the time of filing, the inventor is entitled to maintain small entity

status until any issue fee is due. 37 CFR 1.27(g)(1). (C) – (E) are also wrong because they do not provide for the required petition under 37 CFR 1.84. In (D), the change in small entity status after the application was filed does not require the inventor to retroactively pay a large entity filing fee. Additionally, (E) is wrong because the inventor would be required to file a large entity filing fee and a continuation application therefore does not achieve the stated goal of avoiding unnecessary government fees.

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12. ANSWER: (C). This is not true since 37 CFR 1.76(d)(4) provides, in part, “(4)...Captured bibliographic information derived from an application data sheet containing errors may be recaptured by a request therefore and the submission of a supplemental application data sheet, an oath or declaration under 37 CFR 1.63 or § 1.67, or a letter pursuant to 37 CFR 1.33(b).” (A) is in accordance with 37 CFR 1.76(a). (B) is in accordance with 37 CFR 1.76(b). (D) is in accordance with 37 CFR 1.76(c). (E) is in accordance with 37 CFR 1.76 (d)(4).

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22. ANSWER: (D). 37 CFR 1.97 (g) specifically states that “[a]n information disclosure statement filed in accordance with section shall not be construed as a representation that a search has been made.” The elements of (A) are supported by 37 CFR 1.97 (c). The elements of (B) are supported by 37 CFR 1.97(d). The elements of (C) are supported by 37 CFR 1.97(f). The elements of (E) are supported by 37 CFR 1.97(h).

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38. ANSWER: (A) is the correct answer. 37 CFR 1.97(b)(4) and (c), effective date November 7, 2000; *see*, “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54630 (September 8, 2000); and 37 CFR 1.114, effective date August 16, 2000, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 FR 50092 (Aug. 16, 2000); MPEP § 609, paragraph III.B(1)(b) (pg. 600-125) (8<sup>th</sup> Ed.). (A) is correct since November 15, 2000, is “before the mailing of a first Office action after the filing of a request for continued examination under § 1.114” (37 CFR 1.97(b)(4)). As stated in 65 FR 54630, column 2, “As the filing of a RCE under § 1.114 is not the filing of an application, but merely continuation of the prosecution in the current application, § 1.97(b)(4) does not provide a three-month window for submitting an IDS after the filing of a request for continued examination”; MPEP § 609, paragraph III.B (1)(b) (pg. 600-125) (8<sup>th</sup> Ed.). Thus, choices (B) and (C) are each incorrect as they are subject to the requirements of 37 CFR 1.97(c). (E) is incorrect since (A) is correct.

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42. ANSWER: The most correct answer is (E). A dependent claim must further limit the claim from which it depends. 35 U.S.C. § 112, ¶4; 37 CFR 1.75(c). Dependent claim 6 (Answer E) improperly seeks to broaden Claim 1 by omitting an element set forth in the parent claim.

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44. ANSWER: (A) is the correct answer. 37 CFR 1.114, effective date August 16, 2000, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 FR 50092, 50097; MPEP § 609, paragraph III. B (1)(b) (pg. 600-125) and MPEP 706.07(h), paragraph II (pg. 700-69) (8<sup>th</sup> Ed.). In (A), the information disclosure statement, is a submission under 37 CFR 1.114(c), and the RCE was filed before the payment of the issue fee. 37 CFR 1.114(a)(1). (B) is incorrect because the request for continued examination was filed after payment of the issue fee, and is filed without a petition under 37 CFR 1.313 being granted. Therefore (B) does not satisfy the provision of 37 CFR 1.114(a)(1). (C) is incorrect because the application becomes abandoned on February 14, 2001 for failure to pay the issue fee. Therefore the request for continued examination does not satisfy the provision of 37 CFR 1.114(a)(2). (D) is incorrect because a petition under 37 CFR 1.313 will not be effective to withdraw the application from issue unless it is actually received and granted by the appropriate officials before the date of issue. 37 CFR 1.313(d). Thus, the request for continued examination in (D) does not satisfy the provision of 37 CFR 1.114(a)(1). (E) is incorrect because (A) is correct.

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

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7. ANSWER: (D) is the correct answer. MPEP §608.04(c) (“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) (“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.”). (A), (B), and (C) are incorrect. (E) is incorrect inasmuch as (A), (B) and (C) are incorrect.

