

OmiPrep Chapter Exams Part II Note:

Chapters 1000, 1100, 1700, and 2400 have not been tested in previous exams. Chapter 2100 is in the first part of this chapter examreview. The last section in this chapter exam review consists of general questions which are questions that test multiple chapters.

Chapter 800

Questions

October 16, 2002 AM

8. The MPEP and USPTO rules and procedure provide for ways that a nonstatutory double patenting rejection can be overcome. Which of the following is an effective way to overcome a nonstatutory double patenting rejection?

- (A) Filing a 37 CFR 1.131 affidavit to swear behind the patent on which the rejection is based.
- (B) Filing a terminal disclaimer under 37 CFR 1.321(c).
- (C) Filing a 37 CFR 1.131 affidavit arguing that the claims are for different inventions that are not patentably distinct.
- (D) Filing a reply arguing that there is only one common inventor regarding the claims of the application and the claims of the patent.
- (E) All of the above.

October 16, 2002 AM

15. The MPEP and USPTO rules and procedure provide for ways that a statutory double patenting rejection can be overcome. Which of the following is an effective way to overcome a statutory double patenting rejection?

- (A) Filing a 37 CFR .131 affidavit to swear behind the patent on which the rejection is based.
- (B) Filing a terminal disclaimer under 37 CFR 1.321(c).
- (C) Filing a 37 CFR 1.131 affidavit and arguing that the conflicting claims are coextensive in scope.
- (D) Amending the conflicting claims so that they are not coextensive in scope.
- (E) All of the above.

October 16, 2002 AM

48. The MPEP and USPTO rules and procedure set out factual inquiries that are employed when making an obviousness-type double patenting analysis. Which of the following is not a factual inquiry that would be properly employed when making an obviousness-type double patenting determination with regard to a pending application vis-a-vis a claim in an issued patent?

- (A) Determine the level of ordinary skill in the pertinent art.
- (B) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue.
- (C) Evaluate any objective indicia of nonobviousness of the claim of the application at issue.
- (D) Determine the differences between the scope and content of: the patent claim and the prior art determined in choice (B) above and the claim in the application at issue.
- (E) None of the above (that is, each of the above factual inquiries is properly employed when making an obviousness-type double patenting determination with regard to an issued patent).

October 16, 2002 PM

18. A U.S. patent application for inventor William Tull discloses a target-shooting gun for improved accuracy, and a bullet impregnated with a new chemical composition. The new chemical composition minimizes damage to a target struck by the bullet. In a non-final Office action, an examiner includes a restriction requirement between a group of claims drawn to the target-shooting gun (Group 1), and a group of claims drawn to the bullet (Group 2). Which of the following, included in a timely reply to the non-final Office action, preserves Tull's right to petition for review of the restriction requirement, if the requirement is made final?

- (A) A reply that distinctly points out supposed errors in the restriction requirement, and also states, "The restriction requirement is traversed, and no election is made, thereby preserving Applicant's right to petition for review of the restriction requirement."
- (B) A reply that states, "Applicant elects Group 2 and traverses the restriction requirement because the requirement for restriction between Group 1 and Group 2 is in error."
- (C) A reply that distinctly and specifically points out supposed errors in the restriction requirement, and states, "Applicant traverses the restriction requirement and elects Group 2."
- (D) A reply that states, "The restriction requirement between Group 1 and Group 2 is traversed because it is in error, and no election is made, thereby preserving Applicant's right to petition for review of the restriction requirement."
- (E) None of the above.

October 16, 2002 PM

30. The MPEP sets forth a procedure whereby an examiner may contact an applicant to discuss election of claims after the examiner determines that a restriction requirement should be made. Assume that a primary examiner contacts a practitioner representing applicant by telephone prior to any Office action on the merits, and the examiner orally makes a restriction requirement. During the telephone conversation, the practitioner orally makes an election of claims without traverse. On examination, the examiner finds the elected claims to be allowable. Which of the following would be improper for the examiner to include in a letter to the practitioner attached to a Notice of Allowability?

- (A) A cancellation of the non-elected claims.
- (B) A statement that the prosecution is closed.
- (C) A statement that a Notice of Allowance will be sent in due course.
- (D) A statement that the applicant's election is not upheld because an election must only be made in writing, and cannot be made by telephone.
- (E) All of the above.

October 17, 2001 AM

27. A U.S. patent application for inventor William Tull discloses a target-shooting gun for improved accuracy, and a bullet impregnated with a new chemical composition. The new chemical composition minimizes damage to a target struck by the bullet. In a non-final Office action, an examiner includes a restriction requirement between a group of claims drawn to the target-shooting gun (Group 1), and a group of claims drawn to the bullet (Group 2). Which of the following, included in a timely reply to the non-final Office action, preserves Tull's right to petition for review of the restriction requirement, if the requirement is made final?

- (A) A reply that distinctly points out supposed errors in the restriction requirement, and also states, "The restriction requirement is traversed, and no election is made, thereby preserving Applicant's right to petition for review of the restriction requirement."
- (B) A reply that states, "Applicant elects Group 2 and traverses the restriction requirement because the requirement for restriction between Group 1 and Group 2 is in error."
- (C) A reply that distinctly and specifically points out supposed errors in the restriction requirement, and states, "Applicant traverses the restriction requirement and elects Group 2."
- (D) A reply that states, "The restriction requirement between Group 1 and Group 2 is traversed because it is in error, and no election is made, thereby preserving Applicant's right to petition for review of the restriction requirement."
- (E) None of the above.

April 12, 2000 AM

9. A non-final Office action contains, among other things, a restriction requirement between two groups of claims, (Group 1 and Group 2). Which of the following, if included in a timely reply under 37 C.F.R. § 1.111, preserves applicant's right to petition the Commissioner to review the restriction requirement?

- I. Applicant's entire reply to the restriction requirement is: "The examiner erred in distinguishing between Group 1 and Group 2, and therefore the restriction requirement is respectfully traversed and no election is being made, in order that applicant's right to petition the Commissioner to review the restriction requirement is preserved."
 - II. Applicant's entire reply to the restriction requirement is: "Applicant elects Group 1 and respectfully traverses the restriction requirement, because the examiner erred in requiring a restriction between Group 1 and Group 2."
 - III. Applicant's reply distinctly points out detailed reasons why applicant believes the examiner erred in requiring a restriction between Group 1 and Group 2, and additionally sets forth, "Applicant therefore respectfully traverses the restriction requirement and no election is being made, in order that applicant's right to petition the Commissioner to review the restriction requirement is preserved."
 - IV. Applicant's reply distinctly points out detailed reasons why applicant believes the examiner erred in requiring a restriction between Group 1 and Group 2, and additionally sets forth, "Applicant therefore respectfully traverses the restriction requirement and elects Group 2."
- (A) I.
 - (B) II.
 - (C) III.
 - (D) IV.
 - (E) None of the above.

November 3, 1999 PM

33. Ann invented an electrical signal filter for obtaining increased signal-to-noise ratios in certain electrical systems. Ann filed a first non-provisional patent application on May 1, 1997, fully disclosing and claiming one embodiment of her invention, a capacitor. The sole claim stated: “a capacitor for filtering electrical signals, comprising: a first terminal connected to a first plate; a second terminal connected to a second plate; and an electrical insulator between said first plate and said second plate.” The first application also disclosed that even better results could be obtained if the capacitor were coupled to a resistor. Ann wanted to file a second application in the future specifically claiming the combination of the capacitor and resistor. On February 1, 1999, while Ann’s first application was still pending, Ann filed a continuation application under 37 CFR § 1.53(b). The continuation application contains the following single claim: “a capacitor for filtering electrical signals, comprising: a first terminal connected to a first plate; a second terminal connected to a second plate; an electrical insulator between said first plate and said second plate; and a resistor, connected to said first terminal.” Ann received a non-final Office action wherein the claim in the continuation application was provisionally rejected under the judicially created doctrine of double patenting over the claim drawn to a capacitor in Ann’s copending first application. The rejection correctly stated that the subject matter claimed in Ann’s continuation application was fully disclosed in her copending first application and would be covered by a patent granted containing the claim in the first application. Neither application was ever assigned to anyone. The rejection may be properly overcome by a timely reply:

- (A) traversing the rejection and arguing that since the first application had not yet matured into a patent, a double patenting rejection was unfounded.
- (B) arguing that rejections of this type are no longer warranted for continuation applications, since any utility application filed on or after June 8, 1995, will expire 20 years from its filing date, and therefore Ann’s continuation application, which gets the benefit of the filing date of the first application, would expire at the same time as the first application, anyway.
- (C) arguing that the claim in the continuation application is patentably distinct and unobvious from the claim in the first application.
- (D) including a terminal disclaimer, signed by Ann, disclaiming any portion of the term of any patent granted on the continuation application beyond twenty years from May 1, 1997, and including a provision in the terminal disclaimer that any patent granted on the continuation application shall be enforceable only for and during such period that said patent is commonly owned with the first application.
- (E) including the filing of a terminal disclaimer, signed by Ann, disclaiming any portion of the term of any patent granted on the continuation application beyond twenty years from May 1, 1997.

Chapter 800

Answers

October 16, 2002 AM

8. ANSWER: Choice (B) is the correct answer. MPEP § 804.02, subpart (II) reads, “A rejection based on a nonstatutory type of double patenting can be avoided by filing a terminal disclaimer in the application or proceeding in which the rejection is made.” Choices (A) and (C) are each incorrect. MPEP § 804.02, reads, “The use of a 37 C.F.R. § 1.131 affidavit in overcoming a double patenting rejection is inappropriate...37 C.F.R. § 1.131 is inapplicable if the claims of the application and the patent are ‘directed to substantially the same invention.’ It is also inapplicable if there is a lack of ‘patentable distinctness’ between the claimed subject matter.” Choice (C) is further incorrect since a nonstatutory double patenting rejection can be based on the claims not being patentably distinct. MPEP § 804, subpart (II)(B)(1). Choice (D) is incorrect because MPEP § 804, subpart (I)(A) reads, “Double patenting may exist between an issued patent and an application filed by the same inventive entity, or by an inventive entity having a common inventor with the patent.” Choice (E) is incorrect because choices (A), (C), and (D) are each incorrect.

October 16, 2002 AM

15. ANSWER: Choice (D) is the correct answer. MPEP § 804.02, reads, “A rejection based on the statutory type of double patenting can be avoided by amending the conflicting claims so that they are not coextensive in scope.” Choices (A) and (C) are each incorrect because MPEP § 804.02, reads, “The use of a 37 C.F.R. § 1.131 affidavit in overcoming a statutory double patenting rejection is inappropriate.” Choice (C) is further incorrect since the statutory double patenting rejection is based on the conflicting claims being coextensive in scope. Choice (B) is incorrect because MPEP § 804.02, reads, “A terminal disclaimer is not effective in overcoming a statutory double patenting rejection.” Choice (E) is incorrect because choices (A), (B), and (C) are each incorrect.

October 16, 2002 AM

48. ANSWER: Choice (E) is the correct answer. MPEP § 804, subpart (II)(B)(1), reads, “Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. § 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 138 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103 are employed when making an obvious-type double patenting analysis.” Each of choices (A), (B), (C), and (D) is incorrect because it is a factual inquiry set forth in *Graham v. John Deere Co.*

October 16, 2002 PM

18. ANSWER: (C) is the correct answer. 37 C.F.R. 1.144; MPEP §§ 818.03(a)-(c). (A), (B), and (D) are each incorrect because no supposed errors in the restriction requirement are distinctly and specifically pointed out. (A) and (D) are further incorrect because no election is made. (E) is incorrect because (C) is correct.

October 16, 2002 PM

30. ANSWER: Choice (D) is the correct answer. MPEP § 812.01. Choices (A), (B), and (C) are each incorrect because MPEP § 812.01 reads, “If, on examination, the examiner finds the elected claims to be allowable and no traverse was made, the letter should be attached to the Notice of Allowability form PTOL-37 and should include cancellation of the nonelected

claims, a statement that the prosecution is closed, and that a notice of allowance will be sent in due course.” Choice (E) is incorrect because only choice (D) is correct.

October 17, 2001 AM

27. ANSWER: (C) is the correct answer. 37 CFR 1.144; MPEP §§ 818.03(a)-(c). (A), (B), and (D) are each incorrect because no supposed errors in the restriction requirement are distinctly and specifically pointed out. (A) and (D) are further incorrect because no election is made. (E) is incorrect because (C) is correct.

October 18, 2000 AM

8. ANSWER: (C) is correct. See MPEP § 1411.01. As to (A) see MPEP § 1402. A reissue patent is not granted. As to (B), new matter may not be entered in a reissue. As to (D) see MPEP § 1412.03, p.1400-13. Since (A), and (B) are incorrect, (E) is incorrect.

April 12, 2000 AM

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

November 3, 1999 PM

33. ANSWER: (D). 37 CFR § 1.321(c); and MPEP § 804.02. (A) is incorrect because provisional rejections between copending applications based on the judicially created doctrine of double patenting are provided for in MPEP § 804, item 1B. (B) is incorrect because the rejection is still applicable even though the continuation application gets the filing date of the first application. MPEP § 804.02. (C) is incorrect because the rejection is proper. Applicant voluntarily filed a second application without a restriction requirement by the Examiner. *In re Schneller*, 158 USPQ 210 (CCPA 1968) and MPEP § 804. (E) is incorrect because it omits the provision concerning common ownership. 37 CFR § 1.321(c).

Chapter 900

Questions

April 15, 2003 AM

2. A registered practitioner filed in the USPTO a client's utility patent application on December 30, 2002. The application was filed with a request for nonpublication, certifying that the invention disclosed in the U.S. application has not and will not be the subject of an application in another country, or under a multilateral international agreement, that requires eighteen month publication. Subsequently, the client files an application in Japan on the invention and some recent improvements to the invention. The improvements are not disclosed or supported in the utility application. Japan is a country that requires eighteen month publication. Two months after filing the application in Japan, and before filing any other papers in the USPTO, the client remembers that a nonpublication request was filed and informs the practitioner about the application that was filed in Japan. Which of the following courses of action is in accordance with the USPTO rules and the procedures set forth in the MPEP?

- (A) The application is abandoned because the practitioner did not rescind the nonpublication request and provide notice of foreign filing within 45 days of having filed the application in Japan. The applicant must now file a petition and fee to revive under 37 CFR 1.137(b).
- (B) The application is abandoned because the applicant did not rescind the nonpublication request before filing the application in Japan. The applicant must now file a petition and fee to revive under 37 CFR 1.137(b).
- (C) The applicant should file an amendment to the specification of the U.S. application, adding the recent improvements to the disclosure in the specification.
- (D) The application is abandoned because the applicant did not rescind the nonpublication request by notifying the Office under 37 CFR 1.213(c) within the appropriate time. The applicant must now file a petition and fee to revive under 37 CFR 1.137(b).
- (E) The applicant could today notify the USPTO of the foreign filing. It is not necessary to file a petition and fee to revive for the application to continue to be examined in the USPTO.

April 15, 2003 PM

48. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following statements regarding a proper prior art reference is true?

- (A) Canceled matter in the application file of a U.S. patent is a prior art reference as of the filing date under 35 USC 102(e).
- (B) Where a patent refers to and relies on the disclosure of a copending subsequently abandoned application, such disclosure is not available as a reference.
- (C) Where the reference patent claims the benefit of an earlier filed, copending but subsequently abandoned application which discloses subject matter in common with the patent, and the abandoned application has an enabling disclosure for the common subject matter and the claimed matter in the reference patent, the effective date of the reference patent as to the common subject matter is the filing date of the reference patent.
- (D) Matter canceled from the application file wrapper of a U.S. patent may be used as prior art as of the patent date.
- (E) All foreign patents are available as prior art as of the date they are translated into English.

Chapter 900

Answers

April 15, 2003 AM

2. ANSWER: (A) and (D) are accepted as the correct answers. Regarding answer (A), see 35 U.S.C. § 122(b)(2)(B)(iii); 37 CFR § 1.213; MPEP § 901.03 for information on nonpublication requests. See 37 CFR § 1.137(f); MPEP § 711.03(c), under the heading “3. Abandonment for Failure to Notify the Office of a Foreign Filing After Submission of a Non-Publication Request.” (D) was also accepted because the statement characterizes the status of the application as being abandoned, though the application has not necessarily attained abandoned status. The course of action postulated in (D) is a proper reply if the application was abandoned. Accordingly, (D) was accepted as a correct answer under these circumstances. (B) is incorrect. The notice of foreign filing can be filed as late as 45 days after the foreign filing before the U.S. application becomes abandoned. (C) is incorrect. See MPEP § 608.04(a). The improvements would constitute new matter and new matter cannot be added to the disclosure of an application after the filing date of the application. (E) is not correct. The applicant was required to provide notice of foreign filing within 45 days of filing in Japan, and two months have passed. As a result, a petition to revive under 37 CFR § 1.137(b) is required for examination to continue. Also see 37 CFR § 1.137(f).

April 15, 2003 PM

48. ANSWER: (D) is the most correct answer. See 35 U.S.C. § 102(a). As explained in MPEP § 901.01, the “matter canceled from the application file wrapper of a U.S. patent may be used as prior art as of the patent date in that it then constitutes prior public knowledge under 35 U.S.C. 102(a), *In re Lund*, 376 F.2d 982, 153 USPQ 625 (CCPA 1967). See also MPEP 2127 and 2136.02.” (A) is incorrect. 35 U.S.C. § 102(e). As stated in MPEP § 901.01, “Canceled matter in the application file of a U.S. patent is not a proper reference as of the filing date under 35 U.S.C. 102(e), see *Ex parte Stalego*, 154 USPQ 52, 53 (Bd. App. 1966).” (B) is incorrect. As stated in MPEP § 901.02, “*In re Heritage*, 182 F.2d 639, 86 USPQ 160 (CCPA 1950), holds that where a patent refers to and relies on the disclosure of a copending abandoned application, such disclosure is available as a reference. See also *In re Lund*, 376 F.2d 982, 153 USPQ 625 (CCPA 1967).” (C) is incorrect. As MPEP § 901.02 indicates, where the reference patent claims the benefit of a copending but abandoned application which discloses subject matter in common with the patent, and the abandoned application has an enabling disclosure of the common subject matter and claimed matter in the reference patent, the effective date of the reference as to the common subject matter is the filing date of the abandoned application. *In re Switzer*, 77 USPQ 1, 612 O.G. 11 (CCPA 1948); *Ex parte Peterson*, 63 USPQ 99 (Bd. App. 1944); and *Ex parte Clifford*, 49 USPQ 152 (Bd. App. 1940).” (E) is incorrect. As stated in MPEP § 901.05, “In general, a foreign patent, the contents of its application, or segments of its content should not be cited as a reference until its date of patenting or publication can be confirmed by an examiner’s review of a copy of the document.”

Chapter 1200

Questions

April 15, 2003 AM

8. Following a restriction requirement and election, a registered practitioner received a first Office action dated Friday, December 1, 2000. The primary examiner indicated that claims 1 to 10 were rejected and claims 11 to 20 were withdrawn from consideration. The first Office action set a 3 month shortened statutory period for reply. On February 28, 2001, the practitioner properly filed an express abandonment in the application and at the same time filed a request for continuing application. In a non-final Office action dated May 1, 2001 in the continuing application, the examiner indicated in that claims 1 to 20, all of the pending claims, are rejected. The practitioner filed a notice of appeal on Monday, July 2, 2001. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following most accurately describes the propriety of the practitioner's reply to the May 1st Office action?

- (A) The notice of appeal is not a proper response because the claims of the continuing application have not been finally rejected.
- (B) The notice of appeal is not a proper reply because all of the claims in the continuing application have not been twice rejected.
- (C) The filing of a notice of appeal is not a proper reply because not all the claims in the continuing application have been twice rejected.
- (D) A notice of appeal is never a proper response to a non-final rejection.
- (E) The reply is proper.

April 15, 2003 AM

25. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following is not a proper basis on which the Board of Patent Appeals and Interferences may remand a case to the examiner?

- (A) Remand for a fuller description of the claimed invention.
- (B) Remand for a clearer explanation of the pertinence of the references.
- (C) Remand for a selection by the primary examiner of a preferred or best ground of rejection when multiple rejections of a cumulative nature have been made by the examiner.
- (D) Remand to the primary examiner with instructions to consider an affidavit not entered by the examiner which was filed after the final rejection but before the appeal.
- (E) Remand to the primary examiner to prepare a supplemental examiner's answer in response to a reply brief.

April 15, 2003 AM

37. Applicant properly appealed the primary examiner's final rejection of the claims to the Board of Patent Appeals and Interferences (Board). Claims 1 to 10 were pending in the application. The examiner did not reject the subject matter of claims 7 to 10, but objected to these claims as being dependent on a rejected base claim. Claim 1 was the sole independent claim and the remaining claims, 2 through 10, were either directly or indirectly dependent thereon. After a thorough review of Appellant's brief and the examiner's answer, the Board affirmed the rejection of claims 1 to 6. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following is the appropriate action for the examiner to take upon return of the application to his jurisdiction when the time for appellant to take further action under 37 CFR 1.197 has expired?

- (A) Abandon the application since the Board affirmed the rejection of independent claim 1.
- (B) Convert the dependent claims 7 to 10 into independent form by examiner's amendment, cancel claims 1 to 6, and allow the application.
- (C) Mail an Office action to applicant setting a 1-month time limit in which the applicant may rewrite dependent claims 7 to 10 in independent form. If no timely reply is received, the examiner should amend the objected to claims, 7 to 10, and allow the application.
- (D) Mail an Office action to applicant with a new rejection of claims 7 to 10 based on the Board's decision.
- (E) No action should be taken by the examiner since the Board affirmed the rejection of independent claim 1, the application was abandoned on the date the Board decision was mailed.

April 15, 2003 AM

45. An examiner's answer, mailed on January 2, 2003, contains a new ground of rejection in violation of 37 CFR 1.193(a)(2). If an amendment or new evidence is needed to overcome the new ground of rejection, what is the best course of action the appellant should take in accordance with the USPTO rules and the procedures set forth in the MPEP?

- (A) File a reply brief bringing the new ground of rejection to the attention of the Board of Patent Appeals and Interferences and pointing out that 37 CFR 1.193(a)(2) prohibits entry of the new ground of rejection.
- (B) File a timely petition pursuant to 37 CFR 1.181 seeking supervisory review of the examiner's entry of an impermissible new ground of rejection in the answer, after efforts to persuade the examiner to reopen prosecution or remove the new ground of rejection are unsuccessful.
- (C) File a reply brief arguing the merits of the new ground of rejection.
- (D) File an amendment or new evidence to overcome the new ground of rejection.
- (E) Ignore the new ground of rejection.

April 15, 2003 PM

23. The claims in a patent application having been twice or finally rejected, the applicant files a timely Notice of Appeal on January 2, 2003. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following situations should the USPTO not notify the applicant that the Appeal Brief is defective and allow him an opportunity to correct the deficiency?

- (A) The Appeal Brief is filed on July 10, 2003, without a request for extension of time under 37 CFR 1.136.
- (B) The Appeal Brief is submitted unsigned.
- (C) The Appeal Brief states that the claims do not stand or fall together, and presents argument as to why the claims are separately patentable, but the primary examiner does not agree with the applicant's argument.
- (D) The Appeal Brief does not state whether the claims stand or fall together, but presents arguments why the claims subject to the same rejection are separately patentable.
- (E) The Appeal Brief does not address one of the grounds of rejection stated by the primary examiner.

April 15, 2003 PM

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

- (A) When the subject matter of an appeal is particularly difficult to understand, a patentability report is prepared by an examiner in order to present the technical background of the case to the Board of Patent Appeals and Interferences.
- (B) In those appeals in which an oral hearing has been confirmed and either the Board of Patent Appeals and Interferences or the primary examiner has indicated a desire for the examiner to participate in the oral argument, oral argument may be presented by the examiner whether or not the appellant appears.
- (C) If a patent applicant files a notice of appeal which is unsigned, it will be returned for signature, but the applicant will still receive the filing date of the unsigned notice of appeal.
- (D) Statements made in information disclosure statements are not binding on an applicant once the patent has issued since the sole purpose of the statement is to satisfy the duty of disclosure before the Office.
- (E) None of the above.

April 15, 2003 PM

38. In accordance with USPTO rules and the procedures set forth in the MPEP, an amendment filed with or after a notice of appeal under 37 CFR 1.191(a), but before jurisdiction has passed to the Board of Patent Appeals and Interferences, should be entered by the primary examiner where the amendment:

- (A) requests unofficial consideration by the examiner.
- (B) is less than six pages long.
- (C) removes issues from appeal.
- (D) presents more specific claims, because it is believed that they may have a better chance of being allowable even though the claims do not adopt the examiner's suggestions.
- (E) introduces new issues, allowing the examiner to rethink his position.

October 16, 2002 PM

21. In accordance with the MPEP and USPTO rules and procedure, an applicant for a patent dissatisfied with the primary examiner's decision may appeal to the Board of Patent Appeals and Interferences ("the Board") in certain situations. In which of the following situations may the applicant properly appeal to the Board?

- (A) Applicant's claims have been twice objected to, but have not been rejected.
- (B) Applicant's claims have been rejected once in a non-final Office action during examination of a parent application, and once in a non-final Office action during examination of a continuing application.
- (C) Applicant's claims in an original application have been rejected only once.
- (D) Applicant's claims have been objected to only once, and have been rejected only once in a non-final Office action.
- (E) All of the above.

April 17, 2002 PM

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

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

October 17, 2001 AM

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

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

October 17, 2001 AM

20. Which of the following is true?

- (A) The statement, "Whether claims 1 and 2 are unpatentable," complies with the requirement of 37 CFR 1.192(c)(6) for a concise statement in the appeal brief of the issues presented for review.
- (B) A reissue application may be filed in order to broaden claims back to their original form where the claims were mistakenly narrowed during the original prosecution to avoid the prior art provided that the narrowing of the claims was made without deceptive intent on the part of the applicant.
- (C) Following a new ground of rejection raised by the Board of Patent Appeals and Interferences, the applicant may request a rehearing, or submit an appropriate amendment of the rejected claims or a showing of facts relating to the rejected claims.
- (D) If the Board of Patent Appeals and Interferences decides to require an appellant to address a particular matter, and the appellant cannot respond within the time period set, he may obtain an extension of time by paying the requisite fee.

