

Chapter 700

Questions

April 15, 2003 AM

3. Registered practitioner Rick drafted a patent application for inventor Sam. The application was filed in the USPTO on May 15, 2000, with a power of attorney appointing Rick. On March 15, 2001, Sam filed a revocation of the power of attorney to Rick, and a new power of attorney appointing registered practitioner Dave. In a non-final Office action dated September 12, 2001, the examiner included a requirement for information, requiring Dave to submit a copy of any non-patent literature, published application, or patent that was used to draft the application. Which of the following, if timely submitted by Dave in reply to the requirement for information, will be accepted as a complete reply to the requirement for information?

- (A) A statement by Dave that the information required to be submitted is unknown and is not readily available to Dave.
- (B) A statement by Dave that the requirement for information is improper because it was included in a non-final Office action.
- (C) A statement by Dave that the requirement for information is improper because Dave is not an individual identified under 37 CFR 1.56(c).
- (D) A statement by Dave that the requirement for information is improper because information used to draft a patent application may not be required unless the examiner identifies the existence of a relevant database known by Sam that could be searched for a particular aspect of the invention.
- (E) None of the above.

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6. According to the USPTO rules and the procedures set forth in the MPEP, in which of the following situations would the finality of an Office action rejection be improper?

- I. The final Office action rejection is in a first Office action in a substitute application that contains material which was presented in the earlier application after final rejection but was denied entry because the issue of new matter was raised.
- II. The final Office action rejection is in a first Office action in a continuing application, all claims are drawn to the same invention claimed in the earlier application, and the claims would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.
- III. The final Office action rejection is in a first Office action in a continuation-in-part application where at least one claim includes subject matter not present in the earlier application.

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

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10. A registered practitioner filed a patent application naming Sam as the sole inventor without an executed declaration under 37 CFR 1.63. The USPTO mailed a Notice to File Missing Parts dated January 3, 2000. The Notice to File Missing Parts set a two-month period for reply. Which of the following statements is in accordance with proper USPTO rules and the procedure set forth in the MPEP?

- I. Submit an appropriate reply to the Notice to File Missing Parts by filing, on August 3, 2000, a declaration under 37 CFR 1.63 executed by Sam, accompanied by a petition under 37 CFR 1.136(a) for an extension of five months, and the fee set forth in 37 CFR 1.17(a).
- II. In no situation can any extension requested by the practitioner carry the date on which a reply is due to the Notice to File Missing Parts beyond Monday, July 3, 2000.
- III. An appropriate reply by the practitioner to the Notice to File Missing Parts is to file, on August 3, 2000 a declaration under 37 CFR 1.63 executed by Sam, accompanied by a petition under 37 CFR 1.136(b).

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

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12. The Potter patent application was filed on June 6, 2002, claiming subject matter invented by Potter. The Potter application properly claims priority to a German application filed on June 6, 2001. A first Office action contains a rejection of all the claims of the application under 35 USC 103(a) based on a U.S. patent application publication to Smith in view of a U.S. patent to Jones. A registered practitioner prosecuting the Potter application ascertains that the relevant subject matter in Smith's published application and Potter's claimed invention were, at the time Potter's invention was made, owned by ABC Company or subject to an obligation of assignment to ABC Company. The practitioner also observes that the Smith patent application was filed on April 10, 2001 and that the patent application was published on December 5, 2002. Smith and Potter do not claim the same patentable invention. To overcome the rejection without amending the claims, which of the following timely replies would comply with the USPTO rules and the procedures set forth in the MPEP to be an effective reply for overcoming the rejection?

- (A) A reply that only contains arguments that Smith fails to teach all the elements in the only independent claim, and which specifically points out the claimed element that Smith lacks.
- (B) A reply that properly states that the invention of the Potter application and the Smith application were commonly owned by ABC Company at the time of the invention of the Potter application.
- (C) A reply that consists of an affidavit or declaration under 37 CFR 1.132 stating that the affiant has never seen the invention in the Potter application before.

- (D) A reply that consists of an affidavit or declaration under 37 CFR 1.131 properly proving invention of the claimed subject matter of Potter application only prior to June 6, 2001.
- (E) A reply that consists of a proper terminal disclaimer and affidavit or declaration under 37 CFR 1.130.

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15. In which of the following final Office action rejections is the finality of the Office action rejection in accordance with the USPTO rules and the procedures set forth in the MPEP?

- (A) The final Office action rejection is in a second Office action and uses newly cited art under 35 USC 102(b) to reject unamended claims that were objected to but not rejected in a first Office action.
- (B) The final Office action rejection is in a first Office action in a continuation-in-part application where at least one claim includes subject matter not present in the parent application.
- (C) The final Office action rejection is in a first Office action in a continuing application, all claims are drawn to the same invention claimed in the parent application, and the claims would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the parent application.
- (D) The final Office action rejection is in a first Office action in a substitute application that contains material that was presented after final rejection in an earlier application but was denied entry because the issue of new matter was raised.
- (E) None of the above.

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

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

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27. Assume that conception of applicant's complex invention occurred prior to the date of the reference, but reduction to practice occurred after the date of the reference. Which of the following is sufficient to overcome the reference in accordance with the USPTO rules and the procedures set forth in the MPEP?

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

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39. Applicant received a Final Rejection with a mail date of Tuesday, February 29, 2000. The Final Rejection set a 3 month shortened statutory period for reply. Applicant files an Amendment and a Notice of Appeal on Monday, March 27, 2000. The examiner indicates in an Advisory Action that the Amendment will be entered for appeal purposes, and how the individual rejection(s) set forth in the final Office action will be used to reject any added or amended claim(s). The mail date of the examiner's Advisory Action is Wednesday, May 31, 2000. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following dates is the last date for filing a Brief on Appeal without an extension of time?

- (A) Saturday, May 27, 2000.
- (B) Monday, May 29, 2000 (a Federal holiday, Memorial Day).
- (C) Tuesday, May 30, 2000.
- (D) Wednesday, May 31, 2000.
- (E) Tuesday, August 29, 2000.

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42. Which of the following practices or procedures may be employed in accordance with the USPTO rules and the procedures set forth in the MPEP to overcome a rejection properly based on 35 USC 102(e)?

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

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48. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following does not constitute probative evidence of commercial success to support a contention of non-obviousness?

- (A) In a utility case, gross sales figures accompanied by evidence as to market share.
- (B) In a utility case, gross sales figures accompanied by evidence as to the time period during which the product was sold.
- (C) In a utility case, gross sales figures accompanied by evidence as to what sales would normally be expected in the market.
- (D) In a utility case, gross sales figures accompanied by evidence of brand name recognition.
- (E) In a design case, evidence of commercial success clearly attributable to the design, and not to improved performance of the device.

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4. The Office mailed an Office action containing a proper final rejection dated July 8, 2002. The Office action did not set a period for reply. On January 7, 2003, in reply to the final rejection, a registered practitioner filed a request for continued examination under 37 CFR 1.114, a request for a suspension of action under 37 CFR 1.103(c) to suspend action for three months, and proper payment all required fees. No submission in reply to the outstanding Office action accompanied the request for continued examination. No other paper was submitted and no communication with the Office was held until after Midnight, January 8, 2003. Which of the following statements accords with the USPTO rules and the procedures set forth in the MPEP?

- (A) If an appropriate reply is submitted within the three month period of suspension permitted under 37 CFR 1.103(c), the application will not be held abandoned.
- (B) The application will not be held abandoned if an appropriate reply is submitted within the three month period of suspension and it is accompanied by a showing that the reply could not have been submitted within the period set in the final rejection. For example, the reply includes a showing based on an experiment that required 8 months to conduct.
- (C) No reply will prevent the application from being held abandoned.
- (D) If, on January 10, 2003, the primary examiner and applicant agree to an examiner's amendment that places the application in condition for allowance and a notice of allowance is mailed within the three month period of suspension, application X will not be held abandoned.
- (E) No other submission by applicant is necessary because application X is still pending. The examiner is required to act on the request for continued examination after expiration of the three month period of suspension.

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5. Which of the following practices or procedures may be properly employed in accordance with the USPTO rules and the procedures set forth in the MPEP to overcome a rejection properly based on 35 USC 102(a)?

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

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10. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following is true?

- (A) There is no practical difference between an objection and rejection of a claim.
- (B) If the form of the claim (as distinguished from its substance) is improper, an objection is made.
- (C) An objection, if maintained by an examiner, is subject to review by the Board of Patent Appeals and Interferences.
- (D) An example of a proper objection is where the claims are refused because they fail to comply with the second paragraph of 35 USC 112.
- (E) An example of a proper rejection is a rejection of a dependent claim for being dependent on a claim that has been rejected only over prior art, where the dependent claim is otherwise allowable.

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11. A registered practitioner properly recorded an assignment document for application A identifying XYZ Company as the assignee. The document assigns to XYZ Company the “subject matter claimed in Application A.” A proper restriction requirement was made by a primary examiner in application A between two distinct inventions, and the practitioner elected to prosecute one of the inventions. Application A was prosecuted, and later became abandoned. Before the abandonment date of application A, the practitioner filed a complete application B as a proper divisional application of application A. Application B claimed the nonelected invention of Application A, and was published as a U.S. application publication. XYZ Company remains the assignee of application A. What must the practitioner do in accordance with the USPTO rules and the procedures set forth in the MPEP to ensure that XYZ Company is listed as the assignee on the face of any patent issuing from application B?

- (A) File a proper assignment document in application B identifying XYZ Company as the assignee.
- (B) File a proper assignment document in application B identifying XYZ Company as the assignee, and confirm that USPTO’s bibliographic data for application B identifies XYZ Company as the assignee by checking the filing receipt for application B, the U.S. application publication of application B, or the USPTO’s Patent Application Information Retrieval (PAIR) system data for application B, depending on when the practitioner filed the assignment document in application B.
- (C) Confirm that XYZ Company is identified as the assignee on the U.S. application publication of application B.
- (D) File a proper assignment document in application B identifying XYZ Company as the assignee, and confirm that XYZ Company is identified as the assignee on the U.S. application publication of application B.
- (E) Upon allowance of application B, the practitioner must identify XYZ Company as the assignee in the appropriate space on the Issue Fee Transmittal form for specifying the assignee for application B.

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17. Rolland files a U.S. patent application fourteen months after he perfects an invention in Europe. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following would establish a statutory bar against the granting of a U.S. patent to Rolland?

- (A) A foreign patent issued to Rolland 11 months prior to the filing date of Rolland's U.S. patent application. The foreign patent was granted on an application that was filed 23 months prior to the effective filing date of Rolland's U.S. patent application. The foreign patent application and the U.S. patent application claim the same invention.
- (B) The invention was described in a printed publication in the United States, 11 months prior to the filing date of the U.S. patent application.
- (C) The invention was in public use in the United States, less than one year prior to the filing date of the U.S. patent application.
- (D) The invention was on sale in a foreign (NAFTA member) country, more than one year prior to the filing date of the U.S. patent application.
- (E) None of the above.

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20. Inventor Joe is anxious to get a patent with the broadest claim coverage possible for the invention. Joe retained a registered practitioner, Jane, to obtain the advantage of legal counsel in obtaining broad protection. Jane filed a patent application for the invention. The inventor heard that, although patent prosecution is conducted in writing, it is possible to get interviews with examiners. Joe believes an interview might hasten the grant of a patent by providing the examiner a better understanding of the true novelty of the invention. Which of the following are consistent with the USPTO rules and the procedures set forth in the MPEP regarding usage of interviews?

- (A) Prior to the first Office action being mailed the inventor calls the examiner to whom the application is docketed to offer help in understanding the specification.
- (B) After receiving the first Office action Jane calls the examiner for an interview for the purpose of clarifying the structure and operation of the invention as claimed and disclosed, because the examiner's analysis regarding patentability in the rejection is novel and suggests that the examiner is interpreting the claimed invention in a manner very different from the inventor's intent.
- (C) Jane has Larry, a registered practitioner in the Washington D.C. area, who is more familiar with interview practice to call the examiner. Jane gives Larry a copy of the first Office action, which suggests that the primary examiner's analysis is incorrect, and offers to explain why. Jane instructs Larry that because Larry is unfamiliar with the inventor, Larry should not agree to possible ways in which the claims could be modified, or at least indicate to the examiner that Jane would have to approve of any such agreement.
- (D) Jane calls the primary examiner after receiving the final rejection, demanding that the examiner withdraw the finality of the final action. When the examiner states that the final rejection is proper, Jane demands an interview as a matter of right to explain the arguments.
- (E) (B) and (D).

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21. In accordance with the USPTO rules and the procedures set forth in the MPEP, a petition to make a patent application special may be filed without fee in which of the following cases?

- (A) The petition is supported by applicant's birth certificate showing applicant's age is 62.
- (B) The petition is supported by applicant's unverified statement that applicant's age is 65.
- (C) The petition is supported by applicant's statement that there is an infringing device actually on the market, that a rigid comparison of the alleged infringing device with the claims of the application has been made, and that applicant has made a careful and thorough search of the prior art.
- (D) The petition is accompanied by a statement under 37 CFR 1.102 by applicant explaining the relationship of the invention to safety of research in the field of recombinant DNA research.
- (E) The petition is accompanied by applicant's statement explaining how the invention contributes to the diagnosis, treatment or prevention of HIV/AIDS or cancer.

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22. The Potter patent application was filed on June 6, 2002, claiming subject matter invented by Potter. The Potter application properly claims priority to a German application filed on June 6, 2001. In a first Office action all the claims of the Potter application are rejected under 35 USC 102(e) based on a U.S. patent application publication to Smith et al ("Smith"). A registered practitioner prosecuting the Potter application ascertains that the relevant subject matter in Smith's published application and Potter's claimed invention were, at the time Potter's invention was made, owned by ABC Company or subject to an obligation of assignment to ABC Company. The practitioner ascertains that the Smith application was filed on April 10, 2001 and that the Smith application was published on December 5, 2002. Smith and Potter do not claim the same patentable invention. To overcome the rejection without amending the claims which of the following replies would not comply with the USPTO rules and the procedures set forth in the MPEP to be an effective reply for overcoming the rejection?

- (A) A reply that only contains arguments that Smith fails to teach all the elements in the only independent claim, and which specifically points out the claimed element that Smith lacks.
- (B) A reply that consists of an affidavit or declaration under 37 CFR 1.131 properly proving invention of the claimed subject matter of the Potter application prior to April 10, 2001.
- (C) A reply that consists of an affidavit or declaration under 37 CFR 1.132 properly showing that Smith's invention is not by "another."
- (D) A reply that properly states that the invention of the Potter application and the Smith application were commonly owned by ABC Company at the time of the

- invention of the Potter application.
(E) All of the above.

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26. Co-inventors Smith and Jones filed an application for a patent on a cell phone, on May 15, 2002. They received a first Office action from a primary examiner rejecting the claims under 35 USC 102(a) over a publication by Bell and Watson, published on April 5, 2002, describing a cell phone having all the same features as is claimed in the patent application. In reply, the co-inventors each submitted a declaration under 37 CFR 1.131 stating that they had actually reduced the invention to practice no later than March 13, 2002. However, the declarations failed to include two claimed features. Neither the particular antenna needed to enable the cell phone could receive transmissions from the local cellular transmitting tower, nor a detachable carrying strap was included in the declarations. As evidence of their prior reduction to practice, Smith and Jones submitted their co-authored journal article. The journal article contained a figure of the cell phone as described in the declarations. That is, the cell phone shown in the figure of the article lacked an antenna and a detachable strap. The article was received by the journal on March 13, 2002, and was published on April 30, 2002. The cell phones shown in the figure in the Bell and Watson publication, and in the Smith and Jones patent application have the particular antenna and a detachable strap. Which of the following actions, if taken by the examiner, would be the most proper in accordance with USPTO rules and the procedures set forth in the MPEP?

- (A) The examiner should maintain the rejection of the claims under 35 USC 102(a) and make the rejection final.
- (B) The examiner should withdraw the rejection and look for references which have a publication date prior to May 15, 2001.
- (C) The examiner should withdraw the rejection and notify Smith and Jones that their application is in condition for allowance.
- (D) The examiner should maintain the rejection, but indicate that the claims would be allowable if Smith and Jones provided an original copy of the figure published in their journal article as factual support for their declarations.
- (E) The examiner should maintain the rejection and inform Smith and Jones that the declarations are insufficient because they cannot “swear behind” a reference which is a statutory bar.

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47. John, unaware of the existence of Jane’s U.S. patent, which issued on Tuesday, July 11, 2000, files a patent application on Friday, January 11, 2001. John’s application and Jane’s patent are not commonly owned. On Thursday, July 11, 2001, in reply to an Office action rejecting all of his claims, John files an amendment canceling all of his claims and adding claims setting forth, for the first time, “substantially the same subject matter” as is claimed in Jane’s patent. The examiner rejects John’s claims on the basis of 35 USC 135(b). Which of the following statements accords with the USPTO rules and the procedures set forth in the MPEP?

- (A) The rejection is improper because 35 USC 135(b) relates to interferences.
- (B) The rejection is proper because 35 USC 135(b) is not limited to *inter partes* proceedings, but may be used as a basis for *ex parte* rejections.
- (C) Since John's claims would interfere with Jane's unexpired patent, the proper procedure is for the examiner to declare an interference rather than to reject John's claims.
- (D) The rejection is proper merely by reason of the fact that John's claims are broad enough to cover the patent claims.
- (E) The rejection is improper inasmuch as John is claiming "substantially the same subject matter" as is claimed in the patent.

October 16, 2002 AM

5. Where a final rejection of claims has been made, any question of prematureness of the final rejection should be raised, if at all:

- (A) as a ground of appeal.
- (B) as the basis of a complaint before the Board of Patent Appeals and Interferences.
- (C) by petition under 37 CFR 1.181 while the application is pending before the examiner.
- (D) after 2 months from the examiner's answer plus mail room time, if no reply brief has been timely filed during an appeal to the Board of Patent Appeals and Interferences.
- (E) after a supplemental examiner's answer, pursuant to a remand from the Board of Patent Appeals and Interferences has been mailed.

October 16, 2002 AM

6. According to USPTO rules and procedure, which of the following can be overcome by an affidavit under 37 CFR 1.131?

- (A) A rejection properly based on statutory double patenting.
- (B) A rejection properly made under 35 USC 102(d) based on a foreign patent granted in a non-WTO country.
- (C) A rejection properly made under 35 USC 102(a) based on a journal article dated one month prior to the effective filing date of the U.S. patent application. Applicant has clearly admitted on the record during the prosecution of the application that subject matter in the journal article relied on by the examiner is prior art.
- (D) A rejection properly made under 35 USC 102(b) based on a U.S. patent that issued 18 months before the effective filing date of the application. The patent discloses, but does not claim, the invention.
- (E) None of the above.

October 16, 2002 AM

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

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

October 16, 2002 AM

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

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

October 16, 2002 AM

17. Which of the following statements is true?

- (A) In the context of 35 USC 102(b), a magazine need only be placed in the mail to be effective as a printed publication.
- (B) The earliest date declassified printed material may be taken as *prima facie* evidence of prior knowledge under 35 USC 102(a) is as of the date the material is cataloged and placed on the shelf of a public library.
- (C) Declassified printed material is effective as a printed publication under 35 USC 102(b) as of the date of its release following declassification.
- (D) The American Inventors Protection Act (AIPA) amended 35 USC 102(e) to provide that U.S. patents, U.S. application publications, and certain international application publications can be used as prior art under 35 USC 102(e) based on their earliest effective filing date only against applications filed on or after November 29, 2000.
- (E) The American Inventors Protection Act (AIPA) amended 35 USC 102(e) to provide that U.S. patents, U.S. application publications, and certain international application publications can be used as prior art under 35 USC 102(e) based on their earliest effective filing date only against applications filed prior to November 29, 2000 which have been voluntarily published.

October 16, 2002 AM

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

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

October 16, 2002 AM

33. Xavier files a complete first reply exactly 2 months after the mailing date of a final Office action which sets a 3 month shortened statutory period for reply. An Examiner's Amendment is necessary for the purpose of placing the application in condition for allowance. Which of the following statements is true?