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11. ANSWER: (A) 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 (B) is incorrect because it is an improper multiple dependent claim. 35 U.S.C. §112 ¶ 5; 37 CFR 1.75(c); MPEP § 608.01(n),

part (I)(B)(1). Answer (C) alone is incorrect because, even though canceling the claim will overcome the rejection, it will also leave the application without a claim to the Ethernet cable made using the processes set forth in either Claim 1 or Claim 2. Answer (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 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 (E) 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.

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

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29. ANSWER: (B) is the most correct answer. 37 CFR 1.16(a) and 1.17(e). The fee to request continued examination of an application is currently \$355.00 for a small entity, and \$710.00 for other than a small entity. The fee for filing each application for an original patent, except provisional, design, or plant applications is currently \$355.00 for a small entity, and \$710.00 for other than a small entity. See “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50093 (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000); MPEP §706.07(h) (8<sup>th</sup> Ed.). (A) is not the most correct answer. 37 CFR 1.8(a)(2) provides, in pertinent part, “The procedure described in paragraph (a)(1) of this section does not apply to, and no benefit will be given to a Certificate of Mailing or Transmission on the following: (i) Relative to Patents and Patent Applications – (A) The filing of a national patent application specification and drawing or other correspondence for the purpose of obtaining an application filing date, including a request for a continued prosecution application under § 1.53(d).” (C) is not the most correct answer. 37 CFR 1.21(m). (D) is not the most correct answer. 37 CFR 1.53(c)(3) requires the petition to convert be filed prior to the earliest of the abandonment of the provisional application or the expiration of twelve months after the filing date of the provisional application. (E) is not the most correct answer. Under 37 CFR 1.53, a nonprovisional application based on conversion of a provisional application must include the filing fee for a nonprovisional application. The conversion request must be accompanied by the fee set forth in 37 CFR 1.17(i). In addition, the surcharge required by 37 CFR 1.16(e) if either the basic filing fee for a nonprovisional application, or the oath or declaration was not present on the filing date accorded the resulting nonprovisional application. A properly paid basic filing fee for a provisional application is not applied to the filing or other fees due for a nonprovisional application resulting from conversion of a provisional application. 37 CFR 1.53(c)(3), second sentence.

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35. ANSWER: (C). 37 CFR 1.99(c) requires service on the applicant and provides “[t]he submission under this section must be served upon the applicant in accordance with § 1.248.” (A) contains all of the elements of 37 CFR 1.99(a). (B) contains all of the elements of 37 CFR 1.99(b). (D) contains all of the elements of 37 CFR 1.99(d). (E) contains all of the elements of 37 CFR 1.99(e).

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40. 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)”; MPEP § 201.04(b) (pg. 200-16) (8<sup>th</sup> Ed.). However, the pendency is counted against the patent term. 37 CFR 1.53(c)(3), fourth sentence. (A), being in accord with USPTO practice and procedure, is not the most correct answer. 37 CFR 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); MPEP § 201.04(b) (pg. 200-16) (8<sup>th</sup> Ed.). (C) is not the most correct answer. 37 CFR 1.53(c)(3), fourth sentence. (D), being in accord with USPTO practice and procedure, is not the most correct answer. 37 CFR 1.53(c)(3). (E) is a correct statement, and therefore is not a correct answer. 35 U.S.C. § 119(e)(3).

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45. ANSWER: The most correct answer is (C). (A) is not the best answer because drawing changes normally must be approved by the Examiner before the application will be allowed. The Examiner must give written approval for alterations or corrections before the drawing is corrected. MPEP § 608.02(q). (B) is not the best answer because any proposal by an applicant for amendment of the drawing to cure defects must be embodied in a separate letter. MPEP § 608.02(r). (D) is not the best answer because it incorporates (A) and (B), and (E) is not the best answer because it incorporates (B).

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3. ANSWER: (B) is the most correct answer. Application number of each patent is not required to be listed by 37 CFR § 1.98(b)(1), which provides “(b)(1) Each U.S. patent listed in an information disclosure statement must be identified by inventor, patent number, and issue date.” As to (A), the elements of (A) are found in 37 CFR § 1.98 (a)(3)(ii), which provides “(ii) A copy of the translation if a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c).” As to (C), the elements of (C) are found in 37 CFR § 1.98 (b)(5), which provides “(5) Each publication listed in an

information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.” As to (D), the elements of (D) are found in 37 CFR § 1.98(c), which provides “[w]hen the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications, provided that it is stated that these other patents or publications are cumulative.” As to (E), the elements of (E) are found in 37 CFR § 1.98(d), which provides “(d) A copy of any patent, publication, pending U.S. application or other information, as specified in paragraph (a) of this section, listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application, unless: (1) The earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120; and (2) The information disclosure statement submitted in the earlier application complies with paragraphs (a) through (c) of this section.”