- (E) In an *ex parte* reexamination proceeding of a patent that arises from an application filed in the United States before November 29, 1999, a third party requester who is dissatisfied with a decision of the Board of Patent Appeals and Interferences may seek judicial review by appeal to either the U.S. Court of Appeals for the Federal Circuit or by civil action in the U.S. District Court for the District of Columbia.

October 17, 2001 PM

31. Zak had expended a considerable amount of money, time, and effort in the pursuit of patent protection for an invention that he had conceived of many years before. His sacrifices had been large and his frustration and disappointment could be observed in the expression on his face when his attorney informed him that the Board of Patent Appeals and Interferences (“BPAI”) issued a decision on February 19, 2001, affirming the examiner’s rejection of all the claims in his application. Zak didn’t even think twice when he directed his attorney to immediately file a Request for Rehearing or Reconsideration. Assuming action on the Request for Rehearing or Reconsideration is unfavorable to Zak, which of the following options is available to Zak?

- (A) File a Notice of Appeal to the Court of Appeals of the Federal Circuit (“CAFC”) within 6 months of the BPAI decision, accompanied by a request for extension of time under 37 CFR 1.136 and the appropriate fee.
- (B) File a Notice of Appeal to the U.S. District Court of the District of Columbia (“DDC”) within 5 months of the BPAI decision, accompanied by a request for extension of time under 37 CFR 1.136 and the appropriate fee.
- (C) File a Notice of Appeal to the Court of Appeals of the Federal Circuit (“CAFC”) within 6 months after action on the Request for Rehearing or Reconsideration, accompanied by a request for extension of time under 37 CFR 1.136 and the appropriate fee.
- (D) File a Notice of Appeal to the U.S. District Court of the District of Columbia (“DDC”) within 5 months after action on the Request for Rehearing or Reconsideration, accompanied by a request for extension of time under 37 CFR 1.136 and the appropriate fee.
- (E) File a Notice of Appeal to the U.S. District Court of the District of Columbia (“DDC”) within 2 months after action on the Request for Re hearing or Reconsideration.

April 18, 2001 AM

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

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

April 18, 2001 AM

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

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

April 18, 2001 PM

29. Which of the following is true?

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

October 18, 2000 AM

2. On December 31, 1998, Sam Practitioner files a notice of appeal in a patent application assigned to ABC Corp. after the examiner has rejected all of the claims on prior art. Within two months he sends in his appeal brief and three months after the examiner’s answer is filed the case is sent to the Board of Patent Appeals and Interferences (Board). Subsequently, while reading the Official Gazette Sam notices that a patent issued to XYZ Corp. on October 26, 1999, contains claims which read on an unclaimed embodiment in the ABC application, which is an invention that is not within the scope of the invention claimed in the ABC application. The ABC application was filed one month after the issuance of the XYZ patent. Upon learning of the XYZ patent, ABC Corp. wants to provoke an interference by adding additional claims to its application relating to the previously unclaimed embodiment. It is October 18, 2000 and Sam comes to you for advice. Which of the following is the best and correct course of action?

- (A) Since the ABC application is at the Board of Patent Appeals and Interferences already, Sam need only request that the case be transferred to the Interference part of the Board where an interference can be declared between the ABC application and the XYZ patent.
- (B) Sam should file an amendment adding the claims copied from the XYZ patent and the Board is required to enter the amendment.

- (C) Sam should promptly file an amendment containing the claims copied from the XYZ patent and request entry. If the Board declines to enter the amendment, Sam should file a separate, continuation application no later than October 26, 2000, containing the claims copied from the XYZ patent as well as claims previously appealed, and then, to avoid the rendering of a decision of the Board, he should promptly inform the clerk of the Board in writing that they have decided to refile and abandon the application containing an appeal waiting a decision.
- (D) Sam should file an amendment containing the claims copied from the XYZ patent and ask that the interference between the ABC application and the XYZ patent be considered while the case is at the Board.
- (E) Sam should wait until the appeal is decided before filing an amendment to incorporate claims copied from the XYZ patent and to provoke an interference. There is no benefit to filing new claims since only allowable claims will be considered during an interference.

October 18, 2000 AM

22. Which of the following is true?

- (A) When the subject matter of an appeal is particularly difficult to understand, a patentability report is prepared by an examiner in order to present the technical background of the case to the Board of Appeals and Patent Interferences.
- (B) In those appeals in which an oral hearing has been confirmed and either the Board of Appeals and Patent Interferences or the primary examiner has indicated a desire for the examiner to participate in the oral argument, oral argument may be presented by the examiner whether or not the appellant appears.
- (C) If a patent applicant files a notice of appeal which is unsigned, it will be returned for signature, but the applicant will still receive the filing date of the unsigned notice of appeal.
- (D) Statements made in information disclosure statements are not binding on an applicant once the patent has issued since the sole purpose of the statement is to satisfy the duty of disclosure before the Office.
- (E) None of the above.

October 18, 2000 AM

41. Which of the following is true?

- (A) The statement, "Whether claims 1 and 2 are unpatentable," complies with the requirement of 37 C.F.R. § 1.192(c)(6) for a concise statement in the appeal brief of the issues presented for review.
- (B) A reissue application may be filed in order to broaden claims back to their original form where the claims were mistakenly narrowed during the original prosecution to avoid the prior art provided that the narrowing of the claims was made without deceptive intent on the part of the applicant.

- (C) If the Board of Patent Appeals and Interferences decides to require an appellant to address a particular matter, and the appellant cannot respond within the time period set, he may obtain an extension of time by paying the requisite fee.
- (D) Following a new ground of rejection raised by the Board of Patent Appeals and Interferences, the applicant may request a rehearing, or submit an appropriate amendment of the rejected claims or a showing of facts relating to the rejected claims.
- (E) In an *ex parte* reexamination proceeding, a third party requester who is dissatisfied with a decision of the Board of Patent Appeals and Interferences may seek judicial review by appeal to either the U.S. Court of Appeals for the Federal Circuit or by civil action in the U.S. District Court for the District of Columbia.

October 18, 2000 AM

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

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

October 18, 2000 AM

49. Which of the following is true?

- (A) When an applicant petitions to make his case special, he forfeits the opportunity to request an oral hearing if he should decide to appeal his application to the Board of Patent Appeals and Interferences.
- (B) An oral hearing is a good way to argue a case before the Board of Patent Appeals and Interferences as an appeal decided by an oral hearing is likely to be given closer consideration by the Board of Appeals and Patent Interferences than those without such a hearing.
- (C) During an appeal to the Board of Appeals and Patent Interferences, it is a good idea to schedule the oral hearing before filing a reply brief so that if questions arise at the hearing they may be responded to in the reply brief.
- (D) A rehearing of an appeal involves conducting an oral hearing a second time.
- (E) None of the above.

October 18, 2000 PM

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

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

April 12, 2000 PM

24. Adam is a foreign national legally residing in Baltimore, Maryland. Before moving to the United States, Adam filed a United States patent application. The claims in the application were finally rejected by the examiner. The rejection was affirmed on appeal to the Board of Patent Appeals and Interferences. Adam remains convinced that the rejection is incorrect and wishes to pursue further review. Which of the following will properly consider a request by Adam for official review of the decision by the Board of Patent Appeals and Interferences?

- (A) The Commissioner of Patents and Trademarks.
- (B) The Chairman of the Board of Patent Appeals and Interferences.
- (C) The Director of Patent Quality Review.
- (D) The United States Secretary of Commerce.
- (E) None of the above.

November 3, 1999 AM

16. When does jurisdiction over an application normally transfer from the examining group to the Board of Patent Appeals and Interferences?

- (A) After the examiner has notified the appellant by written communication that the reply brief has been entered and considered, and that the application will be forwarded to the Board.
- (B) After a supplemental examiner's answer, pursuant to a remand from the Board, has been mailed.
- (C) After 2 months from the examiner's answer, plus mail room time, if no reply brief has been timely filed.
- (D) (A), (B), or (C).
- (E) (A) or (C).

Chapter 1200

Answers

April 15, 2003 AM

8. ANSWER: (E) is the most correct answer. MPEP § 1205, under the heading “Appeal By Patent Applicant,” states that “[a] notice of appeal may be filed after any of the claims has been twice rejected, regardless of whether the claim(s) has/have been finally rejected. The limitation of ‘twice or finally...rejected’ does not have to be related to a particular application. For example, if any claim was rejected in a parent application, and the claim is again rejected in a continuing application, then applicant will be entitled to file an appeal in the continuing application, even if the claim was rejected only once in the continuing application.” (A), (B), (C), and (D) are not the most correct answer because a notice of appeal can be filed in a continuing application where at least one of the rejected claims was twice rejected, and one of the rejections may occur in the parent application.

April 15, 2003 AM

25. ANSWER: (D) is the most correct answer. See MPEP § 1211.02. (D) is not a proper basis for remand because the Board has no authority to require the examiner to consider an affidavit which has not been entered after final rejection and which was filed while the application was pending before the examiner. Pursuant to 37 CFR § 1.195, “[a]ffidavits...submitted after the case has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented.” The facts are silent regarding whether such a showing was made. However, as discussed in MPEP § 715.09, “Review of an examiner’s refusal to enter [and consider] an affidavit as untimely is by petition and not by appeal to the Board of Patent Appeals and Interferences. In re Deters, 515 F.2d 1152, 185 USPQ 644 (CCPA 1975); Ex parte Hale, 49 USPQ 209 (Bd. App. 1941).” Thus, remand by the Board cannot be expected. Support for each of answers (A), (B), (C) and (E) is specifically provided for in MPEP § 1211.

April 15, 2003 AM

37. ANSWER: (A) is the most correct answer. MPEP § 1214.06, under the heading “Examiner Sustained in Whole or in Part.” Under the heading “No Claims Stand Allowed” it states “Claims indicated as allowable prior to appeal except for their dependency from rejected claims will be treated as if they were rejected.” (B) and (C) are not the most correct answers. These options would apply to applications where the Board reversed the rejection of the dependent claims and affirmed the rejection of the independent claim. (D) is not correct. The Board does not render a decision on objected to claims. See 37 CFR § 1.191(c). (E) is not correct because the mailing of a Board decision does not abandoned an application. See 37 CFR § 1.197(a).

April 15, 2003 AM

45. ANSWER: (B) is the most correct answer. MPEP § 1208.01 states: “Any allegation that an examiner’s answer contains an impermissible new ground of rejection is waived if not timely (37 CFR 1.181(f)) raised by way of a petition under 37 CFR 1.181(a).” Thus, to avoid waiver of the right to contest the examiner’s action, the appellant must file a timely petition. (A) is incorrect because the question of whether an answer contains a new ground of rejection is a petitionable, not appealable, matter. See MPEP § 1201. (C) is incorrect because an amendment or new evidence is needed to overcome the new ground of rejection and merely presenting arguments will not succeed. (D) is incorrect because the entry of the

amendment or evidence is subject to the provisions of 37 CFR §§ 1.116 and 1.195 and there is no assurance that the examiner will approve entry. (E) is incorrect because it will constitute a waiver on the question of whether an impermissible new ground of rejection has been entered.

April 15, 2003 PM

23. ANSWER: (C) is the most correct answer. See MPEP § 1206, specifically the Examiner Note for Form Paragraph 12.69.01 (“This form paragraph should be used only when no supporting reasons are presented in the brief.”). If the examiner disagrees with the reasons given, the reason for disagreement should be addressed in the Examiner’s Answer. As discussed at MPEP § 1208, in the Examiner Note 2 for Form Paragraph 12.55.01 “If the brief includes a statement that a grouping of claims does not stand or fall together but does not provide reasons, as set forth in 37 CFR 1.192(c)(7), [the examiner is to] notify appellant of the non-compliance using form paragraphs 12.69, 12.69.01 and 12.78.” As discussed at MPEP § 1208, in the Examiner Note for Form Paragraph 12.55.02, if the examiner disagrees with appellant’s statement in the brief that certain claims do not stand or fall together, the examiner explains in the examiner’s answer why the claim grouping listed in the brief is not agreed with and why, if appropriate, *e.g.*, the claims as listed by the appellant are not separately patentable. Answer (A) is incorrect. See MPEP § 1206, Form paragraph 12.17. The Appeal Brief was filed less than seven months after the Notice of Appeal was filed. The applicant should be notified of the deficiency and provided an opportunity to request a five-month extension of time. Answer (B) is incorrect. See MPEP § 1206, Form paragraph 12.12. Answer (D) is incorrect. Where the applicant omits the statement required by 37 CFR § 1.192(c)(7) yet presents arguments in the argument section of the brief, the applicant should be notified of the noncompliance and given time to correct the deficiency. See 37 CFR § 1.192(c)(7); and MPEP § 1206, under the heading “Appeal Brief Content,” subheading “7. Grouping of Claims,” wherein it states, “Where, however, the appellant (A) omits the statement required by 37 CFR 1.192(c)(7) yet presents arguments in the argument section of the brief...the appellant should be notified of the noncompliance as per 37 CFR 1.192(d). *Ex parte Schier*, 21 USPQ2d 1016 (Bd. Pat. App. & Int. 1991); *Ex parte Ohsumi*, 21 USPQ2d 1020 (Bd. Pat. App. & Int. 1991).” See also MPEP § 1206, under the heading “Review of Brief By Examiner,” wherein it states that “if a brief is filed which does not comply with all the requirements of [37 CFR § 1.192](c), the appellant will be notified of the reasons for noncompliance. Appellant will be given the longest of any of the following time periods to correct the defect(s): (A) 1 month or 30 days from the mailing of the notification of non-compliance, whichever is longer; (B) within the time period for reply to the action from which appeal has been taken; or (C) within 2 months from the date of the notice of appeal under 37 CFR 1.191.” Answer (E) is incorrect. MPEP § 1206, under the heading “Appeal Brief Content,” states “Where an appeal brief fails to address any ground of rejection, appellant shall be notified by the examiner that he or she must correct the defect by filing a brief (in triplicate) in compliance with 37 CFR 1.192(c).”

April 15, 2003 PM

31. ANSWER: (B) is the most correct answer. See MPEP § 1209, under the heading “Participation by Examiner.” As to (A), see MPEP § 705. As to (C) signature requirement does not apply. 37 C.F.R. § 1.196(b); MPEP § 1205. The notice will not be returned. As to (D), see *Gentry Gallery v. Berkline Corp.*, 134 F.3d 1473, 45 U.S.P.Q.2d 1498 (Fed. Cir. 1998).

April 15, 2003 PM

38. ANSWER: (C) is the most correct answer. See 37 CFR § 1.116; MPEP § 1207, first paragraph. Answers (A), (B), and (D) are purely fictional. With respect to answer (E), see MPEP § 1207, first paragraph.

October 16, 2002 PM

21. ANSWER: Choice (B) is the correct answer. MPEP § 1205, and 37 C.F.R. § 1.191(a). MPEP § 1205 states that “A notice of appeal may be filed after any of the claims has been twice rejected, regardless of whether the claim(s) has/have been finally rejected. The limitation of ‘twice or finally...rejected’ does not have to be related to a particular application. For example, if any claim was rejected in a parent application, and the claim is again rejected in a continuing application, then applicant will be entitled to file an appeal in the continuing application, even if the claim was rejected only once in the continuing application.” Choices (A), (C), and (D) are each incorrect because Applicant’s claims were not twice or finally rejected. 37 C.F.R. § 1.191(a). MPEP § 706.01 in pertinent part provides, “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.” Choice (E) is incorrect because Choices (A), (C), and (D) are incorrect.

April 17, 2002 PM

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

October 17, 2001 AM

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

original period, as opposed to being added to the day it would have been due when said last day is a Saturday, Sunday, or Federal holiday.

October 17, 2001 AM

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

October 17, 2001 PM

31. ANSWER: (E) is correct because the statement is supported by 37 CFR 1.304(a)(1). (A), (B), (C), and (D) are wrong because 37 CFR 1.304(a)(1) and MPEP § 1216 indicate that the time period for appeal is 2 months from the BPAI decision or from action on the request, and 37 CFR 1.304(a)(2) provides that the 2 month time period is not subject to the provisions of 37 CFR 1.136.

April 18, 2001 AM

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

April 18, 2001 AM

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

April 18, 2001 PM

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

October 18, 2000 AM

2. ANSWER: (C). 35 U.S.C. § 135(b) requires that the claim be made in the ABC patent within one year of the issuance of the XYZ patent. MPEP § 1211.01 states that there is no obligation resting on the Board to consider new or amended claims submitted while the case is on appeal. MPEP § 1210 states that when an application is refiled, the Board should be promptly notified. Failure to notify the Board may result in the Board’s refusing an otherwise proper request to vacate its decision. See also MPEP § 2307.03. (E) is incorrect as 35 U.S.C. § 135(b) requires the claim to be made within one year. (D) is incorrect because the Board may refuse the amendment and because the claims have not yet been determined to be allowable. Note that the XYZ patent was filed before the ABC application and is therefore prior art under 35 U.S.C. § 102(e). See MPEP § 2306 and 2307.02. (A) is incorrect because the claims are not in the application, no interference could be declared and such a “transfer” is not feasible. (B) is incorrect because the Board is not required to enter the amendment and Sam may forfeit his opportunity to present the claims within one year if he does not act promptly (as in answer (C)).

October 18, 2000 AM

22. ANSWER: (B). See MPEP § 1209, p.1200-23, “Participation by Examiner.” As to (A), see MPEP § 705. As to (C) signature requirement does not apply. 37 C.F.R. § 1.196(b); MPEP § 1205. The notice will not be returned. As to (D), see *Gentry Gallery v. Berkline Corp.*, 134 F.3d 1473, 45 U.S.P.Q.2d 1498 (Fed. Cir. 1998)

October 18, 2000 AM

41. ANSWER: (D). See 37 C.F.R. § 1.196(b); MPEP § 1214.01. As to (A) see MPEP § 1206, p.1200-8, “(5) Summary of Invention.” As to (B), the recapture doctrine prevents claims from being recaptured. See MPEP § 1412.02. As to (C) see 37 C.F.R. § 1.196(d) and MPEP § 1212 where it states that failure to respond in time will result in dismissal of the appeal. As to (E), third party may not appeal. *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 11 USPQ2d 1866, 1869 (Fed. Cir. 1989) (a reexamination is conducted *ex parte* after it is instituted); *In re Opprecht*, 10 USPQ2d 1718 (Fed. Cir. 1989) (third parties do not participate before the USPTO).

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

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49. ANSWER: (E). As to (A), see MPEP § 708.02 where no such requirement is stated. See also, MPEP § at 1200-2 under Special Case. As to (B), see MPEP § 1209 and 37 C.F.R. § 1.194. As to (C), reply brief must be filed within two months of examiner’s Answer. MPEP § 1208.03. As to answer (D), see MPEP § 1214.03 at MPEP § 1200-28.

October 18, 2000 PM

42. ANSWER: (E) is the correct answer because there is compliance with 37 C.F.R. § 1.195. MPEP § 1211.02. (A) and (C) are wrong because jurisdiction has not passed to the Board. MPEP § 1210. (B) and (D) are wrong because a remand is an action by the Board when it has jurisdiction of the case. MPEP § 1211. Under the present facts, the Board has no jurisdiction. MPEP § 1210.

April 12, 2000 PM

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

November 3, 1999 AM

16. ANSWER: (D). MPEP § 1210.

Chapter 1300

Questions

April 15, 2003 PM

45. Al files an application for a patent. After the Notice of Allowance is mailed and the issue fee has been paid Al discovers a prior art reference which is material to patentability. What should Al do in accordance with the USPTO rules and the procedures set forth in the MPEP?

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

April 17, 2002 PM

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

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

April 18, 2001 AM

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

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

April 12, 2000 AM

33. Applicant filed a utility patent application in the PTO on Wednesday, June 8, 1994, and the examiner issued a requirement for restriction to one of two inventions claimed. On Wednesday, June 7, 1995, applicant then elected one of the inventions and filed a divisional application thereon in compliance with the requirements of 35 U.S.C. § 120. During prosecution of the divisional application, the examiner issued a Final Rejection, and following a successful appeal to the Board of Patent Appeals and Interferences by applicant, the application issued as a patent on Tuesday, February 11, 1997. Assuming all required maintenance fees are timely paid, on which of the following dates will the patent term end?

- (A) Tuesday, February 11, 2014.
- (B) Sunday, June 8, 2014.
- (C) Sunday, June 7, 2015.
- (D) Friday, August 8, 2014.
- (E) Friday, August 7, 2015.

Chapter 1300

Answers

April 15, 2003 PM

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

April 17, 2002 PM

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

April 18, 2001 AM

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

April 12, 2000 AM

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

Chapter 1400

Questions

April 15, 2003 AM

11. In accordance with the USPTO rules and procedures set forth in the MPEP, a Certificate of Correction effectuates correction of an issued patent where:

- (A) Through error and without deceptive intent, there is a failure to make reference to a prior copending application according to 37 CFR 1.78, and the failure does not otherwise affect what is claimed, but the prior copending application is referenced in the record of the application, and a petition under 37 CFR 1.324 and appropriate fees were filed.
- (B) Through error and without deceptive intent, a preferred embodiment that materially affects the scope of the patent was omitted in the original disclosure in the filed application, and a petition under 37 CFR 1.324 and appropriate fees were filed.
- (C) Through error and without deceptive intent, a prior copending application is incorrectly referenced in the application, the incorrect reference does not otherwise affect the claimed subject matter, and the prior copending application is correctly identified elsewhere in the application file, and a petition under 37 CFR 1.324 and appropriate fees were filed.
- (D) Through error and without deceptive intent, an inventor's name is omitted from an issued patent, a petition under 37 CFR 1.324 and appropriate fees were filed, and the petition was granted.
- (E) (A), (C) and (D).

April 15, 2003 AM

13. In accordance with the USPTO rules and the procedures set forth in the MPEP, impermissible recapture in an application exists _____

- (A) if the limitation now being added in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.
- (B) if the limitation now being omitted or broadened in the present continuation was originally presented/argued/stated in a parent application to make the claims allowable over a rejection or objection made in the parent application.
- (C) if the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.
- (D) if the limitation now being omitted or broadened in the present reissue was being broadened for the first time more than two years after the issuance of the original patent.
- (E) None of the above.

April 15, 2003 AM

35. Igor filed a design patent application in the USPTO on January 24, 2000, which issued as a design patent on January 23, 2001. Igor's design patent covered a design that became immediately popular, resulting in numerous inquiries for licenses from various manufacturers. Igor would like to financially exploit his patent by licensing for five years. However, Igor has decided to dedicate five years of his patent term to the public. Which of the following is in accord with the USPTO rules and the procedures set forth in the MPEP, while best allowing Igor to pursue his intentions?

- (A) Record in the USPTO an assignment of all right, title, and interest in the patent to the public, conditioned on the receipt by Igor of all royalties from licensing the patent after the first five years of the patent term.
- (B) File a disclaimer in the USPTO dedicating to the public the first five years of the patent term.
- (C) File a disclaimer in the USPTO dedicating to the public that portion of the term of the patent from January 24, 2015 to January 24, 2020.
- (D) File a disclaimer in the USPTO dedicating to the public half of all royalties received from licensing the patent for the terminal part of the term of the patent.
- (E) File a disclaimer in the USPTO dedicating to the public that portion of the term of the patent from January 24, 2010 to January 23, 2015.

April 15, 2003 PM

6. In accordance with the USPTO rules and the procedures of the MPEP, which of the following is true?

- (A) If after the filing of a reissue application no errors in the original patent are found, a reissue patent will be granted on the reissue application noting no change, and the original patent will be returned to the applicant.
- (B) In order to add matter not previously found in the patent, a continuation-in-part reissue application must be filed.
- (C) In a reissue application, additions and deletions to the original patent should be made by underlining and bracketing, respectively, except for changes made in prior Certificates of Correction and disclaimer(s) of claims under 37 CFR 1.321(a).
- (D) A dependent claim may be broadened in a reissue application only in the first two years of the enforceable life of the patent.
- (E) (A), (B), and (C).

April 15, 2003 PM

14. Mark Twine obtains a patent directed to a machine for manufacturing string. The patent contains a single claim (Claim 1) which recites six claim elements. The entire interest in Twine's patent is assigned to the S. Clemens String Co., and Twine is available and willing to cooperate with S. Clemens String Co. to file a reissue application. A subsequent reissue application includes Claim 2, which is similar to original Claim 1. However, one of the elements recited in Claim 2 is broader than its counterpart element in the original claim. The remaining five elements are narrower than their respective counterpart elements in the original patent claim. Which of the following scenarios accords with the USPTO rules and the procedures set forth in the MPEP?

- (A) The S. Clemens String Co. files the reissue application more than 2 years after the issue date of the original patent application.
- (B) The S. Clemens String Co. files the reissue application less than 2 years after the issue date of the original patent but more than 2 years after original application filing date.
- (C) Mark Twine files the reissue application less than 2 years after the issue date of the original patent but more than 2 years after original application filing date.
- (D) Mark Twine files the reissue application more than 2 years after the issue date of the original patent.
- (E) Mark Twine and the S. Clemens String Co. jointly file the reissue application more than 2 years after the issue date of the original patent.

October 16, 2002 AM

12. Inventor A filed a patent application and assigned the entire interest in the application to his employer, MegaCorp. The application issued as a utility patent on July 9, 2002. In June 2004, MegaCorp's management first learns that a second inventor, Inventor B, should have been named as a co-inventor with respect to at least one claim of the issued patent. There was no deceptive intent in failing to name Inventor B in the original application. Inventor A, who is unfamiliar with patent law and concepts of inventorship, incorrectly believes that he should be the sole named inventor on the patent, and refuses to cooperate with any effort by MegaCorp to change the named inventive entity. The issued patent contains no other error. In accordance with the Manual of Patent Examining Procedure, which of the following procedures is/are available for MegaCorp to seek correction of the named inventive entity without any agreement, cooperation or action from Inventor A?

- (A) File, on or before July 9, 2004, a reissue application, made by MegaCorp only, that seeks to add Inventor B.
- (B) File, after July 9, 2004, a reissue application, made by MegaCorp only, that seeks to add Inventor B.
- (C) Request a Certificate of Correction to add Inventor B as a named inventor.