- (A) If the Examiner's Amendment is mailed exactly 5 months after Xavier's reply, the application will be allowed.
- (B) The Examiner's Amendment must be made within the 3 month shortened statutory period of the final Office action to avoid abandonment of the application.
- (C) If the Examiner's Amendment is made exactly 4 months after Xavier's reply, the application will be allowed.
- (D) The Examiner's Amendment may be made at any time within 6 months of Xavier's reply to avoid abandonment.
- (E) Abandonment of the application will be avoided if Xavier accompanies his reply with a request for extension of time accompanied by the proper fee and the Examiner's Amendment is made within 6 months of Xavier's reply.

October 16, 2002 AM

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

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

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42. Absent a Certificate of Mailing or Transmission, or use of Express Mail, which of the following actions requires a petition for an extension of time and the appropriate fee?

- (A) Applicant's complete first reply to a final Office action filed on the first day following the end of a shortened statutory period for reply. The Shortened Statutory Period ended on a Wednesday that was not a federal holiday, and the Office is open.
- (B) Interview with examiner conducted after the expiration of the shortened statutory period for reply to a final Office action, but within the 6 months statutory period.
- (C) Action by applicant to correct formal matters identified for the first time after a reply was made to a final Office action in an *Ex parte Quayle* action where the application is otherwise in condition for allowance.
- (D) Applicant's complete first reply to a final Office action filed within 2 months of the final Office action setting a 3 month shortened statutory period for reply.
- (E) Applicant's complete first reply to an Office action on the last day of a shortened statutory period for reply, where the Office action withdraws the finality of a previous Office action in view of a new ground of rejection.

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

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

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

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

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

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

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10. Which of the following is true?

- (A) There is no practical difference between an objection and rejection of a claim.
- (B) If the form of the claim (as distinguished from its substance) is improper, an objection is made.
- (C) An objection, if maintained by an examiner, is subject to review by the Board of Patent Appeals and Interferences.
- (D) An example of a proper objection is where the claims are refused because they fail to comply with the second paragraph of 35 USC 112.
- (E) An example of a proper rejection is a rejection of a dependent claim for being dependent on a claim that has been rejected only over prior art, where the dependent claim is otherwise allowable.

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11. Which of the following practices or procedures may be properly employed to overcome a rejection properly based on 35 USC 102(e)?

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

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13. Which of the following is in accordance with the practice and procedures of Chapter 600 of the MPEP and/or 37 CFR 1.52(c)?

- (A) Handwritten alterations to the claims in a newly filed patent application should be dated and initialed or signed by the applicant on the same sheet of paper.
- (B) The Office will consider evidence of whether noninitialed and/or nondated alterations were made before or after the signing of the oath or declaration rather than require a new oath or declaration.
- (C) Any alteration to a patent application made by the applicant may be made after the application was signed and sworn to.
- (D) Non-initialed or non-dated handwritten alterations to the claims on an application filed in the USPTO are considered to be a minor informality. Thus, the Office personnel should not object to the same.
- (E) It is proper for an applicant to sign an oath or declaration even when the oath or declaration (i) does not identify a patent application or (ii) is not attached to or physically located together with the patent application.

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14. Which of the following timely actions should you take to accord maximum patent protection at minimum government fees for your client whose invention is described in a provisional patent application that was filed 6 months ago with no claim?

- (A) File a request to convert the provisional application to a nonprovisional application, accompanied by a proper executed declaration, an amendment including at least one claim as prescribed by paragraph 2 of 35 USC 112 and the proper fee set forth in 37 CFR 1.17(i).
- (B) File a request to convert the provisional application to a nonprovisional application, accompanied by a proper executed declaration, an amendment including at least one claim as prescribed by paragraph 2 of 35 USC 112, the proper fee set forth in 37 CFR 1.17(i), and the basic filing fee for the nonprovisional application.
- (C) File a request to convert the provisional application to a nonprovisional application, accompanied by a proper executed declaration, an amendment including at least one claim as prescribed by paragraph 2 of 35 USC 112, the proper fee set forth in 37 CFR 1.17(i), the basic filing fee for the nonprovisional application, and the surcharge required by 37 CFR 1.16(e).
- (D) File a nonprovisional application including at least one claim accompanied by a proper executed declaration, and the basic filing fee. The application contains a specific reference to the provisional application in compliance with 37 CFR 1.78(a)(5).
- (E) File a nonprovisional application including at least one claim accompanied by a proper executed declaration but without the basic filing fee. The application contains a specific reference to the provisional application in compliance with 37 CFR 1.78(a)(5).

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

Claim 1. An apparatus for sitting comprising:

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

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

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

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

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

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

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27. Adams filed Application X on March 1, 2001. Beth filed application Y on May 1, 2001. Neither application has been published. Applications X and Y are copending and commonly assigned. Earlier filed application X claims the same invention as claimed in application Y using identical language. In accordance with the MPEP, which of the following actions should the examiner or assignee follow?

- (A) The claims to the same invention in application Y should be rejected under 35 USC 102(a) as being anticipated by application X.
- (B) The claims to the same invention in application Y should be rejected under 35 USC 102(b) as being anticipated by application X.
- (C) The claims to the same invention in application Y should be rejected under 35 USC 102(e) as being provisionally anticipated by application X.
- (D) The common assignee should file a terminal disclaimer in application Y to avoid any question of double patenting.
- (E) The claims to the same invention in application Y should be rejected under 35 USC 102(e) as being anticipated by application X.

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

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

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32. Which of the following practices or procedures may be properly employed to overcome a rejection properly based on 35 USC 102(a)?

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

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33. Xavier files a complete first reply exactly 10 weeks after the mailing date of a final Office action that sets a 3 month shortened statutory period for reply. An Examiner's Amendment is necessary for the purpose of placing the application in condition for allowance. Which of the following statements is true?

- (A) If Xavier gives authorization for the Examiner's Amendment exactly 2 months after his reply, the application will be allowed.
- (B) Authorization for the Examiner's Amendment may be made at any time within 6 months of Xavier's reply to avoid abandonment of the application..
- (C) Unless Xavier gives authorization for the Examiner's Amendment within the 3 months shortened statutory period for reply, the application will be abandoned.
- (D) If Xavier gives authorization for the Examiner's Amendment exactly 2 months after his reply, the application will be abandoned unless accompanied by a proper petition and fee for an extension of time.
- (E) Abandonment of the application will be avoided if Xavier gives authorization for the Examiner's Amendment any time within 6 months of the mail date of a final Office action. No extension of time need be filed if Xavier gives the authorization between 3 months and 6 months after the Office action.

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

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

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

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

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49. Roberto files a U.S. patent application fourteen months after he perfects an invention in Europe. Which of the following would establish a statutory bar against the granting of a U.S. patent to Roberto?

- (A) A foreign patent issued to Roberto 11 months prior to the filing date of Roberto's U.S. patent application. The foreign patent was granted on an application that was filed 23 months prior to the effective filing date of Roberto's U.S. patent application. The foreign patent application and the U.S. patent application claim the same invention.

- (B) The invention was described in a printed publication in the United States, 11 months prior to the filing date of the U.S. patent application.
- (C) The invention was in public use in the United States, less than one year prior to the filing date of the U.S. patent application.
- (D) The invention was on sale in a foreign (NAFTA member) country, more than one year prior to the filing date of the U.S. patent application.
- (E) None of the above.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

- (A) In a 37 CFR 1.131 affidavit or declaration, it is sufficient to allege that applicant or patent owner has been diligent.
- (B) In a 37 CFR 1.131 affidavit or declaration, it is sufficient to clearly establish conception of the invention prior to the effective date of the reference, and diligence from just prior to the effective date of the reference to actual reduction to practice. The presence of a lapse of time between the reduction to practice of an invention and the filing of an application thereon is not relevant.

- (C) In a 37 CFR 1.131 affidavit or declaration, it is sufficient to clearly establish conception of the invention prior to the effective date of the reference. Diligence need not be considered.
- (D) In a 37 CFR 1.131 affidavit or declaration, it is sufficient to show conception and reduction to practice in any country.
- (E) In a 37 CFR 1.131 affidavit or declaration, it is always sufficient to prove actual reduction to practice for all mechanical inventions by showing plans for the construction of the claimed apparatus.

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

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

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

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

April 17, 2002 PM

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

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

April 17, 2002 PM

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

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

April 17, 2002 PM

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

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

April 17, 2002 PM

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

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

April 17, 2002 PM

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

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

April 17, 2002 PM

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

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

April 17, 2002 PM

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

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

April 17, 2002 PM

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

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

October 17, 2001 AM

9. John, unaware of the existence of Jane's U.S. patent, which issued on Tuesday, July 11, 2000, files a patent application on Friday, January 11, 2001. John's application and Jane's patent are not commonly owned. On Thursday, July 11, 2001, in reply to an Office action rejecting all of his claims, John files an amendment canceling all of his claims and adding claims setting forth, for the first time, "substantially the same subject matter" as is claimed in Jane's patent. The examiner rejects John's claims on the basis of 35 U.S.C. § 135(b). Which of the following statements accords with proper USPTO practice and procedure?

- (A) The rejection is improper because 35 U.S.C. § 135(b) relates to interferences.
- (B) The rejection is proper because 35 U.S.C. § 135(b) is not limited to *inter partes* proceedings, but may be used as a basis for *ex parte* rejections.
- (C) Since John's claims would interfere with Jane's unexpired patent, the proper procedure is for the examiner to declare an interference rather than to reject John's claims.
- (D) The rejection is proper merely by reason of the fact that John's claims are broad enough to cover the patent claims.
- (E) The rejection is improper inasmuch as John is claiming "substantially the same subject matter" as is claimed in the patent.

October 17, 2001 AM

11. In which of the following final Office action rejections is the finality of the Office action rejection proper?

- (A) The final Office action rejection is in a second Office action and uses newly cited art under 35 U.S.C. § 102(b) to reject unamended claims that were objected to but not rejected in a first Office action.
- (B) The final Office action rejection is in a first Office action in a continuation-in-part application where at least one claim includes subject matter not present in the parent application.
- (C) The final Office action rejection is in a first Office action in a continuing application, all claims are drawn to the same invention claimed in the parent application, and the claims would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the parent application.
- (D) The final Office action rejection is in a first Office action in a substitute application that contains material that was presented after final rejection in an earlier application but was denied entry because the issue of new matter was raised.
- (E) None of the above.

October 17, 2001 AM

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

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

October 17, 2001 AM

23. Roberto files a U.S. patent application fourteen months after he perfects an invention in Europe. Which of the following would establish a statutory bar against the granting of a U.S. patent to Roberto?

- (A) A foreign patent issued to Roberto 11 months prior to the filing date of Roberto's U.S. patent application. The foreign patent was granted on an application that was filed 23 months prior to the effective filing date of Roberto's U.S. patent application. The foreign patent application and the U.S. patent application claim the same invention.
- (B) The invention was described in a printed publication in the United States, 11 months prior to the filing date of the U.S. patent application.
- (C) The invention was in public use in the United States, less than one year prior to the filing date of the U.S. patent application.
- (D) The invention was on sale in a foreign (NAFTA member) country, more than one year prior to the filing date of the U.S. patent application.
- (E) None of the above.

October 17, 2001 AM

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

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

October 17, 2001 AM

36. The claims of a pending patent application were rejected in an Office action mailed Thursday, November 23, 2000. The Examiner set a three-month shortened statutory period for reply. The applicant petitioned for a one-month extension of time on Friday, February 23, 2001 and paid the appropriate one-month extension fee. No further papers or fees were submitted and the application became abandoned. What was the date of abandonment?

- (A) Friday, February 23, 2001.
- (B) Friday, March 23, 2001.
- (C) Saturday, March 24, 2001.
- (D) Monday, March 26, 2001.
- (E) Thursday, May 24, 2001.

October 17, 2001 AM

39. A non-final Office action in a pending patent application was mailed on Friday, March 16, 2001. The patent examiner set a three month shortened statutory period for reply. The applicant petitioned for a one-month extension of time on Monday, June 18, 2001 and paid the appropriate one-month extension fee. An Amendment responsive to the Office action was filed Tuesday, July 17, 2001. In the Remarks portion of the Amendment, the applicant stated: "It is believed that no fees are required by the present Amendment. However, if any fees are necessary, including fees for any required extension of time, the Director of the United States Patent and Trademark Office is hereby authorized to charge any such fees to applicant's deposit account number nn-nnnn. A duplicate copy of this paper is enclosed." No fees were submitted with the Amendment. Assuming nn-nnnn is a valid deposit account with sufficient funds deposited, which of the following statements is true?

- (A) The Amendment should not be entered because it is untimely.
- (B) The Amendment should be entered with no fees charged to applicant's deposit account.

- (C) The Amendment should be entered, but the fee for a second month extension of time should be charged to applicant's deposit account.
- (D) The request to charge any required fees, including fees for any necessary extension of time, is ineffective because it was not made in a separate paper.
- (E) Statements (A) and (D) are true.

October 17, 2001 AM

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

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

October 17, 2001 AM

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

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

October 17, 2001 AM

47. Registered practitioner Rick drafted a patent application for inventor Sam. The application was filed in the USPTO on May 15, 2000, with a power of attorney appointing Rick. On March 15, 2001, Sam filed a revocation of the power of attorney to Rick, and a new power of attorney appointing registered practitioner Dave. In a non-final Office action dated September 12, 2001, the examiner included a requirement for information, requiring Dave to submit a copy of any non-patent literature, published application, or patent that was used to draft the application. Which of the following, if timely submitted by Dave in reply to the requirement for information, will be accepted as a complete reply to the requirement for information?

- (A) A statement by Dave that the information required to be submitted is unknown and is not readily available to Dave.
- (B) A statement by Dave that the requirement for information is improper because it was included in a non-final Office action.
- (C) A statement by Dave that the requirement for information is improper because Dave is not an individual identified under 37 CFR 1.56(c).
- (D) A statement by Dave that the requirement for information is improper because information used to draft a patent application may not be required unless the examiner identifies the existence of a relevant database known by Sam that could be searched for a particular aspect of the invention.
- (E) None of the above.

October 17, 2001 AM

48. An Office action was mailed in which a three month shortened statutory period for reply was set. Four and one-half months after the mailing date of the Office action, the applicant submitted a fully responsive Amendment along with a petition and fee for a one-month extension of time. The petition for extension of time included an authorization to charge fees under 37 CFR 1.17 to applicant's deposit account. The applicant knew at the time the Amendment was filed that a two-month extension of time was required. Unfortunately, however, a clerical error was made that resulted in only a one-month extension of time being requested. Applicant overlooked this error when the amendment was filed. Assuming no further papers by applicant, which of the following statements is true?

- (A) The Amendment is treated as untimely and the application becomes abandoned. However, applicant may petition to revive the abandoned application on the basis that the abandonment was unavoidable.
- (B) The Amendment is treated as untimely and the application becomes abandoned. However, applicant may petition to revive the abandoned application on the basis that the abandonment was unintentional.
- (C) Applicant will be notified that the petition for extension of time was insufficient and will be given 30 days from the mailing date of the notification to request an extension of time for a second month.
- (D) The petition for a one-month extension of time will be construed as a petition requesting the appropriate period of extension.
- (E) Each of statements (A), (B), (C) and (D) is untrue.

October 17, 2001 PM

4. In 1996, Sydney, while vacationing at the North Pole, invents a new method of ice fishing using a solar powered fishhook with a transmission device for indicating the presence of a fish. For 5 years, Sydney practiced his invention exclusively at the North Pole, outside of the United States, its possessions, or its territories or any WTO or NAFTA country. He showed his invention to only one person, his friend Charlie, while Charlie was visiting him at the North Pole in June 2001. Charlie spoke to no one in the United States about the idea and crafted a near duplicate and began to publicly use it upon his return to Wisconsin in September 2001. On October 18, 2001, Sydney telephones you and complains to you that Charlie, the only person who has ever seen Sydney's device, has begun using his device. In the October 18, 2001 phone conversation, Sydney asks you for advice as to the filing of a patent application. Which of the following is the best advice for Sydney?

- (A) The witnessing of the fishhook by Charlie in June 2001 constitutes knowledge of the invention, and claims directed to Sydney's invention could be properly rejected under 35 U.S.C. §102(a).
- (B) Use of the device in Wisconsin constitutes public use and since Sydney cannot establish prior invention through activities at the North Pole, he is precluded from antedating the date of the first public use in the United States.
- (C) Since Sydney invented the fishing device in 1996, he is the prior inventor and can overcome the first date of public use by Charlie by filing a 37 CFR1.131 affidavit or declaration.
- (D) Since Charlie first used the fishing device in the United States, Charlie may file a patent application.
- (E) Since Charlie's public use in Wisconsin was not authorized, Sydney may still file a patent application on the fishing device.

October 17, 2001 PM

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

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

- (E) less than one year prior to the presentation of claims to that invention in the application being examined, applicant's remedy, if any, is by way of affidavit or declaration traversing the ground of rejection.

October 17, 2001 PM

21. An application, filed September 20, 2001, has not yet been examined. All claims in the application are drawn to a single invention. Which of the following, submitted (independently of each other) by a registered practitioner of record with an otherwise proper petition to make the application special, properly results in the application being advanced out of turn for examination?

- (A) A statement under 37 CFR 1.102 explaining how the invention contributes to the restoration of the basic life-sustaining elements to enhance the quality of the environment, without the petition fee set forth in 37 CFR 1.17(h).
- (B) A search made by a foreign patent office, one copy each of the references deemed most closely related to the subject matter encompassed by the claims, a detailed discussion of the references that points out with the particularity required by 37 CFR 1.111(b) and (c) how the claimed subject matter is patentable over the references, and the petition fee set forth in 37 CFR 1.17(h).
- (C) A doctor's certificate demonstrating that the applicant's health is such that he might not be available to assist in the prosecution of the application if it were to run its normal course, without the petition fee set forth in 37 CFR 1.17(h).
- (D) A birth certificate showing that applicant is 65 years of age, without the petition fee set forth in 37 CFR 1.17(h).
- (E) All of the above.

October 17, 2001 PM

23. Greene is a registered patent agent employed by an intellectual property law firm located in Arlington, Virginia. Greene is awakened at 5:30 AM one morning by a frantic call from Whyte, a senior partner at the law firm. Whyte informs Greene that Whyte has an examiner interview scheduled for 3:00 PM that day in connection with an important patent application Whyte is handling. However, a family emergency arose during the night and Whyte will not be able to attend the interview. It is also the last day of the statutory six-month period for reply, so the interview cannot be rescheduled. Whyte requests that Greene conduct the examiner interview for Whyte and, based on the outcome of the interview, file appropriate papers with the Patent Office. Whyte tells Greene exactly where Greene can locate the file in Whyte's office. Greene has not been given a power of attorney in the application, but has been given a power to inspect the Patent Office file for the application. Assuming Greene has adequate time to prepare for the interview and will competently represent the applicant, which of the following statements is true?

- (A) Greene must obtain either a written power of attorney from the applicant or a written associate power of attorney from Whyte before Greene can participate in the examiner interview.
- (B) Greene can participate in the interview if Greene brings along a copy of the application file and states to the examiner that Greene is authorized to represent the applicant.
- (C) Greene cannot participate in the examiner interview because Greene does not have an express power of attorney and has not previously made an appearance in the application.
- (D) A mere power to inspect is sufficient authority for an examiner to grant an interview involving the merits of an application.
- (E) Statements (B) and (D) are true.

October 17, 2001 PM

25. In accordance with USPTO rules and procedure, in which of the following situations may an applicant file a request on or after August 16, 2000 for continued examination of a non-provisional utility patent application with an earliest effective filing date of March 15, 1999?

- (A) The last Office action is a notice of allowance, the issue fee has been paid, and no petition to withdraw the application from issue has been granted.
- (B) The last Office action is a final action and the application is abandoned.
- (C) The last Office action is a non-final Office action containing a rejection of all claims under 35 U.S.C. § 102(b), and the applicant has filed no reply.
- (D) The last Office action is a notice of allowance, and after four months from the date of the notice of allowance, the issue fee has not been paid.
- (E) None of the above.

October 17, 2001 PM

26. In a non-provisional utility patent application filed January 12, 1999, the examiner sends Applicant a final Office action dated February 14, 2001, rejecting claim 1 under 35 U.S.C. § 102(a), and objecting as to the form of claims 2 through 10. The examiner sets a three-month shortened statutory period for reply. According to USPTO rules and procedure, which of the following by Applicant ensures that the application does not go abandoned on Wednesday, August 15, 2001?