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

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

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

(Sept. 5, 2000). (C), being in accord with USPTO practice and procedure, is not the most correct answer. 37 C.F.R. § 1.53(c)(3), fourth sentence. (D), being in accord with USPTO practice and procedure, is not the most correct answer. 37 C.F.R. § 1.53(c)(3). (E) is a correct statement, and there fore is not a correct answer. 35 U.S.C. § 119(e)(3).

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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).

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

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28. ANSWER: (D) is the most correct answer. Under 37 C.F.R. § 1.85(a), correcting the drawings to comply with 37 C.F.R. § 1.84(a)(1) and (k), and making them suitable for reproduction is a bona fide response. (A), (B), and (C) are not the most correct answer. In each, Smith seeks to hold the requirement in abeyance. As stated in 37 C.F.R. § 1.85(a) (effective November 29, 2000), “Unless applicant is otherwise notified in an Office action,

objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a *bona fide* attempt to advance the application to final action.” See also, “Changes to Implement Eighteen-Month Publication of Patent Applications; Final Rule,” 65 F.R. 57024, 57032, “Section 1.85.” (E) is not the most correct answer inasmuch as (A), (B), and (C) are not the most correct answers.

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42. ANSWER: (A) is the most correct answer. 37 CFR § 1.97(b)(4) and (c), effective date November 7, 2000; *see*, “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54630 (September 8, 2000); and 37 CFR § 1.114, effective date August 16, 2000, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 FR 50092 (Aug. 16, 2000). (A) is correct since November 15, 2000, is “before the mailing of a first Office action after the filing of a request for continued examination under § 1.114” (37 CFR § 1.97(b)(4)). As stated in 65 FR 54630, column 2, “As the filing of a RCE under § 1.114 is not the filing of an application, but merely continuation of the prosecution in the current application, § 1.97(b)(4) does not provide a three-month window for submitting an IDS after the filing of a request for continued examination. Thus, choices (B) and (C) are each incorrect as they are subject to the requirements of 37 CFR § 1.97(c). (E) is incorrect since (A) is correct. (D) is incorrect because (B) is incorrect.

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

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

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

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

U.S.C. 112, first paragraph.

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



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

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

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

most correct answer. The provisions of 35 U.S.C. § 119(e)(2) were amended to eliminate the requirement that a nonprovisional application claiming the benefit of a provisional application must have been filed during the pendency of the provisional. *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50098, left and middle columns (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000).

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

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

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

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41. ANSWER: (C) or (D) are accepted as correct answers. 37 CFR § 1.76(d) (effective November 7, 2000); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54624-25 (Sept. 8, 2000); and 37 CFR § 1.63 (effective November 7, 2000). Under 37 CFR § 1.63(c)(1), Applicant’s mailing address need not be identified in the declaration if it is included in the application data sheet. Thus, (A) is incorrect. The foreign priority

information must be included in the declaration because it was not included in the application data sheet. 37 CFR § 1.63(c)(2). Thus, (C) is correct. Applicant's citizenship in (B) must be included in the declaration under 37 CFR § 1.63(a)(3), if "applicant" in (B) is construed as a person or party, e.g., 37 CFR § 1.42, other than the inventor, and no exception is made for citizenship under 37 CFR § 1.63(c). In the latter instance, where both (B) and (C) are correct, and (D) is the most correct answer because it is inclusive of (B) and (C). (B) alone is not accepted because the foreign priority document must be included in the declaration. (E) is incorrect because (A) is incorrect.

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

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1. ANSWER: (B). MPEP § 608.01, subsection "Illustrations In the Specification." 37 C.F.R. § 1.58(a) permits tables and chemical formulas in the specification in lieu of formal drawings. (A) is incorrect. MPEP § 608.01, subsection "Illustrations In the Specification." Graphical illustrations, diagrammatic views, flowcharts, and diagrams in the descriptive portion of the specification do not come within the purview of 37 C.F.R. § 1.58(a). The examiner should object to such descriptive illustrations in the specification and request formal drawings in accordance with 37 C.F.R. § 1.81 when an application contains graphs in the specification. (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. 37 C.F.R. § 1.75(a). The specification must conclude with one or more claims. (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.