- (D) Submit in the issued patent file: a Request for Correction of Inventorship Under the Provisions of 37 CFR 1.48 that sets forth the desired inventorship change; a statement by Inventor B that the error in inventorship occurred without deceptive intention on her part; an oath or declaration executed by Inventor B; all required fees; and the written consent of MegaCorp.
- (E) A and B are each available procedures.

October 16, 2002 AM

50. If a reissue application is filed within two years of the original patent grant, the applicant may subsequently broaden the claims during prosecution of the pending reissue prosecution beyond the two year limit, _____.

- (A) if the applicant indicates in the oath accompanying the reissue application that the claims will be broadened.
- (B) if an intent to broaden is indicated in the reissue application at any time within three years from the patent grant.
- (C) if the reissue application is filed on the 2-year anniversary date from the patent grant, even though an intent to broaden the claims was not indicated in the application at that time.
- (D) if the reissue application is a continuing reissue application of a parent reissue application, and neither reissue application contained an indication of an intent to broaden the claims until 4 years after the patent grant..
- (E) provided, absent any prior indication of intent to broaden, an attempt is made to convert the reissue into a broadening reissue concurrent with the presentation of broadening claims beyond the two year limit.

April 17, 2002 AM

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

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

April 17, 2002 AM

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

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

April 17, 2002 AM

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

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

- (D) acting *sua sponte*, after first notifying the patentee, for mistakes that the Office discovers.
- (E) only if patentee or the patentee's assignee makes a request.

April 17, 2002 PM

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

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

April 17, 2002 PM

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

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

October 17, 2001 PM

41. Mark Twine obtains a patent directed to a machine for manufacturing string. The patent contains a single claim (Claim 1) which recites six claim elements. The entire interest in Twine's patent is assigned to the S. Clemens String Co., and Twine is available and willing to cooperate with S. Clemens String Co. to file a reissue application. A subsequent reissue application includes Claim 2, which is similar to original Claim 1. However, one of the elements recited in Claim 2 is broader than its counterpart element in the original claim. The remaining five elements are narrower than their respective counterpart elements in the original patent claim. Which of the following scenarios accords with USPTO proper practice and procedure?

- (A) The S. Clemens String Co. files the reissue application more than 2 years after the issue date of the original patent application.
- (B) The S. Clemens String Co. files the reissue application less than 2 years after the issue date of the original patent but more than 2 years after original application filing date.
- (C) Mark Twine files the reissue application less than 2 years after the issue date of the original patent but more than 2 years after original application filing date.
- (D) Mark Twine files the reissue application more than 2 years after the issue date of the original patent.
- (E) Mark Twine and the S. Clemens String Co. jointly file the reissue application more than 2 years after the issue date of the original patent.

April 18, 2001 PM

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

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

April 18, 2001 PM

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

- (A) Although Sam's reissue application was filed within two years, Sam did not indicate his intention to broaden the claims until after the two year period had expired. Sam may not now file broader reissue claims.
- (B) Sam may file a second continuing reissue application with claims 11-20 as well as new claims 23-30. Sam would then cancel claims 11-20 from the first reissue application. The second reissue application would then issue and Sam could file a Notice of Appeal to the Board of Patent Appeals and Interferences in the first reissue application. Since the first application was filed within the two year time limit, Sam would not be subjected to a rejection for broadening his claims.

- (C) Since Sam's reissue application was filed within the two-year statutory time limit on broadening, Sam may add the additional claims 23 -30 to the reissue application.
- (D) Since Sam had only one patent and all reissue applications for the same patent must issue simultaneously, it would not be advantageous to file two reissue applications since they must issue at the same time.
- (E) Since the new invention was disclosed but not claimed in the original application, Sam may file claims directed to this new invention at any time during the life of the patent since claiming entirely different subject matter in entirely new claims does not constitute broadening as long as the original claims are not broadened.

April 18, 2001 PM

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

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

October 18, 2000 AM

8. Which of the following is true?

- (A) If after the filing of a reissue application no errors in the original patent are found, a reissue patent will be granted on the reissue application noting no change, and the original patent will be returned to the applicant.
- (B) In order to add matter not previously found in the patent, a continuation-in-part reissue application must be filed.

- (C) In a reissue application, additions and deletions to the original patent should be made by underlining and bracketing, respectively, except for changes made in prior Certificates of Correction and disclaimer(s) of claims under 37 C.F.R. §1.321(a).
- (D) A dependent claim may be broadened in a reissue application only in the first two years of the enforceable life of the patent.
- (E) (A), (B), and (C).

October 18, 2000 AM

13. A United States patent issued to inventor Smith on January 6, 1998. The Smith patent had a total of nine claims, with claim 1 being the only independent claim. Smith subsequently became aware of prior art that was not before the examiner that likely invalidated claim 1 of the patent. Accordingly, Smith properly filed a narrowing reissue application on September 30, 1999 along with a reissue oath stating that he believed the original patent to be wholly or partly invalid by reason of the patentee claiming more than he had the right to claim in the patent. As filed, the reissue application sought to narrow the first limitation of claim 1 to distinguish over the new prior art. Claims 2 through 9 were rewritten in independent form. On March 15, 2000, while preparing a reply to an Office action in the reissue application, Smith determined that he would like to add further claims to provide a desired range of patent protection. Thus, on March 17, 2000, Smith submitted an amendment that, *inter alia*, added new claims 10-19 to the reissue application, with claims 10 and 16 being presented in independent form. Each of claims 10-15 was narrower than original claim 1 in certain aspects, but broader than original claim 1 in other aspects. Each of claims 16-19 was narrower than claim 1 in all aspects, and was fully supported by the original reissue oath. Smith also submitted on March 17 a supplemental reissue oath stating that he believed the original patent to be wholly or partly inoperative by reason of the patentee claiming less than he had the right to claim in the patent. Which of the following best describes a likely action by the examiner in response to the amendment?

- (A) Each of claims 10-19 is rejected as being improper since the claims were added after the two-year anniversary of the original patent issuance.
- (B) Each of claims 10-19 is examined on the merits.
- (C) Claims 10-15 are rejected as being improper because they improperly seek to broaden the invention claimed in the original patent, and need not be further examined on their merits, but claims 16-19 are examined on the merits.
- (D) Claims 16-19 are examined on the merits, and claims 10-15 are examined on the merits if there is no prosecution history estoppel during the original prosecution relating to the broadened aspects of the claims.
- (E) None of the above.

October 18, 2000 AM

17. In June 1997, Rene invents a circuit board device which automatically logs a computer onto the Internet without the need for entering passwords. During the prosecution of the patent for the circuit board device, Rene's patent practitioner files the following claims 1 and 2:

1. An electronic device for automatically logging onto the Internet comprising: communication means for communicating on the Internet, said communication means further comprising circuit means for automatically entering a password, and storage means for automatically storing a password for logging onto the Internet.
2. The device of claim 1 wherein the communication means is a desktop computer.

During the patent prosecution, the examiner cites as prior art a telephone with a memory, which automatically dials a telephone number. The examiner reasons that because the telephone can store the number in its memory, it would have been obvious to store a password in the memory as well. The examiner objects to claim 2 as being dependent upon a rejected claim. Being very eager to get patent protection and low on financial resources, Rene instructs the practitioner to combine claims one and two and allow the application to issue. One year and one day after issuance, Rene comes to you, a patent attorney, inquiring if her patent reads on a widely distributed, hand-held, pocket sized, portable device that is not a telephone and does not use a desktop computer to access the Internet automatically without a password, and if not, what corrective action is available. Which of the following choices is the best advice for Rene?

- (A) Since the two-year period for broadening has not expired, Rene may file a reissue with a declaration stating that the failure to claim more was due to error without deceptive intent. Rene may broaden her claims to the extent permitted by the prior art, since at no time did she narrow her claims to avoid the prior art.
- (B) Since the prior art device was a telephone, Rene is entitled to seek patent protection on all that which is not in the prior art. Rene should be able to obtain broadened patent protection by reissue of the patent.
- (C) Since Rene's original claim 1 was broadly written and since Rene narrowed her scope of patent protection by incorporating the limitations of the original claim 2 during the original prosecution, she is barred by the doctrine of recapture from enlarging her claims to the scope of the original claim 1.
- (D) Although Rene narrowed her claims during the original prosecution, she can file a declaration stating that the narrowing of her claims was not because she believed the prior art precluded her from claiming more but due to financial concerns. Therefore, the narrowing of the claim was error without deceptive intent and Rene may file a reissue seeking broader claims.
- (E) Rene should file a request for reexamination seeking to enlarge the scope of her patent protection.

October 18, 2000 AM

20. Assume a “claim” for the benefit of an earlier filing date in a foreign country under 35 U.S.C. § 119(a)-(d) was made and a certified copy of the foreign application was filed in a corresponding U.S. application on which the original U.S. patent was granted, and the benefit of priority is desired in a reissue patent application. Which of the following statements accords with proper USPTO practice and procedure?

- (A) It is unnecessary to make such claim in the reissue application.
- (B) It is unnecessary to make such claim in the reissue application provided a certified copy of the foreign application is provided in the reissue application.
- (C) It is unnecessary to make such claim in a reissue application provided the oath or declaration identifies the foreign application and its filing date.
- (D) It is necessary to make such claim in the reissue application, and in addition, the oath or declaration must identify the foreign application on which priority is claimed, and any foreign applications having a filing date before that of the application on which priority is claimed.
- (E) It is necessary to make such claim in the reissue application, and in addition, a certified copy of the foreign application must be provided in the reissue application.

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26. In a reissue patent application, which of the following statements is correct?

- (A) It is unnecessary to claim the benefit of an earlier filing date in a foreign country in order to gain the benefits of 35 U.S.C. § 119(a) - (d) so long as such a claim was made in the application on which the original patent was granted.
- (B) New matter, that is, matter not present in the patent sought to be reissued, may be included in a reissue application in accordance with 35 U.S.C. § 251.
- (C) No additional certified copy of the foreign application is necessary if a claim for the benefit of an earlier filing date in a foreign country under 35 U.S.C. § 119(a)-(d) is made in a reissue application as well as in the application on which the original patent was granted.
- (D) The recapture rule permits a patentee to acquire through reissue claims that are, in all respects, of the same scope as, or are broader than, those claims canceled from the original application to obtain a patent.
- (E) A practitioner’s failure to appreciate the full scope of the invention is not an error correctable through reissue.

October 18, 2000 AM

29. Which, if any, of the following statements relating to amendments of claims in reissue applications accords with proper USPTO practice and procedure?

- (A) To distinguish cancellation of an original patent claim from a claim previously added in the reissue, it is necessary to direct cancellation of the latter by the statement: Cancel reissue claim [recite number].
- (B) Each claim not found in the patent that is newly presented in the reissue application should be presented in brackets.
- (C) In amending original patent claims more than once, the second amendment need not include the changes previously presented in the first amendment.
- (D) Since matter not present in the patent sought to be reissued is excluded from a reissue application, changes made to the claims require an explanation in the Remarks.
- (E) None of the above.

October 18, 2000 AM

36. In July 1999, Pete Practitioner files a reissue application for Sam's patent on a combination washing machine and dryer, which issued on August 5, 1997. The original 20 claims are filed in the reissue application along with two additional dependent claims. The declaration indicates that there was error without deceptive intent in that applicant failed to claim the subject matter of the two newly added dependent claims. Sam also indicates in the declaration that he has no intention doing anything other than adding the two dependent claims. In September 1999 the examiner allows claims 1-10 of the reissue but rejects claims 11-22. Sam is eager to enforce claims 1-10 against a competitor but does not want to give up prosecuting claims 11-22. Sam also wants to add additional claims 23-30 directed to an entirely different invention, which was disclosed in the patent but not claimed. To claim the new invention, Sam must file new independent claims, which claim subject matter not previously claimed. Pete practitioner has retired and Sam comes to you for advice. Which of the following is true?

- (A) Sam may file a second continuing reissue application with claims 11-20 as well as new claims 23-30. Sam would then cancel claims 11-20 from the first reissue application. The second reissue application would then issue and Sam could file a Notice of Appeal to the Board of Patent Appeals and Interferences in the first reissue application. Since the first application was filed within the two year time limit, Sam would not be subjected to a rejection for broadening his claims
- (B) Since Sam's reissue application was filed within the two-year statutory time limit on broadening, Sam may add the additional claims 23 -30 to the reissue application.
- (C) Although Sam's reissue application was filed within two years, Sam did not indicate his intention to broaden the claims until after the two year period had expired. Sam may not now file broader reissue claims.

- (D) Since Sam had only one patent and all reissue applications for the same patent must issue simultaneously, it would not be advantageous to file two reissue applications since they must issue at the same time.
- (E) Since the new invention was disclosed but not claimed in the original application, Sam may file claims directed to this new invention at any time during the life of the patent since claiming entirely different subject matter in entirely new claims does not constitute broadening as long as the original claims are not broadened.

October 18, 2000 AM

50. Which of the following is true?

- (A) In order to have a reissue application expedited, the reissue applicant should file a Petition to Make Special.
- (B) Once a reissue issues, the date on which the maintenance fee is due is calculated from the date of issuance of the reissue certificate.
- (C) A dependent claim may not be broadened during a reexamination proceeding.
- (D) If the examiner raises a new ground of rejection in the Examiner's Answer, the applicant has the option of continuing with the appeal or asking that prosecution be reopened.
- (E) None of the above.

October 18, 2000 PM

3. Which of the following statements regarding amending a reissue application is not correct?

- (A) An entire paragraph in the specification other than the claims may be deleted by a statement deleting the paragraph without presentation of the text of the paragraph.
- (B) In a claim, hand entry of an amendment of five words or less is permitted.
- (C) Each amendment submission must set forth the status, on the date of the amendment, of all patent claims and of all added claims.
- (D) When responding to an Office action, each amendment when originally submitted must be accompanied by an explanation of the support in the disclosure of the patent for the amendment.
- (E) A new claim added by amendment must be presented with underlining throughout the claim.

April 12, 2000 AM

2. A Certificate of Correction effectuates correction of an issued patent where:

- (A) Through error and without deceptive intent, there is a failure to make reference to a prior copending application according to 37 C.F.R. § 1.78, and the failure does not otherwise affect what is claimed, but the prior copending application is referenced in the record of the application, and a petition under 37 C.F.R. § 1.324 and appropriate fees were filed.
- (B) Through error and without deceptive intent, a preferred embodiment that materially affects the scope of the patent was omitted in the original disclosure in the filed application, and a petition under 37 C.F.R. § 1.324 and appropriate fees were filed.
- (C) Through error and without deceptive intent, a prior copending application is incorrectly referenced in the application, the incorrect reference does not otherwise affect the claimed subject matter, and the prior copending application is correctly identified elsewhere in the application file, and a petition under 37 C.F.R. § 1.324 and appropriate fees were filed.
- (D) Through error and without deceptive intent, an inventor's name is omitted from an issued patent, a petition under 37 C.F.R. § 1.324 and appropriate fees were filed, and the petition was granted.
- (E) (A), (C) and (D).

April 12, 2000 AM

25. GMD Corp. files a patent application on a computer with a display screen which powers itself by solar panels. The examiner restricts the claims into two groups. Group 1 contains claims 1-5 directed to the combination of the computer and display screen. Group 2 contains claims 6-10 directed solely to the display screen. Practitioner Sam advises GMD Corp. that (a) the restriction requirement could be traversed since the inventions are not separate and distinct and (b) the restriction requirement may be traversed by adding patentable claims linking the two inventions. Nonetheless, GMD instructs Sam to delete claims 6-10 and file a divisional application incorporating claims 6-10. Sam deletes the claims 6-10, and the patent is granted on May 4, 1999 for claims 1-5. However, Sam inadvertently failed to file a divisional application. Today, April 12, 2000, GMD's president comes to you for advice as to how they can obtain patent protection for the subject matter in claims 6-10. Which of the following is the best advice you can offer in accordance with proper PTO practice and procedure?

- (A) GMD is barred from filing an application for claims 6-10 since during the original prosecution they deleted the very same claims following a restriction requirement.
- (B) Since GMD instructed Sam to file a divisional application and because his failure to do so was inadvertent, GMD may file a reissue application to obtain patent protection for those claims based upon inadvertent error without deceptive intent.

- (C) Since the restriction was made in the original case and not contested, a divisional reissue and appropriate fees must be filed to obtain patent coverage for claims 6-10.
- (D) Since the inventions were not separate and distinct, a reissue application and appropriate fees may be filed in which the restriction requirement may be traversed, and if successful, claims 6-10 can be added and entered.
- (E) Before one year transpires from the issuance of the patent, GMD should file a patent application containing claims directed to the same subject matter as deleted claims 6-10, and the appropriate fee.

April 12, 2000 AM

38. Inventor Charles patented a whirlwind device for defeathering poultry. Although the scope of the claims never changed substantively during original prosecution of the patent application, practitioner Roberts repeatedly argued that limitations appearing in the original claims distinguished the claimed subject matter from prior art relied upon by the examiner in rejecting the claims. After the patent issued, Charles realized that the claims were unduly narrow, and that the limitations argued by Roberts were not necessary to patentability of the invention. Accordingly, a timely application was made for a broadened reissue patent in which Charles sought claims without limitations relied upon by Roberts during original prosecution. The new claims were properly supported by the original patent specification. Charles asserted in his reissue oath that there was an error in the original patent resulting from Roberts' failure to appreciate the full scope of the invention during original prosecution of the application. No supporting declaration from Roberts was submitted in the reissue application. Based on the foregoing facts and controlling law, which of the following statements is most accurate?

- (A) Although the scope of the claims was not changed substantively during prosecution of the original patent, the recapture doctrine may preclude Charles from obtaining the requested reissue because of the repeated arguments made by practitioner Roberts.
- (B) The recapture doctrine cannot apply because the claims were not amended substantively during original prosecution.
- (C) The reissue application will not be given a filing date because no supporting declaration from practitioner Roberts was submitted.
- (D) The doctrine of prosecution history estoppel prevents Charles from seeking by reissue an effective claim scope that is broader than the literal scope of the original claims.
- (E) The doctrine of late claiming prevents Charles from seeking an effective claim scope broader than the literal scope of the original claims.

April 12, 2000 AM

39. Impermissible recapture in an application exists _____

- (F) if the limitation now being added in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.
- (G) if the limitation now being omitted or broadened in the present continuation was originally presented/argued/stated in a parent application to make the claims allowable over a rejection or objection made in the parent application.
- (H) if the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.
- (I) if the limitation now being omitted or broadened in the present reissue was being broadened for the first time more than two years after the issuance of the original patent.
- (J) None of the above.

April 12, 2000 AM

46. Which of the following statements regarding amending a reissue application is not correct?

- (A) In a claim, hand entry of an amendment of five words or less is permitted.
- (B) Each amendment submission must set forth the status, on the date of the amendment, of all patent claims and of all added claims.
- (C) An entire paragraph in the specification other than the claims may be deleted by a statement deleting the paragraph without presentation of the text of the paragraph.
- (D) When responding to an Office action, each amendment when originally submitted must be accompanied by an explanation of the support in the disclosure of the patent for the amendment.
- (E) A new claim added by amendment must be presented with underlining throughout the claim.

April 12, 2000 PM

39. A U.S. patent issued to Smith on January 6, 1998. Realizing that the claims of the issued patent were too narrow, Smith properly filed a broadening reissue application on September 30, 1999. On March 15, 2000, while preparing a reply to an Office action in the reissue application, Smith recognized that additional claims should be added to provide the desired range of patent protection. On March 17, 2000, Smith submitted an Amendment that, *inter alia*, added new claims 20-33 to the reissue application. Each of claims 20-22 was broader than the claims originally submitted on September 30, 1999, with the application for a broadened reissue. Each of claims 23-28 was narrower than the claims originally submitted on September 30, 1999, but broader than the original patent claims. Each of claims 29-33 was narrower than the original patent claims. The reissue oath originally filed with the reissue application is adequate to support the newly submitted claims. Which of the following best describes a proper action by the examiner in reply to the Amendment?

- (A) Each of claims 20-33 is rejected as being improper since the claims were added after the two-year anniversary of the original patent issuance.
- (B) Each of claims 20-33 is examined on the merits, but are not rejected for improperly broadening the reissue application after the two-year anniversary of the original patent issue.
- (C) Claims 20-28 are rejected as being improper because they were added after the two-year anniversary of the original patent issue, but claims 29-33 are examined on the merits.
- (D) Claims 20-22 are rejected as being improper because they were added after the two-year anniversary of the original patent issue, but claims 23-33 are examined on the merits.
- (E) Claims 20-28 are examined on the merits, but claims 29-33 are rejected as improper because this is a broadening reissue application and these claims are narrower than the original patent claims.

April 12, 2000 PM

45. You obtained a patent for inventor Jones. The patent, although disclosing a use for her invention, and the best mode contemplated by Jones at the time the application was filed for making and using her invention, through error and without deceptive intent, failed to describe an embodiment of her invention. The embodiment has become a commercial success. Eighteen months after the patent issued, you filed a reissue application adding a claim and new, necessary supporting disclosure directed to the omitted embodiment, together with Jones' declaration explaining the error, and other required papers. In accordance with proper PTO practice and procedure:

- (A) The claim is subject to a new matter rejection under 35 U.S.C. § 132.
- (B) The specification is subject to rejection under 35 U.S.C. § 101 for failure to disclose the best mode for achieving commercial success.
- (C) The claim is subject to a rejection under 35 U.S.C. § 251 and a rejection under 35 U.S.C. § 112, first paragraph.
- (D) The claim is allowable.
- (E) (B) and (D).

November 3, 1999 AM

45. Which of the following statements regarding a reissue patent application is *true*?

- (A) Only one reissue patent application is permitted to be issued for distinct and separate parts of the thing patented.
- (B) New matter may be properly added in a reissue application to correct an error made during the prosecution of the original patent application.
- (C) A reissue will not be granted to "recapture" claimed subject matter deliberately canceled in an application to obtain a patent.
- (D) To retain the benefit of priority under 35 U.S.C. § 119, it is not necessary to make a new claim for priority in the reissue patent application if a claim for priority was perfected in the application on which the original patent was made.
- (E) (C) and (D).

November 3, 1999 PM

5. On March 1, 1995, applicant filed a nonprovisional patent application for a stool. The original disclosure set forth that a base member of the stool was generally elliptical and, in particular, could be circular (a special kind of ellipse). It also stated that all leg members must be parallel to each other. The only claim included in the application stated as follows:

1. A stool for sitting on, comprising a circular shaped base member having a top surface and a bottom surface; said bottom surface having a center portion and three circular holes equally spaced about said center portion; and three leg members connected to said bottom surface, each hole having a leg member protruding therefrom.

In a first Office action rejection, the examiner rejected claim 1 under 35 U.S.C. § 102(e) as unpatentable over a U.S. Patent to Pigeon. The Pigeon patent specified that each of the leg members formed a thirty degree angle with each of the other leg members. Applicant filed a timely response to the Office action, amending the specification to state that the leg members could be substantially parallel and including guidelines for determining what would be considered “substantially parallel.” Applicant also amended claim 1 as follows:

1. (once amended) A stool for sitting on, comprising a circular shaped base member having a top surface and a bottom surface; said bottom surface having a center portion and three circular holes equally spaced about said center portion; and three leg members connected to said bottom surface, each hole having a leg member protruding therefrom, wherein the leg members are parallel to each other.

The examiner allowed Claim 1 as amended and a patent was granted to applicant on January 5, 1997. On January 5, 1999, applicant filed a reissue application, including a proper declaration pursuant to 37 CFR § 1.175. Assume that there is no other relevant prior art. In accordance with PTO rules and procedure, which of the following statements concerning the reissue application is true?

- (A) Any amendment to claim 1 so as to broaden its scope will likely be considered untimely.
- (B) If applicant amends claim 1 to replace “a circular shaped member” with “an elliptical shaped member,” then the amendment should be considered untimely since the amendment would broaden the scope of the claim.
- (C) If applicant amends claim 1 to delete “wherein the leg members are parallel to each other,” then the amended claim should be allowed.
- (D) If applicant amends claim 1 to replace “parallel” with “substantially parallel,” then the amended claim will likely be allowed.
- (E) None of the above.

November 3, 1999 PM

18. Bill wishes to amend the sole, original Claim 1 of the patent granted to him and obtain the following amended Claim 1. The amended Claim 1 set forth below is fully supported by the original disclosure in the application:

1. A computer processor comprising:
 - a. a plurality of registers divided into a global port subset and a local pool subset;
 - b. means for distinguishing a successful [unconditional] interruptable jump operation;
 - c. means for receiving interrupts or exceptions; and
 - d. an interrupt or exception handler for handling the interrupts or exceptions in response to distinguishing the [unconditional] interruptable jump operation [from the local pool subset].

In the absence of questions of recapture, novelty, obviousness, and utility, which of the following statements, if any, is true?

- (A) A claim so amended is properly presented during a reexamination proceeding where a request for reexamination was filed on September 9, 1999, and a certificate of reexamination may be issued where reexamination is sought of a patent granted on July 15, 1997.
- (B) A claim so amended is properly presented in a reissue application filed on September 9, 1999, and a reissue patent is grantable where reissuance is sought of a patent granted on July 15, 1997.
- (C) A claim so amended is properly presented in a reissue application filed on September 9, 1999, and a reissue patent is grantable where reissuance is sought of a patent granted on November 18, 1997.
- (D) A claim so amended is properly presented in a request for reexamination filed on September 9, 1999, and a certificate of reexamination may be issued where reexamination is sought of a patent granted on November 18, 1997.
- (E) A claim so amended is properly presented in a reissue application filed any time before expiration of the term of the patent inasmuch as the scope of Claim 1 in the original patent is narrowed by replacing the word “unconditional” with the word “interruptable.”