- (A) Mailing to the USPTO, using a certificate of mailing under 37 CFR 1.8, dated August 14, 2001, a petition and fee for an extension of three months, a request for a continued prosecution application, and the fee for a request for a continued prosecution application. The foregoing is received by the USPTO on August 17, 2001.
- (B) Mailing to the USPTO, using a certificate of mailing under 37 CFR 1.8, dated August 14, 2001, a petition and fee for an extension of three months, a request for continued examination with a submission that meets the reply requirements of 37 CFR 1.111, and the fee for a request for continued examination. The foregoing is received by the USPTO on August 17, 2001.

- (C) Mailing to the USPTO, using a certificate of mailing under 37 CFR 1.8, dated August 14, 2001, a petition and fee for an extension of three months. The foregoing is received by the USPTO on August 17, 2001. Also, telephoning the examiner on August 14, 2001 to discuss the rejections of claims in the final Office action, but without reaching an agreement with the examiner.
- (D) Mailing to the USPTO a petition and fee for an extension of three months, a request for continued examination with a reply that states, "Applicant requests that objections as to form be held in abeyance until allowable subject matter is indicated, at which time Applicant will reply to the rejection of claim 1," and the fee for a request for continued examination. The foregoing is received by the USPTO on August 14, 2001.
- (E) Each of items (A), (B), (C) and (D) would ensure that the application does not go abandoned on Wednesday, August 15, 2001.

October 17, 2001 PM

46. According to USPTO rules and procedure, which of the following can be overcome by an affidavit under 37 CFR 1.131?

- (A) A rejection properly based on statutory double patenting.
- (B) A rejection properly made under 35 U.S.C. § 102(d) based on a foreign patent granted in a non-WTO country.
- (C) A rejection properly made under 35 U.S.C. § 102(a) based on a journal article dated one month prior to the effective filing date of the U.S. patent application. Applicant has clearly admitted on the record during the prosecution of the application that subject matter in the journal article relied on by the examiner is prior art.
- (D) A rejection properly made under 35 U.S.C. § 102(b) based on a U.S. patent that issued 18 months before the effective filing date of the application. The patent discloses, but does not claim, the invention.
- (E) None of the above.

April 18, 2001 AM

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

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

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

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

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

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

- (A) An information disclosure statement, filed by Ethel on Monday, January 15, 2001, that complies with the provisions of 37 CFR § 1.98, listing a foreign patent, and stating that each item of information contained in the information disclosure statement was first cited in a communication from a foreign patent office less than three months prior to the filing of the information disclosure statement.
- (B) A statement filed by Ethel on Wednesday, March 7, 2001, stating that Ethel is not an individual identified under 37 CFR § 1.56(c).
- (C) A statement filed by Ethel on Thursday, March 8, 2001, with the appropriate petition and fee for a one-month extension, that states that the information required to be submitted is not readily available to the party from which it was requested.

- (D) A statement filed by Ethel on Thursday, March 8, 2001, with the appropriate petition and fee for a one month extension, which states that Ethel has a good faith belief that the information required is not material to patentability.
- (E) None of the above.

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

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

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

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

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

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

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

- (A) A utility application was filed in October 1999. Following a restriction requirement, the applicant elected claims 1-5, and the examiner withdrew non-elected claims 6-10. After a final rejection of claims 1-5 in January 2001, the applicant may submit an amendment canceling previously examined claims and present claims to the previously non-elected invention of claims 6-10 when filing a request for continued examination under 37 CFR § 1.114.
- (B) Claims in an allowed application may be amended as a matter of right after payment of the issue fee inasmuch as the Office may not rule on amendment filed after a notice of allowance until after the period for payment of the issue fee has expired.
- (C) If, at the time an application is allowed in January 2001, a corrected drawing is required or formal drawing is needed, the applicant is given a three month period in the notice of allowability to file the same, and is permitted to file corrected or formal drawings after payment of the issue fee upon filing a request of an extension of time and payment of the requisite fee.
- (D) Where, after a final rejection, a request for continued examination complying with 37 CFR § 1.114, is filed in April 2001 accompanied by a request to suspend action by the Office for a period not exceeding three months to provide time to submit an information disclosure statement, and the requisite fees, the Office may grant the requested suspension.
- (E) Where an examiner has finally rejected all the claims in a utility application in January 2001, and sets a three month shortened statutory period for reply, the Office may grant a request to suspend action by the applicant for a period not exceeding six months to provide time to gather and submit evidence, if the request and requisite fees are filed within the three month reply period.

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31. Which of the following statements is correct regarding an antedating declaration or affidavit being used in accordance with proper USPTO practice and procedure?

- (A) Where the reference publication date is more than one year before applicant's effective filing date.
- (B) Where the reference is a prior U.S. patent to the same entity, claiming the same invention.
- (C) Where the subject matter relied on in the reference is prior art under 35 U.S.C. § 102(g).
- (D) Where the reference, a U.S. Patent, with a patent issue date less than one year prior to applicant's effective filing date, shows but does not claim the same patentable invention.
- (E) Where the effective filing date of applicant's parent application or an International Convention-proved filing date is prior to the effective date of the reference.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

8. Which of the following statements is most correct?
- (A) The promotional article in the Saskatoon Times constituted an offer to sell that operates as an absolute bar against Thomas' patent application.
 - (B) Thomas, as the inventor, can overcome the rejection by establishing he is also the author of the promotional article.
 - (C) The Saskatoon Times article is not *prima facie* prior art because it was published without Thomas' knowledge or permission.
 - (D) The Saskatoon Times article is not *prima facie* prior art because it does not evidence knowledge or use in the United States.
 - (E) The promotional article cannot be used as prior art because the Birdoculars had not been reduced to practice at the time the article appeared in the Saskatoon Times.
9. Which of the following statements is most correct?
- (A) Thomas can rely on his activities in Canada in establishing a date of invention prior to publication of the Saskatoon Times article.
 - (B) In a priority contest against another inventor, Thomas can rely on his activities in Canada in establishing a date of invention.
 - (C) In a priority contest against another inventor, Thomas can rely on his activities in Germany in establishing a date of invention.
 - (D) Statements (A) and (B) are correct, but statement (C) is incorrect.
 - (E) Statements (A), (B), and (C) are each correct.

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

- I. An affidavit by Jane stating that the application files of Sally and Jane both refer to assignments to Ted.
 - II. A copy of Sally's assignment to Ted, clearly indicating that common ownership of Jane's and Sally's inventions existed at the time Jane's invention was made.
 - III. An affidavit by Ted stating sufficient facts to show that there is common ownership of the Sally and Jane inventions and that common ownership existed at the time the Jane invention was made.
- (A) I.
 - (B) II.
 - (C) III.
 - (D) II and III.
 - (F) None of the above.

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

- 11. An electronic device comprising: circuitry; said circuitry operating to emit signals of a predetermined waveform; said signals being used to automatically change channels on a television set and automatically open the door of a garage.
- 12. A method for opening a garage door comprising using a television remote control device to emit signals, comprising the steps of:
 - a) adapting a television remote control device to emit signals to open a garage door;
 - b) pointing said television remote control device at said garage door; and
 - c) actuating said television remote control to cause said garage door to open.

Which of the following is true?

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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47. Applicant receives a rejection and objection in a non-final Office action dated December 12, 2000. Applicant timely files a reply dated February 12, 2001, that distinctly and specifically points out the supposed errors in the examiner's action. The reply addresses every ground of objection and rejection in the Office action dated December 12, 2000, by presenting arguments pointing out specific distinctions believed to render the claims, including any newly presented claims, patentable over the applied references. Applicant mails a second reply. Thereafter, Applicant mails a third reply to the USPTO, which would result in a change to the specification only, if entered. In accordance with proper USPTO rules and procedure, which of the following are factors that will be considered in deciding whether to disapprove Applicant's third reply?

- (A) Whether Applicant's reply dated February 12, 2001, includes a request that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated.
- (B) The state of preparation of an Office action responsive to the Applicant's reply dated February 12, 2001, as of the date of receipt of Applicant's third reply.
- (C) The nature of any changes to the specification that would result from entry of Applicant's second reply.
- (D) (A), (B), and (C).
- (E) (B) and (C).

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3. You are a registered practitioner and filed a new application on behalf of John. All claims were drawn to a single invention. With the application, you submitted an offer to elect without traverse if the Office deems the application to be drawn to more than one invention, a search made by a foreign patent office, one copy each of the references deemed most closely related to the claimed subject matter, and a detailed discussion of the references pointing out with the particularity required by 37 C.F.R. § 1.111(b) and (c), how the claimed subject matter is patentable over the references. You also submitted a petition to make John's application special. John was 75 years of age at the time of filing, and in such poor health that his doctor had issued a certificate stating that John is unable to assist in the prosecution of his application. Which of the following, singularly or in combination, submitted with the petition, is not sufficient to result in the petition being granted?

- I. The fee set forth in 37 C.F.R. § 1.17(i).
 - II. John's birth certificate showing his date of birth.
 - III. The doctor's certificate stating that John's health is such that he is unable to assist in the prosecution of his application.
- (A) I
 - (B) II
 - (C) III
 - (D) II and III
 - (B) None of the above.

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4. Regarding amendments to the specification of an application or the claims in an application, which of the following is not true?

- (A) If an amendment signed by the applicant is received in an application in which there is a duly appointed registered patent attorney or agent, the amendment should be entered and acted upon.
- (B) Where, by amendment under 37 C.F.R. § 1.121(a), a dependent claim is rewritten to be in independent form, the subject matter from the prior independent claim is considered to be "added" matter and should be underlined.
- (C) Any amendment using parentheses to indicate canceled matter in a claim rewritten under 37 C.F.R. 1.121(a) may be held nonresponsive.
- (D) Amendments to the original patent drawings in a reissue application are not permitted. Any change to the patent drawings must be by way of a new sheet of drawings with the amended figures identified as "amended" and with added figures identified as "new" for each sheet changed.
- (E) Amendment to the claims in a nonprovisional application, other than a reissue application may be made by specifying only the exact matter to be added or deleted, and the precise point where the deletion or insertion is to be made, where the change is limited to deletions and/or additions of no more than ten words in any one claim.

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5. You filed a U.S. patent application for Pete, obtaining an effective filing date of January 5, 1999, for a legal slot machine, fully disclosing and claiming only one claim as follows. Claim 1. A slot machine comprising: a cylindrical drum mechanically coupled to a motor; an electronic random data generator electrically coupled to the motor; and a push button coupled to the random data generator. You received a non-final Office action dated September 20, 1999. The examiner rejected claim 1 under 35 U.S.C. 102(e) as anticipated by a U.S. patent dated May 4, 1999 to Bud. The examiner stated and pointed out that the Bud patent, filed January 7, 1998, disclosed a slot machine with a cylindrical drum mechanically coupled to a motor; a mechanically spinning random data generator electrically coupled to the motor; and a push button coupled to the random data generator. The examiner further stated, "The examiner takes official notice that it was well known by those of ordinary skill in the art of slot machines, prior to applicant's invention, to use interchangeably either a mechanically spinning, or an electronic random data generator." The examiner did not provide any references to support the official notice. Which of the following timely filed replies to the Office action (compared to each other) is best?

- (A) Traverse the rejection arguing that the examiner's use of official notice was improper because the examiner did not provide any references to support the official notice.
- (B) Traverse the rejection arguing that Bud's invention was patented after Pete's effective filing date.
- (C) Amend Pete's claim to further include a flat screen video monitor display and point out that the newly added feature distinguishes Pete's invention over Bud.
- (D) Traverse the rejection arguing that the examiner did not create a prima facie case of obviousness because the examiner did not show why one of ordinary skill in the art of slot machines would be motivated to modify the patent to Bud.
- (E) Traverse the rejection arguing that the examiner's rejection under 35 U.S.C. § 102(e) was improper because Pete's claim is not anticipated by the patent to Bud.

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9. Which of the following statements, in accordance with proper USPTO practice and procedure, is true?

- (A) Inasmuch as the Defensive Publication Program was removed from the rules in view of the applicant's ability to obtain a Statutory Invention Registration, a defensive publication is not available as prior art.
- (B) An application from which a defensive publication has been prepared may be used as a reference under 35 U.S.C. § 102(a) effective only from the date of publication of the defensive application.

- (C) A defensive publication may be cited as prior art only if used alone, but not in combination with other prior art in rejecting claims under 35 U.S.C. § 102 and 35 U.S.C. § 103.
- (D) Abbreviations contain specific portions of the disclosures of abandoned applications and were discontinued in 1965. They may be cited as prior art only if used in combination with other prior art in rejecting claims under 35 U.S.C. § 102 and 35 U.S.C. § 103.
- (E) Abstracts include a summary of the disclosure of an abandoned application. Publication of such abstracts was discontinued in 1953. These publications may be cited as prior art alone or in combination with other prior art in rejecting claims under 35 U.S.C. § 102 and 35 U.S.C. § 103.

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11. An Office action issued with a three month shortened statutory period for reply. Four and one-half months after the mailing date of the Office action, the applicant submitted a fully responsive amendment along with a petition and fee for a one-month extension of time. The petition for extension of time included an authorization to charge fees under 37 C.F.R. § 1.17 to applicant's deposit account. The applicant knew at the time the amendment was filed that a two-month extension of time was required. Unfortunately, however, a clerical error was made that resulted in only a one-month extension of time being requested. Applicant overlooked this error when the amendment was filed. Assuming no further papers by applicant, which of the following statements is true?

- (A) The amendment is treated as untimely and the application becomes abandoned. However, applicant may petition to revive the abandoned application on the basis that the abandonment was unavoidable.
- (B) The amendment is treated as untimely and the application becomes abandoned. However, applicant may petition to revive the abandoned application on the basis that the abandonment was unintentional.
- (C) The petition for a one-month extension of time will be construed as a petition requesting the appropriate period of extension, and the appropriate fee will be charged to the deposit account.
- (D) Applicant will be notified that the petition for extension of time was insufficient and will be given 30 days from the mailing date of the notification to request an extension of time for a second month.
- (E) None of the above.

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

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

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24. Which of the following actions accords with proper USPTO practice and procedure?

- (A) Filing a petition to make special on the ground of applicant's health accompanied by a doctor's certificate showing that the state of health of the applicant is such that he might not be available to assist in the prosecution of the application if it were to run its normal course, unaccompanied by a petition fee.
- (B) Filing a petition to make special on the ground of prospective manufacture by applicant's business competitor accompanied by the required petition fee and a statement by applicant alleging the possession by the competitor of sufficient available capital (stating an approximate amount) and facilities (stating the nature) to manufacture the invention in quantity, that the business competitor is manufacturing the invention in the United States, and that the competitor has a good knowledge of the pertinent prior art, on information and belief.
- (C) Filing a petition to make special on the ground of prospective infringement accompanied by the required fee and a statement by the applicant alleging that an infringing device is about to be put on the market, that a rigid comparison of the alleged infringing device with the claims of the application has been made, and that in applicant's opinion, some of the claims are unquestionably infringed, and that applicant has made a careful and thorough search of the prior art.
- (D) Filing a petition to make special on the ground of environmental quality accompanied by a statement from a Professor of Environmental Engineering at a leading university explaining how the invention contributes to the restoration of lakes and streams, but unaccompanied by a petition fee.
- (E) Filing a petition to make special on the ground of inventions relating to recombinant DNA accompanied by a statement from a Professor of Genetics at a leading university explaining the relationship of the invention to safety of research in the field of recombinant DNA research, and accompanied by the required fee.

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28. Which of the following is true?

- (A) There is no practical difference between an objection and rejection of a claim.
- (B) If the form of the claim (as distinguished from its substance) is improper, an objection is made.
- (C) An objection, if maintained by an examiner, is subject to review by the Board of Patent Appeals and Interferences.
- (D) An example of a proper objection is where the claims are refused because they fail to comply with the second paragraph of 35 U.S.C. § 112.
- (E) An example of a proper rejection is a rejection of a dependent claim for being dependent on a claim that has been rejected only over prior art, where the dependent claim is otherwise allowable.

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34. In which of the following situations would the finality of an Office action rejection be improper?

- II. The final Office action rejection is in a first Office action in a substitute application that contains material which was presented in the earlier application after final rejection but was denied entry because the issue of new matter was raised.
 - III. The final Office action rejection is in a first Office action in a continuing application, all claims are drawn to the same invention claimed in the earlier application, and the claims would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.
 - IV. The final Office action rejection is in a first Office action in a continuation-in-part application where at least one claim includes subject matter not present in the earlier application.
-
- (A) I
 - (B) II
 - (C) III
 - (D) I and III
 - (B) II and III

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37. An Office action was mailed in a pending patent application on Wednesday, November 17, 1999. The examiner set a three month shortened statutory period for reply. The applicant petitioned for a one-month extension of time on Thursday, February 17, 2000 and paid the appropriate one-month extension fee. No further papers or fees were submitted and the application became abandoned. What was the date of abandonment?

- (A) Friday, February 18, 2000.
- (B) Friday, March 17, 2000.
- (C) Saturday, March 18, 2000.
- (D) Monday, March 20, 2000.
- (E) Thursday, May 18, 2000.

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

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

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47. Blackacre is a registered patent agent employed by an intellectual property law firm located in Arlington, Virginia. He is awakened at 5:30 AM one morning by a frantic call from Whiteaker, a senior partner at the law firm. Whiteaker informs Blackacre that she has an examiner interview scheduled for 3:00 PM that day in connection with an important patent application she is handling. However, a family emergency arose during the night and she will not be able to attend the interview. It is also the last day of the statutory six-month period for reply, so the interview cannot be rescheduled. She requests that Blackacre conduct the examiner interview for her and, based on the outcome of the interview, file appropriate papers with the USPTO. She tells him exactly where he can locate the file in her office. Blackacre has not been given a power of attorney in the application, but has been given a power to inspect the USPTO file for the application. Assuming Blackacre has adequate time to prepare for the interview and will competently represent the applicant, which of the following statements is true?

- (A) Blackacre can participate in the interview if he brings along a copy of the application file and states to the examiner that he is authorized to represent the applicant.
- (B) Blackacre cannot participate in the examiner interview because he does not have an express power of attorney and has not previously made an appearance in the application.
- (C) The power to inspect alone is sufficient authority for an examiner to grant an interview involving the merits of an application.
- (D) Blackacre must obtain either a written power of attorney from the applicant or a written associate power of attorney from Whiteaker before he can participate in the examiner interview.
- (E) Statements (B) and (D) are true.

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

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

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8. In early 1998, at the request of MC Motors, Eve demonstrated her reverse automobile heating system at a testing facility in Germany. MC Motors signs a confidentiality agreement and agrees not to disclose the invention to anyone. The test is conducted in a secluded area and the persons involved are sworn to secrecy. Unbeknownst to Eve, MC Motors installs the reverse heating system on its MC cars and begins selling its cars with the reverse heating system in the United States in September 1998. In August 1999, MC files a patent application in the United States for the reverse automobile heating system. In December 1999, Eve files a patent application claiming the automobile heating system. The examiner rejects all the claims in Eve's application based upon an MC Motors brochure advertising its cars in September 1998. Which of the following is true?

- (A) Since the MC Motors misappropriated the invention and since Eve did not authorize the sale, the rejection may be overcome by showing that the sales by MC Motors were not authorized by Eve.
- (B) Eve is not entitled to a patent since the invention was on sale in this country, more than one year prior to the date of the application for patent in the U.S.

- (C) MC Motors is entitled to a patent since although it misappropriated the idea for the invention from Eve, the misappropriation was beyond the jurisdiction of the USPTO.
- (D) (B) and (C).
- (E) None of the above.

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12. Which of the following is true?

- (A) Claims may be properly rejected on the ground that applicant has disclaimed the subject matter involved if the applicant fails to copy a claim from a patent when suggested by the examiner.
- (B) Res Judicata, as a proper ground for rejection, should be applied when the earlier decision was a final rejection by the same examiner.
- (C) If an article of manufacture capable of illustration is originally claimed and it is not shown in the drawing, the claim should be rejected based on the reason the claimed subject matter is not shown in the drawing, and applicant is required to add it to the drawing.
- (D) A thing occurring in nature, which is substantially unaltered, such as a shrimp with the head and digestive tract removed, is a “manufacture.”
- (E) A scientific principle, divorced from any tangible structure, is a statutory class of patentable subject matter.