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7. ANSWER: (B). 37 C.F.R. § 1.84(a)(2), MPEP § 608.02, "Color Drawings or Color Photographs." (A) is wrong because a petition under 37 C.F.R. § 1.84 is required to avoid an objection to the color photographs. Also, since small entity status was properly established at the time of filing, the inventor is entitled to maintain small entity status until any issue fee is due. 37 C.F.R. § 1.28(b). (C) – (E) are also wrong because they do not provide for the required petition under § 1.84. In (D), the change in small entity status after the application was filed does not require the inventor to retroactively pay a large entity filing fee. Additionally, (E) is wrong because the inventor would be required to file a large entity filing fee and a continuation application therefore does not achieve the stated goal of avoiding unnecessary government fees.

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15. ANSWER: (E). Both (B) and (D) cannot be incorporated into a U.S. utility application. MPEP § 608.01(p).

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

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35. ANSWER: The best answer is (E). MPEP § 609(B)(4). Statements (A), (B) and (C) do not apply (at least) because the IDS was not filed within three months of the filing date or before the mailing date of a notice of allowance. 37 C.F.R. § 1.97(c). Statement (D) does not apply because the issue fee has been paid. 37 C.F.R. § 1.97(d).

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43. ANSWER: (D) is the correct answer because a substitute drawing is usually submitted to replace an original informal drawing, not an original formal drawing. MPEP § 608.02 under the heading “Definitions.” (A), (B), (C), and (E) are wrong answers because they accord with the definitions set forth in MPEP § 608.02.

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46. ANSWER: (D) is the correct answer. 35 U.S.C. § 113; MPEP § 608.02(a), under heading “Handling of Drawing Requirements Under The Second Sentence Of 35 U.S.C. 113,” p.600-87. (A) is incorrect inasmuch as I is false. The examiner will normally require a drawing where the case admits of illustration. 37 C.F.R. § 1.81(c). (B) is incorrect because III is also true. (C) is incorrect because II is also true. (E) is incorrect because I is false.

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48. ANSWER: (A). Under 37 C.F.R. § 1.53(c)(2), a nonprovisional patent application “may be converted to a provisional application and be accorded the original filing date of the” nonprovisional patent application. MPEP § 601.01(c). (B), (C), and (D) are wrong because they recite dates other than the original filing date of the nonprovisional patent application. (E) is wrong because (A) is correct.

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2. ANSWER: (D) is the correct answer. MPEP § 608.01(p). (A) is incorrect because abandoned applications less than 20 years old can be incorporated by reference to the same extent as copending applications. (B) is incorrect because non-essential material may be incorporated by reference to patents or applications published by the United States. (C) is incorrect because material necessary to provide an enabling disclosure is essential material, which may be incorporated by reference to a U.S. patent. (E) is incorrect because non-essential material may be incorporated by reference to a U.S. patent which incorporates essential material.

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21. ANSWER: (C). (A) is not the best answer because drawing changes normally must be approved by the examiner before the application will be allowed. The examiner must give written approval for alterations or corrections before the drawing is corrected. MPEP § 608.02(q). (B) is not the best answer because any proposal by an applicant for amendment of the drawing to cure defects must be embodied in a separate letter to the draftsman. MPEP § 608.02(r). (D) is not the best answer because it incorporates (A) and (B), and (E) is not the best answer because it incorporates (B).

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28. ANSWER: (C) is the correct answer. MPEP § 609(B)(3) and 37 C.F.R. § 1.97. (A) is incorrect because each individual associated with the filing and prosecution of a patent application has a duty to disclose to the Office all information which they know to be material to the patentability of pending claims. 37 C.F.R. § 1.56. (B) is incorrect because 37 C.F.R. § 1.97(d) requires the filing of the items specified in III, including the § 1.97(e) statement, after the mailing date of a notice of allowance. (D) is incorrect because I is incorrect. (E) is incorrect because only III is correct, and I and II are incorrect.

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36. ANSWER: (A). 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.

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37. ANSWER: (E). MPEP §§ 608.04(b) and 608.04(c). Answer (A) is incorrect because the preliminary amendment does not enjoy the status as part of the original disclosure in an application accompanied by a signed declaration unless the preliminary amendment is referred to in the declaration. (B) is incorrect because a petition under §1.181 would only be appropriate if the new matter is confined to the specification. If the new matter is introduced into or affects the claims, the question becomes an appealable one. (C) is incorrect because the Office action is a first, non-final action and the issue is therefore not yet ripe for appeal. 37 C.F.R. § 1.191. (D) is incorrect because the original disclosure cannot be altered merely by filing of a subsequent oath or declaration referring to different papers.