November 3, 1999 PM

27. On April 21, 1998, a patent was issued to Belinda on a novel switching circuit. Shortly after receiving the patent grant, Belinda assigned 50% of her right, title and interest in her patent to Ace and 25% of the right, title and interest to Duce. After the assignments were recorded in the PTO, Belinda discovered that her claim coverage is too narrow because her patent attorney did not appreciate the full scope of her invention. Today, November 3, 1999, Belinda consults you about filing a reissue application. The reissue oath must be signed and sworn to by:

- (A) Belinda, Ace and Duce.
- (B) Belinda only.
- (C) Belinda and either Ace or Duce.
- (D) Ace and Duce only.
- (E) the attorney or agent of record.

Chapter 1400

Answers

April 15, 2003 AM

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

April 15, 2003 AM

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

April 15, 2003 AM

35. ANSWER: (E) is correct because 37 CFR § 1.321(a) states, in pertinent part, that “any patentee may disclaim or dedicate to the public...any terminal part of the term, of the patent granted.” 35 U.S.C. § 173 states, “Patents for designs shall be granted for the term of fourteen years from the date of grant.” (A) is wrong because such action would not permit Igor to financially exploit any portion of the term of his patent, since 37 CFR § 3.56 indicates that the result is a conditional assignment, which is regarded as an absolute assignment for Office purposes. (B) is wrong because 37 CFR § 1.321(a) provides for dedication to the public of “the entire term, or any terminal part of the term” only. “[T]he first five years of the patent term” does not qualify as a terminal part of the term. (C) is wrong because Igor would not achieve his objective of dedicating at least a portion of his patent term to the public, since the term of the design patent would expire on January 23, 2015. 35 U.S.C. § 173. (D) is wrong because 37 CFR § 1.321(a) restricts a disclaimer to “any complete claim or claims” or “the entire term, or any terminal part of the term” of a patent. “Royalties received from licensing” are not addressed by 37 CFR § 1.321(a).

April 15, 2003 PM

6. ANSWER: (C) is the most correct answer. See MPEP § 1411.01. As to (A) see MPEP § 1402. A reissue patent is not granted. As to (B), new matter may not be entered in a reissue. As to (D) see MPEP § 1412.03. Since (A), and (B) are incorrect, (E) is incorrect.

April 15, 2003 PM

14. ANSWER: (C) is the most correct answer. Answers (A), (D) and (E) are incorrect because a broadening reissue application must be filed within two years of issuance of the original patent. 35 U.S.C. § 251; MPEP § 1412.03. Answer (B) is incorrect because the assignee may not file a broadening reissue application. MPEP § 706.03(x).

October 16, 2002 AM

12. ANSWER: The best choice is (E). *See* MPEP § 1412.04. Reissue is a proper vehicle for correcting inventorship in a patent. Because correction of inventorship does not enlarge the scope of the patent claims, the reissue application may be filed more than two years after the patent issued. Answers (A) and (B) are therefore both correct, and (E) is the best response. Although a certificate of correction may be used to correct inventorship where all parties are in agreement, the facts of the question show that Inventor A is not in agreement. Choice (C) is thus not an available option for MegaCorp. Choice (D) is incorrect because the provisions of 37 C.F.R. § 1.48 are not available to correct inventorship in an issued patent.

October 16, 2002 AM

50. ANSWER: (A) is correct. MPEP § 1412.03. *In re Doll*, 164 USPQ 218, 220 (CCPA 1970). (B) is wrong because 35 U.S.C. § 251 prescribes a 2-year limit for filing applications for broadening reissues. (C) is wrong because although *Switzer v. Sockman*, 142 USPQ 226 (CCPA 1964), holds that while a reissue application filed on the 2-year anniversary date from the patent grant is considered to be filed within 2 years of the patent grant, it is necessary that an intent to broaden be indicated in the reissue application within the two years from the patent grant. MPEP § 1412.03. (D) is wrong because a proposal for broadened claims must be made in the parent reissue application within two years from the grant of the original patent. MPEP § 1412.03. *In re Graff*, 42 USPQ2d 1471, 1473-74 (Fed. Cir. 1997). (E) is wrong because there was no intent to broaden indicated within the two years. MPEP § 1412.03. *In re Fotland*, 228 USPQ 193 (Fed. Cir. 1985).

April 17, 2002 AM

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

April 17, 2002 AM

35. ANSWER: The correct answer is (D). The practice is set out in MPEP §1450. (A) is incorrect since the CAFC decision of *In re Amos*, 21 USPQ 2d 1271, held that reissue applicants have a right to claim any disclosed subject matter satisfying the first paragraph of 35 U.S.C. § 112. MPEP §1412.01. (A) and (B) are incorrect because the Office cannot reissue original unamended patent claims (where no error under 35 U.S.C. § 251 is corrected). (C) is incorrect because the original patent can only be surrendered once. USPTO has procedures for transferring the original patent grant from a reissue application to an divisional reissue application. USPTO procedures do not provide for surrendering a duplicate copy of an original patent grant. Reference may be made to the application in which it is surrendered. MPEP §1416(E) is incorrect since 37 C.F.R. § 1.176 only authorizes restriction between the originally claimed subject matter of the patent and previously

unclaimed subject matter.

April 17, 2002 AM

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

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

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

divisional application while the original application is still pending is not considered to be an error correctable via reissue, *Id.*

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41. ANSWER: (C) is the correct answer. Answers (A), (D) and (E) are incorrect because a broadening reissue application must be filed within two years of issuance of the original patent. 35 U.S.C. § 251; MPEP § 1412.03. Answer (B) is incorrect because the assignee may not file a broadening reissue application. MPEP § 706.03(x).

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

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20. ANSWER: All answers accepted.

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

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13. ANSWER: (C). An effort to convert a narrowing reissue application to a broadening reissue application more than two years after issuance of the original patent is ineffective. Furthermore, a claim that is broader than the original claims in any aspect is a broadened claim for the purposes of reissue. Thus, claims 10-15 are improper (regardless of whether there is any prosecution history estoppel), and statements (B) and (D) are incorrect. Statement (A) is incorrect because claims 16-19 are narrower than the original patent claims and are fully supported by the original reissue oath. For that same reason, (C) is correct. (E) is incorrect because (C) is correct.

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17. ANSWER: (C). Rene is barred by the recapture rule. MPEP § 1412.02. As to (A), see MPEP § 1412.02. Rene responded to a rejection by amending her claims, similar to Example B in MPEP § 1412.02, p.1400-10. As to (B), again recapture is the determinative factor. As to (D), the issue of financial concerns is of no import. As to (E) independent claims may not be broadened during a reexamination.

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20. ANSWER: (D) is the correct answer because the statement complies with 35 U.S.C. §§ 119(a)-(d) and 251; 37 C.F.R. § 1.55 and 1.63; MPEP § 1417. (A), (B), (C), and (E) are wrong because their statements do not comply with MPEP § 1417.

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26. ANSWER: (C). MPEP § 1417. The procedure is similar to that for “Continuing Applications” in MPEP § § 201.14(b). (A) is incorrect. MPEP § 1417. A “claim” for the benefit of an earlier filing date in a foreign country under 35 U.S.C. § 119(a) - (d) must be made in a reissue application even though such a claim was made in the application on which the original patent was granted. (B) is incorrect. New matter is excluded from a reissue application in accordance with 35 U.S.C. 251. Also see MPEP § 1411.02. (D) is incorrect. MPEP § 1412.02, “Reissue Claims Have Same Or Broader Scope In All Respects.” The recapture rule bars a patentee from acquiring through reissue claims that are, in all respects, of the same scope as, or are broader than, those claims canceled from the original application to obtain a patent. *Ball Corp v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). (E) is incorrect. A practitioner’s failure to appreciate the full scope of the invention has been held to be an error correctable through reissue. *In re Wilder*, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984); MPEP § 1402.

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29. All Answers Accepted.

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36. ANSWER: (C). It is essential that Sam file broader claims and indicate his intention to broaden within the two year time limit of 35 U.S.C. § 251. See MPEP § 1412.03, p.1400-13, and *In re Graf*, 111 F.3d 874, 877, 42 USPQ2d 1471, 1473-74 (Fed. Cir. 1997). As to answer (D), according to MPEP § 1451, p.1400-38, the requirement of 37 C.F.R. § 1.177 requiring that all divisional reissue applications issue simultaneously will be routinely waived *sua sponte*. As to a continuation application, they may also issue at different times as explained at MPEP § 1451, p.1400-38. Since (C) is true, (A), (B) and (E) are false. Further as to (E), claims reading on subject matter not covered by the original claims are broader.

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50. ANSWERS: (D) and (E). As to (A) see MPEP § 1442. All reissue applications, except those under suspension because of litigation, will be taken up for action ahead of other “special” applications. Therefore, it would do no good to file a petition to make special. As to (B), maintenance fees are always calculated from the patent issue date. MPEP §§ 2506 and 1415.01. As to (C), claims may not enlarge the scope of the claims in a patent during a reexamination. However, since a dependent claim is construed to contain all the limitations of the claim from which it depends, the dependent claim must be at least as narrow as the independent claim from which it depends, and thus does not broaden the patent. Thus, one does not necessarily enlarge the scope of the patent by broadening the claim. 37 C.F.R. § 1.193(a)(2); MPEP §§ 1412.03 (page 1400-13), 2258, subsection III, A (page 2200-60). As to (D), it is accepted due to ambiguity contained therein.

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3. ANSWER: (B). Hand entry of amendments to a claim in a reissue application is no longer permitted. 37 C.F.R. § 1.121(b)(2). Answers (A), (C) and (D) are all changes that were made pursuant to the December 1, 1997, change. 37 C.F.R. §§ 1.121(b)(2)(ii), and 1.121(b)(2)(iii). Answer (E) is also a correct statement. 37 C.F.R. § 1.121(b)(2)(i)(A) and MPEP § 1453.

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

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

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

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

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

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

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45. ANSWER: (C). MPEP § 1411.02. (A) is incorrect because a rejection for new matter in a reissue application must be made under 35 U.S.C. § 251, and not 35 U.S.C. § 132. (B) is incorrect because patent complied with 35 U.S.C. § 101 inasmuch as the patent disclosed a use for the invention, and Jones is not required by the Patent Statute to disclose the best mode for achieving commercial success. (D) is incorrect because the embodiment was not disclosed in the original patent. (E) is incorrect because (B) and (D) are incorrect.

November 3, 1999 AM

45. ANSWER: (C). 35 U.S.C. § 251; and MPEP §§ 1411, 1411.02, and 1412.02. (D) is not a correct answer. MPEP § 1417. (A) is incorrect. 35 U.S.C. § 251, paragraph 2. (B) is incorrect. 35 U.S.C. § 251, paragraph 1.

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5. ANSWER: (E). (A) and (B) are incorrect because a broadened claim can be presented within two years from the grant of the original patent in a reissue application. MPEP § 1412.03. (C) is incorrect because it would involve an attempt to recapture claimed subject matter deliberately canceled in a patent application. MPEP § 1412.02. (D) is incorrect because it improperly relies on new matter. The given facts state that “all leg members must be parallel.” Although the specification of the nonprovisional application was later amended

to state that the leg member could be substantially parallel, this is new matter, even in the absence of an objection to entry of new matter in the nonprovisional application. There was no support in the original disclosure for “substantially parallel,” where the specification requires the legs “must be parallel.” Therefore, amending the claim in the reissue application to replace “parallel” with “substantially parallel” is not likely to be allowed. MPEP § 1411.02.

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18. ANSWER: (C). The scope of Claim 1 is enlarged, or broadened by the deletion of “from the local pool subset” from the claim. As presented in (C), the reissue application is filed less than two years after the original patent was granted and the application seeks to enlarge the scope of Claim 1. As such, a reissue application may be properly granted containing the claim. 35 U.S.C. § 251. (A) and (B) are incorrect. The scope of Claim 1 is enlarged by the proposed amendment. Claims cannot be enlarged or broadened in a reexamination application regardless of when the application is filed. 35 U.S.C. § 305; 37 CFR § 1.552(b). (D) and (E) are also incorrect given that the scope of Claim 1 is broadened by the proposed amendment. As such, the reissue application cannot be filed more than two years from the grant of the original patent. 35 U.S.C. § 251.

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27. ANSWER: (B). 37 CFR § 1.172.

Chapter 1500

Questions

October 16, 2002 AM

11. In accordance with MPEP § 1500, relating to design patent applications:

- (A) the invention may be properly represented in a single application by both an ink drawing and a black and white photograph.
- (B) the invention may be properly represented in a single application by a black and white photograph disclosing environmental structure by broken lines, in lieu of an ink drawing if the invention is shown more clearly in the photograph.
- (C) the invention may be properly represented in a single application by both an ink drawing and a color photograph, and the application should be accompanied by the required petition, fee, three sets of color photographs, and an amendment to the specification.
- (D) the invention may be properly represented by a color photograph disclosing environmental structure by broken lines, in lieu of an ink drawing if the invention is not capable of being illustrated in an ink drawing.
- (E) the invention may be properly represented by a color photograph if the invention is not capable of being illustrated in an ink drawing, and if the application is accompanied by the required petition, fee, and an amendment to the specification is presented to insert required language regarding the color photographs, and three sets of color photographs.

October 16, 2002 PM

23. Which of the following statements relating to design patents does not accord with proper USPTO practice and procedure?

- (A) Both design and utility patents may be obtained on an article if the invention resides both in its utility and ornamental appearance.
- (B) The design for an article consists of the visual characteristics embodied in or applied to an article.
- (C) Design patent applications are included in the Patent Cooperation Treaty (PCT), and the procedures followed for PCT international applications are to be followed for design patent applications.
- (D) A claim directed to a computer-generated icon shown on a computer screen complies with the “article of manufacture” requirement of 35 USC 171.
- (E) A claimed design may encompass multiple articles or multiple parts within an article.

April 17, 2002 PM

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

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

April 18, 2001 AM

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

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

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

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

October 18, 2000 PM

24. Abigail has invented a novel watering mechanism for a flower pot. The flower pot also possesses a unique ornamental design. Abigail consults with patent practitioner P for advice on the differences between a design patent and a utility patent. Which of the following general statements regarding design and utility patents, if made by P, would be accurate?

- (A) A “utility patent” protects the way an article is used and works, while a “design patent” protects the way an article looks.
- (B) Unlike utility patent applications, a design patent application may not make a claim for priority of a provisional patent application.
- (C) Maintenance fees are required for utility patents, while no maintenance fees are required for design patents.
- (D) Both design and utility patents may be obtained on an article if the invention resides both in its utility and ornamental appearance.
- (E) All of the above.

April 12, 2000 AM

35. Which of the following statements regarding design patent applications is not correct?

- (A) The specification may contain a brief description denoting the nature and environmental use of the claimed design.
- (B) Different embodiments or modifications may be set forth in the specification, but do not need to be shown in the drawings.
- (C) The drawings may be color drawings or color photographs if accompanied by a grantable petition.
- (D) The design application may have only a single claim.
- (E) The inventive novelty or nonobviousness of a design resides in the shape or configuration, and/or surface ornamentation embodied in or applied to an article of manufacture.

November 3, 1999 AM

1. Abigail has invented a novel watering mechanism for a flower pot. The flower pot also possesses a unique ornamental design. Abigail consults with patent practitioner P for advice on the differences between a design patent and a utility patent. Which of the following general statements regarding design and utility patents, if made by P, would be accurate?

- (A) A “utility patent” protects the way an article is used and works, while a “design patent” protects the way an article looks.
- (B) Unlike utility patent applications, a design patent application may not make a claim for priority of a provisional patent application.
- (C) Maintenance fees are required for utility patents, while no maintenance fees are required for design patents.
- (D) Both design and utility patents may be obtained on an article if the invention resides both in its utility and ornamental appearance.
- (E) All of the above.

Chapter 1500

Answers

October 16, 2002 AM

11. ANSWER: (E) is correct. The statement finds support in MPEP § 1503.02, V. “Photographs and Color Drawings.” (A) and (C) are wrong because 37 C.F.R. § 1.152 states, “Photographs and ink drawings are not permitted to be combined as formal drawings in one application.” Reproduced in MPEP § 1503.02. (B) and (D) are wrong because 37 C.F.R. § 1.152 states, “Photographs submitted in lieu of ink drawings in design patent applications must not disclose environmental structure but must be limited to the design claimed for the article.” Reproduced in MPEP § 1503.02.

October 16, 2002 PM

23. ANSWER: (C) is the best choice because there is no provision for design patents under PCT. MPEP § 1502.01. (A) is a true statement. MPEP § 1502.01. (B) is a true statement. MPEP § 1502. (D) is a true statement. MPEP § 1504.01(a), I.A. (E) is a true statement. MPEP § 1504.01(b).

April 17, 2002 PM

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

April 18, 2001 AM

41. ANSWER: (D) is the most correct answer. There is no such refund permitted since 35 U.S.C. 42(d) only permits a refund of any fee “paid by mistake or any amount paid in excess of that required.” According to the statute, any refund of an “amount paid in excess” must be based upon an overpayment of a fee that was, in fact, required when the fee was paid. See “Changes to Implement the Patent Business Goals; Final Rule,” 65 F.R. 54604, 54642

(center column) (September 8, 2000), 1238 Official Gazette 77 (September 19, 2000). As to (A) and (B), see “Changes to Implement the Patent Business Goals; Final Rule,” 65 F.R. 54604, 54642 (center column) (September 8, 2000), 1238 Official Gazette 77 (September 19, 2000), which states: “[t]his procedure further expedites design application processing by decreasing clerical processing time as well as the time spent routing the application between processing steps... . Further, the ‘Petition to Make Special’ procedure will continue to be made available without any anticipated increase in the required petition fee.” As to (C), it contains all of the elements of 37 CFR § 1.155(a), which provides “(a) The applicant may request that the Office expedite the examination of a design application. To qualify for expedited examination: (1) The application must include drawings in compliance with § 1.84; (2) The applicant must have conducted a preexamination search; and (3) The applicant must file a request for expedited examination including: (i) The fee set forth in § 1.17(k); and (ii) A statement that a preexamination search was conducted. The statement must also indicate the field of search and include an information disclosure statement in compliance with § 1.98.” As to (E), it contains all of the elements of 37 CFR § 1.155(b), which provides “(b) The Office will not examine an application that is not in condition for examination (e.g., missing basic filing fee) even if the applicant files a request for expedited examination under this section.”

April 18, 2001 PM

7. ANSWER: (D), not being in accord with proper USPTO practice and procedure, is the most correct answer. Photographs and ink drawings may not appear in the same application. See § 1.152 Design drawings. Moreover, the order is not that appearing in 37 CFR § 1.154. As to (A), (A) contains the elements set forth in 37 CFR § 1.154 (a), which provides “(a) The elements of the design application, if applicable, should appear in the following order: (1) Design application transmittal form. (2) Fee transmittal form. (3) Application data sheet (see § 1.76). (4) Specification. (5) Drawings or photographs. (6) Executed oath or declaration (see § 1.153(b)).” As to (B), (B) contains the elements set forth in 37 CFR § 1.154 (b), which provides: “(b) The specification should include the following sections in order: (1) Preamble, stating the name of the applicant, title of the design, and a brief description of the nature and intended use of the article in which the design is embodied. (2) Cross-reference to related applications (unless included in the application data sheet). (3) Statement regarding federally sponsored research or development. (4) Description of the figure or figures of the drawing. (5) Feature description. (6) A single claim.” As to (C), (C) contains the elements set forth in 37 CFR § 1.154 (c), which provides “(c) The text of the specification sections defined in paragraph (b) of this section, if applicable, should be preceded by a section heading in uppercase letters without underlining or bold type.” Since (D) is incorrect, (E) is not the right answer.

October 18, 2000 PM

24. ANSWER: (E). MPEP §§ 1502.01; 201.04(b).

April 12, 2000 AM

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

November 3, 1999 AM

1. ANSWER: (E). MPEP §§ 1502.01, and 201.04(b) [p. 200-14].

Chapter 1600

Questions

October 17, 2001 AM

7. Sue has discovered a plant variety that has been asexually reproduced for which she desires patent protection. She comes to you for advice as to how she may file for a plant patent. Which of the following is not accurate with respect to proper USPTO procedure in relation to **plant** patent applications filed on or after January 1, 2001?

- (A) The specification must be drafted so as to contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. For a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.
- (B) View numbers and reference characters must be used for the plant patent drawings unless excused by the examiner.
- (C) The elements of her plant application should be organized in the following order: (1) plant patent application transmittal form, (2) fee transmittal form, (3) application data sheet, (4) specification, (5) drawings (in duplicate), and (6) executed oath or declaration under 37 CFR 1.162.
- (D) The specification should include the following sections in order: (1) title of the invention, which may include an introductory portion stating the name, citizenship, and residence of the applicant, (2) cross-reference to related applications (unless included in the application data sheet), (3) statement regarding federally sponsored research or development, (4) latin name of the genus and species of the plant claimed, (5) variety denomination, (6) background of the invention, (7) brief summary of the invention, (8) brief description of the drawing, (9) detailed botanical description, (10) a single claim, and (11) abstract of the disclosure.
- (E) A section heading in upper case, without underlining or bold type, should precede each section of the plant specification.

Chapter 1600

Answers

October 17, 2001 AM

7. ANSWER: (B). The opposite is true in that 37 CFR 1.165 (Plant Drawings) expressly provides that “[v]iew numbers and reference characters need not be employed unless required by the examiner.” The elements of (A) are all present in 37 CFR 1.163. The elements of (C) are all present in 37 CFR 1.163(b). The elements of (D) are all present in 37 CFR 1.163(c). The elements of (E) are all present in 37 CFR 1.163(d).

Chapter 1800

Questions

April 17, 2002 AM

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

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

April 17, 2002 AM

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

- (A) Abandoned for failure to submit the basic national fee within 20 months from the priority date.
- (B) Abandoned for failure to submit the basic national fee and copy of the international application within 20 months from the priority date.

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

April 18, 2001 AM

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

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

October 18, 2000 AM

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

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

Chapter 1800

Answers

April 17, 2002 AM

3. ANSWER: (D). This answer is correct because it would be the best option, as it would give Ms. Bordeaux the filing date of the PCT, specifically 1/10/01, as her U.S. filing date (for the purpose of determining whether information is prior art), it would give her a foreign priority date of 1/10/00, with no further need to provide the foreign priority document; it would also give her the full benefits of filing PCT applications, i.e., a search report and preliminary examination report on her invention(s) prior to filing a national application, so that she has an indication of which claims have the best chance of being determined to be patentable. (A) This answer is incorrect, as it would not give Belle Bordeaux the benefit of a preliminary examination report for her international application, prior to filing the national application. (B) This answer is incorrect because the procedure would not achieve the objective of obtaining an international preliminary search report. It would give Belle Bordeaux a later U.S. filing date, the filing date of the national application, *e.g.*, 9/10/01; the invention(s) would be subject to U.S. restriction practice; and the applicant would have to provide a certified copy of the foreign priority document. (C) This answer is incorrect, as a provisional application is not entitled to the right of priority of any other application under 35 U.S.C. §§ 119 or 365(a), or to the benefit of an earlier filing date in the United States under 35 U.S.C. §§ 120, 121 or 365(c). (E) is not correct because (A), (B) and (C) are incorrect.

April 17, 2002 AM

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

April 18, 2001 AM

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

October 18, 2000 AM

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

Chapter 1900

Questions

October 16, 2002 PM

46. Which of the following statements does not accord with proper USPTO practice and procedure?

- (A) A protest may be filed by an attorney or other representative on behalf of an unnamed principal.
- (B) Information which may be relied on in a protest includes information indicating violation of the duty of disclosure under 37 CFR 1.56.
- (C) While a protest must be complete and contain a copy of every document relied on by the protestor, a protest without copies of prior art documents will not necessarily be ignored.
- (D) A protest must be submitted prior to the date the application was published or the mailing of a notice of allowance, whichever occurs later, provided the application is pending.
- (E) Since a protestor is not authorized to participate in the prosecution of a pending application, the examiner must not communicate in any manner with the protestor.

October 17, 2001 PM

24. Pete wants to file a protest against a patent application filed by a coworker. In the locker room at his place of employment, Pete overheard Sol talking about an application for a golf ball retriever. Pete feels that the invention strongly resembles a golf ball retriever device published in a 1995 edition of Popular Golf magazine. Pete comes to you to file a protest. Pete wants to know if it will be considered by the examiner, and if the applicant (Sol) is required to respond. Pete believes he heard Sol say the application was filed in May 2001, and wonders whether he should include evidence of fraud since Pete believes that his (Pete's) wife may have shown Sol the Popular Golf article. Which of the following is not accurate with respect to proper USPTO procedure in relation to applications filed on or after January 1, 2001?

- (A) Pete's protest against Sol's pending application will be referred to the examiner having charge of the subject matter involved provided Pete can adequately identify the application. Protests that do not adequately identify a pending patent application will be returned to the protestor and will not be further considered by the Office.
- (B) Pete's protest, provided it adequately identifies Sol's application, will be entered in the application file if: (1) the protest is submitted prior to the date the application was published or the mailing of a notice of allowance under § 1.311, whichever occurs first; and (2) the protest is either served upon Sol in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible.
- (C) If Pete submits evidence that his wife gave Sol a copy of the Popular Golf article and contends that Sol fraudulently copied the device from that disclosed in the article, the examiner will generally not comment on the issues related to fraud.

- (D) Pete's protest, provided it adequately identifies Sol's application and is submitted prior to the date the application was published or the mailing of a notice of allowance under § 1.311, and which is either served upon Sol in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible, will be considered by the Office if the application is still pending when the protest and application file are brought before the examiner, and the protest includes: (1) a listing of the patents, publications, or other information relied upon; (2) a concise explanation of the relevance of each listed item; (3) a copy of each listed patent or publication or other item of information in written form or at least the pertinent portions thereof; and (4) an English language translation of all the necessary and pertinent parts of any non-English language patent, publication, or other item of information in written form relied upon.
- (E) If Pete files the protest before the final office action, Sol has a duty to respond to the issues raised by Pete's protest even in the absence of a request by the USPTO for comments. If such issues are not addressed, the issues will be deemed admitted.

April 12, 2000 PM

12. Clem and Tine, while dating, invent a wedding ring programmed to chime on each wedding anniversary. Unfortunately, the romance did not last. Clem comes to you, a registered practitioner, and says that he now wants to file a patent application. Clem admits that it was partly Tine's idea. Clem further advises you that before the couple ended their relationship, Tine deceptively filed a patent application for the same wedding ring in her name alone, application No. 09/123456. Which of the following is the proper advice to give Clem in accordance with proper PTO practice and procedure?