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13. On February 3, 1999, you filed an application for inventor Sam, fully disclosing and claiming only the following:

Claim 1. A system for preventing unauthorized entry into a garage, comprising: an electric garage opener coupled to a computer and to a video camera.

You received a non-final Office action dated February 4, 2000, wherein the examiner rejected claim 1 under 35 U.S.C. § 102(b) as anticipated by Dan. The examiner attached a copy of Dan’s journal article published on July 4, 1997, fully disclosing an electric garage opener coupled to a computer and to a video camera. Which of the following actions, if taken by you, can overcome the rejection in accordance with proper USPTO practice and procedure?

- (A) Timely filing a reply traversing the rejection, arguing that claim 1 is patentably distinguished from the Dan reference.
- (B) Timely filing a reply traversing the rejection, arguing that since the date of the Dan reference falls on a Federal holiday, the Dan reference is not a statutory bar under 35 U.S.C. § 102(b).
- (C) Timely filing a reply with an affidavit under 37 C.F.R. § 1.131 showing prior invention by Sam.

- (D) Timely filing a reply traversing the rejection, arguing that the examiner did not demonstrate why one of ordinary skill in the art at the time the invention was made would have been motivated to modify the system disclosed by Dan.
- (E) Timely filing a reply including an amendment to the specification perfecting priority under 35 U.S.C. § 120, containing a specific reference in accordance with 37 C.F.R. § 1.78(a), to a U.S. application filed by Sam on July 3, 1997 that fully disclosed but did not claim a garage opener coupled to a computer and a video camera.

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15. In December 1987, Molly invents a new potato cutter that cuts the potatoes into shapes having a star cross section. Because of the proximity of the star outer surface to the inter core of the potato, the shape achieves optimal cooking of the potato when fried without resulting in an overly cooked outer surface. Molly, thinking that the invention is important, has two people, Sue and Tom, both sworn to secrecy, witness a drawing of the invention. Molly then locks the drawing in a safe deposit box where it remains for the next twelve years. Neither Molly, Sue, or Tom discloses the invention to anyone for the next twelve years. In December 1999, Troy invents a new potato cutter which produces potatoes having a star cross section, and the potatoes are then fried. The invention becomes an overnight success. Troy files a patent application on February 1, 2000. Molly, after seeing the success of Troy's invention in the marketplace, decides to file an application, also on February 1, 2000. The examiner is unable to find any prior art and no other prior art is cited by either applicant. Which of the following is true?

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

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16. In June 1995 Michael buys a television set with a remote control for automatically changing channels on the television set. In June 1997, Michael moves to a new neighborhood and discovers while watching television that the remote control for his television not only changes the channels on his television set but also operates to open his neighbor's garage door. Michael, believing that people no longer need to have separate devices for operating their television and opening their garage doors, goes to a registered practitioner to seek patent protection on his new idea. The practitioner files a patent application in 1997. During the prosecution of the patent for the circuit board device, the practitioner files the following claims 11 and 12:

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

12. A method for opening a garage door comprising using a television remote control device to emit signals, comprising the steps of: a) adapting a television remote control device to emit signals to open a garage door; b) pointing said television remote control device at said garage door; and c) actuating said television remote control to cause said garage door to open.

Which of the following is true?

- (A) Since the television and remote control were sold in June 1995, claims 11 and 12 are barred by 35 U.S.C. § 102(b) since the device was on sale more than one year prior to the invention by Michael.
- (B) Although the device was bought in June 1995, Michael did not use it to open a garage door until 1997. Since claim 11 requires that the signals of the remote control operate to open the garage door, the limitations of claim 11 are not met by the device bought in 1995, and 35 U.S.C. § 102(b) does not apply.
- (C) Since the television remote control device was in public use more than one year prior to the filing date of the application, Michael may obtain the patent coverage for the method claim 12 but not the device of claim 11.
- (D) Since Michael did not make the remote control himself and only inadvertently discovered that his neighbor's garage door opens when changing the channel on his television set, this is merely an inadvertent discovery and not entitled to patent protection.
- (E) Whether or not claim 11 is patentable is solely a question of obviousness. Michael need only produce evidence of commercial success to overcome an obviousness rejection.

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18. Sally, an employee of Ted, conceived of and reduced to practice a spot remover for Ted on May 1, 1997. Sally's spot remover was made from water, chlorine, and lemon juice. On June 2, 1997, Sally filed a nonprovisional U.S. patent application for the spot remover, and assigned the entire rights in the application to Ted. Sally's assignment was not recorded in the USPTO, but was referred to in her application. On June 12, 1998, Jane, also an employee of Ted, having no knowledge of Sally's spot remover, conceived of and reduced to practice a spot remover for Ted. Jane's spot remover was made from carbonated water, chlorine, and lemon juice. On May 26, 1998, the USPTO granted Sally a patent. On November 6, 1998, Jane filed a nonprovisional U.S. patent application for the spot remover. As noted in Jane's application, Jane assigned the entire rights in her application to Ted. Jane's assignment was duly recorded in the USPTO. The examiner mailed a non-final Office action rejection under 35 U.S.C. § 103 to Jane in October 2000, citing the patent to Sally as prior art. Which of the following, if timely filed by Jane, would be effective in disqualifying Sally's patent?

- I. An affidavit by Jane stating that the application files of Sally and Jane both refer to assignments to Ted.
 - II. A copy of Sally's assignment to Ted, clearly indicating that common ownership of Jane's and Sally's inventions existed at the time Jane's invention was made.
 - III. An affidavit by Ted stating sufficient facts to show that there is common ownership of the Sally and Jane inventions and that common ownership existed at the time the Jane invention was made.
- (A) I
 - (B) II
 - (C) III
 - (D) II and III
 - (B) None of the above.

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

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

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23. Which of the following statements is correct regarding an antedating declaration or affidavit being used in accordance with proper USPTO practice and procedure?

- (B) Where the reference, a U.S. Patent, with a patent issue date less than one year prior to applicant's effective filing date, shows but does not claim the same patentable invention.
- (C) Where the reference publication date is more than one year before applicant's effective filing date.
- (D) Where the reference is a prior U.S. patent to the same entity, claiming the same invention.
- (E) Where the subject matter relied on in the reference is prior art under 35 U.S.C. § 102(g).
- (F) Where the effective filing date of applicant's parent application or an International Convention-proved filing date is prior to the effective date of the reference.

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

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

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

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

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

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

October 18, 2000 PM

34. You filed a patent application naming your client, Sam, as the sole inventor without an executed declaration under 37 C.F.R. § 1.63. The USPTO mailed you a Notice to File Missing Parts dated January 3, 2000. The Notice to File Missing Parts set a 2-month period for reply. Which of the following statements is in accordance with proper USPTO rules and procedure?

- I. An appropriate reply by you to the Notice to File Missing Parts is, on August 3, 2000 you file a declaration under 37 C.F.R. § 1.63 executed by Sam, with a petition under 37 C.F.R. § 1.136(a) for an extension of five months, and the fee set forth in 37 C.F.R. § 1.17(a).
 - II. In no situation can any extension requested by you carry the date on which reply is due to the Notice to File Missing Parts beyond Monday, July 3, 2000.
 - III. An appropriate reply by you to the Notice to File Missing Parts is, on August 3, 2000 you file a declaration under 37 C.F.R. § 1.63 executed by Sam, with a petition under 37 C.F.R. § 1.136(b).
- (A) I
 - (B) II
 - (C) III
 - (D) I and III
 - (F) None of the above.

October 18, 2000 PM

46. A non-final Office action was mailed in a pending patent application on Friday, November 12, 1999. The examiner set a three month shortened statutory period for reply. The practitioner petitioned for a one-month extension of time on Monday, February 14, 2000 and paid the appropriate one-month extension fee. An amendment responsive to the Office action was filed Tuesday, March 14, 2000. Each independent claim in the application was revised and two dependent claims were cancelled. No claim was added by the amendment. In the Remarks portion of the amendment, the practitioner express his belief that no fees are required by the amendment, but nevertheless gave authorization to charge any fees to the practitioner's account, nn-nnnn, if any fees are necessary, including fees for any required extension of time. A duplicate copy of the amendment was filed. No fees were submitted with the amendment. Assuming nn-nnnn is a valid deposit account, which of the following statements is true?

- (A) The amendment should be entered with no fees charged to practitioner's deposit account.
- (B) The amendment should be entered, but the fee for a second month extension of time should be charged to the practitioner's deposit account.
- (C) The amendment should not be entered because it is untimely.
- (D) The request to charge any required fees, including fees for any necessary extension of time, is ineffective because it was not made in a separate paper.
- (E) Statements (C) and (D) are true.

April 12, 2000 AM

1. The claimed invention in a patent application is directed to an explosive composition “comprising 60-90% solid ammonium nitrate, and 10-40% water-in-oil in which sufficient aeration is entrapped to enhance sensitivity to a substantial degree.” The application discloses that the explosive requires both fuel (the ammonium nitrate), and oxygen to “sensitize the composition.” A prior art reference, published more than two years before the effective filing date of the application, discloses explosive compositions containing water-in-oil emulsions having identical ingredients to those claimed, in ranges overlapping with the claimed composition. The only element of the claim not recited in the reference is “sufficient aeration entrapped to enhance sensitivity to a substantial degree.” The reference does not recognize that sufficient aeration sensitizes the fuel to a substantial degree. However, in fact, “sufficient aeration” is necessarily an inherent element in the prior art blasting composition within the overlapping ranges inasmuch as the blasting composition explodes. The prior art reference:

- (A) anticipates the claim because it discloses every limitation of the claim either explicitly or inherently.
- (B) does not anticipate the claim because the prior art reference does not recognize an inherent property.
- (C) does not anticipate the claim because the prior art reference does not recognize an inherent function of oxygen.
- (D) does not anticipate the claim because the prior art reference does not recognize an inherent ingredient, oxygen.
- (E) (B), (C) and (D).

April 12, 2000 AM

8. Applicant received a Final Rejection with a mail date of Tuesday, February 29, 2000. The Final Rejection set a 3 month shortened statutory period for reply. Applicant files an Amendment and a Notice of Appeal on Monday, March 27, 2000. The examiner indicates in an Advisory Action that the Amendment will be entered for appeal purposes, and how the individual rejection(s) set forth in the final Office action will be used to reject any added or amended claim(s). The mail date of the examiner’s Advisory Action is Wednesday, May 31, 2000. Which of the following dates is the last date for filing a Brief on Appeal without an extension of time?

- (A) Saturday, May 27, 2000.
- (B) Monday, May 29, 2000 (a Federal holiday, Memorial Day).
- (C) Tuesday, May 30, 2000.
- (D) Wednesday, May 31, 2000.
- (E) Tuesday, August 29, 2000.

April 12, 2000 AM

Please answer questions 10 and 11 based on the following facts.

Mario Lepieux was a member of a Canadian national hockey team touring Europe. While travelling through Germany (a WTO member country) in December 1998, Mario conceived of an aerodynamic design for a hockey helmet that offered players improved protection while reducing air resistance during skating. Upon Mario's return to Canada (a NAFTA country), he enlisted his brothers Luigi and Pepe Lepieux to help him market the product under the tradename "Wing Cap." On February 1, 1999, without Mario's knowledge or permission, Luigi anonymously published a promotional article written by Mario and fully disclosing how the Wing Cap was made and used. The promotional article was published in Moose Jaw Monthly, a regional Canadian magazine that is not distributed in the United States. The Wing Cap was first reduced to practice on March 17, 1999. A United States patent application properly naming Mario as the sole inventor was filed September 17, 1999. That application has now been rejected as being anticipated by the Moose Jaw Monthly article.

10. Which of the following statements is most correct?

- (A) The promotional article cannot be used as prior art because the Wing Cap had not been reduced to practice at the time the article appeared in the regional Canadian magazine.
- (B) The regional Canadian magazine article is not *prima facie* prior art because it was published without Mario's knowledge or permission.
- (C) The regional Canadian magazine article is not *prima facie* prior art because it appeared in a regional Canadian publication and does not evidence knowledge or use in the United States.
- (D) The promotional article in the regional Canadian magazine constituted an offer to sell that operates as an absolute bar against Mario's patent application.
- (E) Mario, as the inventor, can overcome the rejection by filing an affidavit under 37 C.F.R. § 1.132 establishing that he is the inventor, and the article describes his work.

11. Which of the following statements is most correct?

- (A) In a priority contest against another inventor, Mario can rely on his activities in Canada in establishing a date of invention.
- (B) In a priority contest against another inventor, Mario can rely on his activities in Germany in establishing a date of invention.
- (C) Mario can rely on his activities in Canada in establishing a date of invention prior to publication of the regional Canadian magazine article.
- (D) (A) and (C).
- (E) (A), (B), and (C).

April 12, 2000 AM

14. On August 7, 1997, practitioner Costello filed a patent application identifying Laurel, Abbot, and Hardy as inventors. Each named inventor assigned his patent rights to Burns just prior to the application being filed. Laurel and Abbot, alone, jointly invented the subject matter of independent claim 1 in the application. Hardy contributed to inventing the subject matter of claim 2. Claim 2 properly depends upon claim 1. The examiner rejected claim 1 and claim 2 under 35 U.S.C. § 102(a) as anticipated by a journal article by Allen, dated July 9, 1997. Laurel, Abbot, and Hardy are readily available to provide evidence in support of and sign an antedating affidavit under 37 C.F.R. § 1.131 showing reduction to practice of the subject matter of claims 1 and 2 prior to July 9, 1997. Which of the following may properly make an affidavit under 37 C.F.R. § 1.131 to overcome the rejection of claims 1 and 2.?

- (A) Laurel and Abbot.
- (B) Laurel, Abbot, and Hardy.
- (C) Laurel, Hardy and Burns.
- (D) Burns only.
- (E) None of the above.

April 12, 2000 AM

20. In the course of prosecuting a patent application, you receive a final rejection wherein the examiner has set a 3 month shortened statutory period for reply. You file an initial reply with a Certificate of Mailing in accordance with 37 C.F.R. § 1.8 within 2 months of the final rejection mail date. The examiner responds with an Advisory Action having a mail date before the end of the 3 month shortened statutory period. In accordance with proper PTO practice and procedure, the fee for an extension of time for applicant to take subsequent appropriate action in the PTO is calculated from:

- (A) the mail date of the Advisory Action.
- (B) the date your reply is received by the PTO.
- (C) the date your reply is mailed with a Certificate of Mailing in accordance with 37 C.F.R. § 1.8.
- (D) the mail date of the Final Rejection.
- (E) the date the shortened statutory period expires.

April 12, 2000 AM

29. You are attorney of record appointed by XYZ Corp. to prosecute a patent application directed to an invention assigned to the XYZ Corp. by an employee-inventor. In the course of prosecution, you receive an Office action rejecting all the claims as anticipated by a patent to Williams. After carefully reviewing the Office action and discussing the same with XYZ officers, it is concluded that the rejection is sound. In accordance with instructions from XYZ officers, you file in the PTO a certification by XYZ Corp. that it is the assignee of the invention, and an express abandonment signed by you under 37 C.F.R. § 1.138. An appropriate PTO official acknowledges receipt and accepts the express abandonment. Shortly thereafter, you receive an urgent call from the employee-inventor, who informs you that she just learned of the action taken to abandon the application, and that she has reviewed the Williams patent and concluded that her invention differs therefrom in a subtle but significant manner. Which of the following courses of action, if any, are properly available to you to successfully revive the application in accordance with proper PTO practice and procedure?

- (A) Request reconsideration of the abandonment on the ground that the filing of the express abandonment was without the inventor's consent.
- (B) Request reconsideration of the abandonment on the ground that the filing of the express abandonment was the result of a mistake.
- (C) File a petition to revive the application with all the elements required under 37 C.F.R. § 1.137(a) on the ground that the filing of the express abandonment was unavoidable.
- (D) File a petition to revive the application with all the elements required under 37 C.F.R. § 1.137(b) on the ground that the filing of the express abandonment was unintentional.
- (B) None of the above.

April 12, 2000 AM

32. Nonobviousness of a claimed invention may be demonstrated by:

- (A) producing evidence that all the beneficial results are expected based on the teachings of the prior art references.
- (B) producing evidence of the absence of a property the claimed invention would be expected to possess based on the teachings of the prior art.
- (C) producing evidence showing that unexpected results occur over less than the entire claimed range.
- (D) producing evidence showing that the unexpected properties of a claimed invention have a significance less than equal to the expected properties.
- (E) (A), (B), (C) and (D).

April 12, 2000 AM

34. You have just received an Office action rejecting all of your claims in your patent application as anticipated under 35 U.S.C. § 102(a) using published declassified material as the reference. The examiner explains that the declassified material is being used as *prima facie* evidence of prior knowledge as of the printing date. The published declassified material contains information showing that it was printed six months before the filing date of the application, and that it was published two months after the application's filing date. You correctly note that although the printing date precedes your application filing date by six months, you note that the publication was classified as of its printing date (thus, available only for limited distribution even when the application was filed), and was not declassified until its publication date (when it became available to the general public). Each element of the claimed invention is described in the publication of the declassified material. Which of the following statements is **true** ?

- (A) The rejection is not supported by the reference.
- (B) The publication is not available as a reference because it did not become available to the general public until after the filing date of your patent application.
- (C) The publication is *prima facie* evidence of prior knowledge even though it was available only for limited distribution as of its printing date.
- (D) The publication constitutes an absolute statutory bar.
- (E) It is not possible to use a Rule 131 affidavit or declaration to antedate the printing date of the publication.

April 12, 2000 AM

36. A petition to make a patent application special may be filed without fee in which of the following cases?

- (A) The petition is supported by applicant's birth certificate showing applicant's age is 62.
- (B) The petition is supported by applicant's unverified statement that applicant's age is 65.
- (C) The petition is supported by applicant's statement that there is an infringing device actually on the market, that a rigid comparison of the alleged infringing device with the claims of the application has been made, and that applicant has made a careful and thorough search of the prior art.
- (D) The petition is accompanied by a statement under 37 C.F.R. § 1.102 by applicant explaining the relationship of the invention to safety of research in the field of recombinant DNA research.
- (E) The petition is accompanied by applicant's statement explaining how the invention contributes to the diagnosis, treatment or prevention of HIV/AIDS or cancer.

April 12, 2000 PM

1. Which of the following does not constitute probative evidence of commercial success to support a contention of non-obviousness?

- (A) In a utility case, gross sales figures accompanied by evidence as to market share.
- (B) In a utility case, gross sales figures accompanied by evidence as to the time period during which the product was sold.
- (C) In a utility case, gross sales figures accompanied by evidence as to what sales would normally be expected in the market.
- (D) In a utility case, gross sales figures accompanied by evidence of brand name recognition.
- (E) In a design case, evidence of commercial success clearly attributable to the design, and not to improved performance of the device.

April 12, 2000 PM

2. Which of the following statements is **true** based on current PTO practice and procedure?

- (A) Where claims in an application on appeal have been rejected on prior art, the Board cannot consider a reference having a publication date after the effective date of the application.
- (B) Objective indicia of non-obviousness cannot depend on facts developed after the effective date of the application under consideration.
- (C) Evidence that has developed only after the filing date of an application cannot be used to show non-obviousness.
- (D) The scope of objective evidence of non-obviousness is independent of the scope of the claim for which the evidence is offered to support.
- (E) Objective evidence of non-obviousness must be commensurate in scope with the claims for which the evidence is offered to support.

April 12, 2000 PM

5. Beverly, who was already well known for her research work in the shampoo industry, was working toward a Ph.D. in chemistry from a university near Berlin, Germany. As part of her doctoral program, Beverly prepared (in German) a thesis directed to her work on a new formulation for an “all-in-one” shampoo and conditioner. Following approval of the thesis by her faculty advisor on December 21, 1998, the sole copy of Beverly’s thesis was placed on the shelves of the university library on January 29, 1999, where it was accessible to the faculty and students of the university as well as to the general public. At that time, the thesis was indexed in a general user’s catalog maintained locally at the university library by author, title and subject. On March 4, 1999, the general user’s catalog was made freely available on an Internet web page maintained by the university. Which of the following statements is most correct?

- (A) Beverly's thesis may be used under 35 U.S.C. § 102(b) as a prior art printed publication against a United States application for patent filed January 15, 2000.
- (B) Beverly's thesis may be used under 35 U.S.C. § 102(b) as a prior art printed publication against a United States application for patent filed February 26, 2000.
- (C) Beverly's thesis may be used under 35 U.S.C. § 102(b) as a prior art printed publication against a United States application for patent filed March 8, 2000.
- (D) (A), (B) and (C).
- (E) (B) and (C).