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38. ANSWER: (A) is the correct answer. MPEP § 608.01(n). (B) 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. (C) is incorrect because there is no antecedent basis for the wheels. MPEP § 2173.05(e). (D) is incorrect because it does not refer back in the alternative only. MPEP § 608.01(n). (E) is incorrect because (A) is correct.

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39. ANSWER: (D). See 37 C.F.R. § 1.313(b); MPEP §§ 609, subpart (B)(4) and 1308. After payment of the issue fee it is impractical for the Office to consider any information disclosures. As to (A), a prior art statement is applicable only to patent, not application, files. 37 C.F.R. § 1.501. As to (B), duty of disclosure continues until the patent is issued. As to (C), the patent should not be allowed to issue since it may contain invalid claims. As to (E) no amendment is entitled to entry after payment of the issue fee. 37 C.F.R. § 1.312(b).

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

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48. ANSWER: (C). 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 (D) are incorrect because they are practices encouraged by the MPEP §. MPEP § 608.01(n), subsection "IV. Claim Form and Arrangement." (E) is incorrect because it represents a practice encouraged by MPEP § 608.01(m). See *Fressola v. Manbeck*, 36 USPQ2d 1211 (D.D.C. 1995).

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50. ANSWER: (C). 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) ("Claims should preferably be arranged in order of scope so that the first claim presented is the least restrictive."). (B) is a USPTO recommendation. See MPEP 608.01(m) ("Similarly, product and process claims should be separately grouped."). (D) is a PTO recommendation. See MPEP 608.01(n), part IV. (E) is a USPTO requirement. See MPEP 608.01(m) ("Each claim begins with a capital letter and ends with a period.").

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

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

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

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

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

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3. ANSWER: (E). Both (B) and (D) cannot be incorporated into a U.S. utility application. MPEP § 608.01(p) [pp. 600-72-73].

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4. ANSWER: (D) and (E). (D) is a correct statement because a claim that includes a tradename, whose definition is neither sufficiently precise nor definite, fails to comply with 35 U.S.C. § 112, paragraph 2. Claim 2 has two tradenames, “Acme SmellNice” and “A-1 Silky.” The ingredient composition of “Acme SmellNice” has “recently changed,” and the change is “unknown,” and otherwise indefinite. MPEP §§ 608.01(v), and 706.03(d); and *Ex*

*parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). (E) is also correct to the extent (B) correctly points out that an incorrect theory of operation is incorporated into a claim, that claim is invalid under either 35 U.S.C. § 101 (utility) or 35 U.S.C. § 112 (enablement). *Raytheon Co. v. Roper Corp.*, 724 F2d 951, 220 USPQ 592, 596 (Fed. Cir. 1983). (B) alone is not accepted as a correct answer because no fact was given preceding the answer that claim 2 sets forth an incorrect theory of formation of chemical X, whereas sufficient facts were given to recognize that (D) is a correct answer. (A) is incorrect at least because prophetic examples may well provide an enabling disclosure. MPEP 608.01(p), and 2164.02. Also, an inventor need not understand how an invention works. (C) is incorrect because naturally occurring compounds may be patented particularly when a new use (industrial lubricant) is part of the claim.

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10. ANSWER: (C). “A claim may be written in dependent or multiple dependent form.” 35 U.S.C. § 112, paragraph 3. When written in dependent form, the claim “shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed.” 35 U.S.C. § 112, paragraph 4. When written in multiple dependent form, the claim “shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed.” 35 U.S.C. § 112, paragraph 5. See also 37 CFR § 1.75(c); MPEP § 608.01(n). Here, the claim is in proper multiple dependent form, referring back in the alternative to claims previously set forth, i.e., claims 1, 2 or 3. Answers (A) and (B) are incorrect because each claim does not refer back to a preceding claim. In Answer (A), claim 4 refers to claim 5. In Answer (B), claim 2 refers to claim 5. 35 U.S.C. § 112, paragraph 4; 37 CFR § 1.75(c); MPEP § 608.01(n) (“2. Claim Does Not Refer to a Preceding Claim”). Answers (D) and (E) are incorrect because each claim does not refer back in the alternative. In Answer (D), claim 3 refers to all the preceding claims, i.e., claims 1, 2 and 3. In Answer (E), claim 5 refers to claims 1 and 2, or claim 3. 35 U.S.C. § 112, paragraph 5; 37 CFR § 1.75(c); MPEP § 608.01(n) (“1. Claim Does Not Refer Back in the Alternative Only”).