- (A) File a patent application listing Clem as the sole inventor, and the appropriate fees. Since Tine has already filed an application for the same device as sole inventor, she cannot be listed as a co-inventor in another application for the same device. An interference must be declared to determine proper inventorship.
- (B) File a patent application listing both Clem and Tine as coinventors, and the appropriate fees. If Tine refuses to sign the declaration, Clem has to file (i) a declaration signed by him naming himself and Tine as joint inventors, (ii) a petition, and (iii) the appropriate fees.
- (C) File a protest in the PTO (prior to the mailing of a notice of allowance in Tine's application) indicating the application serial number 09/123456 and informing the PTO that Clem is a coinventor.
- (D) Advise Clem that he could save money by allowing Tine to continue to prosecute her application and then, after the patent issues, he can sue her for half of the royalties.
- (E) (B) and (C).

Chapter 1900

Answers

October 16, 2002 PM

46. ANSWER: (D) is the best answer. MPEP § 1901.04. (A) is a true statement. MPEP § 1901.01. (B) is a true statement. MPEP § 1901.02, paragraph (G). (C) is a true statement. MPEP § 1901.03. (E) is a true statement. MPEP § 1907.

October 17, 2001 PM

24. ANSWER: (E). 37 CFR 1.291(c). In the absence of a request by the Office, an applicant has no duty to, and need not, reply to a protest. (A) contains portions of the elements of 37 CFR 1.291(a) & (b). (B) contains portions of the elements of 37 CFR 1.291(a). (C) contains portions of the elements of 37 CFR 1.291(a) & (b). (D) contains portions of the elements of 37 CFR 1.291(a) & (b).

April 12, 2000 PM

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

Chapter 2000

Questions

October 16, 2002 PM

5. In accordance with the MPEP and USPTO rules and procedure, certain individuals owe a duty to the USPTO to disclose all information known to be material to patentability of the claim(s) pending in an application. Which of the following parties does not have the duty?

- (A) An inventor named in the application who relies on a patent attorney to prepare and prosecute the application.
- (B) A corporation to which an assignment of the entire interest in the application is on record at the USPTO.
- (C) An agent who prepares the application.
- (D) An attorney who prosecutes the application.
- (E) A person, who is not an inventor named in the application, who is substantively involved in the preparation and prosecution of the application, and who is associated with an inventor named in the application.

April 18, 2001 AM

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

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

Which of the following is true?

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

October 18, 2000 PM

4. In January 1997, Chris invents an electrical door stop for automatically stopping a door at any position by simply pressing the doorknob downward. The doorknob is such that when carrying a large package, one may rest the package on the doorknob to stop the motion of the door. During a lunch break before completing the writing of the application for the patent on the automatic door stop, Chris' patent agent, Sam, visits a local Shack restaurant and notices a door stop which is actuated by stepping with one's foot on a mechanical lever located at the bottom of the door. Sam makes a mental note to ask a colleague as to whether he needs to disclose the doorstop at the Shack restaurant to the USPTO in conjunction with Chris' application in an information disclosure statement, but ultimately neglects to do so. Sam knows that the restaurant (and doorstop) was in existence at least one year prior to Sam's visit. In the first Office action, the only prior art uncovered by the examiner relates to stopping a door using a lever that engages a channel in the ceiling upon being pressed upward. The examiner rejects the claim asserting it would have been obvious to have either upward or downward actuating motion. In the reply to the first Office action Sam argues that the downward motion is essential because it affords the ability to actuate when one is carrying a package and that the prior art does not disclose a downwardly actuated doorstop. Following Sam's argument, the case issues. Claim 1 reads as follows:

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

Which of the following is true?

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

April 12, 2000 AM

48. Kevin invents a solar energy device for cooking food having a parabolic reflector with a rod connected along the center axis of the reflector, and a cooking grill connected to the top of the rod. A thorough search of the prior art results in locating Bill's United States patent, issued July 22, 1997. Bill's patent discloses a parabolic reflector having a cut-out portion from the base of the reflector with a rod connected along the center axis of the reflector, and a grill for cooking connected to the top of rod. Figures in Bill's patent show the invention with (Fig. 2) and without (Fig. 1) the cut-out portion, respectively. Bill's patent specifically teaches away from making the device by omitting the cut-out portion because the base portion of the reflector would unnecessarily gather fat and grease when the device is used to cook meat. On July 1, 1998, you, a registered practitioner, discuss the patent with Kevin, who states that his invention would be advantageous, since by leaving out the cut-out portion, the invention could be used to collect fat and grease, which could be sold. On July 20, 1998, you file a patent application for Kevin disclosing the solar energy device and its advantages, and claiming the device. During examination of the application, an examiner finds a publication disclosing a solar energy cooking device having a reflector without a cut-out portion. Which of the following accurately describes the duty to disclose Bill's patent to the PTO?

- (A) Only you have a duty to disclose the patent to the PTO.
- (B) Both you and Kevin have a duty to disclose the patent to the PTO, but the disclosure need not be in writing.
- (C) Both you and Kevin have a duty to disclose the patent to the PTO, and the disclosure must be in writing.
- (D) There is no duty to disclose the patent to the PTO, since it is a United States patent, and the examiners already independently have access to electronically search the database with all the United States patents.
- (E) There is no duty to disclose the patent to the PTO, because the patent is not material to patentability since it teaches away from the inventive concept of Kevin's invention.

Chapter 2000

Answers

October 16, 2002 PM

5. ANSWER: Choice (B) is the correct answer. MPEP § 2001.01, and 37 C.F.R. § 1.56(c). MPEP § 2001.01 states that “the duty applies only to individuals, not to organizations...the duty of disclosure would not apply to a corporation or institution as such.” (A) is incorrect because the duty of disclosure applies to each inventor named in the application. 37 C.F.R. § 1.56(c)(1). (C) and (D) are each incorrect because the duty of disclosure applies to an each attorney or agent who prepares or prosecutes the application. 37 C.F.R. § 1.56(c)(2). (E) is incorrect because, in the case of a person who is not a named inventor or an attorney or agent but who prepares or prosecutes the application, the duty of disclosure applies to each such person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application. 37 C.F.R. § 1.56(c)(3).

April 18, 2001 AM

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

October 18, 2000 PM

4. ANSWER: (E). Since the claim reads on a downward moving actuator and only a upward moving actuator was cited during the prosecution, the Shack restaurant device was material to the patentability of the invention. Moreover, Sam argued the significance of the downward motion feature. 37 C.F.R. § 1.56(b)(2)(i). Sam should have disclosed it under 37 C.F.R. § 1.56(c)(2). As to (A), the duty of disclosure extends to each practitioner who prepares or prosecutes the application. 37 C.F.R. § 1.56(c)(2). As to (B), even though Chris had completed the disclosure, the sighting of the Shack restaurant doorstep occurred prior to the filing date. Moreover, the restaurant (and doorstep) was in existence at least one year prior to Sam’s visit. MPEP § 2001.06. As to (C), information material to the invention is more than just patents and printed publications. 37 C.F.R. § 1.56; MPEP 2001.04, p.2000-4. As to (D), only patents and printed publication may be considered during a reexamination. 35 U.S.C. § 303(a); MPEP § 2209.

April 12, 2000 AM

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

Chapter 2200

Questions

April 15, 2003 PM

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

- (A) Interferences will generally be declared even when the applications involved are owned by the same assignee since only one patent may issue for any given invention.
- (B) A senior party in an interference is necessarily the party who obtains the earliest actual filing date in the USPTO.
- (C) Reexamination proceedings may not be merged with reissue applications since third parties are not permitted in reissue applications.
- (D) After a reexamination proceeding is terminated and the certificate has issued, any member of the public may obtain a copy of the certificate by ordering a copy of the patent.
- (E) None of the above.

April 15, 2003 PM

35. Which of the following is a proper basis for establishing a substantial new question of patentability to obtain reexamination in accordance with proper USPTO rules and the procedures set forth in the MPEP?

- (A) An admission *per se* by the patent owner of record that the claimed invention was on sale, or in public use more than one year before any patent application was filed in the USPTO.
- (B) A prior art patent that is solely used as evidence of an alleged prior public use.
- (C) A prior art patent that is solely used as evidence of an alleged insufficiency of disclosure.
- (D) A printed publication that is solely used as evidence of an alleged prior offer for sale.
- (E) None of the above.

April 15, 2003 PM

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

- (A) The loser in an interference in the PTO is estopped from later claiming he or she was the first to invent in a Federal District Court since the loser must win in the USPTO or he/she will lose the right to contest priority.
- (B) A person being sued for infringement may file a request for reexamination without first obtaining the permission of the Court in which the litigation is taking place.
- (C) A practitioner may not represent spouses, family members or relatives before the USPTO since such representation inherently creates a conflict of interest and a practitioner is likely to engage in favoritism over his/her other clients.
- (D) Employees of the USPTO may not apply for a patent during the period of their employment and for two years thereafter.
- (E) None of the above.

April 17, 2002 AM

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

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

April 17, 2002 PM

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

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

instruct her to take the action that will best protect Mr. Flash's patent rights. Which of the following acts would be in accordance with proper USPTO practice and procedure, and Annie should be authorized to follow?

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

April 17, 2002 PM

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

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

- (D) Weisman should file a request for *ex parte* reexamination of the Einstein patent under 35 U.S.C. § 302, citing the April 1998 printed publication of football pads in, and explain the pertinency and manner of applying such prior art to at least one claim of the Einstein patent.
- (E) Weisman should file a request for *inter partes* reexamination of the Einstein patent under 35 U.S.C. § 311, citing public use of the football pads in April 1998, and explain the pertinency and manner of applying such prior use to at least one claim of the Einstein patent.

October 17, 2001 PM

20. Which of the following is true?

- (A) In rejecting claims the examiner may rely upon facts within his own personal knowledge, unless the examiner qualifies as an expert within the art, in which case he is precluded from doing so, since only evidence of one of ordinary skill in the art is permitted.
- (B) If an applicant desires to claim subject matter in a reissue which was the same subject matter waived in the statutory invention registration of another, the applicant is precluded by the waiver from doing so, even though the applicant was not named in the statutory invention registration.
- (C) If an applicant, knowing that the subject matter claimed in his patent application was on sale in Michigan and sales activity is a statutory bar under 35 U.S.C. § 102(b) to the claims in his application, nevertheless withholds the information from the patent examiner examining the application, and obtains a patent including the claims in question, the applicant may remove any issue of inequitable conduct by filing a request for reexamination based on the sales activity.
- (D) An applicant for a patent may overcome a statutory bar under 35 U.S.C. § 102(b) based on a patent claiming the same invention by acquiring the rights to the patent pursuant to an assignment and then asserting the assignee's right to determine priority of invention pursuant to 37 CFR 1.602.
- (E) None of the above.

April 18, 2001 AM

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

- (A) In every instance of an interview with an examiner in an *ex parte* reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner.
- (B) An interview does not remove the necessity for reply to Office actions as specified in 37 CFR § 1.111.
- (C) A patent owner's reply to an outstanding Office action after the interview does not remove the necessity for filing the written statement of the reasons presented at the interview as warranting favorable action.

- (D) The written statement must be filed as a separate part of a reply to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.
- (E) Third party requesters have the option of attending interviews, but their presence is not mandatory.

April 18, 2001 AM

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

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

October 18, 2000 PM

5. Which of the following is a proper basis for establishing a substantial new question of patentability to obtain reexamination in accordance with proper USPTO practice and procedure?

- (A) An admission *per se* by the patent owner of record that the claimed invention was on sale, or in public use more than one year before any patent application was filed in the USPTO.
- (B) A prior art patent that is solely used as evidence of an alleged prior public use.
- (C) A prior art patent that is solely used as evidence of an alleged insufficiency of disclosure.
- (D) A printed publication that is solely used as evidence of an alleged prior offer for sale.
- (E) None of the above.

April 12, 2000 AM

40. Which of the following is **true** ?

- (A) Once the claims of a patent application are determined to be invalid by the Board of Patent Appeals and Interferences, an applicant may not thereafter file another patent application regarding the same invention with narrower claims.

- (B) Once the claims of a patent application are determined to be invalid by the Court of Appeals for the Federal Circuit, an applicant may not thereafter file another patent application regarding the same invention with narrower claims.
- (C) Collateral estoppel bars an applicant from filing several applications for obvious improvements of the same invention.
- (D) The failure of an independent claim in a patent to claim a feature of the invention, which is not found in a genus, results in Jepson estoppel against the inventor claiming the invention with the feature in another patent application.
- (E) During reexamination, if the independent claims of a patent are not broadened, then amendments to the dependent claims cannot broaden the scope of the invention covered by the claims.

April 12, 2000 AM

47. Which of the following, if any, is **true** ?

- (A) The loser in an interference in the PTO is estopped from later claiming he or she was the first to invent in a Federal District Court since the loser must win in the PTO or he/she will lose the right to contest priority.
- (B) A person being sued for infringement may file a request for reexamination without first obtaining the permission of the Court in which the litigation is taking place.
- (C) A practitioner may not represent spouses, family members or relatives before the PTO since such representation inherently creates a conflict of interest and a practitioner is likely to engage in favoritism over his/her other clients.
- (D) Employees of the PTO may not apply for a patent during the period of their employment and for two years thereafter.
- (E) None of the above.

April 12, 2000 PM

3. Which of the following is **true** ?

- (A) Interferences will generally be declared even when the applications involved are owned by the same assignee since only one patent may issue for any given invention.
- (B) A senior party in an interference is necessarily the party who obtains the earliest actual filing date in the PTO.
- (C) Reexamination proceedings may not be merged with reissue applications since third parties are not permitted in reissue applications.
- (D) After a reexamination proceeding is terminated and the certificate has issued, any member of the public may obtain a copy of the certificate by ordering a copy of the patent.
- (E) None of the above.

April 12, 2000 PM

8. It is widely understood in the relevant art that a knife is but one of many types of “cutting means,” and that a knife can have a blade that is “serrated” or “honed.” During reexamination of a patent, the patent owner seeks to amend Claim 1 as follows:

(amended) A [knife] cutting means having a handle portion and a serrated blade.

All changes in the claim are fully supported by the original disclosure in the patent. Which of the following correctly explains why the claim, as amended, should or should not be rejected?

- (A) The claim should be rejected because the amendment broadens the scope of the patent claim by changing replacing “knife” with “cutting means,” a broader recitation.
- (B) The claim should be rejected because the claim has not been amended in accordance with PTO rules for amending patent claims.
- (C) The claim should not be rejected because the claim is fully supported by the original patent disclosure.
- (D) The claim should not be rejected because the amendment does not add new matter into the claim.
- (E) The claim should not be rejected because the amendment narrows the scope of the patent by modifying “blade” to being a “serrated blade.”

April 12, 2000 PM

10. On December 1, 1998, Sam, attorney for the firm of Thrill and Chill, files a request for reexamination of a patent owned by his client, Hurley Corp., along with a recently discovered Russian patent which issued more than one year before the filing date of the patent. Hurley’s patent contains one independent claim and nine dependent claims. The request for reexamination is granted on February 1, 1999. On June 1, 1999, an Office action issues in which the Examiner properly rejects independent claim 1 under 35 U.S.C. §§ 102 and 103 using the Russian reference and objects to the remaining claims as being dependent upon a rejected claim. Sam receives the Office action, agrees with the Examiner that claim 1 is unpatentable over the Russian patent and forwards it to his client, Hurley Corp. Hurley Corp. is undergoing financial problems and files for bankruptcy protection with the Federal District Court. They advise Sam that they have no funds available to further prosecute the reexamination proceeding. In accordance with proper PTO practice and procedure what should Sam do?

- (A) Advise the Examiner on the telephone that the patentee has filed for bankruptcy protection, and that nothing should be done in the reexamination proceeding until the bankruptcy is settled.
- (B) Do nothing and a reexamination certificate will issue indicating that claim 1 is canceled and that the patentability of claims 2 - 10 is confirmed.
- (C) File a fallacious reply arguing the patentability of claim 1 in order to allow the reexamination proceeding to continue.

- (D) File a divisional reexamination proceeding whereby claims 2 through 10 will be transferred into the divisional and allowed to issue. Claim 1, still in the original reexamination proceeding, can then be appealed to the Board of Patent Appeals and Interferences at a later point in time after the bankruptcy is resolved.
- (E) Send a letter to his client Hurley Corp. advising them that unless he is paid in advance, he will take no further action in the proceeding and file no papers with the PTO.

April 12, 2000 PM

19. Which of the following is **true** ?

- (A) A final decision by a United States District Court finding a patent to be invalid will have no binding effect during reexamination since the PTO may still find the claims of the patent to be valid.
- (B) A final decision by a United States District Court finding a patent to be valid will have no binding effect during reexamination since the PTO may still find the claims of the patent to be invalid.
- (C) Once the Court of Appeals for the Federal Circuit determines that the claims of a patent are valid, the USPTO may not find such claims invalid based upon newly discovered art.
- (D) If a patentee fails to disclose prior art to the PTO during regular prosecution, the only way that a patentee can disclose later discovered prior art to the PTO after issuance is by filing a request for reexamination.
- (E) Once a patent claim is found valid during a District Court Proceeding then the patent claims are entitled to a higher standard of patentability and the presumption of validity can only be rebutted by clear and convincing evidence in a concurrent or later reexamination proceeding.

November 3, 1999 AM

17. A request for reexamination of U.S. Patent X,XXX,XXX (the 'XXX patent) was filed by ABC Technology, Inc. (ABC) on the ground that a substantial new question of patentability exists. In the first Office Action during reexamination, all the claims, i.e., claims 1 through 4, were rejected as unpatentable under 35 U.S.C. § 103 over U.S. Patent Z,ZZZ,ZZZ (the 'ZZZ patent). Claims 1 through 4 are all independent and original claims, and are the only claims that were presented during prosecution of the application that matured into 'XXX patent. All the claims are directed to a hydrocyclone separator apparatus. The apparatus is used for separating material, including fibers suspended in a liquid suspension, into a light fraction containing the fibers, and a heavy fraction containing rejects. Assuming no issues under 35 U.S.C. §§ 102, 103, or 112 are raised, which of the following claims, if any, would be properly subject to rejection under 35 U.S.C. § 305?

- (A) Claim 5. A hydrocyclone separator apparatus according to claim 4, wherein said blades are configured in the form of generally plane surfaces curved in one plane only.
- (B) Claim 5. A hydrocyclone separator apparatus according to claim 4, wherein the outlet duct is in the form of two frustro-conical portions joined at their narrow ends.
- (C) Claim 5. A method of separating material including fibers suspended in a liquid suspension comprising the steps of separating the material into a light fraction containing the fibers and a heavy fraction containing rejects, and converting the light fraction into a pulp and paper stock suspension.
- (D) Claim 5. A hydrocyclone separator apparatus according to claim 4, wherein the separator chamber is conical in shape having at the narrow end an outlet for the heavy fraction and at its wide end an outlet for the light fraction.
- (E) None of the above.

November 3, 1999 AM

21. Which of the following would be a proper rejection in a reexamination proceeding?

- (A) A rejection under 35 U.S.C. § 102(a) based on an affidavit that the invention was known or used by others before the invention thereof by the applicant for patent.
- (B) A rejection under 35 U.S.C. § 102(b) based on an affidavit that the invention was in the public use in this country more than one year prior to the date of the application for a patent in the United States.
- (C) A rejection under 35 U.S.C. § 102(e) that the invention was described in a patent by another filed in the United States before the invention thereof by the patent applicant.
- (D) A rejection under 35 U.S.C. § 102(f) that the applicant did not himself invent the subject matter sought to be patented.
- (E) A rejection under 35 U.S.C. § 102(b) that 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.

November 3, 1999 AM

22. Patentee P wishes to amend Claim 1 in the patent granted to P, and obtain the following amended Claim 1 either through reexamination or reissue:

- 1. A ball valve comprising:
 - i) a housing;
 - ii) a valve [member] ball rotatably joined in the housing;
 - iii) a [flanged] seal engagable with surfaces of the [member] ball; and iv) a linear spring [means] interposed between the housing and the seal and biasing the seal into engagement with the [member] ball.

The amended claim is supported by the original disclosure in the application, which matured into P's patent. In the absence of questions of recapture, novelty, obviousness, and utility which of the following statements is/are true?

- (A) A claim so amended is properly presented in a reissue application filed on October 14, 1999, and a reissue patent is grantable where reissuance is sought of a patent granted on September 9, 1997.
- (B) A claim so amended is properly presented in a reissue application filed on September 9, 1999, and a reissue patent is grantable where reissuance is sought of a patent granted on October 7, 1997.
- (C) A claim so amended is properly presented in a request for reexamination filed on October 14, 1999, and a certificate of reexamination is grantable where reexamination is sought of a patent granted on September 9, 1997.
- (D) A claim so amended is properly presented in a request for reexamination filed on September 9, 1999, and a certificate of reexamination is grantable where reexamination is sought of a patent granted on October 7, 1997.
- (E) (B) and (D).

November 3, 1999 AM

26. A patent was granted to inventor Munch on August 3, 1999, on a patent application filed in the PTO on March 5, 1997. In which of the following circumstances in a reexamination proceeding of the Munch patent, considered independently of each other, will the cited prior art reference(s) properly support a determination that there is substantial new question of patentability?

- (A) In a reexamination proceeding, claims 7-15 in the Munch patent are rejected as being anticipated under 35 U.S.C. § 102(a) by the disclosure in the Leal patent. The Leal patent was granted on January 21, 1997. It is the only rejection in the reexamination proceeding. During the original prosecution of the Munch application, the Leal patent was used by the examiner as prior art to reject original claims 1-5 as being anticipated under 35 U.S.C. § 102(a).
- (B) In a reexamination proceeding, newly added claims 16-20 in the Munch patent are rejected as being anticipated under 35 U.S.C. § 102(b) by the disclosure in the Zellot patent. The Zellot patent was granted in 1987. It is the only rejection in the reexamination proceeding. During the original prosecution of the Munch application the examiner cited the Zellot patent against claims 1-7 in the patent application Munch filed on March 5, 1997.
- (C) In a reexamination proceeding, claims 1-15 in the Munch patent are rejected as being obvious under 35 U.S.C. § 103 over the Wills patent in view of the Note patent. The Wills patent was granted on December 3, 1996, and the Note patent was granted in 1994. It is the only rejection in the reexamination proceeding. During the original prosecution of the Munch application the examiner used the Wills patent as prior art to reject original claims 1 and 2 in the Munch application. The Note patent was never before the examiner during the original prosecution of the Munch application, is not cumulative with the prior art cited during the original prosecution, and is material to the question of obviousness.

- (D) In a reexamination proceeding, claims 1-15 in the Munch patent are rejected as being anticipated under 35 U.S.C. § 102(a) by the disclosure in the Richards patent. The Richards patent was granted on January 14, 1997. It is the only rejection in the reexamination proceeding. During the original prosecution of the Munch application, the examiner used the Richards patent in combination with a patent to Smith, granted in 1923, to reject original claims 1-5 in the application as being obvious under 35 U.S.C. § 103.
- (E) All of the above.

November 3, 1999 AM

33. During a reexamination proceeding, you submit the following amendment less than two years from the date that a patent was granted with the claim:

1. (once amended) An application specific integrated circuit for calculating a correlation coefficient, comprising: a multiplication unit [having a plurality of sixty-four bit shift registers]; an integration unit coupled to said multiplication unit; and a digital filter unit coupled to said integration unit and to said multiplication unit.

The original disclosure in the patent application stated that a plurality of thirty-two bit shift registers could be used to form the multiplication unit. In accordance with PTO rules and procedure, which, if any, of the following statements, including any reasons given in support thereof, concerning the amendment is true?

- (A) The form of the amendment is improper, since underlining and brackets are not proper in proceedings where only issues concerning substantial new questions of patentability may be raised.
- (B) The claim as amended should be allowed if it overcomes the art of record in the application since the amendment was made less than two years from the date that a patent was granted.
- (C) The claim as amended should be allowed if it overcomes the art of record in the application since the amendment, although broader in some respects than the claim of the patent, is narrower in other respects.
- (D) The claim as amended should not be allowed since it broadens the scope of the claim of the patent.
- (E) None of the above.

November 3, 1999 PM

32. A client comes to you and tells you that he has been informed by his competitor that he is infringing the competitor's patent. Your client tells you that the competitor's invention was well known in the field at the time the application for the patent was filed. Your client shows you several published articles, two United States patents, and two written statements by experts in the field which clearly support his conclusion. Upon further investigation, you find that the published articles and patents were not considered by the examiner during the prosecution of the patent application. Your client informs you that he would like to avoid litigation, and have the PTO take action to invalidate the patent. Which of the following choices would be an appropriate course of action to take on behalf of your client?

- (A) Petition the Commissioner of Patents and Trademarks to revoke the patent.
- (B) File a request and fee for reexamination of the claims in the patent relying on the published articles and the U.S. patents as the basis for reexamination, and include all statements, information, and documents required by PTO rules for initiating reexamination proceedings.
- (C) File a protest in the PTO with copies of the published articles, patents and the written statements from the experts, along with an explanation of their pertinence to the claims of the patent.
- (D) File in the PTO copies of all of the documents provided to you by your client and request that they be made of record in the patented file.
- (E) (B) and (C).

Chapter 2200

Answers

April 15, 2003 PM

12. ANSWER: (D) is the most correct answer. See MPEP § 2292. As to (A) see 37 CFR § 1.602(a). As to (B) see 37 CFR § 1.601(m), which provides that the senior party has earliest effective filing date. As to (C), see MPEP § 2285 regarding merger of reissues and reexamination proceedings. As to (E), (D) is true.