April 12, 2000 PM

6. In the course of prosecuting a patent application for his client, Smith did not receive a Notice of Allowance and Issue Fee Due from the PTO. Fifteen months after submitting a reply to a final rejection, Smith received from the PTO a Notice of Abandonment advising that the application became abandoned for failure to pay the issue fee. Which of the following actions, if any, accords with proper PTO practice and procedure, and is most likely to succeed in protecting the interests of Smith's client?

- (A) File a petition to revive the application including a statement that the entire delay in paying the issue fee, from the due date for the payment of the fee until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(a), was unavoidable, accompanied by the issue fee then in effect, and any required terminal disclaimer.
- (B) File a petition to revive the application including a statement that the entire delay in paying the issue fee, from the due date for the payment of the fee until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b), was unintentional, and required terminal disclaimer.
- (C) File a timely petition to withdraw the holding of abandonment accompanied by a statement that the Notice of Allowance and Issue Fee Due was not received, and that a search of the file jacket and docket records indicates that the Notice of Allowance and Issue Fee Due was not received. Include with the petition a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed.
- (D) All of the above.
- (E) None of the above.

April 12, 2000 PM

9. In the course of prosecuting a patent application, you receive a final rejection wherein the examiner has set a 3 month shortened statutory period for reply. You file an initial reply within 2 months of the Final Rejection mail date, and the examiner responds with an Advisory Action having a mail date after the end of the 3 month shortened statutory period. In accordance with proper PTO practice and procedure, the fee for an extension of time for applicant to take subsequent appropriate action in the PTO is calculated from:

- (A) the date your reply is received by the PTO.
- (B) the mail date of the Final Rejection.
- (C) the mail date of the Advisory Action.
- (D) the date the Advisory Action is received by you.
- (E) the date the shortened statutory period expires.

April 12, 2000 PM

20. Which of the following is (are) appropriate for restarting the period for replying to an Office action, dated September 25, 2000?

- I. The examiner set a shortened statutory period of three months for replying to the Office action, and three months from September 25, 2000 falls on Christmas Day, December 25, 2000, a federal holiday, and the registered practitioner calls this to the attention of the examiner within one month of the mail date of the Office action.
- II. The examiner's interpretation of the prior art in rejecting certain claims, as set forth in the Office action, is believed by a registered practitioner to be contrary to the interpretation given by one of ordinary skill in the art, and the practitioner calls this alone to the examiner's attention within one month of the mail date of the office action.
- III. The examiner incorrectly cited one of the references, and the registered practitioner calls this to the attention of the examiner within one month of the mail date of the Office action.

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

April 12, 2000 PM

21. Mr. Roberts, an American citizen touring a vineyard, saw a unique grape-squeezing machine in France. The machine was highly efficient, and produced excellent wine. The vineyard owner was not hiding the machine. It was out of public view and was the only one of its kind. The vineyard owner had built it himself several years earlier, and no drawing or technical description of the machine was ever made. The vineyard made only local sales of its wines. Using his photographic memory, Roberts went back to his hotel and made technical drawings of what he had seen. Upon his return to the United States, Roberts promptly prepared and filed a patent application directed to the machine. Which of the following statements is correct?

- (A) Roberts may not obtain a patent on the machine because it was known by others before Mr. Roberts made technical drawings of the machine.
- (B) Roberts may not obtain a patent on the machine because wine made by the machine had been sold more than a year before Roberts' application filing date.
- (C) Roberts is entitled to a patent because a goal of the patent system is public

- disclosure of technical advances, and the machine would not have been disclosed to the public without Roberts' efforts.
- (D) Roberts may not obtain a patent on the machine because the vineyard owner was not hiding the machine and therefore the machine was in public use more than a year before Roberts' application filing date.
 - (E) Statements (A), (B), (C) and (D) are each incorrect.

April 12, 2000 PM

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

A steam cooker comprising:

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

Assuming all of the following amendments are supported by the original disclosure in the specification, which amendment is in accord with proper PTO amendment practice and procedure?

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

April 12, 2000 PM

37. Today, April 12, 2000, is the last day of a three month shortened statutory period for reply to a non-final rejection over references under 35 U.S.C. § 103. Today, your client, located overseas, requests in a facsimile that you cancel all of the current claims in the application, and advises that a new set of claims to replace the current claims will be sent to you no later than April 29, 2000. There is no deposit account. The client pays all fees in a timely manner. In accordance with proper PTO practice and procedure, which of the following is the most appropriate course of action to take regarding the non-final rejection?

- (A) Await receipt of the new claims and necessary fees, and then file the amendment, request for reconsideration, and appropriate fee for an extension of time, no more than six months from the date of the non-final rejection.
- (B) File a request for a one month extension of time today and pay the fee when you file the amendment.

- (C) File an amendment today canceling all claims in accordance with your client's instructions.
- (D) File a request for reconsideration today, stating only that "[t]he rejection is in error because the claims define a patentable invention."
- (E) File a request for reconsideration today, and state that a supplemental amendment will be forthcoming.

November 3, 1999 AM

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

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

November 3, 1999 AM

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

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

November 3, 1999 AM

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

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

November 3, 1999 AM

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

Claim 1. A talbecloth for protecting the finish of a table comprising:

a layer of cotton;
a layer of vinyl affixed to the layer of cotton; and
a backing of felt.

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

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

November 3, 1999 AM

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

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

November 3, 1999 PM

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

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

November 3, 1999 PM

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

- (A) The rejected claim is drawn to a genus. The Smith patent issued in March 1998, on an application filed in June 1994. The patent discloses, but does not claim, a single species of the genus claimed by Jones. The declaration shows completion in April 1994, of the same species disclosed by Smith.
- (B) The rejected claim is drawn to a species. The Smith patent issued in March 1998 on an application filed in June 1994. The patent discloses, but does not claim, the species claimed by Jones. The declaration shows completion in April 1994, of a different species.

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

November 3, 1999 PM

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

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

November 3, 1999 PM

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

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

respectively.

- (D) Tuesday, December 28, 1999.
- (E) Thursday, January 13, 2000.

November 3, 1999 PM

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

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

November 3, 1999 PM

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

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

November 3, 1999 PM

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

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

Chapter 700

Answers

April 15, 2003 AM

3. ANSWER: (A) is the correct answer. See 37 CFR § 1.105(a)(3); MPEP § 704.12(b). MPEP § 704.12(b) states “A reply stating that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will generally be sufficient unless, for example, it is clear the applicant did not understand the requirement, or the reply was ambiguous and a more specific answer is possible.” The given facts do not state that the applicant did not understand the requirement, or the reply was ambiguous and a more specific answer is possible. (B) is incorrect because the requirement for information may be included in an Office action, or sent separately. 37 CFR § 1.105(b). (C) is incorrect because 37 CFR § 1.56(c) includes each attorney or agent who prepares or prosecutes the application. 37 CFR § 1.56(c)(2). (D) is incorrect because information used to draft a patent application may be required and there is no support for (D) in 37 CFR § 1.105. (E) is incorrect because (A) is correct.

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6. ANSWER: (D) is the correct answer. MPEP § 706.07(b). In both I and III the finality is improper. MPEP § 706.07(b). Therefore (A) and (C) are incorrect. In II the finality is proper. MPEP § 706.07(b). Therefore (B) and (E) are incorrect.

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10. ANSWER: (A) is the most correct answer. MPEP § 710.02(d), last paragraph, and 37 CFR § 1.136(a). (B) is incorrect because a Notice to File Missing Parts of an Application is not identified on the Notice as a statutory period subject to 35 U.S.C. § 133. (C) and (D) are incorrect because the provisions of 37 CFR § 1.136(a) are available. (E) is incorrect because (A) is correct.

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12. ANSWER: (B) is the most correct answer. See 35 U.S.C. § 103(a); MPEP §§ 706.02(l)(1) and 2145. The prior art exception in 35 U.S.C. § 103(c) is applicable because the Smith reference is only prior art under 35 U.S.C. § 102(e), (f), or (g), was applied in a rejection under 35 U.S.C. § 103(a), and was commonly owned at the time Potter made the invention claimed by Potter. See MPEP § 706.02(l)(1). Answer (A) is not a correct answer in that one cannot show nonobviousness by attacking the references individually where the rejections are based on a combination of references. See MPEP § 2145. Answer (C) is not a correct answer. An affirmation that the affiant has never seen the invention before is not relevant to the issue of nonobviousness of the claimed subject matter. See MPEP 716. Answer (D) is not a correct answer. Invention must be proved prior to the effective filing date of Smith, which is April 10, 2001. See MPEP § 715. Answer (E) is not a correct answer. A terminal disclaimer and affidavit or declaration under 37 CFR § 1.130 are not proper because the Potter application and the Smith reference are not claiming the same patentable invention. See MPEP § 706.02(k).

April 15, 2003 AM

15. ANSWER: (C) is the most correct answer. See MPEP § 706.07(b). (A) is incorrect because a final rejection is not proper on a second action if it includes a rejection on newly cited art other than information submitted in an information disclosure statement under 37 CFR 1.97(c). MPEP § 706.07(a). (B) is incorrect because it is improper to make final a first Office action in a continuation-in-part application where any claim includes subject matter not present in the parent application. MPEP § 706.07(b). (D) is incorrect because it is improper to make final a first Office action in a substitute application where that application contains material, which was presented in the earlier application after final rejection, or closing of prosecution but was denied entry because the issue of new matter was raised. MPEP § 706.07(b). (E) is incorrect because (C) is correct.

April 15, 2003 AM

19. ANSWER: (B) is the most correct answer. 37 CFR § 1.133; MPEP § 713.02. As stated in MPEP § 713.02, “[a] request for an interview prior to the first Office action is ordinarily granted in continuing or substitute applications. A request for an interview in all other applications before the first action is untimely and will not be acknowledged if written, or granted if oral. 37 CFR 1.133(a).” (A) is incorrect because interview will not be permitted off Office premises without the authority of the Commissioner. 37 CFR § 1.133(a)(1). (C) is incorrect because an interview for the discussion of the patentability of a pending application will not occur before the first Office action, unless the application is a continuing or substitute application. 37 CFR § 1.133(a)(2). (D) is incorrect because (A) and (C) are incorrect. (E) is incorrect because (B) is correct.

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27. ANSWER (B) is the most correct answer. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947) (holding that the “lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon” is not relevant to an affidavit or declaration under 37 CFR § 1.131(b)); MPEP § 715.07(a). (A) is incorrect. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm’r Pat. 1889); MPEP § 715.07(a). Applicant must show evidence of facts establishing diligence. (C) is incorrect. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958) (after conception has been clearly established, diligence must be considered prior to the effective date is clearly established, since diligence then comes into question); MPEP § 715.07(a). (D) is incorrect. MPEP § 715.07(c). 37 CFR § 1.131(a) provides for the establishment of a date of completion of the invention in a NAFTA or WTO member country, as well as in the United States, an applicant can establish a date of completion in a NAFTA member country on or after December 8, 1993, the effective date of section 331 of Public Law 103 - 182, the North American Free Trade Agreement Act, and can establish a date of completion in a WTO member country other than a NAFTA member country on or after January 1, 1996, the effective date of section 531 of Public Law 103 - 465, the Uruguay Round Agreements Act. Not all countries are members of NAFTA or WTO, and prior invention in a foreign country cannot be shown without regard for when the reduction to practice occurred. (E) is incorrect. MPEP § 715.07. Actual reduction to practice generally, but not always, requires a showing that the apparatus actually existed and worked, “There are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice.” *In re Asahi/America Inc.*, 68 F.3d 442, 37 USPQ2d 1204 (Fed. Cir.

1995) (citing *Newkirk v. Lulegian*, 825 F.2d 1581, 3USPQ2d 1793 (Fed. Cir. 1987) and *Sachs v. Wadsworth*, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931). The claimed restraint coupling held to be so simple a device that mere construction of it was sufficient to constitute reduction to practice. Photographs, coupled with articles and a technical report describing the coupling in detail were sufficient to show reduction to practice.).

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

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42. ANSWER: (E) is the most correct answer. See MPEP § 706.02(b), under the heading “Overcoming A 35 U.S.C. § 102 Rejection Based On A Printed Publication Or Patent.” (A), (B), and (C) alone, as well as (D) are not correct because they are not the most inclusive.

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48. ANSWER: (D) is the most correct answer. Gross sales figures must be measured against a logical standard in order to determine whether or not there is commercial success. The recitations of accompanying evidence in (A), (B), and (C) are logical in that they provide a comparative basis for determining commercial success. (D), on the other hand, recites accompanying evidence which is illogical in that it does not provide a comparative basis for determining commercial success. (E) is wrong because it provides a logical basis for attributing commercial success to the design of the device, rather than the utilitarian function of the device. MPEP § 716.03(b).

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4. ANSWER: (C) is the most correct answer. As stated in MPEP § 709, under the heading “Request By The Applicant,” subheading “Request for Suspension Under 37 CFR 1.103(b) or (c),” “The Office will not grant the requested suspension of action unless the following requirements are met: (A) the request must be filed with the filing of a CPA or an RCE...(1) if the request is filed with an RCE, the RCE must be in compliance with 37 CFR 1.114, i.e., the RCE must be accompanied by a submission and the fee set forth in 37 CFR 1.17(e). Note that the payment of the RCE filing fee may not be deferred and the request for suspension

cannot substitute for the submission.” The RCE was improper because no submission in reply to the outstanding Office action accompanied the RCE. Since the RCE was improper, the Office will not recognize the request for suspension. The time period set in the final rejection continues to run from the mail date of the Office action. Since the Office action did not set a period for reply, applicant has a maximum period of six months for reply. A reply was due on February 8, 2003. Since the RCE was improper and the Office did not recognize the request for suspension, the application became abandoned at Midnight of February 8, 2003. (A), (B) and (E) are not correct. As stated in MPEP § 706.07(h), under the heading “Submission Requirement,” “If a reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of 37 CFR 1.111. See 37 CFR 1.114(c).” An RCE that is not accompanied by a submission is an improper RCE. As stated in MPEP § 706.07(h), under the heading “Initial Processing,” subheading “Treatment of Improper RCE,” “An improper RCE will **not** operate to toll the running of any time period set in the previous Office action for reply to avoid abandonment of the application.” The period for filing a proper reply was six months inasmuch as no shortened statutory period for reply was set. A proper reply to the final rejection was not filed. Therefore, the application went abandoned for failure to file a proper reply to the final rejection. (D) is not correct. As set forth in MPEP § 706.07(f) under the heading “Examiner’s Amendments,” paragraph (H), “[a]n examiner’s amendment may not be made more than 6 months from the date of the final Office action, as the application would be abandoned at that point by operation of law.”

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5. ANSWER: (A) is the most correct answer. See MPEP § 706.02(b), under the heading “Overcoming a 35 U.S.C. § 102 Rejection Based on a Printed Publication or Patent.” (B), and (C) are incorrect because they present showings that support the rejection. See MPEP § 706.02(b), *supra*. (D) are not correct because to perfect priority under 35 U.S.C. §§ 119(e) or 120 it is, *inter alia*, necessary to amend the specification of the application to contain a specific reference to a prior application having a filing date prior to the reference. See MPEP § 706.02(b), *supra*. Furthermore, the declaration is not to be amended. (E) is incorrect because (B), (C) and (D) are incorrect.

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10. ANSWER: (B) is the most correct answer. MPEP § 706.01. (A) and (C) are incorrect. As stated by MPEP § 706.01, “The practical difference between a rejection and an objection is that a rejection, involving the merits of the claim, is subject to review by the Board of Patent Appeals and Interferences, while an objection, if persisted, may be reviewed only by way of petition to the Commissioner.” (D) is incorrect. MPEP § 706.03(d). (E) is incorrect. As stated in MPEP § 706.01, “If the form of the claim (as distinguished from its substance) is improper, an “objection” is made. An example of a matter of form as to which objection is made is dependency of a claim on a rejected claim, if the dependent claim is otherwise allowable. See MPEP § 608.01(n).”

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11. ANSWER: (E) is the most correct answer. See MPEP §§ 306 and 307. MPEP § 306 states, “In the case of a division or continuation application, a prior assignment recorded against the original application is applied to the division or continuation application because the assignment recorded against the original application gives the assignee rights to the subject matter common to both applications.” MPEP § 307 states, “Irrespective of whether the assignee participates in the prosecution of the application, the patent issues to the assignee if so indicated on the Issue Fee Transmittal form PTOL-85B. Unless an assignee’s name and address are identified in item 3 of the Issue Fee Transmittal form PTOL-85B, the patent will issue to the applicant. Assignment data printed on the patent will be based solely on the information so supplied.” A new assignment document need not be recorded for a divisional or continuation application where the assignment recorded in the parent application remains the same. Accordingly, answers (A), (B) and (D) are incorrect. In addition, (A), (B) and (D) are incorrect because unless an assignee’s name and address are identified in item 3 of PTOL-85B, the patent will issued to the application and the assignee information, even if recorded, will not appear on the patent. (C) is incorrect for the same reason. (B) is also incorrect. There is no connection between the filing receipt, PAIR or the patent application publication and the recorded assignment. Assignment data is reflected on the filing receipt, PAIR, or a patent application publication when applicant includes assignment information for purposes of publication of the application on the transmittal letter. Assignment data printed on the patent will be based solely on the information supplied on the Issue Fee Transmittal Form PTOL-85B. See MPEP §§ 1309 and 1481. Accordingly, answer (E) is correct and answer (C) is incorrect.

April 15, 2003 PM

17. ANSWER: (A) is the correct answer. See 35 U.S.C. § 102 (d), and MPEP § 706.02(c). (A) is correct because the foreign patent establishes a bar under 35 U.S.C. §102(d). MPEP § 706.02(e). (B) is incorrect because the invention is not described in a printed publication more than one year prior to the date of the U.S. application. 35 U.S.C. § 102(b). (C) is incorrect because the invention is not in public use more than one year prior to the date of the U.S. application. MPEP § 2133. (D) is incorrect because the sale is not in the United States. 35 U.S.C. § 102(b); MPEP §§ 706.02(c) and 2133.03(d). (E) is incorrect because (A) is correct.

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20. ANSWER: (B) is the most correct answer. See MPEP § 713.01. An interview should be had only when the nature of the case is such that the interview could serve to develop and clarify specific issues and lead to a mutual understanding between the examiner and the applicant, and thereby advance the prosecution of the application. (A) is incorrect. 37 CFR § 1.133(a)(2); MPEP § 713.02. Section 713.02 states that although “[a] request for an interview prior to the first Office action is ordinarily granted in continuing or substitute applications[,] [a] request for an interview in all other applications before the first action is untimely and will not be acknowledged if written, or granted if oral. 37 CFR 1.133(a).” (C) is incorrect. MPEP § 713.03. Larry is only sounding out the examiner and has no authority to commit Joe to any agreement reached with the examiner. (D) is incorrect. MPEP § 713.09. Jane has no right to an interview following the final rejection. Although such an

interview may be granted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration, interviews merely to restate arguments of record or to discuss new limitations which would require more than nominal reconsideration or new search should be denied. (E) is incorrect because D is incorrect.

April 15, 2003 PM

21. ANSWER: (B) is the most correct answer. See MPEP § 708.02, under the heading “IV. Applicant’s Age.” (A) is wrong because MPEP § 708.02, under the heading “IV. Applicant’s Age, states, “[a]n application may be made special upon filing a petition including any evidence showing that the applicant is 65 years of age, or more, such as a birth certificate or applicant’s statement. No fee is required with such a petition.” (C), (D), and (E) are wrong because a fee is required with respect to each petition. MPEP § 708.02, under the headings “II. Infringement,” “VII. Inventions Relating To Recombinant DNA,” and “X. Inventions Relating To HIV/AIDS and Cancer,” respectively.