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25. ANSWER: (C). The PTO does not require or recommend a minimum or maximum number of dependent claims. 37 CFR § 1.75(c). (A) is a PTO 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.”). (B) is a PTO recommendation. See MPEP § 608.01(m) (“Similarly, product and process claims should be separately grouped.”). (D) is a PTO requirement. See MPEP § 608.01(n), at 600-63 (Claim Form and Arrangement). (E) is a PTO requirement. See MPEP § 608.01(m) (“Each claim begins with a capital letter and ends with a period.”).

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28. ANSWER: (E). The cancellation of Claim 3 overcomes the examiners objection. The addition of Claim 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, paragraph 5; 37 CFR § 1.75(c); MPEP § 608.01(n) (“1. Claim Does



Not Refer Back in the Alternative Only”). Answer (B) alone is incorrect because, even though canceling the claim will overcome the rejection, it will also leave the application without a claim to the Ethernet cable made using the processes set forth in either claim 1 or claim 2.

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31. ANSWER: (D). 37 CFR § 1.75(c); MPEP § 608.01(n).

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32. ANSWER: (B). When an amendment accompanies a non-provisional patent application filed without a signed declaration, the amendment is considered part of the original disclosure, provided that the subsequently filed declaration refers to both the patent application and the amendment. MPEP §§ 608.04(b), and 714.09. Here, the application was filed with an unexecuted declaration, i.e., an unsigned declaration. Thus, the best way to overcome the rejection is to file an executed declaration that refers to both the application and amendment. Answer (A) is incorrect because the declaration must refer to both the application and amendment. MPEP §§ 608.04(b), and 714.09. Answer (C) is incorrect because, even if the original declaration had been signed, the original disclosure of an application cannot be altered by filing a supplemental declaration that refers to paper different from those referred to in the original declaration. 37 CFR § 1.67(b) (no new matter may be introduced into a non-provisional patent application after its filing date even if a supplemental declaration is filed). See also MPEP § 608.04(b). Answer (D) is incorrect because an examiner’s objection to an amendment as adding new matter to the specification is a matter petitionable to the Commissioner, pursuant to 37 CFR § 1.181(a)(1). See also MPEP § 608.04(c). Answer (E) is incorrect because, while canceling the new matter will overcome the examiner’s objection, it is not the best way to overcome the rejection because, after cancellation, the application will fail to set forth the best mode contemplated by the inventor of carrying the claimed invention. 35 U.S.C. § 112.

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42. ANSWER: (B) is the most correct answer. MPEP § 601.01(f). “It has been PTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. § 113 (first sentence).” As such, the application will be processed for examination. (A) is not the minimum that must be submitted to obtain a filing date given that the filing fee and oath may be submitted after the specification and drawing are submitted. 35 U.S.C. § 111(a)(3). (C) is not the correct answer because the filing of a petition may be deferred until the examiner requires acceptable formal drawings. MPEP § 608.02 [p. 600-86]. Also, the filing fee may be filed after the specification is submitted. 35 U.S.C. § 111(a)(3). (D) is not correct because it does not represent the minimum, which must be submitted to obtain a filing date before the statutory bar. (E) is not correct because (B) is correct.

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7. ANSWER: (D). 37 CFR §§ 1.97; 1.98; 1.607(c); and 10.23(c)(7). (A), (B) and (C) are not correct because they do not identify the number of the patent claim that has been copied. (E) is not the most proper course of action to take. The IDS does not identify the QED patent from which the claim was copied. Arguing that Claim 6 of the QED patent is an obvious improvement to the instant invention would not be considered relevant. 37 CFR § 1.98(a)(3).

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28. ANSWER: (D). 37 CFR § 1.52(c), and MPEP § 605.04(a).

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35. ANSWER: (D). MPEP § 608.01(l). (A) is incorrect because the original numbering of the claims must be preserved throughout the prosecution. 37 CFR § 1.126. (B) is incorrect and nonsensical. (C) is incorrect because a multiple dependent claim will always be considered to be the total number of claims (dependant and independent) to which direct reference is made therein. 37 CFR § 1.75(c). (E) is incorrect because (D) is correct.

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42. ANSWER: (C). 37 CFR § 1.75(c); and MPEP 608.01(n).

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49. ANSWER: (B). 37 CFR § 1.53; and MPEP §§ 601.01, and 601.01(g). The only way to retain the original filing date of the application is to delete all reference to the omitted figure and comply with the requirements set forth in MPEP § 608.02.