April 15, 2003 PM

35. ANSWER: (E) is the most correct answer. See 35 U.S.C. § 302; MPEP § 2217. The prior art applied may only consist of prior art patents or printed publications. Substantial new questions of patentability may be based upon 35 U.S.C. §§ 102(a), (b), (d) and (e), new questions of patentability under 35 U.S.C. § 103 that are based on the foregoing indicated portions of 35 U.S.C. § 102, and substantial new questions of patentability may be found under 35 U.S.C. §§ 102(f)/103 or 102(g)/103 based on the prior invention of another disclosed in a patent or printed publication. (A) is incorrect. See MPEP § 2217. An admission, *per se*, may not be the basis for establishing a substantial new question of patentability. However, an admission by the patent owner of record in the file or in a court record may be utilized in combination with a patent or printed publication. (B), (C), and (D) are incorrect. A prior art patent cannot be properly applied as a ground for reexamination if it is merely used as evidence of alleged prior public use or sale, or insufficiency of disclosure. The prior art patent must be applied directly to claims under 35 U.S.C. § 103 and/or an appropriate portion of 35 U.S.C. § 102 or relate to the application of other prior art patents or printed publications to claims on such grounds.

April 15, 2003 PM

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

April 17, 2002 AM

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

April 17, 2002 PM

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

April 17, 2002 PM

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

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20. ANSWER: The best answer is (E). (A) is incorrect since facts within the knowledge of the examiner may be used whether or not the examiner qualifies as an expert. 37 CFR 1.104(c)(3). (B) is incorrect since the waiver is only effective against those named in the statutory registration. (C) is incorrect since on sale activities is not proper subject matter for reexamination, and inequitable conduct cannot be resolved or absolved by reexamination. (D) is not correct since a statutory bar cannot be overcome by acquiring the patent.

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

Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.”

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

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5. ANSWER: (E). 35 U.S.C. § 302; MPEP § 2217. The prior art applied may only consist of prior art patents or printed publications. Substantial new questions of patentability may be based upon 35 U.S.C. § 102(a), (b), (d) and (e), new questions of patentability under 35 U.S.C. § 103 that are based on the foregoing indicated portions of 35 U.S.C. § 102, and substantial new questions of patentability may be found under 35 U.S.C. §§ 102(f)/103 or 102(g)/103 based on the prior invention of another disclosed in a patent or printed publication. (A) is incorrect. MPEP § 2217. An admission, *per se*, may not be the basis for establishing a substantial new question of patentability. However, an admission by the patent owner of record in the file or in a court record may be utilized in combination with a patent or printed publication. (B), (C), and (D) are incorrect. A prior art patent cannot be properly applied as a ground for reexamination if it is merely used as evidence of alleged prior public use or sale, or insufficiency of disclosure. The prior art patent must be applied directly to claims under 35 U.S.C. § 103 and/or an appropriate portion of 35 U.S.C. § 102 or relate to the application of other prior art patents or printed publications to claims on such grounds.

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

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

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3. ANSWER: (D). MPEP § 2292. As to (A) see 37 C.F.R. § 1.602(a). As to (B) see 37 C.F.R. § 1.601(m), which provides that the senior party has earliest effective filing date. As to (C), see MPEP § 2285 regarding merger of reissues and reexamination proceedings. As to (E), (D) is true.

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

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

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19. ANSWER: (B) is the most correct answer. As to (A) and (B) see MPEP 2286, page 220097, stating, “[t]he issuance of a final district court decision upholding validity during a reexamination also will have no binding effect on the examination of the reexamination.” Thus, (A) is incorrect because a final holding of invalidity is binding on the PTO. As to (C), the PTO may discover new art and find claims unpatentable as that art would raise a substantial new question. MPEP §§ 2216 and 2286. As to (D), the patentee could file a prior art statement under 35 U.S.C. § 301, or disclose prior art in reissue application if the original patent (through error without deceptive intent) is defective or claims more or less than should be claimed. As to (E), preponderance of evidence standard does not change in reexamination proceedings. MPEP 2286.

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17. ANSWER: (C). 35 U.S.C. § 305 recites, *inter alia*, “No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter.” MPEP §§ 2254, and 2258, item III. Since no claims drawn to a method were ever presented during prosecution of the ‘XXX patent, (claims 1-4 “are the only claims that were presented during prosecution of the application that matured into ‘XXX patent”), the claim recited in (C) is not directed to “the invention as claimed.” Moreover, such claim is

regarded as enlarging the scope of the claims in the 'XXX patent. *Ex parte Wikdahl*, 10 USPQ2d 1546, 1549 (Bd. Pat. App. & Int. 1989). (A), (B), and (C) are all incorrect because each of their claims are directed to a hydrocyclone separator apparatus, i.e., "the invention as claimed," and they do not enlarge the scope of the claims in the 'XXX patent. (E) is an incorrect answer because (C) is the correct answer.

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21. ANSWER: (C). 35 U.S.C. § 301; 37 CFR § 1.552; and MPEP § 2258. (A), (B), (D) and (E) are incorrect because reexamination is limited to substantially new questions of patentability based on patents and publications.

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22. ANSWER: (B). The scope of Claim 1 is enlarged, or broadened by the deletion of "flanged" as a modifier of "seal." Inasmuch as the reissue application is filed less than two years after the original patent was granted, and the application seeks to enlarge the scope of Claim 1, a reissue patent may be properly granted containing the claim. 35 U.S.C. § 251. (A) is incorrect. Inasmuch as the scope of Claim 1 is enlarged by the amendment and the reissue application was filed more than two years from the grant of the original patent, no reissue patent shall be granted. 35 U.S.C. § 251. (C) and (D) are incorrect inasmuch as the scope of Claim 1 is enlarged, or broadened as discussed above, and claims cannot be enlarged or broadened in a reexamination application regardless of when the application is filed. 35 U.S.C. § 305; 37 CFR § 1.552(b).

(E) is incorrect since (D) is incorrect.

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26. ANSWER: (C). The combination of references presents a substantial new question of patentability. MPEP § 2244. *In re Hiniker Co.*, 150 F.3d 1362, 47 USPQ2d 1523 (Fed. Cir. 1998) (where the prior art references are applied in combination, and one reference served as a rejection in the prosecution of the original patent while the other reference "was never before the examiner during the original prosecution and is thus new art[, and t]here is no indication that the [new art] was not material to the question of obviousness vel non or that it was cumulative with any old art" the decisions rejecting the claims "were based on a substantial new question of patentability." Answers (A) and (D) are incorrect because a "prior art reference that served as a rejection in the prosecution of the original patent could not support a substantial new question of patentability that would permit the institution of a reexamination proceeding." *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ 1776 (Fed. Cir. 1996). Answer (B) is incorrect because "prior art that was before the original examiner could not support a reexamination proceeding despite the fact that it was not the basis of a rejection in the original prosecution; as long as the art was before the original examiner, it would be considered 'old art'." *In re Portola Packaging, Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997). Answer (E) is incorrect because answers (A), (B) and (D) are incorrect.

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33. ANSWER: (D). MPEP § 2258, item III. (A) is incorrect because it is nonsensical and the form of the amendment is proper. MPEP § 2250. (B) is incorrect because the amendment broadens the scope of the claim of the patent, which is never allowed in a reexamination proceeding. MPEP § 2258, item III (C) is incorrect because a claim is broader than another claim if it is broader in any respect, even though it may be narrower in other respects. MPEP § 2258, item III. (E) is incorrect because (D) is correct.

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32. ANSWER: (B). 37 CFR §§ 1.291, and 1.501; MPEP §§ 2202, and 2203.

Chapter 2300

Questions

April 12, 2000 AM

43. On January 3, 2000, inventor Jones became aware of a patent issued to Smith that was directed to subject matter very similar to that claimed in Jones' pending application. Smith's patent issued on February 2, 1999, but was based on an application filed after Jones' application. On January 14, 2000, Jones sent a letter to registered practitioner Wilson requesting that Wilson copy claims 1-5 of the Smith patent and seek to have an interference declared between Jones and Smith. The letter arrived in Wilson's office on January 18. However, Wilson was away on an extended vacation, and did not see Jones' letter until his return to the office on February 7, 2000. The next day Wilson filed an Amendment adding to Jones' application claims 21-25, which were directed to the same invention as Smith's claims 1-5. Wilson informed the PTO that these claims were copied from Smith's patent for the purpose of instituting an interference. However, the examiner rejected the claims and refused to declare an interference because the copied claims were not presented in a timely manner. Which of the following should help Jones obtain priority in the PTO to the commonly claimed subject matter?

- (A) Jones petitions the Commissioner under 37 C.F.R. § 1.183 for acceptance of the copied claims on the basis that any delay in presenting the claims was unavoidable, and requesting that an interference then be declared. Jones pays the appropriate fee.
- (B) Jones petitions the Commissioner under 37 C.F.R. § 1.183 for acceptance of the copied claims on the basis that any delay in presenting the claims was unintentional, and requesting that an interference then be declared. Jones pays the appropriate fee.
- (C) While his application is still pending, Jones files a civil action against Smith in U.S. District Court under 35 U.S.C. § 291 seeking to adjudge the validity of the Smith patent.
- (D) Jones files with the examiner a request for reconsideration noting that Smith's filing date is subsequent to Jones' filing date and, therefore, an interference should be declared and Jones named the senior party.
- (E) None of the above.

Chapter 2300

Answers

April 12, 2000 AM

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

Chapter 2500

Questions

April 17, 2002 PM

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

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

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

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

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49. Which of the following statements accords with proper USPTO practice and procedure?

- (A) If a design patent was granted 3 years and 9 months ago, a maintenance fee paid today must include a surcharge because the payment is being made during the grace period.
- (B) If a design patent was granted 3 years and 9 months ago, and payment of the maintenance fee and surcharge is not paid through the day of the 4th anniversary of the grant for the first maintenance fee, the patent will expire.
- (C) If a plant patent was granted 7 years and 3 months ago, a maintenance fee must be paid, but a surcharge is not required, because the payment is not being made during the grace period.
- (D) If a utility patent was granted 7 years and 9 months ago, the first maintenance fee was timely paid, and the 8th anniversary of the patent grant falls on a Saturday, then the 2nd maintenance fee may be paid without surcharge on the next succeeding day which is not a Sunday or Federal holiday.
- (E) If a reissue application issues as a reissue patent exactly two years after the grant of the original patent, the maintenance fee for the 4th anniversary of the patent grant must be paid within eighteen months of the reissuance of the patent to avoid a surcharge.

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

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

November 3, 1999 AM

35. Morris, a registered practitioner with a solo practice he operates out of his house, obtained a plant patent for a client on a commercial catnip hybrid. One morning, over four years later, as he was sorting through his cat's toys, he came across a letter from his client indicating the client's belief that a maintenance fee was due four years after issuance. By the time Morris found the letter, it was eight months after the four year anniversary of the plant patent's issuance. Morris should immediately:

- (A) Tender the maintenance fee and submit a petition (with the required fee) for acceptance of payment where the delay was unintentional.
- (B) Pay the maintenance fee plus the surcharge for filing a maintenance fee during the grace period.
- (C) Write the client that no maintenance fee is in fact owed, and apologize for the delay in responding to the client.
- (D) Do nothing because the patent is irrevocably lost due to failure to pay the maintenance fee within the grace period.
- (E) Tender the maintenance fee and submit a petition (with an affidavit blaming the cat and with the required fee) for acceptance of payment where the delay was unavoidable.

Chapter 2500

Answers

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

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42. ANSWER: (C) is the correct answer. 37 CFR 1.366(c) (effective September 8, 2000), “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54649 (Sept. 8, 2000); MPEP § 2515 (pg. 2500-5) (8th Ed.). Under 37 CFR 1.366(a), any person or organization may pay maintenance fees and any necessary surcharges on behalf of a patentee. Authorization by the patentee is not required. 37 CFR 1.366(c) states, “If the payment includes identification of only the patent number (i.e., does not identify the application number of the United States application for the patent on which the maintenance fee is being paid), the Office may apply the payment to the patent identified by patent number in the payment or may return the payment.” Only in (C) does the USPTO have the option of returning the maintenance fee. (A) and (B) are each incorrect. (D) is incorrect because (A) and (B) are incorrect. (E) is incorrect because (C) is correct.

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49. ANSWER: (E) is correct because 37 CFR 1.362(h) states that the periods specified for payment of the maintenance fees “are counted from the date of grant of the original non-reissue application on which the reissued patent is based.” The facts are that the original non-reissue application was granted and the reissue patent was granted exactly two years later. A year from the date of grant of the reissue would calculate to be 3 years from the date of the grant of a patent on the original non-reissue application. 37 CFR 1.362(d)(1) indicates that a maintenance fee may be paid in patents without surcharge if paid during the period “3 years through 3 years and 6 months after grant for the first maintenance fee.” (A), (B), and (C) are wrong because 37 CFR 1.362(b) states, in pertinent part, “Maintenance fees are not required for any plant patents or for any design patents.” (D) is wrong because payment of the maintenance fee without surcharge for the 2nd maintenance fee must be made during the period “7 years through 7 years and 6 months after grant of the nonprovisional utility patent.”

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

November 3, 1999 AM

35. ANSWER: (C). 35 U.S.C. § 41(b); 37 CFR § 1.20(e). There is no maintenance fee for a plant patent. Thus, all of the other answers, which assume that a maintenance fee is owed, are wrong.

Chapter 2600

Questions

April 17, 2002 PM

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

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

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48. Your longstanding client, Acme Chemical, comes to you for advice concerning a competitor’s patent that Acme fears might cover Acme’s key commercial product. Acme informs you that it began selling its product approximately eleven months before the competitor filed its patent application, and that a complete description of the product and how to make it was published in a trade magazine approximately ten months before the competitor’s December 8, 1999 application filing date. Acme asks you to recommend options short of litigation that might be available to challenge validity of the patent. Acme also asks that in making your recommendation you take into account that Acme will not challenge the patent’s validity unless it can be actively involved in all phases of the proceeding, even if that involvement will increase Acme’s costs. Which of the following is the most reasonable advice to Acme?

- (A) You suggest that Acme request *ex parte* reexamination on the basis of the trade magazine publication and that Acme file a reply to any statement by the patent owner concerning any new question of patentability.
- (B) You suggest that Acme request *ex parte* reexamination on the basis of Acme’s prior sales and the trade magazine publication.
- (C) You suggest that Acme request *inter partes* reexamination on the basis of the trade magazine publication only.
- (D) You suggest that Acme request *inter partes* reexamination on the basis of Acme’s prior sales and the trade magazine publication.
- (E) You suggest that Acme inform the competitor in writing of the prior sales and trade magazine publication to force the competitor to inform the USPTO of this information and to force the competitor to initiate a reexamination of its own patent.

Chapter 2600

Answers

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

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48. ANSWER: (C). Answers (B) and (D) are unreasonable advice at least because reexamination is available only on the basis of prior art patents or publications. *See, e.g.*, 37 CFR 1.510, 1.552, 1.906 and 1.915. A request for reexamination may not properly rely upon evidence of public use or sales. Answer (A) is less reasonable than (C) at least because Acme will have the opportunity to submit a reply only if the patent owner chooses to file a statement under 37 CFR 1.530. 37 CFR 1.535. Any further proceedings would be completely *ex parte*. Acme has made it clear that it wants to participate in the proceedings. Answer (E) is less reasonable than (C) because a patent owner is not obliged to cite prior art to the USPTO in an issued patent. Also, the competitor would not be required to request reexamination. Indeed, the competitor would not be able to request reexamination unless the competitor had a good faith belief that the trade magazine article raised a substantial new question of patentability.

Chapter 2700

Questions

April 17, 2002 AM

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

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

April 17, 2002 AM

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

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

April 17, 2002 AM

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

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

Chapter 2700

Answers

April 17, 2002 AM

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

April 17, 2002 AM

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

Part 10

Questions

April 15, 2003 AM

23. Which of the following is not prohibited conduct for a practitioner under the USPTO Code of Professional Responsibility?

- (A) Entering into an agreement with the client to limit the amount of any damages which the client may collect for any mistakes the practitioner may make during prosecution of the client's patent application in exchange for prosecuting the application at a reduced fee.
- (B) Encouraging the client to meet with an opposing party for settlement discussions.
- (C) Failing to disclose controlling legal authority which is adverse to the practitioner's client's interest when arguing the patentability of claims in a patent application.
- (D) In reply to an Office action, stating honestly and truthfully in the remarks accompanying an amendment that the practitioner has personally used the device and found it to be very efficient and better than the prior art.
- (E) Investing the funds the client advanced for the practitioner legal fees (not costs and expenses) in long term United States Treasury Bills in order to obtain guaranteed protection of the principal.

April 18, 2001 PM

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

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

October 18, 2000 PM

9. In August 1999, a recently registered patent agent, who is not an attorney, asked a registered patent attorney to help the agent establish a practice. Considering the additional facts in the following choices separately, which choice best comports with the professional responsibilities of both the agent and the attorney?

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

April 12, 2000 AM

44. Which of the following is not prohibited conduct for a practitioner under the PTO Code of Professional Responsibility?

- (A) Entering into an agreement with your client to limit the amount of any damages which your client may collect for any mistakes you make during prosecution of your client's patent application in exchange for prosecuting the application at a reduced fee.
- (B) Encouraging your client to meet with an opposing party for settlement discussions.
- (C) Failing to disclose controlling legal authority which is adverse to the client's interest when arguing the patentability of claims in a patent application.
- (D) In reply to an Office action, stating honestly and truthfully in the remarks accompanying an amendment that you have personally used the device and found it to be very efficient and better than the prior art.
- (E) Investing the funds your client advanced for your legal fees (not costs and expenses) in long term United States Treasury Bills in order to obtain guaranteed protection of the principal.

April 12, 2000 AM

49. Which of the following statements is NOT true?

- (A) In representation of a client, a patent practitioner may not refuse a client's request that the practitioner aid or participate in conduct that the practitioner believes to be unlawful so long as there is some support for an argument that the conduct is legal.
- (B) A patent practitioner may not form a partnership with a non-practitioner if any of the activities of the partnership consists of the practice of patent law before the PTO.
- (C) In a patent case, a practitioner may take an interest in the patent as part or all of his or her fee.
- (D) If a practitioner receives information clearly establishing that a client has, in the course of representation, perpetrated a fraud on the PTO that the client refuses or is unable to reveal, the practitioner must reveal the fraud to the PTO.
- (E) A patent practitioner may not accept compensation from a friend of a client for legal services performed by the practitioner for the client, unless the client consents after full disclosure.

April 12, 2000 PM

7. A potential new client XYZ Corp. calls you for representation. The President of XYX informs you that XYZ has been accused by ANY Corp. of infringing ANY's soon to be issued patent. The President indicates that XYZ has been making the accused infringing device for three months, and want to file their own patent application on the device themselves. You determine that your law partner, also a registered practitioner, represents ANY before the PTO in regard to the patent application filed by ANY, and that you and the partner have a power of attorney in the application from ANY. Which of the following should you do and/or advise XYZ, to do in accordance with the PTO Disciplinary Rules?

- (A) Decline to accept employment from XYZ.
- (B) Perform a patent search, and upon locating a published PCT application referencing the patent application filed by ANY, you decide that no information about the ANY application is confidential. Thus, you can ask your partner for information regarding the ANY application to relay to your client, XYZ.
- (C) Advise XYX that you can file a patent application for the device on behalf of XYZ. Even though ANY was the first to file, an interference may be declared to determine priority of invention if the claims are the same or substantially similar.
- (D) Advise XYZ that because your partner has had experience with similar types of cases, that it will be easy for him to file a patent application on behalf of XYZ.
- (E) You must ask XYZ for any prior art which they have available and give it to your partner in order to satisfy the duty of disclosure rules with respect to the case which your partner is handling for ANY.

April 12, 2000 PM

36. Which of the following is **true** ?

- (A) As a registered practitioner, it is not necessary to notify the Director of Enrollment and Discipline of your address changes as long as you file a change of address in each individual application for which you are responsible.
- (B) At any time the Director of Enrollment and Discipline may send out letters to registered practitioners for the purpose of ascertaining whether they wish to remain on the register and if no reply is received, without further warning, the name may be removed from the register.
- (C) A practitioner may not refuse to aid or participate in conduct that the practitioner believes to be unlawful, even though the client presents some support for an argument that the conduct is legal.
- (D) Any person who passes this examination and is registered as a patent agent or patent attorney is entitled to file and prosecute patent applications and trademark registration applications before the PTO for the same client.
- (E) It is permissible to give examiners gifts valued at between \$25 and \$250 so long as the gift is made after issuance of all patent applications that the practitioner or the practitioner's firm has before the Examiner.

April 12, 2000 PM

43. Which of the following is not prohibited conduct for a practitioner under the PTO Code of Professional Responsibility?

- (A) The practitioner entering into a business partnership with an individual who is neither an attorney nor a registered practitioner, where the activities of the partnership consist of the practice of patent law before the Office by the practitioner, and the individual will market the practitioner's services and the client's inventions.
- (B) Filing an amendment wherein claims are presented that have been copied from an issued patent of another, and knowingly withholding from the Office information identifying the patent from which the claims have been copied.
- (C) Telling a client that the client's application will go abandoned if the client's bill is not paid and refusing to file any papers in the PTO unless and until the fee is paid.
- (D) Upon being discharged by a client, filing a request to withdraw wherein the client's intent to discharge is set forth as the reason for the request.
- (E) When the client refuses to pay, without the client's consent after full disclosure, accepting compensation from a client's friend for the practitioner's legal services on behalf of the client.

November 3, 1999 AM

11. In August 1999, a recently registered patent agent, who is not an attorney, asked a registered patent attorney to help the agent establish a practice. Considering the additional facts in the following choices separately, which choice best comports with the professional responsibilities of both the agent and the attorney?

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

Part 10

Answers

April 15, 2003 AM

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

April 18, 2001 PM

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

October 18, 2000 PM

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

April 12, 2000 AM

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

April 12, 2000 AM

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

April 12, 2000 PM

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

April 12, 2000 PM

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

April 12, 2000 PM

43. ANSWER: (D). See 37 CFR § 10.40 where it states: "(b) Mandatory withdrawal. A practitioner representing a client before the Office shall withdraw from employment if:...

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

November 3, 1999 AM

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

General Questions

April 15, 2003 AM

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

- (A) In rejecting claims the examiner may rely upon facts within his own personal knowledge, unless the examiner qualifies as an expert within the art, in which case he is precluded from doing so, since only evidence of one of ordinary skill in the art is permitted.
- (B) If an applicant desires to claim subject matter in a reissue which was the same subject matter waived in the statutory invention registration of another, the applicant is precluded by the waiver from doing so, even though the applicant was not named in the statutory invention registration.
- (C) If an applicant, knowing that the subject matter claimed in his patent application was on sale in Michigan and sales activity is a statutory bar under 35 USC 102(b) to the claims in his application, nevertheless withholds the information from the patent examiner examining the application, and obtains a patent including the claims in question, the applicant may remove any issue of inequitable conduct by filing a request for reexamination based on the sales activity.
- (D) An applicant for a patent may overcome a statutory bar under 35 USC 102(b) based on a patent claiming the same invention by acquiring the rights to the patent pursuant to an assignment and then asserting the assignee's right to determine priority of invention pursuant to 37 CFR 1.602.
- (E) None of the above.

April 15, 2003 AM

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

- (A) Once the issue fee has become due, provided an original application has not been pending more than three years, the applicant may request and the Office may grant a request for deferral of payment of the issue fee.
- (B) The time period set for the payment of the issue fee is statutory and cannot be extended. However, if payment is not timely made and the delay in making the payment is shown to be unavoidable, upon payment of a fee for delayed payment, it may be accepted as though no abandonment had occurred, but there will be a reduction on the patent term adjustment for the period of abandonment.
- (C) Upon written request, a person citing patents and printed publications to the Office that the person believes has a bearing on the patentability of a particular patent, may request that his or her name remain confidential.
- (D) To obtain benefit of priority based on an earlier filed U.S. patent application, an applicant in a later filed continuation application is not required to meet the conditions and requirements of 35 USC 120.
- (E) Each of statements (B) and (C) is true.

October 16, 2002 AM

25. If a *prima facie* case of obviousness is properly established by a primary examiner, how can an applicant effectively rebut the rejection in accordance with proper USPTO practice and procedure?

- (A) Rebuttal may be by way of arguments of counsel used in place of factually supported objective evidence to rebut the *prima facie* case.
- (B) Rebuttal may be by way of an affidavit or declaration under 37 CFR 1.132 containing objective evidence arising out of a secondary consideration related to the claimed invention.
- (C) No substantive showing is required by applicant. The burden remains on the examiner to maintain a *prima facie* case.
- (D) Rebuttal evidence must be found elsewhere than in the specification.
- (E) Rebuttal may be by way of arguing that the prior art did not recognize latent properties.

October 16, 2002 AM

The following facts apply to Questions 28 and 29.

Claims 1 and 2, fully disclosed and supported in the specification of a patent application having an effective filing date of March 15, 2000, for sole inventor Ted, state the following:

Claim 1. An apparatus intended to be used for aerating water in a fish tank, comprising:

- (i) an oxygen source connected to a tube, and
- (ii) a valve connected to the tube.

Claim 2. An apparatus as in claim 1, further comprising an oxygen sensor connected to the valve.

28. Which of the following claims, if fully disclosed and supported in the specification, and included in the application, provides a proper basis for an objection under 37 CFR 1.75(c)?

- (A) Claim 3. An apparatus as in any one of the preceding claims, in which the tube is plastic.
- (B) Claim 3. An apparatus according to claims 1 or 2, further comprising a temperature sensor connected to the valve.
- (C) Claim 3. An apparatus as in the preceding claims, in which the tube is plastic.
- (D) Claim 3. An apparatus as in any preceding claim, in which the tube is plastic.
- (E) Claim 3. An apparatus as in either claim 1 or claim 2, further comprising a temperature sensor connected to the valve.

29. Which of the following, if relied on by an examiner in a rejection of claim 2, can be a statutory bar under 35 USC 102 of claim 2?

- (A) A U.S. patent to John, issued February 2, 1999, that discloses and claims an apparatus intended to be used for aerating ice cream, having an oxygen source connected to a tube, a valve connected to the tube, and a battery coupled to the oxygen source.
- (B) A U.S. patent to John, issued April 6, 1999, that discloses and claims an apparatus intended to be used for aerating water in a fish tank, having an oxygen source connected to a tube, a valve connected to the tube, and an oxygen sensor connected to the tube.
- (C) A U.S. patent to Ned, issued February 9, 1999, that discloses, but does not claim, an apparatus intended to be used for aerating ice cream, having an oxygen source connected to a tube, a valve connected to the tube, an oxygen sensor connected to the valve, and a battery coupled to the oxygen source.
- (D) A foreign patent to Ted issued April 12, 2000, on an application filed on March 12, 1997. The foreign patent discloses and claims an apparatus intended to be used for aerating water in a fish tank, having an oxygen source connected to a tube, a valve connected to the tube, and an oxygen sensor connected to the tube.
- (E) None of the above.