April 15, 2003 PM

22. ANSWER: (D) is the most correct answer. See 35 USC §§ 102(e) and 103(c); MPEP § 706.02(l)(1). The prior art exception in 35 U.S.C. § 103(c) only applies to references that are only prior art under 35 U.S.C. § 102(e), (f), or (g), and that are applied in a rejection under 35 U.S.C. § 103(a). In this situation, the Smith reference was applied in a rejection under 35 U.S.C. § 102(e) and not under 35 U.S.C. § 103(a). See MPEP § 706.02(l)(1). Therefore, the reply in answer (D) would not overcome the rejection. Answer (A) is a proper reply in that it addresses the examiner’s rejection by specifically pointing out why the examiner failed to make a *prima facie* showing. See MPEP § 706.02(b). (B) is incorrect inasmuch as it is a proper reply. See MPEP § 706.02(b). Answer (C) is incorrect inasmuch as it is a proper reply. See MPEP 706.02(b). Answer (E) is not a correct answer because answers (A), (B) and (C) all are replies that are in accordance with the USPTO rules and procedures set forth in the MPEP.

April 15, 2003 PM

26. ANSWER: (A) is the most correct answer. MPEP § 715.07, under the heading “Facts and Documentary Evidence” states that “The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. ... The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country (MPEP § 715.07(c)) at least the conception being at a date prior to the effective date of the reference. ... In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose.” Here, the co-inventors admit, and the documentary exhibits relied upon demonstrate that they failed to reduce the claimed invention to practice prior to the publication date of the Bell and Watson reference. It is also apparent that due to the lack of an antenna in the cell phone described in Smith’s and Jones’s declarations and journal article, that the cell phone which was reduced to practice prior to the publication date of the Bell and Watson article would not have worked for its intended purpose. Accordingly, the examiner should maintain the rejection and make it final.

(B) and (C) are incorrect choices since the evidence of record shows that Smith and Jones are unable to overcome the prior art. (D) is wrong because an original copy of the published figure which shows that Smith and Jones were not in possession of the claimed invention prior to Bell and Watson publication cannot help their case. (E) is incorrect because prior art under 102(a) is not a statutory bar.

April 15, 2003 PM

47. ANSWER: (B) is the most correct answer, and (A) and (C) are wrong. MPEP § 715.05 states “[i]f the patent is claiming the same invention as the application and its issue date is one year or more prior to the presentation of claims to that invention in the application, a rejection of the claims of the application under 35 U.S.C. § 135(b) should be made. See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632, 1635 (Fed.Cir. 1997) (holding that application of 35 U.S.C. § 135(b) is not limited to *inter partes* interference proceedings, but may be used as a basis for *ex parte* rejections.)”. (D) is wrong. See MPEP § 2307 (“The fact that the application claim may be broad enough to cover the patent claim is not sufficient. *In re Frey*, 182 F.2d 184, 86 USPQ 99 (CCPA 1950)”). (E) is also wrong. See MPEP § 2307 (“If the claim presented or identified as corresponding to the proposed count was added to the application by an amendment filed more than one year after issuance of the patent...then under the provisions of 35 U.S.C. § 135(b), an interference will not be declared unless at least one of the claims which were in the application...prior to expiration of the one-year period was for ‘substantially the same subject matter’ as at least one of the claims of the patent.”).

October 16, 2002 AM

5. ANSWER: (C) is most correct. 37 C.F.R. § 1.181; MPEP § 706.07(c). (A) and (B) are wrong. 37 C.F.R. § 1.181(a)(1); MPEP § 706.07(c). Prematureness of a final rejection is not appealable. 37 C.F.R. § 1.191(a). (D) and (E) are wrong because MPEP § 706.07(c) states, “Any question as to prematureness of a final rejection should be raised, if at all, while the application is still pending before the primary examiner.” MPEP § 1210 indicates that jurisdiction is before the Board at the times set forth in (D) and (E).

October 16, 2002 AM

6. ANSWER: (E) is the correct answer. MPEP § 715. (A) is incorrect because an affidavit under 37 C.F.R. § 1.131 is not appropriate where the reference is a prior U.S. patent to the same entity, claiming the same invention. MPEP § 715. (B) and (D) are each incorrect because an affidavit under 37 C.F.R. § 1.131 is not appropriate where the reference is a statutory bar under 35 U.S.C. § 102(d) as in (B) or a statutory bar under 35 U.S.C. § 102(b) as in (D). MPEP § 715. (C) is incorrect because an affidavit under 37 C.F.R. § 1.131 is not appropriate where applicant has clearly admitted on the record that subject matter relied on in the reference is prior art. MPEP § 715.

October 16, 2002 AM

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

October 16, 2002 AM

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

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17. ANSWER: (C) is correct. MPEP § 707.05(f) states, "In the use of [declassified material] ... as an anticipatory publication, the date of release following declassification is the effective date of publication within the meaning of the statute." (A) is wrong. MPEP § 706.02(a) states, "A magazine is effective as a printed publication under 35 U.S.C. § 102(b) as of the date it reached the addressee and not the date it was placed in the mail." (B) is wrong. MPEP § 707.05(f) states, "For the purpose of anticipation predicated upon prior knowledge under 35 U.S.C. §102(a) the above noted declassified material may be taken as *prima facie* evidence of such prior knowledge as of its printing date even though such material was classified at that time." (D) and (E) are wrong. The AIPA amended 35 U.S.C. § 102(e) to provide that U.S. patents, U.S. application publications, and certain international application publications can be used as prior art under 35 U.S.C. § 102(e) based on their earliest effective filing date against applications filed on or after November 29, 2000, and applications filed prior to November 29, 2000 which have been voluntarily published. MPEP § 706.02(a).

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18. ANSWER: (E) is the most correct answer. Thomas may rely on activities in both Germany (a WTO member country) and Canada (a NAFTA country) in establishing a date of invention prior to publication of the Saskatoon Times article or in establishing priority. 35 U.S.C. § 104; see also MPEP 715.01(c).

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33. ANSWER: (C) is correct and (B) is wrong because MPEP § 706.07(f), part (H), states, "Where a complete first reply to a final Office action has been filed within 2 months of the

final Office action, an examiner's amendment to place the application in condition for allowance may be made without the payment of extension fees even if the examiner's amendment is made more than 3 months from the date of the final Office action." (A), (D) and (E) are wrong because MPEP § 706.07(f), part (H), states, "Note that an examiner's amendment may not be made more than 6 months from the date of the final Office action, as the application would be abandoned at that point by operation of law." In (A), when an examiner's amendment is mailed exactly 5 months after Xavier's reply, the examiner's amendment would be made more than 6 months after the Office action.

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38. ANSWER: (D) is the most correct answer. A reference is a "printed publication" if one of ordinary skill in the art can locate it with reasonable diligence. Its availability as prior art under § 102(b) depends upon proof of when the reference was "published" or became publicly accessible. Here, (D) is the correct answer because the Japanese patent application was published, *i.e.*, "laid open," more than 1 year before applicant's filing date. (C) is incorrect because it was posted or published less than one year after applicant's filing date. (B) is incorrect because (1) the database retrieval date is after applicant's filing date, (2) the printout does not include the date on which the MEDLINE abstract was publicly posted and (3) reliance is on the printout per se not the actual article (reliance on the actual article would require getting the article and an English translation as well as determining the date when the journal was publicly available). (A) is incorrect because there is no evidence when the journal was publicly available. The examiner was unable to determine the actual date of publication. (E) is incorrect because (A), (B) and (C) are incorrect

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42. ANSWER: (A) is correct. MPEP § 706.07(f), paragraph (I). (B) is wrong. MPEP § 706.07(f), paragraph (M). (C) is wrong. MPEP § 706.07(f), paragraph (N). (D) is wrong. MPEP § 706.07(f), paragraph (H). (F) is wrong. MPEP § 706.07(f), paragraph (O).

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44. ANSWER: (D). 37 C.F.R. § 1.116; MPEP § 714.13, Entry Not Matter of Right [p. 700-118]. The reply in (D) is directed to a reply permitted to be made under 37 C.F.R. § 1.116(a). (A), (B), and (C) are directed to the merits of the application, and are not in accord with 37 C.F.R. § 1.116(a).

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2. ANSWER: (B) is the most correct answer. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947) (holding that the "lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon" is not relevant to an affidavit or declaration under 37 C.F.R. § 1.131(b)); MPEP § 715.07(a). (A) is incorrect. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889); MPEP § 715.07(a). Applicant must show evidence of facts establishing diligence. (C) is incorrect. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958) (after conception has been clearly established, diligence must be considered prior to the effective date is clearly established, since diligence then comes into question); MPEP § 715.07(a). (D) is incorrect. MPEP § 715.07(c). 37 C.F.R. § 1.131(a) provides for the establishment of a date of completion of the invention in a NAFTA or WTO

member country, as well as in the United States, an applicant can establish a date of completion in a NAFTA member country on or after December 8, 1993, the effective date of section 331 of Public Law 103 - 182, the North American Free Trade Agreement Act, and can establish a date of completion in a WTO member country other than a NAFTA member country on or after January 1, 1996, the effective date of section 531 of Public Law 103 - 465, the Uruguay Round Agreements Act. Not all countries are members of NAFTA or WTO, and prior invention in a foreign country cannot be shown without regard for when the reduction to practice occurred. (E) is incorrect. MPEP § 715.07. Actual reduction to practice generally, but not always, requires a showing that the apparatus actually existed and worked, “There are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice.” *In re Asahi/America Inc.*, 68 F.3d 442, 37 USPQ2d 1204 (Fed. Cir. 1995) (citing *Newkirk v. Lulegian*, 825 F.2d 1581, 3USPQ2d 1793 (Fed. Cir. 1987) and *Sachs v. Wadsworth*, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931). The claimed restraint coupling held to be so simple a device that mere construction of it was sufficient to constitute reduction to practice. Photographs, coupled with articles and a technical report describing the coupling in detail were sufficient to show reduction to practice.).

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

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10. ANSWER: (B). MPEP § 706.01. (A) and (C) are incorrect. As stated by MPEP § 706.01, “The practical difference between a rejection and an objection is that a rejection, involving the merits of the claim, is subject to review by the Board of Patent Appeals and Interferences, while an objection, if persisted, may be reviewed only by way of petition to the Commissioner.” (D) is incorrect. MPEP § 706.03(d). (E) is incorrect. As stated in MPEP § 706.01, “If the form of the claim (as distinguished from its substance) is improper, an “objection” is made. An example of a matter of form as to which objection is made is dependency of a claim on a rejected claim, if the dependent claim is otherwise allowable. See MPEP § § 608.01(n).”

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

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13. ANSWER: (A). MPEP 605.04(a) provides that non-initialed or non-dated alterations are not in accord with 37 C.F.R. § 1.52(c). As to (C) see MPEP § 605.04, which states that the Office will not consider whether noninitialed and/or nondated alterations were made before or after the signing of the oath or declaration but will require a new oath or declaration. As to (C), MPEP § 605.04(a) provides that non-initialed or non-dated alterations are not in accord with 37 C.F.R. § 1.52(c). As to (D), see MPEP § 605.04(a). As to (E), according to MPEP § 605.04(a), it is improper for an applicant to sign an oath or declaration which is not attached to or does not identify the patent application.

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14. ANSWER: (D) is correct. (A), (B) and (C) are wrong because MPEP § 601.01(c) states, “Claiming priority is less expensive [than conversion] and will result in a longer patent term.” Conversion requires payment of the conversion fee. (D) is correct because MPEP § 601.01(c) states, “In addition, if the provisional application was not filed with an executed oath or declaration and the filing fee for a non-provisional application, the surcharge set forth in 37 C.F.R. § 1.16(e) is required. (E) is wrong because the action taken claims priority under 35 U.S.C. § 119(e)(1) rather than conversion under 37C.F.R. § 1.53(c)(3). No surcharge is required.

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17. 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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25. ANSWER: The most correct answer is (D). See MPEP § 706.07(h), page 700-71, under “IV. IMPROPER CPA TREATED AS RCE.” The request for a second CPA filed on December 28, 2001 is improper because the application in which the CPA was filed in has a filing date of December 29, 2000 and is not eligible for the CPA practice. The CPA practice does not apply to applications that have a filing date on or after May 29, 2000. The Office will automatically treat the improper request for a CPA as a Request for Continued Examination under 37 C.F.R. § 1.114. However, the request for a CPA filed on December 28, 2001 does not satisfy the requirements of 37 C.F.R. § 1.114 to be a proper RCE because it lacks the filing fee required by 37 C.F.R. § 1.17, and the required submission under 37 C.F.R. § 1.114. Therefore, the improper CPA will be treated as an improper RCE and the time period set in the last Office action mailed on June 28, 2001 will continue to run. Since the time period expired on December 28, 2001, the application is abandoned. Answers (A),

(B), and (C) are incorrect because the request for a second CPA filed on December 28, 2001 is improper and the amendment was not entered. Answer (E) is incorrect because a request for a suspension of action will not be granted if the CPA or the RCE is improper (*e.g.*, a filing date was not accorded in the CPA or the RCE was filed without a submission). See 37 C.F.R. § 1.103, MPEP § 709, page 700-113.

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27. ANSWER: (C) is correct 35 U.S.C. § 102(e); MPEP § 804, Chart III-A. (C) is correct because section I. of MPEP § 706.02(f) states, “If (1)...the applications are commonly assigned and (2) the effective filing dates are different, then a provisional rejection of the later filed application should be made.” (A) is wrong because the facts do not indicate prior knowledge or use by others, or that the application Y is patented or published. (B) is wrong because the facts do not indicate that the application Y is patented or published, or the existence of “public use” or “on sale” bars. (D) is wrong. This is a statutory double patenting situation that cannot be avoided by filing a terminal disclaimer. See *In re Bartfeld*, 17 USPQ2d 1885 (Fed. Cir. 1991). MPEP § 706.02(f), section I; MPEP § 804.02, part I. (E) is wrong. It is improper to make a nonprovisional rejection under § 102(e) in the circumstances described in the question. Choice (E) provides for an improper nonprovisional rejection under § 102(e). MPEP § 804, Chart I-A.

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

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

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33. ANSWER: (D) is correct. (A), (C), and (E) are wrong because MPEP § 706.07(f), paragraph (I), states, “Where a complete first reply to a final Office action has not been filed within 2 months of the final Office action, applicant’s authorization to make an amendment to place the application in condition for allowance must be made either within the 3 month shortened statutory period or within an extended period for reply that has been petitioned and paid for by applicant pursuant to 37 C.F.R. § 1.136(a).” (B) is wrong because MPEP §

706.07(f), paragraph (H), states, “Note that an examiner’s amendment may not be made more than 6 months from the date of the final Office action, as the application would be abandoned at that point by operation of law.”

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

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42. ANSWER: (D) is the most correct answer because mere attorney argument, unsupported by factual evidence, is insufficient to establish unexpected results. *See In re Geisler*, 116 F.3d 1465, 1470-71, 43 USPQ2d 1362, 1365-66 (Fed. Cir. 1997). (A) is not the proper choice because such a comparison is required. *See In re Baxter Travenol Labs.*, 952 F.2d 388, 392, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991); *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984), and MPEP § 716.02(e). (B) is not the proper choice because evidence relied upon for overcoming a *prima facie* case of obviousness must be commensurate in scope with the claims. *See In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983); *In re Clemens*, 622 F.2d 1029, 1035, 206 USPQ 289, 296 (CCPA 1980), and MPEP § 716.03(a). (C) is not the proper choice because the unobviousness of a broader range recited in a claim can be proven by a narrower range of data provided that one of ordinary skill in the art could ascertain a trend in the data which would allow that person to reasonably extend the probative value of the data to the broader range. *See In re Kollman*, 595 F.2d 48, 56, 201 USPQ 193, 199 (CCPA 1979), and MPEP § 717.02(d). (E) is not the proper choice because the relied-upon evidence can be in the specification. *See In re Soni*, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

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49. ANSWER: (A) is the correct answer. 35 U.S.C. § 102 (d), and MPEP § 706.02(c). (A) is correct because the foreign patent establishes a bar under 35 U.S.C. § 102 (d). MPEP § 706.02 (e). (B) is incorrect because the invention is not described in a printed publication more than one year prior to the date of the U.S. application. 35 U.S.C. § 102(b). (C) is incorrect because the invention is not in public use more than one year prior to the date of the U.S. application. MPEP § 2133. (D) is incorrect because the sale is not in the United States. 35 U.S.C. § 102(b); MPEP §§ 706.02(c) and 2133.03(d). (E) is incorrect because (A) is correct.

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

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

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

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

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

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

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

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37. ANSWER: (A) is the most correct answer, while (D) is not the most correct answer. See MPEP § 715.05, which, in pertinent part, states: When the reference in question is a noncommonly owned U.S. patent claiming the same invention as applicant and its issue date is less than 1 year prior to the presentation of claims to that invention in the application being examined, applicant's remedy, if any, must be by way of 37 C.F.R. § 1.608 instead of 37 C.F.R. § 1.131... . The reference patent can then be overcome only by way of interference. (B) and (C) are not the most correct answers. See MPEP § 715.05, which, in pertinent part, states: If the patent is claiming the same invention as the application and its issue date is 1

year or more prior to the presentation of claims to that invention in the application, a rejection of the claims of the application under 35 U.S.C. § 135(b) should be made. See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632, 1635 (Fed.Cir. 1997) (The court holding that application of 35 U.S.C. § 135(b) is not limited to inter partes interference proceedings, but may be used as a basis for ex parte rejections.). (E) is a wrong answer because an affidavit or declaration traversing a ground of rejection may be received only where the reference “substantially shows or describes but does not claim the same patentable invention.” 37 C.F.R. § 1.132.

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41. ANSWER: Answer (A) is the best answer because it is an incorrect statement. See 37 C.F.R. § 1.131, which reads in relevant part: (a)(2) A date of completion of the invention may not be established under this section before December 8, 1993, in a NAFTA country, or before January 1, 1996, in a WTO member country other than a NAFTA country. (D) is correct statement. MPEP § 715.07. (B), (C) and (E) are also correct. 37 C.F.R. § 1.131. 35 U.S.C. § 104 (see history).

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

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

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

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4. ANSWER: (B) is the most correct answer. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947) (holding that the “lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon” is not relevant to an affidavit or

declaration under 37 C.F.R. § 1.131(b)); MPEP § 715.07(a). (A) is incorrect. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889); MPEP § 715.07(a). Applicant must show evidence of facts establishing diligence. (C) is incorrect. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958) (after conception has been clearly established, diligence must be considered prior to the effective date is clearly established, since diligence then comes into question); MPEP § 715.07(a). (D) is incorrect. MPEP § 715.07(c). 37 C.F.R. § 1.131(a) provides for the establishment of a date of completion of the invention in a NAFTA or WTO member country, as well as in the United States, an applicant can establish a date of completion in a NAFTA member country on or after December 8, 1993, the effective date of section 331 of Public Law 103 -182, the North American Free Trade Agreement Act, and can establish a date of completion in a WTO member country other than a NAFTA member country on or after January 1, 1996, the effective date of section 531 of Public Law 103 -465, the Uruguay Round Agreements Act. Not all countries are members of NAFTA or WTO, and prior invention in a foreign country cannot be shown without regard for when the reduction to practice occurred. (E) is incorrect. MPEP § 715.07. Actual reduction to practice generally, but not always, requires a showing that the apparatus actually existed and worked, "There are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice." *In re Asahi/America Inc.*, 68 F.3d 442, 37 USPQ2d 1204 (Fed. Cir. 1995) (citing *Newkirk v. Lulegian*, 825 F.2d 1581, 3USPQ2d 1793 (Fed. Cir. 1987) and *Sachs v. Wadsworth*, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931). The claimed restraint coupling held to be so simple a device that mere construction of it was sufficient to constitute reduction to practice. Photographs, coupled with articles and a technical report describing the coupling in detail were sufficient to show reduction to practice.).

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6. ANSWER: (C) is the most correct answer. MPEP § 715.04 pages 700-207 and 208 (8th ed.), under the heading "WHO MAY MAKE AFFIDAVIT OR DECLARATION" states "[t]he following parties may make an affidavit or declaration under 37 C.F.R. [§] 1.131: ... (B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection." In addition, 37 C.F.R. § 1.131(a) states "... the inventor of the subject matter of the rejected claim ... or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration..." Accordingly, answer (A) is incorrect because a declaration with less than all named inventors is acceptable when it is shown that less than all named inventors of an application invented the subject matter of the claim under rejection. Answer (B) is incorrect because the declaration was properly signed. Answer (D) is incorrect because 37 C.F.R. § 1.131(a) expressly provides for who must sign the declaration. Answer (E) is incorrect because it is the inventor of the subject matter of the claim under rejection who must sign the declaration, not any inventor named on the application.

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13. ANSWER: (E) is the correct answer. 37 C.F.R. § 1.115(b)(1). As stated in 65 FR at 54636, middle and right columns, “Factors that will be considered in disapproving a preliminary amendment include: the state of preparation of a first Office action as of the date of receipt (§1.6, which does not include § 1.8 certificate of mailing dates) of the preliminary amendment by the Office...” Thus, choices (C) and (D) are incorrect.

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

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

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25. ANSWER: (A) is the most correct answer. 37 C.F.R. § 1.114(a) and (d). The filing of a request for continued examination, including a submission, after the filing of a Notice of Appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal is considered a request to withdraw the appeal and reopen prosecution of the application before the examiner. The submission may be an amendment to the written description. 37 C.F.R. § 1.114(c). See, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50095, left column, third complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (B) is not the most

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

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

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

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

jurisdiction of the USPTO. 35 U.S.C. § 102(f). (D) is incorrect inasmuch as (C) is incorrect. (E) is incorrect inasmuch as (A) is correct.

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34. ANSWER: (B). See 37 C.F.R. § 1.114(e)(1). Answer (A) is wrong because the issue fee has been paid and ?§ 1.114(a)(1) prohibits an RCE unless a petition under § 1.313 is granted. Answer (C) is wrong for the same reason and further if the application had been abandoned an RCE could not be filed. Answer (D) is wrong because RCE practice does not apply to provisional applications under 37 C.F.R. §?

1.114(e)(5). (E) is wrong because, as explained in (B), after the issue fee is paid, you cannot file an RCE unless you have successfully withdrawn the case from issue by petition under 37 C.F.R. § 1.313.

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

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9. ANSWER: (B) is the most correct answer, and (A) and (C) are wrong. MPEP § 715.05 (“If the patent is claiming the same invention as the application and its issue date is one year or more prior to the presentation of claims to that invention in the application, a rejection of the claims of the application under 35 U.S.C. § 135(b) should be made. See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632, 1635 (Fed.Cir. 1997) (holding that application of 35 U.S.C. § 135(b) is not limited to *inter partes* interference proceedings, but may be used as a basis for ex parte rejections.”). (D) is wrong. See MPEP § 2307 (“The fact that the application claim may be broad enough to cover the patent claim is not sufficient. *In re Frey*, 182 F.2d 184, 86 USPQ 99 (CCPA 1950)”). (E) is also wrong. See MPEP § 2307 (“If the claim presented or identified as corresponding to the proposed count was added to the application by an amendment filed more than one year after issuance of the patent...then under the provisions of 35 U.S.C. § 135(b), an interference will not be declared unless at least one of the claims which were in the application...prior to expiration of the one-year period was for ‘substantially the same subject matter’ as at least one of the claims of the patent.”).

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11. ANSWER: (C) is the correct answer. MPEP § 706.07(b). (A) is incorrect because a final rejection is not proper on a second action if it includes a rejection on newly cited art other than information submitted in an information disclosure statement under 37 CFR 1.97(c). MPEP § 706.07(a). (B) is incorrect because it is improper to make final a first Office action in a continuation-in-part application where any claim includes subject matter not present in the parent application. MPEP § 706.07(b). (D) is incorrect because it is improper to make final a first Office action in a substitute application where that application contains material, which was presented in the earlier application after final rejection, or closing of prosecution

but was denied entry because the issue of new matter was raised. MPEP § 706.07(b). (E) is incorrect because (C) is correct.

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

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23. ANSWER: (A) is the correct answer. 35 U.S.C. § 102 (d), and MPEP § 706.02(c). (A) is correct because the foreign patent establishes a bar under 35 U.S.C. §102 (d). MPEP § 706.02 (e). (B) is incorrect because the invention is not described in a printed publication more than one year prior to the date of the U.S. application. 35 U.S.C. § 102(b). (C) is incorrect because the invention is not in public use more than one year prior to the date of the U.S. application. MPEP § 2133. (D) is incorrect because the sale is not in the United States. 35 U.S.C. § 102(b); MPEP §§ 706.02(c) and 2133.03(d). (E) is incorrect because (A) is correct.

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26. All answers accepted.

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36. ANSWER: The most correct answer is (C). The one-month extension of time filed February 23, 2001 properly extended the deadline for reply to Friday, March 23, 2001. When a timely reply is ultimately not filed, the application is regarded as abandoned after midnight of the date the period for reply expired, *i.e.*, the application was abandoned at 12:01 AM on Saturday, March 24, 2001. The fact that March 24 was a Saturday does not change the abandonment day because the reply was due on March 23, a business day. MPEP § 710.01(a).

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39. ANSWER: The most correct answer is (C). The petition for extension of time filed June 18, 2001 provided applicant with a one-month extension of time from the original due date, June 16, 2001 (not from the date the petition was filed). See MPEP § 710.01(a). Thus, the extended due date was Monday, July 16. Since an additional extension of time is needed, (B) is incorrect. Under the provisions of 37 CFR 1.136(a)(3), applicant’s statement is treated as a constructive petition for extension of time. MPEP § 710.02(e). (A) is incorrect because applicant’s statement in the Remarks portion of the Amendment acted as a constructive petition for extension of time and, therefore, the Amendment is timely. There is no need for the petition to appear in a separate paper, so (D) is not correct. (E) is incorrect because (A) and (D) are both incorrect.

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41. ANSWER: (E) is the correct answer. 37 CFR 1.114 (effective August 16, 2000); “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 FR 50092, 50097 (August 16, 2000); MPEP § 706.07(h), paragraph

I (pg. 700-69) (8th Ed.). (A) is a final action (37 CFR 1.113). 65 FR 50097, column 1, states in pertinent part, "...an action that otherwise closes prosecution in the application (e.g., an Office action under *Ex Parte Quayle*, 1935 Comm'r Dec. 11 (1935))." Thus (A), (B), (C) and (D) are individually correct, and (E), being the most inclusive, is the most correct answer.

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

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47. ANSWER: (A) is the correct answer. 37 CFR 1.105(a)(3). 37 CFR 1.105, effective date November 7, 2000, "Changes To Implement the Patent Business Goals; Final Rule," September 8, 2000, 65 FR 54604, 54634; MPEP § 704.12(b) (pg. 700-10) (8th Ed.). (B) is incorrect because the requirement for information may be included in an Office action, or sent separately. 37 CFR 1.105(b). (C) is incorrect because 37 CFR 1.56(c) includes each attorney or agent who prepares or prosecutes the application. 37 CFR 1.56(c)(2). (D) is incorrect because information used to draft a patent application may be required and there is no support for (D) in 37 CFR 1.105. (E) is incorrect because (A) is correct.

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48. ANSWER: The most correct answer is (D). MPEP § 710.02(e) at p. 700-77. (A) and (B) are not true because the amendment is treated as timely. (C) is incorrect because there is no authority for giving 30 days from the notification mailing date to request an extension time. 37 CFR 1.136; MPEP § 710.02(a). (E) is untrue because (D) is true.

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4. ANSWER: (B). Sydney is precluded from filing for a patent because of Charlie's recent public use in Wisconsin. A declaration or affidavit under 37 CFR 1.131 is not permissible since the use at the North Pole did not occur in a NAFTA or WTO country. Answer (A) is not correct as the knowledge did not occur in the United States and was not public knowledge. Answer (C) is not correct because of the reasoning stated in (B). Answer (D) is not correct since Charlie was not the inventor. Answer (E) is not correct since public use in the United States by a third party may establish a date for prior art purposes. 35 U.S.C. § 102(a).

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

When the reference in question is a noncommonly owned U.S. patent claiming the same invention as applicant and its issue date is less than 1 year prior to the presentation of claims

to that invention in the application being examined, applicant's remedy, if any, must be by way of 37 CFR 1.608 instead of 37 CFR 1.131.... The reference patent can then be overcome only by way of interference. (B) and (C) are not the most correct answers. See MPEP § 715.05, which, in pertinent part, states: If the patent is claiming the same invention as the application and its issue date is 1 year or more prior to the presentation of claims to that invention in the application, a rejection of the claims of the application under 35 U.S.C. 135(b) should be made. See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632, 1635 (Fed.Cir. 1997) (The court holding that application of 35 U.S.C. 135(b) is not limited to inter partes interference proceedings, but may be used as a basis for ex parte rejections.). (E) is a wrong answer because an affidavit or declaration traversing a ground of rejection may be received only where the reference "substantially shows or describes but does not claim the same patentable invention." 37 CFR 1.132.

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21. ANSWER: (E) is the correct answer. (A) is supported by 37 CFR 1.102. MPEP § 708.02(V). (B) is supported by 37 CFR 1.102. MPEP § 708.02(VIII). (C) is supported by 37 CFR 1.102. MPEP § 708.02(III). (D) is supported by 37 CFR 1.102. MPEP § 708.02(IV).

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23. ANSWER: The most correct answer is (B). MPEP § 713.05. Statements (A) and (C) are incorrect because Greene may participate in the interview if he possesses a copy of the application file and states he is authorized to represent the applicant. (D) is incorrect because a mere power to inspect is insufficient authority for an examiner to grant an interview involving the merits of an application. *Id.* (E) is therefore also incorrect.

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25. ANSWER: (E) 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 § 706.07(h) (8th Ed.). (A) and (B) are each incorrect because if prosecution in an application is closed, an applicant may request continued examination "prior to the earliest of: (1) Payment of the issue fee, unless a petition under 37 CFR 1.313 is granted; (2) Abandonment of the application; or ..." 37 CFR 1.114(a). (C) is incorrect because prosecution is not closed. 37 CFR 1.114(b). (D) is incorrect because the application is abandoned for failure to pay the issue fee. 37 CFR 1.316.

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26. ANSWER: (B) is the correct answer. 37 CFR 1.8, and 1.114, effective date August 16, 2000, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 FR 50092, 50096; MPEP § 706.07(h), paragraph I. (pg. 700-69) (8th Ed.). Prosecution in the application is closed because the last Office action is a final action. 37 CFR 1.114(b). In (B), the facts given indicate that the submission meets the reply requirements of 37 CFR 1.111. Thus, according to 37 CFR 1.114(d), the Office will withdraw the finality of the Office action and the submission in (B) will be entered and considered. 65 FR 50096, columns 2-3, state, "There are a number of additional differences between request for continued examination procedure set forth in this notice with the CPA

procedure set forth in §1.53(d) resulting from the fact that a CPA is the filing of a new application, whereas continued examination under §1.114 merely continues the examination of the same application...(4) a request for continued examination under §1.114 is entitled to the benefit of a certificate of mailing under § 1.8 (*cf.* 1.8(a)(2)(i)(A))....”; see also the comparison chart on pg. 700-78 to 700-81 of MPEP § 707.07(h) (8th Ed.). (A) is incorrect inasmuch as a continued prosecution application is not entitled to the benefit of a certificate of mailing under 37 CFR 1.8. 37 CFR 1.8(a)(2)(i)(A). Contrary to the desire to avoid abandonment of the application, filing an application filed under 37 CFR 1.53(d) would result in abandonment of the application inasmuch as the filing is a request to expressly abandon the prior application. 37 CFR 1.53(d)(2)(v). (C) is incorrect because the telephone call does not meet the reply requirements of 37 CFR 1.111. No reply under 37 CFR 1.114(d) to the Office action has been filed. All business must be conducted in writing. 37 CFR 1.2. (D) is incorrect because the reply does not reply to the rejection of claim 1 and therefore does not meet the reply requirements of 37 CFR 1.111 and is not a proper submission pursuant to 37 CFR 1.114(d). In (A), (C), and (D), the date of abandonment is August 15, 2001, i.e., after midnight of the date on which the set shortened statutory period, including any extensions under 37 CFR 1.136, expired. MPEP §711.04(a). (E) is incorrect because (A), (C), and (D) are incorrect.

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46. ANSWER: (E) is the correct answer. MPEP § 715. (A) is incorrect because an affidavit under 37 CFR 1.131 is not appropriate where the reference is a prior U.S. patent to the same entity, claiming the same invention. MPEP § 715. (B) and (D) are each incorrect because an affidavit under 37 CFR 1.131 is not appropriate where the reference is a statutory bar under 35 U.S.C. §102(d) as in (B) or a statutory bar under 35 U.S.C. § 102(b) as in (D). MPEP § 715. (C) is incorrect because an affidavit under 37 CFR 1.131 is not appropriate where applicant has clearly admitted on the record that subject matter relied on in the reference is prior art. MPEP § 715.

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

purposes in the first CPA. See, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50093, right column, second paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (E) is not the most correct answer. 37 C.F.R. § 1.53(d)(1)(i)(A) does not authorize the filing of a divisional or continuation application as a CPA of a prior complete nonprovisional utility application filed on or after May 29, 2000.

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

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

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

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

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22. All answers accepted.

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30. ANSWER: (D) is the most correct answer. 37 C.F.R. § 1.103(c). *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50100, right column, Comment 11 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (A) is not the most correct answer. 37 C.F.R. § 1.114. “An applicant may not obtain examination of a different or non-elected invention (e.g., a divisional) in a request for continued examination under § 1.114.” *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50102, left column, Comment 21 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (B) is not the most correct answer. 37 C.F.R. § 1.312. Amendments are not entered as a matter of right. Section 1.312 is not intended to be used for continued examination of applications. *See* MPEP 714.16. Any amendments considered necessary by the applicant should be completed before the notice of allowance is issued.” *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50102, middle column, Comment 24 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (C) is not the most correct answer. 37 C.F.R. §§ 1.85(c) and 1.136(c)(2). The three-month period set in the notice of allowability for submission of any outstanding corrected or formal drawing is not extendable under 37 C.F.R. § 1.136(a) or (b). *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50102, middle column, Comment 23 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (E) is not the most correct answer. 37 C.F.R. § 1.103(a). The Office will not suspend action if a reply by the applicant is due. *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50101, left column, Comment 12 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000).

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

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

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

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2. ANSWER: (A) is the most correct answer, while (D) is not the most correct answer. See MPEP § 715.05, which, in pertinent part, states: When the reference in question is a noncommonly owned U.S. patent claiming the same invention as applicant and its issue date is less than 1 year prior to the presentation of claims to that invention in the application being examined, applicant's remedy, if any, must be by way of 37 CFR 1.608 instead of 37 CFR 1.131... . The reference patent can then be overcome only by way of interference. (B) and (C) are not the most correct answers. See MPEP § 715.05, which, in pertinent part, states: If the patent is claiming the same invention as the application and its issue date is 1 year or more prior to the presentation of claims to that invention in the application, a rejection of the claims of the application under 35 U.S.C. 135(b) should be made. See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632, 1635 (Fed.Cir. 1997) (The court holding that application of 35 U.S.C. 135(b) is not limited to inter partes interference proceedings, but may be used as a basis for ex parte rejections.). (E) is a wrong answer because an affidavit or declaration traversing a ground of rejection may be received only where the reference "substantially shows or describes but does not claim the same patentable invention." 37 CFR § 1.132.

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3. ANSWER: All answers accepted.

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

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

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8. ANSWER: (B) is the most correct answer. See, e.g., *Ex parte Lemieux*, 115 USPQ 148 (Bd. Pat. App. & Int. 1957); MPEP 715.01(c). (A) is incorrect because even if the promotional article constituted an offer to sell in the United States, it was made less than a year prior to Thomas' filing date. 35 USC § 102(b). With regard to statement (C), there is no requirement under 35 USC § 102 that a publication be made with an inventor's knowledge or permission before it constitutes prior art. Statement (D) is incorrect at least because the Birdoculars were "described in a printed publication in...a foreign country" (35 USC § 102(a)) before Thomas' filing date and is therefore presumptive prior art. There is no

requirement that a publication describe something that has actually been reduced to practice before the publication can act as a prior art reference. Thus, statement (E) is not correct.

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9. ANSWER: (E) is the most correct answer. Thomas may rely on activities in both Germany (a WTO member country) and Canada (a NAFTA country) in establishing a date of invention prior to publication of the Saskatoon Times article or in establishing priority. 35 U.S.C. § 104; see also MPEP 715.01(c).

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10. ANSWER: All answers accepted.

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

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

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

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30. ANSWER: (B) is the most correct answer. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947) (holding that the “lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon” is not relevant to an affidavit or declaration under 37 C.F.R. 1.131(b)); MPEP § 715.07(a). (A) is incorrect. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm’r Pat. 1889); MPEP § 715.07(a). Applicant must show evidence of facts establishing diligence. (C) is incorrect. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958) (after conception has been clearly established, diligence must be considered prior to the effective date is clearly established, since diligence then comes into question); MPEP § 715.07(a). (D) is incorrect. MPEP § 715.07(c). 37 C.F.R. 1.131(a) provides for the

establishment of a date of completion of the invention in a NAFTA or WTO member country, as well as in the United States, an applicant can establish a date of completion in a NAFTA member country on or after December 8, 1993, the effective date of section 331 of Public Law 103 - 182, the North American Free Trade Agreement Act, and can establish a date of completion in a WTO member country other than a NAFTA member country on or after January 1, 1996, the effective date of section 531 of Public Law 103 - 465, the Uruguay Round Agreements Act. Not all countries are members of NAFTA or WTO, and prior invention in a foreign country cannot be shown without regard for when the reduction to practice occurred. (E) is incorrect. MPEP § 715.07. Actual reduction to practice generally, but not always, requires a showing that the apparatus actually existed and worked, “There are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice. *In re Asahi/America Inc.*, 68 F.3d 442, 37 USPQ2d 1204 (Fed. Cir. 1995) (citing *Newkirk v. Lulegian*, 825 F.2d 1581, 3USPQ2d 1793 (Fed. Cir. 1987) and *Sachs v. Wadsworth*, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931). The claimed restraint coupling held to be so simple a device that mere construction of it was sufficient to constitute reduction to practice. Photographs, coupled with articles and a technical report describing the coupling in detail were sufficient to show reduction to practice.).

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34. ANSWER: All answers accepted.

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

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

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39. ANSWER: (B) is the correct answer. 37 CFR § 1.133 (effective November 7, 2000); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54640-54641 (September 8, 2000). As stated in 65 FR at 54641, left column, “Comment 65: One comment urged that interviews be allowed in a CPA prior to a first action. Response: The comment has been adopted in a broader manner to apply to all continuations and substitute applications

that conform to practice set forth in the MPEP.” Thus, (B) is correct. (A) is incorrect because interview will not be permitted off Office premises without the authority of the Commissioner. 37 CFR § 1.133(a)(1). (C) is incorrect because an interview for the discussion of the patentability of a pending application will not occur before the first Office action, unless the application is a continuing or substitute application. 37 CFR § 1.133(a)(2). (D) is incorrect because (B) is correct. (E) is incorrect because (A) and (C) are incorrect.

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

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45. ANSWER: (B) is the most correct answer. 37 CFR § 1.114(c) (effective August 16, 2000), “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 FR 50092, 50097 (Aug. 16, 2000), and 37 CFR § 1.111(b). As stated in 65 FR 50097, column 1, “Section 1.114(c) also provides that if reply to an Office action under 35

U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111.” (B) is correct because the reply complies with 37 CFR § 1.111(b). (A) is incorrect because a reply under 37 CFR § 1.111(b) must be reduced to writing. 37 CFR § 1.2. (C) is incorrect because a reply under 37 CFR § 1.111(b) must present arguments pointing out the specific distinctions believed to render the claims patentable over the applied references. (D) is incorrect because (A) and (C) are incorrect. (E) is incorrect because (B) is correct. April 18, 2001 PM

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

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3. ANSWER: (E) is the correct answer. MPEP § 708.02. I is sufficient to result in the petition being granted. MPEP § 708.02, subpart (VIII). II is sufficient. MPEP § 708.02, subpart (IV). III is sufficient. MPEP § 708.02, subpart (III). Therefore, (A) through (D) are incorrect.

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4. ANSWER: (E). Amendment in said manner is limited to deletions or additions of no more than five words. 37 C.F.R. § 1.121(a)(2)(i)(B). Thus, the answer is not true. (A) is true, and therefore an incorrect answer. MPEP § 714.01(d). (B) is true, and therefore an incorrect answer. MPEP § 714.22. (C) is true, and therefore an incorrect answer. 37 C.F.R. § 1.121(a); MPEP § 714.22. (D) is true, and therefore an incorrect answer. 37 C.F.R. § 1.121(b)(3)(i).