October 16, 2002 PM

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

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

October 16, 2002 PM

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

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

April 17, 2002 AM

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

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

27. Upon initial examination, the patent examiner issues a requirement for restriction on the basis that the application claims two or more independent and distinct inventions. Specifically, the examiner requires an election between (a) claims directed to the non-hormonal substance *per se* (claims 1-5); (b) claims directed to the salt lick and to the method of forming the salt lick (claims 6-14); and (3) claims directed to the method of controlling deer population by distributing salt licks that are treated with XYZ to reduce pregnancy rates

(claims 15-20). The restriction requirement was set forth in an Office action dated December 12, 2001, and the examiner set a one month (not less than 30 days) shortened statutory period for response. December has 31 calendar days. Which of the following is most likely to be treated by the USPTO as a timely, fully responsive reply to the Office action.

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

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

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

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

- (A) The Examiner may properly reject claim 15 under 35 U.S.C. §103 as being obvious over Deere in view of Doe because Deere teaches the method of distributing salt licks treated with a substance to reduce pregnancy rates and suppression of sexual activity in male deer is merely an inherent characteristic of a known substance XYZ.

- (B) The examiner may not rely on the Doe patent in a 35 U.S.C. § 103 obviousness rejection because there is no evidence that Salt was aware of its teachings at the time the invention was made and therefore the invention could not have been obvious to Salt at that time.
- (C) The examiner may rely on the Doe patent in making an obviousness rejection under 35 U.S.C. § 103 only if the Doe patent is in the field of Salt's endeavor or, if not in that field, then reasonably pertinent to the problem with which Salt was concerned.
- (D) The examiner may properly reject claim 15 under the first paragraph of 35 U.S.C. § 112 because the specification is inadequate to enable a person skilled in the art to which it pertains to practice the invention.
- (E) The examiner may properly reject claim 15 under the second paragraph of 35 U.S.C. § 112 because the recitation of "an effective amount of XYZ" renders the claim indefinite.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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8. Joan comes to you wanting to know the status of the applications of her competitor Pete. During Joan's previous relationship with Pete she believes she may have been a coinventor on one of the applications filed by Pete. Pete owns Applications A, B, C and D. Application B is a continuation of application A and a redacted copy of application A has been published under 35 U.S.C. §122(b). Joan is listed as a coinventor on Application C. Pete has an issued patent that claims priority to Application D. Assume only the last six digits of the numerical identifier are available for Application D and Application D is abandoned. Which of the following is not true?

- (A) Joan may obtain status information for Application B that is a continuation of an application A since application A has been published under 35 U.S.C. § 122(b).
- (B) Joan may be provided status information for Application D that includes the filing date if the eight-digit numerical identifier is not available and the last six digits of the numerical identifier are available.
- (C) Joan may obtain status information for Application D since a U.S. patent includes a specific reference under 35 U.S.C. §120 to Application D, an abandoned application. Joan may obtain a copy of that application-as-filed by submitting a written request including the fee set forth in 37 CFR 1.19(b)(1).
- (D) Joan may obtain status information as to Application C since a coinventor in a pending application may gain access to the application if his or her name appears as an inventor in the application, even if she did not sign the § 1.63 oath or declaration.
- (E) Joan may obtain access to the entire Application A by submitting a written request, since, notwithstanding the fact that only a redacted copy of Application A has been published, a member of the public is entitled to see the entire application upon written request.

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The following facts apply to Questions 16 and 17.

Claims 1 and 2, fully disclosed and supported in the specification of a patent application having an effective filing date of March 15, 2000, for sole inventor Ted, state the following:

Claim 1. An apparatus intended to be used for aerating water in a fish tank, comprising:

- (i) an oxygen source connected to a tube, and
- (ii) a valve connected to the tube.

Claim 2. An apparatus as in claim 1, further comprising an oxygen sensor connected to the valve.

16. Which of the following claims, if fully disclosed and supported in the specification, and included in the application, provides a proper basis for an objection under 37 CFR 1.75(c)?

- (A) Claim 3. An apparatus as in any one of the preceding claims, in which the tube is plastic.
- (B) Claim 3. An apparatus according to claims 1 or 2, further comprising a temperature sensor connected to the valve.
- (C) Claim 3. An apparatus as in the preceding claims, in which the tube is plastic.
- (D) Claim 3. An apparatus as in any preceding claim, in which the tube is plastic.
- (E) Claim 3. An apparatus as in either claim 1 or claim 2, further comprising a temperature sensor connected to the valve.

17. Which of the following, if relied on by an examiner in a rejection of claim 2, can be a statutory bar under 35 U.S.C. § 102 of claim 2?

- (A) A U.S. patent to John, issued February 2, 1999, that discloses and claims an apparatus intended to be used for aerating ice cream, having an oxygen source connected to a tube, a valve connected to the tube, and a battery coupled to the oxygen source.
- (B) A U.S. patent to John, issued April 6, 1999, that discloses and claims an apparatus intended to be used for aerating water in a fish tank, having an oxygen source connected to a tube, a valve connected to the tube, and an oxygen sensor connected to the tube.
- (C) A U.S. patent to Ned, issued February 9, 1999, that discloses, but does not claim, an apparatus intended to be used for aerating ice cream, having an oxygen source connected to a tube, a valve connected to the tube, an oxygen sensor connected to the valve, and a battery coupled to the oxygen source.
- (D) A foreign patent to Ted issued April 12, 2000, on an application filed on March 12, 1997. The foreign patent discloses and claims an apparatus intended to be used for aerating water in a fish tank, having an oxygen source connected to a tube, a valve connected to the tube, and an oxygen sensor connected to the tube.
- (E) None of the above.

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28. Which of the following is true?

- (A) When an applicant successfully petitions to make his case special, the special status ends if applicant appeals the case to the Board of Patent Appeals and Interferences.
- (B) A reissue application may be filed in order to broaden claims back to their original form where the claims were mistakenly narrowed during the original prosecution to avoid the prior art provided that the narrowing of the claims was made without deceptive intent on the part of the applicant.
- (C) If the Board of Patent Appeals and Interferences decides to require an appellant to address a particular matter, and the appellant cannot respond within the time period set, he may obtain an extension of time by paying the requisite fee.
- (D) Following a new ground of rejection raised by the Board of Patent Appeals and Interferences, the applicant may request a rehearing, or submit an appropriate amendment of the rejected claims or a showing of facts relating to the rejected claims.
- (E) In an *ex parte* reexamination proceeding, a third party requester who is dissatisfied with a decision of the Board of Patent Appeals and Interferences may seek judicial review by appeal to either the U.S. Court of Appeals for the Federal Circuit or by civil action in the U.S. District Court for the District of Columbia.

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The following facts apply to Questions 29 through 32.

Kat Forrest has been a famous golf prodigy since childhood and currently enjoys phenomenal success on the professional golf tour, having won four straight major titles. Kat conceived, constructed and successfully tested a golfer's aid to help less-skilled players. Briefly, the aid includes a distance-finder that determines the precise distance from the golfer's ball to a target such as a fairway landing area or the hole. The aid obtains data concerning playing conditions (*e.g.*, wind speed and direction, soil moisture, *etc.*) from a series of sensors distributed throughout a golf course. A global positioning system provides accurate positional coordinates for the ball location and the target location. A user interface allows manual input of situational data (*e.g.*, ball in divot) and permits the user to override system settings and sensor data. The golfer's aid also includes computer memory that stores performance data calibrated to a specific golfer. In use, a digital processor determines a suggested play based on playing conditions and golfer skill level, and automatically displays information concerning the suggested play (*e.g.*, recommended golf club and preferred line of flight for the ball). Other information can be displayed in reply to user requests.

Kat comes to you in September 2001 and asks you to prepare and file a patent application on her behalf. She informs you that she has shown the golfer's aid only to her caddie and only under terms of strict confidentiality, and that she finalized the design on June 5, 2001. Her golfer's aid has not been sold or offered for sale. She also informs you that she derived the

general idea for the golfer's aid, in part, from (1) an article appearing in the July 2000 edition of a golf magazine concerning a commercial distance finder and (2) a customized personal digital assistant (PDA) she saw on a store shelf while traveling in Thailand in April 2001. The distance finder has been available for sale in the United States since August 2000. The customized PDA was first offered for sale in the United States on June 8, 2001, but has not been disclosed in any publication or patent document. You prepare a patent application with claims that you believe are likely to be found patentably distinct over the commercially available distance finder and the golf magazine article, either alone or in combination. The application is filed with the USPTO on September 17, 2001.

29. Which of the following statements is most true?

- (A) Kat should disclose the golf magazine article to the USPTO for consideration by the examiner, but need not disclose information concerning the customized PDA.
- (B) Kat need not disclose either the golf magazine article or information concerning the customized PDA to the USPTO for consideration by the examiner.
- (C) Kat should disclose both the golf magazine article and information concerning the customized PDA to the USPTO for consideration by the examiner.
- (D) Kat's observation of the customized PDA is not material to patentability because the observation took place in Thailand and the PDA was not offered for sale in the United States until June 2001, the PDA has not been described in a publication, and the PDA has not been patented.
- (E) Kat's observation of the customized PDA cannot be material to patentability because golfer's aids are nonanalogous art.

30. Which of the following is most likely to be considered in a proper obviousness determination?

- (A) Evidence demonstrating the manner in which the invention was made.
- (B) Evidence that a combination of prior art teachings, although technically compatible, would not be made by businessmen for economic reasons.
- (C) Evidence demonstrating the level of ordinary skill in the art.
- (D) Evidence that one of ordinary skill in the art, after reading Kat's application, would readily be able to make and use Kat's invention without undue experimentation.
- (E) Evidence that the distance finder described in the July 2000 golf magazine has enjoyed great commercial success.

31. A United States patent issued to Jack Nichols on September 18, 2001 based on an application filed in the USPTO in May 2000. The Nichols patent claimed priority from a German application that was filed in April 2000 and was first published in October 2001. The Nichols U.S. application was an exact translation of the German priority application, and fully anticipated the subject matter of Kat's broadest claims. The Examiner locates the Nichols U.S. patent and the Nichols published priority application during prosecution. Which of the following actions, if taken by the Examiner, would be most proper (keeping in mind that the Examiner has no evidence of Kat's activities prior to September 17, 2001)?

- (A) Reject Kat's broadest claims under 35 U.S.C. §102(a) because Nichols' U.S. patent is evidence that the claimed subject matter was known by others prior to Kat's invention.
- (B) Reject Kat's broadest claims under 35 U.S.C. § 102(a) because the claimed subject matter was patented or described in a printed publication by Nichols before Kat's invention.
- (C) Reject Kat's broadest claims under 35 U.S.C. § 102(b) because the claimed subject matter was patented or described in a printed publication by Nichols before Kat's invention.
- (D) Reject Kat's broadest claims under 35 U.S.C. § 102(d) because the claimed subject matter was first patented or caused to be patented in a foreign country on an application filed more than twelve months before Kat's filing date.
- (E) Reject Kat's broadest claims under 35 U.S.C. § 102(e) because the claimed subject matter was described in a U.S. patent granted to Nichols on an application filed before Kat's invention.

32. Kat's patent application includes the following incomplete independent claim 8 and complete dependent claims 9 and 10:

Claim 8. An aid for assisting a golfer comprising:

- i) a _____ display _____ device;
- ii) an input device adapted to receive user inputs from said golfer;
- iii) _____;
- iv) a memory for storing user specific data indicating, at least in part, a skill level for said golfer; and
- v) a processor which (1) obtains signals from said input device, said receiver, and said memory, (2) calculates a suggested play based at least in part on said signals from said input device, said receiver, and said memory, and (3) displays said suggested play on said display device.

Claim 9. The aid of claim 8, wherein said plurality of remote devices includes multiple sensors distributed on a golf course for detecting and transmitting playing condition data.

Claim 10. The aid of claim 9, wherein said plurality of remote devices further includes a global positioning system for obtaining position data.

Which of the following best completes claim 8?

- (A) a plurality of remote devices operable to detect playing conditions and position and to generate sensor signals that indicate playing condition data and position data;
- (B) a plurality of remote devices, said plurality of remote devices including at least one device that indicates playing condition data and at least one device that indicates position data;
- (C) means for receiving playing condition data and position data transmitted by a plurality of remote devices;
- (D) a receiver operable to obtain data transmitted by a plurality of remote devices, said plurality of remote devices including at least one device that transmits playing condition data and at least one device that transmits position data;
- (E) a receiver operable to obtain a plurality of remote sensor signals, said remote sensor signals indicating playing condition data and position data;

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33. Igor, a refugee from the civil turmoil that recently befell his native country, filed a design patent application in the USPTO on January 24, 2000, which issued as a design patent on January 23, 2001. Igor's design patent covered a design of a cell phone holder for motor vehicles and became immediately popular with cell phone owners, resulting in numerous inquiries for licenses from various manufacturers. Igor would like to financially exploit his patent by licensing for five years. However, in appreciation for the benefits bestowed upon him since immigrating to the U.S., Igor has decided to dedicate five years of his patent term to the public. Which of the following is in accord with proper USPTO practice and procedure, while best allowing Igor to pursue his intentions?

- (A) Record in the USPTO an assignment of all right, title, and interest in the patent to the public, conditioned on the receipt by Igor of all royalties from licensing the patent after the first five years of the patent term.
- (B) File a disclaimer in the USPTO dedicating to the public the first five years of the patent term.
- (C) File a disclaimer in the USPTO dedicating to the public that portion of the term of the patent from January 24, 2015 to January 24, 2020.
- (D) File a disclaimer in the USPTO dedicating to the public half of all royalties received from licensing the patent for the terminal part of the term of the patent.
- (E) File a disclaimer in the USPTO dedicating to the public that portion of the term of the patent from January 24, 2010 to January 23, 2015.

October 17, 2001 AM

35. During their period of courtship, Amy and Pierre invented and actually reduced to practice an improved frying pan, wherein the sides and integral handle are formed from a metal having a low coefficient of conductivity, and a base providing the cooking surface formed from a metal having a high coefficient of conductivity. While the basic concept was old in the art, Amy's concept was to sandwich a layer of aluminum between layers of copper, while Pierre's concept was to sandwich a layer of copper between layers of aluminum. Accordingly, acting as *pro se* joint inventors, they filed a nonprovisional patent application in the USPTO on January 10, 2001, along with a proper nonpublication request. The application disclosed both Amy's and Pierre's concepts in the specification, and contained three independent claims: claim 1 was generic to the two concepts; claim 2 was directed to Amy's concept, and claim 3 was directed to Pierre's concept. Thereafter, Amy and Pierre had a "falling out" and Pierre returned to his home in France where he filed a corresponding patent application in the French Patent Office on January 31, 2001. Pierre was completely unaware of any obligation to inform the USPTO of the French application. Amy first learned of Pierre's application in the French Patent Office on October 10, 2001. Once Amy learns of the French application, which of the following actions should she take which accords with proper USPTO practice and procedure and which is in her best interest?

- (A) Immediately notify the USPTO of the filing of the corresponding application in the French Patent Office.
- (B) Promptly submit a request to the USPTO under Amy's signature to rescind the nonpublication request.
- (C) File an amendment under Amy's signature deleting claim 3 and requesting that Pierre's name be deleted as an inventor on the ground that he is not an inventor of the invention claimed.
- (D) Promptly file a document, jointly signed with Pierre, giving notice to the USPTO of the filing of the corresponding application in the French Patent Office and showing that any delay in giving the notice was unintentional.
- (E) File an application for a reissue patent that is accompanied by an amendment paper with proper markings deleting Pierre's concept from the specification and a statement canceling claims 1 and 3.

October 17, 2001 AM

45. Which of the following statements accords with proper USPTO practice and procedure?

- (A) A request for publication of a provisional application on a certain date will be treated as a request for publication as soon as possible.
- (B) If an applicant filed an application in a foreign country and the description of the invention in the foreign application is less extensive than the description of the invention in the application filed in the USPTO, the applicant may submit a redacted copy, eliminating the description not contained in the foreign application, for publication within 12 months after the filing date for which a benefit is sought under 35 U.S.C.

- (C) Early publication of a reissue application may be honored only if accompanied by a copy of the application in compliance with the Office electronic filing system requirements.
- (D) If an applicant filed an application in a foreign country and the description of the invention in the foreign application is more extensive than the description of the invention in the application filed in the USPTO, the applicant may submit a redacted copy, eliminating the description not contained in the foreign application, for publication within 14 months after the filing date for which a benefit is sought under 35 U.S.C.
- (E) Re-publication of a patent application is available where the Office makes a material mistake apparent from the records and the request for re-publication is filed within 3 months from the date of the patent application publication.

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49. Joe files a nonprovisional patent application containing claims 1 through 10 in the USPTO and properly receives a filing date of December 6, 2000. The first Filing Receipt including a confirmation number for the application was mailed on December 20, 2000. On January 30, 2001, the examiner mails Joe a NOTICE indicating that a nucleotide sequence listing in accordance with 37 CFR§ 1.821-1.825 is required. On February 27, 2001, Joe files the required sequence listing as well as a preliminary amendment adding claims 11 through 13 to the application, along with a copy of the application as amended in compliance with the Office electronic filing system requirements. Assuming the Office has not started the publication process at such time and that Joe's application is subsequently published pursuant to 35 U.S.C. § 122(b), which of the following statements accords with proper USPTO practice and procedure?

- (A) The published application will contain claims 1 through 10 only because the preliminary amendment adding claims 11 through 13 was not submitted in reply to the NOTICE.
- (B) The published application will contain claims 1 through 13 because a copy of the application as amended in compliance with the Office electronic filing system requirements was filed.
- (C) The published application will contain claims 1 through 10 only because the copy of the application as amended in compliance with the Office electronic filing system requirements was not filed within one month of the actual filing date of the application.
- (D) The published application may contain claims 1 through 13 because the Office may use an untimely filed copy of the application as amended in compliance with the Office electronic filing system requirements where the Office has not started the publication process.
- (E) The published application will contain claims 1 through 10 only because publication is based solely on the application papers deposited on the filing date of the application.

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The following facts apply to Questions 14 through 16.

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

Thomas was occupied with other matters and did not file a reply in full compliance with the Notice until September 3, 2001. A Petition for a three-month extension of time and all required fees accompanied the reply.

A first substantive Office action on the merits of the application issued January 21, 2002 and set a three-month shortened statutory time period for reply. All pending claims were rejected on the basis of prior art. Thomas filed a fully responsive Amendment on April 15, 2002, and a final Office action issued September 12, 2002 with a three-month shortened statutory period for reply. The final Office Action allowed certain claims and rejected other claims on substantially the same grounds set forth in the first Office action. Thomas filed a Notice of Appeal on October 21, 2002 and an Appeal Brief on April 18, 2003. A Petition for extension of time and proper authorization to charge a deposit account for any required fees accompanied the Appeal Brief.

An Examiner's Answer issued on May 2, 2003, and Thomas filed a Reply Brief on May 15, 2003. The Board of Patent Appeals and Interferences affirmed the Examiner's rejections on September 17, 2003. With regard to the allowed claims, a Notice of Allowance and Issue Fee Due was mailed October 3, 2003. Thomas paid the Issue Fee on October 20, 2003 and the patent issued March 23, 2004.

14. The Director of the U.S. Patent and Trademark Office determined that Thomas failed to engage in reasonable efforts to conclude prosecution of the application from January 21, 2003 to April 18, 2003. Which of the following statements is most true?

- (A) Thomas is entitled to no patent term adjustment because the Patent Term Guarantee Act of 1999 does not apply to Thomas' patent application.
- (B) Although the Patent Term Guarantee Act of 1999 applies to Thomas' application, Thomas forfeited any patent term adjustment by failing to engage in reasonable efforts to conclude prosecution of the application from January 21, 2003 to April 18, 2003.
- (C) Thomas is entitled to a patent term adjustment of approximately two (2) months because the application was pending for more than three (3) years.
- (D) By responding to the Notice to File Missing Parts approximately three (3) months after the deadline set by the USPTO, Thomas reduced any patent term adjustment by approximately three (3) months.
- (E) Statements (A), (B), (C) and (D) are each incorrect.

15. In the facts set forth in connection with the preceding question, what, if any, extension of time was required by Thomas for filing an Appeal Brief on April 18, 2003?

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

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

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

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32. Which of the following is true?

- (A) Once the issue fee has become due, provided an original application has not been pending more than three years, the applicant may request and the Office may grant a request for deferral of payment of the issue fee.
- (B) The time period set for the payment of the issue fee is statutory and cannot be extended. However, if payment is not timely made and the delay in making the payment is shown to be unavoidable, upon payment of a fee for delayed payment, it may be accepted as though no abandonment had occurred, but there will be a reduction on the patent term adjustment for the period of abandonment.
- (C) Upon written request, a person citing patents and printed publications to the Office that the person believes has a bearing on the patentability of a particular patent, may request that his or her name remain confidential.
- (D) To obtain benefit of priority based on an earlier filed patent application, an applicant in a later filed continuation application is not required to claim priority under 35 U.S.C. § 120 to an earlier filed application.
- (E) Each of statements (B) and (C) is true.

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The following facts pertain to questions 33 and 34.

Applicant Sonny filed a patent application having an effective U.S. filing date of February 15, 2000. The application fully discloses and claims the following:

- Claim 1. An apparatus for converting solar energy into electrical energy comprising:
- (i) a metallic parabolic reflector;
 - (ii) a steam engine having a boiler located at the focal point of the metallic parabolic reflector; and
 - (iii) an electrical generator coupled to the steam engine.

In a non-final Office action dated March 15, 2001, the examiner rejects claim 1 under 35 U.S.C. § 102(d) as anticipated by a patent granted in a foreign country to Applicant Sonny ("Foreign patent"). The Foreign patent was filed February 1, 1999, and was patented and published on January 17, 2000. The examiner's rejection points out that the invention disclosed in the Foreign patent is a glass lens with a steam engine having a boiler at the focal point of the glass lens, and an electrical generator coupled to the steam engine. The rejection states that the examiner takes official notice that it was well known by those of ordinary skill in the art of solar energy devices, prior to Applicant Sonny's invention, to use either a lens or a parabolic reflector to focus solar rays.

33. Sonny informs you that you should not narrow the scope of the claims unless absolutely necessary to overcome the rejection. Which of the following, in reply to the Office action dated March 15, 2001, is best?

- (A) Traverse the rejection arguing that the examiner's use of the Foreign patent is improper because an applicant cannot be barred by a foreign patent issued to the same applicant.
- (B) Amend claim 1 to further include a feature that is disclosed only in the U.S. application, and point out that the newly added feature distinguishes Sonny's invention over the invention in the Foreign patent.
- (C) Traverse the rejection arguing that the examiner does not create a *prima facie* case of obviousness because the examiner does not show why one of ordinary skill in the art of solar energy devices would be motivated to modify the Foreign patent.
- (D) Traverse the rejection arguing that the examiner's rejection under 35 U.S.C. § 102(d) was improper because claim 1 is not anticipated by the Foreign patent.
- (E) Traverse the rejection arguing that it was not well known to use either a lens or a parabolic reflector to focus solar rays, and submit an affidavit under 37 CFR 1.132.

34. Which of the following claims, if fully disclosed and presented in Sonny's U.S. application, provides a proper basis for an objection under 37 CFR 1.75(c)?

- (A) Claim 2. An apparatus as in claim 1, further comprising a voltage regulator coupled to the electrical generator.
- (B) Claim 2. An apparatus as in claim 1, wherein the metallic parabolic reflector is aluminum.
- (C) Claim 2. An apparatus as in claim 1, wherein the steam engine has two cylinders.
- (D) Claim 2. An apparatus as in claim 1, wherein the parabolic reflector is either metallic or plastic.
- (E) Claim 2. An apparatus as in claim 1, further comprising an electronic pressure sensor coupled to the steam engine.

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

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

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

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

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

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

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21. Which of the following is true?

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

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

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

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34 – 36. The following facts apply to the following three questions.

For purposes of these questions, it should be assumed that the statutes and regulations effective as of April 18, 2001 apply for all time periods covered by the questions.

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

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

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

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

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

- (A) Joseph is entitled to no patent term extension because neither the Uruguay Round Agreements Act nor the Patent Term Guarantee Act of 1999 applies to Joseph's patent application.
- (B) Although the Patent Term Guarantee Act of 1999 applies to Joseph's application, Joseph forfeited any patent term extension by failing to engage in reasonable efforts to conclude prosecution of the application.
- (C) Joseph is entitled to a total patent term extension of approximately two (2) months because the application was pending for more than three (3) years.
- (D) Joseph's successful appellate review adds approximately 11 months to any calculation of patent term extension.
- (E) By replying to the Notice to File Missing Parts approximately two (2) months after the deadline set by the USPTO, Joseph reduced any patent term extension by two (2) months.

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

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

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

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

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

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

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

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

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

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16. Which of the following statements regarding a proper prior art reference is true?
- (A) Canceled matter in the application file of a U.S. patent is a prior art reference as of the filing date under 35 U.S.C. 102(e).
 - (B) Where a patent refers to and relies on the disclosure of a copending subsequently abandoned application, such disclosure is not available as a reference.
 - (C) Where the reference patent claims the benefit of an earlier filed, copending but subsequently abandoned application which discloses subject matter in common with the patent, and the abandoned application has an enabling disclosure for the common subject matter and the claimed matter in the reference patent, the effective date of the reference patent as to the common subject matter is the filing date of the reference patent.
 - (D) Matter canceled from the application file wrapper of a U.S. patent may be used as prior art as of the patent date.
 - (E) All foreign patents are available as prior art as of the date they are translated into English.

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Please answer questions 18 and 19 based on the following facts.