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5. ANSWER: (E) is the correct answer. MPEP § 706.02 points out the distinction between rejections based on 35 U.S.C. §§ 102 and 103. For anticipation under 35 U.S.C. § 102 the reference must teach every aspect of the claimed invention either explicitly or impliedly. (A), (B), (C), and (D) are each incorrect because each reply does not address the lack of anticipation by Bud. (A) is further incorrect. It is proper to take official notice without citing a reference until the practitioner challenges the examiner to provide support. Until seasonably challenged, the examiner would not have to provide support for the official notice. MPEP § 2144.03. (B) is further incorrect because a § 102(e) reference can properly have a patent date after the filing date of an application. (C) is further incorrect because no amendment is necessary. (D) is further incorrect because a prima facie case of obviousness is not necessary in a rejection under 35

U.S.C. § 102.

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9. All Answers accepted.

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11. ANSWER: (C). 37 C.F.R. § 1.136; MPEP § 710.02(e), p. 700-77. (A) and (B) are not true because the amendment is treated as timely. There is no authority for (D). (E) is untrue because (C) is true.

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14. ANSWER: (D). 37 C.F.R. § 1.116; MPEP § 714.13, Entry Not Matter of Right [p. 700-118]. The reply in (D) is directed to a reply permitted to be made under 37 C.F.R. § 1.116(a). (A), (B), and (C) are directed to the merits of the application, and are not in accord with 37 C.F.R. § 1.116(a).

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24. ANSWER: (A) is the correct answer because it satisfies the requirements set forth in MPEP § 708.02, part (III). (B) is wrong because the requirement in MPEP § 708.02, part (I), calls for a statement by the applicant, assignee or an attorney/agent registered to practice before the Office. Applicant's business competitor does not qualify as a prospective manufacturer. (C) is wrong because MPEP § 708.02, part (II), applies to "actual infringement," and expressly excludes "prospective infringement." (D) is wrong because MPEP § 708.02, part (V), calls for a statement by the applicant, assignee or an attorney/agent registered to practice before the Office. The Professor does not qualify. (E) is wrong because MPEP § 708.02, part (VII), calls for a statement by the applicant, assignee or an attorney/agent registered to practice before the Office. The Professor does not qualify.

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28. ANSWER: (B). MPEP § 706.01. (A) and (C) are incorrect. As stated by MPEP § 706.01, “The practical difference between a rejection and an objection is that a rejection, involving the merits of the claim, is subject to review by the Board of Patent Appeals and Interferences, while an objection, if persisted, may be reviewed only by way of petition to the Commissioner.” (D) is incorrect. MPEP § 706.03(d). (E) is incorrect. As stated in MPEP § 706.01, “If the form of the claim (as distinguished from its substance) is improper, an “objection” is made. An example of a matter of form as to which objection is made is dependency of a claim on a rejected claim, if the dependent claim is otherwise allowable. See MPEP § § 608.01(n).”

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34. ANSWER: (D) is the correct answer. MPEP § 706.07(b). In both I and III the finality is improper. MPEP § 706.07(b). Therefore (A) and (C) are incorrect. In II the finality is proper. MPEP § 706.07(b). Therefore (B) and (E) are incorrect.

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37. ANSWER: The correct answer is (C). The one-month extension of time filed February 17, 2000 properly extended the deadline for filing a reply to Friday, March 17, 2000. When a timely reply is ultimately not filed, the application is regarded as abandoned after midnight of the date the period for reply expired, *i.e.*, the application was abandoned at 12:01 AM on Saturday, March 18, 2000. The fact that March 18 was a Saturday does not change the abandonment day because the reply was due on March 17, a business day. MPEP § 710.01(a).

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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.

45. ANSWER: (C). 35 U.S.C. §§ 102(b) and (e); 37 C.F.R. § 1.131(a). A reference under 35 U.S.C. § 102(b) cannot be antedated. Therefore, (A), (B) and (E) are incorrect. (D) is incorrect because it is non-responsive, and it does not matter when the Spot patent issued.

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47. ANSWER: (A). 37 C.F.R. §§ 1.31 and 1.34; MPEP § 713.05. Statements (B) and (D) are incorrect because Blackacre may participate in the interview if he possesses a copy of the application file and states he is authorized to represent the applicant. (E) is therefore also incorrect. (C) is incorrect because a mere power to inspect is insufficient authority for an examiner to grant an interview involving the merits of an application. *Id.*

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

required by 35 U.S.C. § 102(d).

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

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12. ANSWER: (A). MPEP § 706.03(u). (B) is incorrect. MPEP § 706.03(w) Res Judicata should be applied only when the earlier decision was a decision of the Board of Appeals or any one of the reviewing courts and when there is no opportunity for further court review of the earlier decision. (C) is incorrect. MPEP § 608.01(l) and 706.03(o). If subject matter capable of illustration is originally claimed and it is not shown in the drawing, the claim should not be rejected, but on that basis applicant is required to add it to the drawing. (D) is incorrect. As stated in MPEP § 706.03(a), “A thing occurring in nature, which is substantially unaltered, is not a ‘manufacture.’ A shrimp with the head and digestive tract removed is an example. *Ex parte Grayson*, 51 USPQ 413 (Bd. App. 1941).” (E) is incorrect. MPEP § 706.03(a) indicates that a scientific principle, divorced from any tangible structure, can be rejected as not within the statutory classes. *O’Reilly v. Morse*, 56 U.S. (15 Howard) 62 (1854).

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13. ANSWER: (E) is the correct answer. MPEP § 706.02(b). (A) is incorrect because the Dan reference includes all the elements of claim 1. (B) is incorrect because the Federal holiday is merely to move the statutory bar date to the next succeeding business day. *Ex parte Olah*, 131 USPQ 41 (Bd. App. 1960). (C) is incorrect because a 37 C.F.R. § 1.131 affidavit can not be used to overcome a rejection under 35 U.S.C. § 102(b). (D) is incorrect because the rejection was not made under 35 U.S.C. § 103.

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

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16. ANSWER: (C). When the article is preexisting, one may only secure patent protection of the method of using the article. Since claim 11 is defined in terms of circuitry and this circuitry was preexisting, claim 11 is not allowable. *Cf. Monsanto Co. v. Rohm & Haas Co.*, 312 F.Supp. 778, 164 USPQ 556 (ED Pa. 1970), *aff’d*, 456 F.2d 592, 172 USPQ 324 (CA 3), *cert. denied*, 407 U.S. 934, 172 USPQ 323 (1972) (new use of preexisting chemical as

herbicide entitles applicant to method claims). (A) is incorrect because claim 12 is not barred by 35 U.S.C. § 102(b). As to (B), the remote control device was preexisting and claim 11 reads on the circuitry as it existed in 1995. (D) is incorrect. The manner of invention, whether it be by painstaking research or an inadvertent discovery of a new use is without significance. As to (E), claim 11 is not patentable based upon previous public use. The evidence of commercial success, which may be relevant for overcoming a rejection under 35 U.S.C. § 103, cannot overcome a rejection under 35 U.S.C. § 102.

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18. ANSWER: (E) is the correct answer because Sally's patent is prior art under 35 U.S.C. § 102(a) and cannot be disqualified by a showing of common ownership, which can be used to disqualify prior art under 35 U.S.C. 102(f) and (g). 37 C.F.R. § 1.104(a)(5); MPEP §§ 706.02(l) ("If the subject method qualifies as prior art under any other subsection (e.g., subsection 35 U.S.C. 102(a) . . .) it will not be disqualified as prior art under 35 U.S.C. 103."), and 706.02(l)(2).

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

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

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29. ANSWER: The best answer is (C). With regard to Statement (A), public use in Canada is not a statutory bar under 35 U.S.C. § 102(b) regardless of whether Canada is a NAFTA

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

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

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31. ANSWER: (C). See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947) (holding that the “lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon” is not relevant to an affidavit or declaration under 37 C.F.R. 1.131); MPEP § 715.07(a). (A) is incorrect. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889); MPEP § 715.07(a). Applicant must show evidence of facts establishing diligence. (B) is incorrect. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958) (after conception has been clearly established, diligence must be considered prior to the effective date is clearly established, since diligence then comes into question); MPEP § 715.07(a). (D) is incorrect. MPEP § 715.07(c). 37 C.F.R. 1.131(a) provides for the establishment of a date of completion of the invention in a NAFTA or WTO member country, as well as in the United States, an applicant can establish a date of completion in a NAFTA member country on or after December 8, 1993, the effective date of section 331 of Public Law 103 - 182, the North American Free Trade Agreement Act, and can establish a date of completion in a WTO member country other than a NAFTA member country on or after January 1, 1996, the effective date of section 531 of Public Law 103 - 465, the Uruguay Round Agreements Act. Not all countries are members of NAFTA or WTO, and prior invention in a foreign country cannot be shown without regard for when the reduction to practice occurred. (E) is incorrect. MPEP § 715.07. Actual reduction to practice generally, but not always, requires a showing that the apparatus actually existed and worked, “There are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice. *In re Asahi/America Inc.*, 68 F.3d 442, 37 USPQ2d 1204 (Fed. Cir. 1995) (citing *Newkirk v. Lulegian*, 825 F.2d 1581, 3USPQ2d 1793 (Fed. Cir. 1987) and *Sachs v. Wadsworth*, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931). The claimed restraint coupling held to be so simple a device that mere construction of it was sufficient to constitute reduction to practice.

Photographs, coupled with articles and a technical report describing the coupling in detail were sufficient to show reduction to practice.).

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34. ANSWER: (A) is the correct answer. MPEP § 710.02(d), last paragraph, and 37 C.F.R. § 1.136(a). (B) is incorrect because a Notice to File Missing Parts of an Application is not identified on the Notice as a statutory period subject to 35 U.S.C. § 133. (C) and (D) are incorrect because the provisions of 37 C.F.R. § 1.136(a) are available. (E) is incorrect because (A) is correct.

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46. ANSWER: (B). The petition for extension of time filed February 14, 2000 provided applicant with a one-month extension of time from the original due date, February 12, 2000 (not from the date the petition was filed). See MPEP § 710.01(a). Thus, the extended due date was Sunday, March 12, which means a reply was due by Monday, March 13. Since an additional extension of time is needed, (A) is incorrect. Under the provisions of 37 C.F.R. § 1.136(a)(3), applicant's statement is treated as a constructive petition for extension of time. MPEP § 710.02(e). (C) is incorrect because applicant's statement in the Remarks portion of the amendment acted as a constructive petition for extension of time and, therefore, the amendment is timely. There is no need for the petition to appear in a separate paper, so (D) is not correct. (E) is incorrect because (C) and (D) are both incorrect.

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

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8. ANSWER: (D). MPEP § 710.02(e), pages 700-82 and 83, under the heading "FINAL REJECTION – TIME FOR REPLY" states, "If an applicant initially replies within 2 months from the date of mailing of any final rejection setting a 3-month shortened statutory period for reply and the Office does not mail an advisory action until after the end of the 3-month shortened statutory period, the period for reply for purposes of determining the amount of

any extension fee will be the date on which the Office mails the Advisory Action advising applicant of the status of the application...” Hence, since no extension fee was paid in the fact pattern, the time allowed applicant for reply to the action from which the appeal was taken is the mail date of the Advisory Action, i.e., May 31, 2000. 37 C.F.R. § 1.192(a) recites, in pertinent part, “Appellant must, within two months from the date of the notice of appeal under § 1.191 or within the time allowed for reply to the action from which the appeal was taken, if such time is later, file a brief in triplicate.” (A), (B), and (C) are wrong because they recite dates which are earlier than May 31, 2000, the last date for filing a Brief without an extension of time. (E) is wrong because it is after the last date for filing a Brief without an extension of time, and therefore an extension of time would be required.

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

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

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

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

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29. ANSWER: (E) is correct because the express abandonment was the result of a

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

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

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

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

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1. ANSWER: (D) is correct because gross sales figures must be measured against a logical standard in order to determine whether or not there is commercial success. The recitations of accompanying evidence in (A), (B), and (C) are logical in that they provide a comparative basis for determining commercial success. (D), on the other hand, recites accompanying evidence which is illogical in that it does not provide a comparative basis for determining commercial success. (E) is wrong because it provides a logical basis for attributing

commercial success to the design of the device, rather than the utilitarian function of the device. MPEP 716.03(b).

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2. ANSWER: (E). *In re Tiffin and Erdman*, 171 USPQ 294 (CCPA 1971). MPEP § 716.03(a). (A), (B), (C), and (D) are wrong. *In re Tiffin and Erdman*, 170 USPQ 88, 91, 92 (CCPA 1971). MPEP § 716.03(a).

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5. ANSWER: (E) is the most correct reply. Beverly's thesis constitutes a printed publication as of January 29, 1999. *In re Hall*, 228 USPQ 453 (Fed. Cir. 1986). Since (B) and (C) are both correct statements, the most correct response is (E). (A) is incorrect. To be used under 35 U.S.C. § 102(b) as a prior art printed publication against a United States application for patent filed January 15, 2000, the published thesis must have been published more than one year before the application for patent. The publication of Beverly's thesis on January 29, 1999, is less than one year before the filing of the application on January 15, 2000.

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

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

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

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

a year before Roberts' filing date, it was not "in this country" as required by 35 U.S.C. §102(b).

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

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37. ANSWER: (A). 37 C.F.R. § 1.111; MPEP § 714.02. (B) is incorrect because the fee must be paid when the request for extension of time is made. 37 C.F.R. § 1.136(a); MPEP 710.02(e). (C) is incorrect. The client did not give instructions to file the amendment today. Further, an amendment canceling all claims is non-responsive to the non-final rejection.. As stated in 37 C.F.R. § 1.111(b), "In order to be entitled to reconsideration..., the applicant...must reply to the Office action. The reply...must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action." MPEP § 714.19, item (H). (D) is incorrect. "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section." 37 C.F.R. § 1.111(b). (E) is incorrect inasmuch as it does not comply with 37 C.F.R. § 1.111(b).

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5. ANSWER: (D). 37 CFR § 1.116; MPEP § 714.13, Entry Not Matter of Right [p. 700-124]. The reply in (D) is directed to a reply authorized under 37 CFR § 1.116(a). (A), (B), and (C) are directed to the merits of the application, and are not in accord with 37 CFR § 1.116(a).

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7. ANSWER: (C) is the most correct answer. 37 CFR § 1.116; MPEP § 714.13.

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12. ANSWER: (C). 35 U.S.C. § 102(b) and (e); 37 CFR § 1.131(a). A reference under 35 U.S.C. § 102(b) cannot be antedated. Therefore, (A), (B) and (E) are incorrect. (D) is incorrect because it is non-responsive, and it does not matter when the Spot patent issued.

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14. ANSWER: (E). A claim may be amended by specifying the exact matter to be deleted or added, and the precise point where the deletion or addition is to be made. 37 CFR § 1.121(a)(2)(i). The amendments are limited to additions of no more than 5 words per claim or deletions. 37 CFR §§ 1.121(a)(2)(i)(A) and 1.121(a)(2)(i)(B). Here, Answer (A) is improper because the amendment does not specify the precise point where the addition is to

be made. Answer (B) is improper because the amendment adds more than 5 words to the claim. Answer (C) is improper because line 3 contains the word “layer” twice and the amendment does not specify whether the word “thin” is added before the first occurrence, second occurrence, or all occurrences of the word “layer.” Answer (D) is improper because the amendment gives no direction for who to correctly spell “talbecloth.”

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43. ANSWER: (C). 37 CFR § 1.137(b).

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3. ANSWER: (D). It would not be proper to make final a first Office action in a continuing application where that application contains material that was presented in the earlier application after final rejection, and the material was denied entry because new issues were raised that required further consideration and/or search. MPEP § 706.07(b). Since the Amendment After Final Rejection was denied entry, a first Action final rejection in the CPA is improper. (A) is incorrect because it is based on the false premise. The determination that the amendment presented new issues requiring further consideration or search did not state that Claims 1-10 that the revisions failed to place Claims 1-10 in condition for allowance. In any event, proper PTO practice and procedure does not prevent the Examiner from reconsidering such a determination, even if it had been made, and allowing the claims. (B) is incorrect because proper PTO practice and procedure does not prevent the Examiner from determining in the CPA application that the revisions do not overcome the rejection of claims 11-20 made in the parent application. There is no requirement that the Examiner reject Claims 11-20 on grounds that differ from the grounds that these claims were rejected in the parent application due to the determination in the parent application that the Amendment After Final Rejection presented new issues. (C) is incorrect because the applicant may request that the amendment after final be entered in the CPA before issuance of an Office action. See 37 CFR § 1.53(d)(3)(ii); MPEP § 201.06(d), “FILING FEE.” (E) is incorrect because (B) is incorrect.

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8. ANSWER: (A) is the most correct answer. 37 CFR § 1.131; and MPEP § 715.03. See *In re Spiller*, 500 F.2d 1170, 182 USPQ 614 (CCPA 1974). (B) and (C) are incorrect. To overcome a reference indirectly, as in (B) and (C), a showing of prior completion of a different species should be coupled with a showing that the claimed species would have been an obvious modification of the species completed by applicant. *In re Spiller, supra*; *In re Clark*, 148 USPQ 665 (CCPA 1966); *In re Plumb*, 176 USPQ 323 (CCPA 1973); *In re Hostettler*, 356 F.2d 562, 148 USPQ 514 (CCPA 1966), MPEP § 715.03. (D) is incorrect because the declaration cannot be used to antedate a statutory bar, and the reference is a statutory bar under 35 U.S.C. § 102(b) inasmuch as it issued more than one year before the Jones application was filed. 37 CFR § 1.131. (E) is incorrect because the declaration is ineffective to overcome a U.S. patent where there is no patentable distinction between the claims of the application and of the patent. *In re Hidy*, 303 F.2d 954, 133 USPQ 650 (CCPA 1962); MPEP §§ 715.05 and 2308.01.

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9. ANSWER: (D). MPEP § 713.05.

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13. ANSWER: (B). MPEP §§ 710.04, and 710.04(a).

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15. ANSWER: (E). 37 CFR §§ 1.131, and 1.132; and MPEP §§ 706.02(b), 715, and 716.

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44. ANSWER: (D). “Applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the application or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.” 35 U.S.C. § 122. However, when the applications share a common assignee, an examiner may provisionally reject claims, under 35 U.S.C. § 102(e)/103, in the later filed application, when appropriate. MPEP § 706.02(k). Here, G’s application and H’s application share a common assignee. Answers (A) and (E) are incorrect because a provisional rejection, under 35 U.S.C. § 102(e)/103, in any of these circumstances would not maintain the confidence of G’s application or H’s application. 35 U.S.C. § 122. Thus, in neither of the circumstances presented in these answers will you most likely need to overcome the rejection. Answer (B) is incorrect. Inasmuch as there is no common assignee, the confidential status of applications under 35 U.S.C. § 122 must be maintained, and no rejection can be made using or relying on the earlier filed application as prior art. MPEP 706.02(g), item II. Answer (C) is incorrect because a provisional rejection under 35 U.S.C. § 102(e)/103, cannot be properly made when the applications have the same filing date. A provisional double patenting rejection may be proper. Answer (E) is incorrect because the examiner may not properly reject claims in an earlier filed application over the claim of a later filed application. 35 U.S.C. § 102(e)/103; MPEP § 706.02.

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46. ANSWER: (A). An applicant in a patent application filed on or before June 8, 1995, and which has an effective filing date of June 8, 1993 or earlier, is entitled to have new evidence in support of patentability entered and considered (and the finality of the final rejection withdrawn), provided the submission (along with the appropriate fee) is filed prior to the filing of an appeal brief to the Board of Patent Appeals and Interferences or abandonment of the application. 37 CFR § 1.129(a); MPEP § 706.07(g). Here, the application is filed on June 8, 1995, it has an effective filing date of June 8, 1993, and the submission (along with the appropriate fee) is filed prior to the filing of the appeal brief to the Board of Patent Appeals and Interferences or the abandonment of the application. Answers (B) and (D) are incorrect because the submission was not filed prior to the filing of the appeal brief to the Board of Patent Appeals and Interferences. 37 CFR § 1.129(a); MPEP § 706.07(g). Answer (C) is incorrect because the submission was not filed prior to the abandonment of the application on December 18, 1999. 37 CFR § 1.129(a); and MPEP § 706.07(g). Answer (E) is incorrect because Answer (C) is incorrect.