You are a registered patent practitioner handling prosecution of a patent application assigned to your client, Manufacturing Company, Inc. (“ManCo”). In discussing a reply to a first, non-final Office action with the sole named inventor (I. M. Putin) on August 11, 2000, you uncover evidence that suggests an individual employed by your client may have intentionally concealed the identity of a possible joint inventor (Phil Leftout). Leftout quit ManCo after a dispute with the company president, and is currently involved in litigation against ManCo over his severance package. You learn that Leftout would be entitled to additional severance payments if he were indeed a joint inventor. You decide it is necessary to further investigate the identity of the proper inventive entity and, if the inventive entity was misidentified on the application, determine the circumstances behind this misidentification. Particularly in light of the schedules of individuals with relevant information, such an investigation would take at least three months and perhaps longer to complete. The outstanding Office action issued 5½ months ago with a 3-month shortened statutory period for reply. The examiner has raised only minor matters of form in the Office action, and you are confident the application would be in condition for allowance after you submit a reply. After discussing the matter with you, ManCo informs you they want the matter straightened out before any patent issues on the application.

18. How do you best advise ManCo?

- (A) Recommend promptly filing a Request for Stay of Prosecution until you can complete your investigation, and upon completion of the investigation filing an appropriate reply to the outstanding Office action along with a petition and associated fees for a three month extension of time.
- (B) Recommend promptly filing a petition and associated fees for a three month extension of time along with a Request for Stay of Prosecution until you can complete your investigation, and upon completion of the investigation filing an appropriate reply to the outstanding Office action.
- (C) Recommend proceeding with prosecution by promptly filing an appropriate reply to the outstanding Office action along with a petition and associated fees for a three month extension of time; and allowing the patent to issue in Putin’s name alone with the understanding that, if the investigation shows the possible joint inventor should have been named, correcting the inventorship after issuance of the patent in accordance with 37 C.F.R. § 1.48.
- (D) Recommend promptly filing an appropriate reply to the outstanding Office action along with a petition and fees for a three-month extension of time and concurrently submitting a petition and associated fees for suspension of action for a reasonable time until you can complete your investigation.
- (E) Recommend promptly filing a petition and associated fees for suspension of action for a reasonable time until you can complete your investigation.

19. Further assume that the application is awaiting action by the Office at the time you complete your investigation. The investigation revealed that Leftout should indeed have been named as a joint inventor and that the error in naming the inventive entity resulted from Putin's assistant purposely omitting Leftout from an invention disclosure form to avoid increasing the value of Leftout's severance package. Although the application was originally filed with an inventor's Declaration and an Assignment to ManCo signed by Putin as a sole inventor, Putin did not realize at the time that he was not the sole inventor of the claimed subject matter. Leftout was unaware that the application had even been prepared and filed. Thus, neither Putin nor Leftout were aware that an error had been made in the named inventive entity. There was never any deceptive intent by either Putin or Leftout concerning the error. How do you correct the named inventive entity?

- (A) Promptly file a replacement declaration executed jointly by Putin and Leftout along with a cover letter explaining that Leftout was inadvertently omitted as an inventor.
- (B) Because Putin's assistant purposely omitted Leftout's name, the mistake in the named inventive entity was not an error without deceptive intention and the mistake cannot be corrected.
- (C) Simply file a continuation application naming Leftout and Putin as inventors and submit any necessary filing fee.
- (D) Amend the application to name Leftout and Putin as joint inventors and, along with the amendment, submit a petition including a statement from Leftout that the error in inventorship occurred without deceptive intention on his part, a declaration executed by both Putin and Leftout, and all necessary fees.
- (E) (C) and (D) are each an appropriate way to correct the named inventive entity.

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Please answer questions 38 and 39 based on the following information.

Ace Equipment Corp., approaches you with information concerning a pending original U.S. patent application of its chief competitor. A copy of the patent application, which was filed July 9, 1999, and its entire prosecution history was provided to Ace during negotiations concerning the competitor's trade secret technology. The application stands rejected by the examiner on the basis of a prior art patent. A foreign patent application corresponding to the competitor's U.S. patent application had previously published, and Ace was not required to maintain its knowledge of the U.S. application in confidence. Ace is virtually certain that the competitor had used the claimed invention publicly more than one year before the filing date of the patent application and would like to take whatever steps are available to prevent the application from issuing as a patent. However, Ace does not want the competitor to know they oppose issuance of the patent. The competitor does not know that you represent Ace.

38. Which of the following would be the best advice from you to Ace?
- (A) Recommend initiating a public use proceeding by filing a petition signed by you and serving a copy of the petition on the competitor. The petition would assert that a statutory bar exists that prohibits the patenting of the subject matter of the application, would be supported by appropriate affidavits or declarations, and would describe the subject matter that was in public use sufficiently to enable the examiner to compare the claimed subject matter to the subject matter in public use. The petition would indicate that a copy of the petition was served on the applicant and would specifically identify the application by serial number and filing date, but would not identify Ace. Any required fee would also be submitted with the petition.
 - (B) Recommend filing a copy of the competitor's application as a new patent application naming an Ace employee as the inventor. You then submit a statement that the claims have been copied from the competitor's application, and request that an interference proceeding be declared. During the interference proceeding, you can file a preliminary motion under 37 C.F.R. § 1.633(a) in an effort to obtain a ruling that the subject matter is not patentable to the competitor due to the earlier public use.
 - (C) Inform Ace that because patent applications are maintained in confidence under 35 U.S.C. § 122 and because patent prosecution is conducted *ex parte*, there is nothing that can be done until the patent issues. Once the patent issues, you can file an anonymous request for re-examination based on the competitor's public use of the invention more than one year before the filing date.
 - (D) For strategic reasons, recommend waiting to see if the competitor is able to overcome the examiner's rejection. If the patent issues, you can then file an anonymous request for re-examination on Ace's behalf based on the competitor's public use of the invention more than one year before the filing date.
 - (E) Recommend initiating an *inter partes* protest by submitting a written protest signed by you. The protest would not provide any information other than identifying the application.
39. Based on the foregoing facts, which of the following statements is true?
- (A) Since the corresponding foreign patent application was published, confidentiality of the U.S. application is waived and Ace may inspect the Patent Office file to monitor its progress simply by filing a request for access.
 - (B) Since the competitor provided Ace with a copy of the U.S. patent application and the prosecution history, confidentiality of the U.S. application is waived and Ace may inspect the Patent Office file to monitor its progress simply by filing a request for access.
 - (C) The competitor violated 35 U.S.C. § 122 by providing a copy of the application to Ace.
 - (D) A violation of 35 U.S.C. § 122 would occur if Ace publicly disclosed the competitor's patent application.
 - (E) Statements (A), (B), (C) and (D) are each untrue.

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

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

October 18, 2000 PM

7. Which of the following is true?

- (A) Once an application is ready to be issued, there is a public policy that the patent will issue in regular course once the issue fee is timely paid. In accordance with the foregoing, issuance of a patent may not be deferred.
- (B) The time period set for the payment of the issue fee is statutory and cannot be extended.
- (C) While anyone may file a request for *ex parte* reexamination, a patent practitioner filing a request for *ex parte* reexamination must disclose the client's name.
- (D) It is necessary to claim priority under 35 U.S.C. § 120 to earlier filed applications for which a corresponding claim of priority has been made in the corresponding foreign filed applications of the same applicant.
- (E) (A), (B), and (C).

October 18, 2000 PM

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

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

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

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

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

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

October 18, 2000 PM

41. Where an amendment of a specification or claims is filed after a notice of allowance has been mailed, which of the following is not in accordance with proper USPTO practice and procedure?

- (A) Even though prepared by a practitioner and mailed without a certificate of mailing and not by express mail, all prior to allowance, and the amendment reaches the Office only after the notice of allowance has been mailed, such amendment has the status of one filed after the mailing of the notice of allowance.
- (B) A supplemental oath or declaration is treated as an amendment of the specification or claims.
- (C) The amendment may be refused entry because an additional search is required.
- (D) The amendment may be refused entry because more than a cursory review of the record is necessary.
- (E) The amendment may be refused entry because the amendment would involve materially added work on the part of the examiner; e.g., checking excessive editorial changes in the specification or claims.

April 12, 2000 AM

19. On February 1, 1999, you filed an application on behalf of Williams directed to a system for detecting expired parking meters. The specification fully supports original Claim

1, the sole claim. The application includes several drawings. One of the drawings shows a block diagram of the system, illustrating the electronics control unit as a box, labeled “electronics control unit.” Claim 1 of the Williams application is as follows:

Claim 1. A system for detecting expired parking meters, comprising: a timer mechanism; an infrared sensor for detecting the presence of a parked vehicle; and an electronics control unit coupled to the infrared sensor and the timer mechanism.

You received a final Office action, dated February 1, 2000, containing an indication that claim 1 is allowable subject matter, but objecting to the specification, on the grounds that the subject matter of the electronics control unit, though adequately described in the original specification, was required to be shown in the drawings. Which of the following actions, if any, comports with proper PTO practice and procedure for overcoming the objection?

- (A) On April 1, 2000, file a Notice of Appeal, appropriate fees, and a brief pointing out that a patent should issue since the subject matter of the electronics control unit was adequately described in the original specification.
- (B) On April 1, 2000, file in the PTO a drawing illustrating only the portion of the electronics control unit that was described in the original specification.
- (C) On April 1, 2000, file a Notice of Appeal, appropriate fees, and a brief pointing out that the addition of a drawing showing the electronics control unit would not constitute addition of new matter since the electronics control unit was adequately described in the original specification.
- (D) On September 1, 2000, file a petition urging that no further drawing should be required because the subject matter of the electronics control unit, for purposes of the application, was adequately disclosed in the block diagram drawing.
- (E) None of the above.

April 12, 2000 AM

21. All of the following portions of a patent application can be used for interpreting the scope of the claims in the application except the _____

- (A) description of the preferred embodiment.
- (B) abstract of the disclosure.
- (C) background of the invention.
- (D) drawings.
- (E) detailed description of the drawings.

April 12, 2000 AM

22. Which of the following rejections can properly be overcome using a 37 C.F.R. § 1.131 affidavit?

- I. A rejection under 35 U.S.C. § 102(a) based on a journal article that describes the invention as claimed.
 - II. A rejection under 35 U.S.C. § 102(b) based on a patent that discloses but does not claim the invention.
 - III. A rejection based on statutory double patenting.
 - IV. A rejection under 35 U.S.C. § 102(e) based on a patent that discloses but does not claim the same patentable invention.
- (A) I.
 - (B) II.
 - (C) III.
 - (D) IV.
 - (E) I and IV.

April 12, 2000 AM

Please answer questions 23 and 24 based on the following facts.

Jo invented a new and unobvious technique for inexpensively manufacturing a chemical that has been used in paper mills for years to bleach paper. Tommie developed a new and unobvious technique to clean-up toxic waste spills. Jo and Tommie collaborated to invent a method to clean-up toxic waste spills using the chemical made according to the unobvious technique invented by Jo. The inventions have been assigned to your client, Dowel Chemical Company. You prepared a single patent application fully disclosing and claiming each invention. Claims 1-9 were directed to the method of manufacturing; claims 10-19 were directed to the method of cleaning up toxic waste spills; and claim 20 was directed to a method of cleaning up toxic waste spills using the chemical manufactured in accordance with claim 1. Both inventors approve the application, but Tommie is unavailable to sign an oath before an upcoming statutory bar date. Accordingly, you are instructed to immediately file the application without an executed oath. On June 1, 1999, you file the application along with an information sheet to identify the application. However, you do not notice that Tommie was inadvertently left off the list of inventors on the information sheet, which listed Jo as a sole inventor. After receiving a Notice to File Missing Parts, you submit an oath executed by both Jo and Tommie. No paper was filed to change the named inventive entity. You later receive an Office action requiring restriction between Jo's invention and Tommie's invention. In reply to the restriction requirement, you elect Jo's invention, cancel claims 10-20, and immediately file a divisional application directed to the invention of claims 10-19. Claim 20 was omitted from the divisional application. The divisional application includes a specific reference to the original application and is filed with an inventor's oath executed by Tommie only. The divisional application incorporated the original application by reference.

23. Which of the following statements is correct?

- (A) Because the original application as filed named only Jo as an inventor, Tommie's divisional application is not entitled to the filing date of the original application because there is no common inventor between the original application and the divisional application.
 - (B) The incorrect inventorship listed on the information sheet of the original application was never properly corrected and, therefore, any patent issuing on that application will be invalid under 35 U.S.C. § 116 unless the inventorship is later corrected.
 - (C) After canceling claims 10-20, it is necessary to change the named inventive entity in the original application by filing a petition including a statement identifying Tommie as being deleted and acknowledging that Tommie's invention is no longer being claimed in the application and an appropriate fee.
 - (D) Written consent of Dowel Chemical Company is required before Tommie can be deleted as an inventor in the original application.
 - (E) It is necessary in the divisional application to file a petition including a statement identifying Jo as being deleted as an inventor and acknowledging that Jo's invention is not being claimed in the divisional application.
24. Which of the following statements is most correct?
- (A) Since claim 20 was omitted from the divisional application as filed, it cannot be added to the divisional application by a subsequent Amendment because such an Amendment would constitute new matter.
 - (B) It was improper to include Tommie and Jo as joint inventors in the parent application.
 - (C) The examiner may properly make a provisional obviousness-type double patenting rejection in the divisional application based on the parent application, but that rejection may be readily overcome with the filing of a terminal disclaimer.
 - (D) Because the inventive entity of the amended parent application is different than the inventive entity of the divisional application, the examiner may reject the claims of the divisional application under the provisions of 35 U.S.C. § 102(e).
 - (E) Statements (A), (B), (C) and (D) are each incorrect.

April 12, 2000 AM

35. On July 1, 1998, a registered practitioner files an application containing 10 claims that are directed to a computer. The practitioner thereafter receives an Office action wherein claims 1 -5 are properly rejected under 35 U.S.C. § 102 based upon reference A dated January 3, 1999. Reference A is an abstract identifying a computer, the computer's vendor, and information informing potential buyers whom to contact, price terms, documentation, warranties, training and maintenance programs, and the date of the computer's release to the public. In sufficient detail to meet the requirements of 35 U.S.C. § 112, reference A describes a computer having all of the elements of the rejected claims. According to reference A, the computer described therein was publicly sold in the United States in June 1997. As a practitioner, what should you advise your client to do in accordance with proper PTO practice and procedure?

- (A) File a reply arguing that Reference A cannot constitute prior art since it is dated subsequent to the filing date of the application.
- (B) File an amendment canceling the rejected claims and argue patentability of the remaining claims.
- (C) Argue that reference A constitutes hearsay evidence because there is no direct evidence that the computer of Reference A was actually in existence in June 1997.
- (D) Argue that even if the computer of Reference A was in existence in June 1997, the failure to disclose the invention until 1999 constituted abandonment of the invention.
- (E) Request a public use hearing to determine if there actually was public use in June 1997.

April 12, 2000 AM

37. You are preparing a patent application for your client, Perry. The invention is disclosed in the specification as a doodad making machine comprising elements A, B, and means C for performing a function. The specification discloses two specific embodiments for performing the function defined by means C, namely C' and C''. The specification also discloses that components D or E may be combined with A, B, and means C to form: (i) A, B, D, and means C; or (ii) to form A, B, E, and means C. The specification also discloses that component G may be used, but with only means C' to improve the machine's performance. The specification also states that the machine is rendered inoperative if component G is used with C'', or whenever components D or E are present. The first three claims in the application are:

- 1. A doodad making machine comprising A, B, and means C for performing a function.
- 2. A doodad making machine as claimed in Claim 1 wherein means C is C'.
- 3. A doodad making machine as claimed in Claim 1 or 2 further comprising D.

Which of the following would be a proper claim 4 and be supported by the specification?

- (A) A doodad making machine as claimed in Claim 2, further comprising E.
- (B) A doodad making machine consisting essentially of A, B, means C for performing a function, D and G.
- (C) A doodad making machine as claimed in Claim 1 or 2, further comprising D.
- (D) A doodad making machine as claimed in Claims 1 and 2, further comprising G.
- (E) A doodad making machine as claimed in any of the following claims, wherein means C is C'', and further comprising G.

April 12, 2000 PM

11. Which of the following is **true** ?

- (A) The differences between a continuation application and a continuation-in-part (C-I-P) application include: (1) new matter can be added when a C-I-P is filed and (2) the inventive entity in an original application and continuation application must be the same, whereas only one common inventor is necessary between an original application and a CIP application.
- (B) A reissue applicant's failure to timely file a divisional application is error and proper grounds for filing a reissue application.
- (C) A patent claiming a process is shown to be inoperative by showing no more than that it is possible to operate within the disclosure of the patent without obtaining the alleged product.
- (D) Where appeal to the Board of Patent Appeals and Interferences is dismissed for failure to argue a ground of rejection involving all the appealed claims, but allowed claimed remain in the application, the application becomes abandoned.
- (E) None of the above.

April 12, 2000 PM

25. You filed a patent application on behalf of Smith, an employee of Fix Corporation. The application contains a power of attorney authorizing you to transact all business before the Office on behalf of Smith. After the application is filed, Smith assigns all rights in the application to Fix Corp. In which of the following situations will the power of attorney granted to you be properly revoked?

- I. Joe, in-house corporate counsel at Fix Corp., but not an officer of Fix, signs a submission, pursuant to 37 C.F.R. 3.73(b), establishing ownership of the entire interest in the application by Fix Corp., and forwards the submission along with a revocation of the power of attorney granted to you, to the PTO. Joe is not a registered practitioner, and he has not been authorized to bind Fix Corp.
 - II. Smith refuses to revoke the power of attorney given to you, but Snix, president of Fix Corp., signs a submission, pursuant to 37 C.F.R. 3.73(b), establishing ownership of the entire interest in the application by Fix Corp., and forwards the submission along with a Snix-signed revocation of the power of attorney granted to you, to the PTO.
 - III. Joe, in-house corporate counsel at Fix Corp., advises Snix, president of Fix Corp., that the assignment by Smith to Fix Corp, automatically operates as a revocation of the power of attorney granted to you, and Snix relies upon Joe's advice in good faith and takes no further action toward revoking the power of attorney. Joe is not a registered practitioner, and he has not been authorized to bind Fix Corp.
- (A) I.
 - (B) II.
 - (C) III.
 - (D) I and II.
 - (E) None of the above.

April 12, 2000 PM

28. Which of the following is **true** ?

- (A) On appeal of a rejection of ten claims to the Board of Patent Appeals and Interferences, each appealed claim stands or falls separately as a result of appellant pointing out differences in what the claims cover.
- (B) The 2-month period for filing a petition mentioned in 37 CFR 1.181(f) is extendable under 37 CFR 1.136(a).
- (C) An examiner may enter a new ground of rejection in the examiner's answer to an applicant's appeal brief.
- (D) After filing a notice of appeal, an applicant is estopped from further prosecuting the same claims in a continuation application.
- (E) When desiring to claim foreign priority, the oath or declaration in a reissue application must claim foreign priority even though the priority claim was made in the original patent.

April 12, 2000 PM

32. Your client has asked you to determine whether his invention is patentable. The client developed a fishing lure made of a composition that is so effective that a fisherman need wait only a few minutes to lure fish to a hook or net. Your client purchased the material and cut it with a knife into a fishing lure. Your client does not know how to make the composition. Upon conducting a prior art search, you find that the client's composition is a well known gel used in shoes that has been in public use for 5 years. The prior art does not disclose the use of the composition as a fishing lure. Which of the following is the most appropriate advice to give the client?

- (A) Explain that it would be impossible for any claims to the process of using the composition as a fish lure to be allowed under the current PTO guidelines.
- (B) File a U.S. patent application (and required fees) claiming the composition.
- (C) File a U.S. patent application (and required fees) claiming a method of using the composition as a fishing lure.
- (D) File a provisional patent application (and required fees) directed only to the composition to gain a competitive advantage for one year. Within one year of filing the provisional application, file a nonprovisional application claiming the composition.
- (E) File a Disclosure Document (and required fee) to obtain a document from the PTO showing that the invention is registered with and protected by the PTO.

April 12, 2000 PM

34. A Notice of Allowance, setting a three month statutory period for reply, is dated and mailed on April 4, 2000, to the applicant. In which of the following situations would the issue fee be considered to be paid late?

- (A) The issue fee is filed in the PTO on Monday, July 3, 2000.
- (B) The issue fee is filed in the PTO on Wednesday, July 5, 2000, inasmuch as the PTO was closed for a Federal holiday on Tuesday, July 4, 2000.
- (C) The issue fee is filed in the PTO on Wednesday, October 4, 2000, and is accompanied by a petition to the Commissioner for a three month extension of time, as well as the late payment fee.
- (D) The issue fee is received in the PTO on Thursday, July 6, 2000, accompanied by a certificate of mailing complying with 37 C.F.R. § 1.8 and dated Monday, July 3, 2000.
- (E) (B), (C), and (D).

April 12, 2000 PM

41. Which of the following may not be properly used as prior art for purposes of rejecting a claim under 35 U.S.C. § 102(b) in an application having an effective filing date of Monday, May 3, 1999?

- (A) A journal article, published Saturday, May 2, 1998, disclosing all the claimed elements and fully teaching how to make and use the invention as claimed.
- (B) A foreign patent, published March 3, 1998, which applicant referenced in the application when claiming foreign priority based on the foreign application date, and applicant submitted a certified copy of the original foreign application.
- (C) Applicant's statement in a declaration under 37 C.F.R. § 1.132 that although the invention as claimed had been offered for sale in department stores in New York during 1997, this was done only to analyze consumer acceptance of the packaging in which the invention is marketed.
- (D) A journal article, published May 1, 1997, disclosing all the elements of the claim and teaching how to make and use the claimed invention. The examiner used the article in combination with another journal article in a previous non-final Office action to reject the same claim under 35 U.S.C. § 103.
- (E) All of the above.

April 12, 2000 PM

46. Assume that a corporation employing more than 500 persons does not qualify as a small business entity. Which of the following qualifies for reduction of certain patent fees by claiming small entity status in an application?

- (A) An independent inventor, who intends to make a profit through producing goods made according to the invention disclosed in the application, who has not assigned, granted, conveyed, or licensed any rights in the invention disclosed in the application, and is under no obligation to assign, grant, convey, or license any rights in the invention disclosed in the application.
- (B) A corporation, assigned all rights in the invention disclosed in the application, having 600 employees, which derives a profit from producing and selling energy-saving devices.
- (C) An eighty-five year-old inventor who has assigned to a corporation, having 600 employees, all rights in the invention disclosed in the application. The corporation derives a profit from producing and selling energy-saving devices.
- (D) A patent examiner who works in a group which examines applications which are funded solely by Federal agencies.
- (E) None of the above.

April 12, 2000 PM

47. Which of the following actions, if any, when taken as an initial step to dispute the propriety of the finality of an Office action, comports with proper PTO rules and procedure?

- I. Filing a request for reconsideration concerning the finality of the Office action, while the application is still pending before the primary examiner.
 - II. Filing a Notice of Appeal, then a brief, and arguing in the brief the impropriety of the finality of the rejection.
 - III. Filing a petition under 37 C.F.R. 1.181 based on improper finality of the rejection to stay the running of the period for reply set in the final Office action.
- (A) I. only.
 - (B) II. only.
 - (C) III. only.
 - (D) I. and III.
 - (F) None of the above.

April 12, 2000 PM

49. A parent application A was filed on September 9, 1988, and became abandoned on October 19, 1993. Application B was filed on October 21, 1993, and referred to application A as well as claimed the benefit of the filing date of application A. Application B issued as a patent on June 17, 1997. Application C was filed on October 29, 1993, and referred to application B as well as claimed the benefit of the filing date of application B. Application D was filed on December 20, 1996. Application D referred to application B and claimed the benefit of the filing date of application B. Both applications C and D were abandoned for failure to file a timely reply to Office actions that were mailed on April 20, 1999. Application E was filed on July 22, 1999 and is drawn to the same invention as claimed in applications C and D. Application E claims the benefit of the filing dates of applications A, B, C, and D, and makes reference to all preceding applications. The earliest effective filing date of application E with respect to any common subject matter in the prior applications is:

- (A) October 21, 1993.
- (B) December 20, 1996.
- (C) October 29, 1993.
- (D) September 9, 1988.
- (E) July 22, 1999.

April 12, 2000 PM

50. Which of the following is **true** ?

- (A) Reissue applications may be filed to correct errors made without deceptive intent provided that an application is filed within two years from issuance.
- (B) An interference may be declared between three parties who invent their inventions in three different countries and each party may be declared the winner for some of the counts at issue.
- (C) An assignment may not be made conditional on the performance of the payment of money since the public has no way of knowing whether or not payment is made.
- (D) A patent may not be issued to an assignee and if the inventor dies before the patent issues, the rights to the invention are forfeited.
- (E) Anyone may obtain reexamination of a patent upon filing a request for the same as many times as they please provided they pay the required fee each time.

November 3, 1999 AM

6. You are preparing a patent application for filing in the PTO. The application contains the following partial claim:

A walking device comprising:

- (i) a vertical member having opposing top and bottom portions;
- (ii) a handle connected to the top portion of the vertical member forming a 45° angle with the top portion of the vertical member;
- (iii)
- (iv) a set of non-skid covers for the set of legs, said set of legs being aluminum.

Following proper PTO practices and procedures, which of the following claim limitations best completes the claim by providing the missing limitation (iii)?

- (A) a horizontal member, substantially round in shape, having opposing sides connected along one of the opposing sides to the bottom side of the vertical member and along the other of the opposing sides to a set of legs; and
- (B) a horizontal member, substantially round in shape, having first and second opposing sides connected along the first opposing side to the bottom side of the vertical member and along the second opposing side to a set of legs; and
- (C) a horizontal member, substantially round in shape, connected to the bottom portion of the vertical member; and
- (D) a horizontal member, substantially round in shape, having opposing top and bottom portions; the top portion of the horizontal member is connected to the bottom portion of the vertical member, and the bottom portion long the bottom portion of the vertical member is connected to a set of legs; and
- (E) a horizontal member, substantially round in shape, having a top side connected to the bottom side of the vertical member and a bottom side connected to the set of legs; and

November 3, 1999 AM

13. Able files a patent application in 1999 disclosing a barstool having a rectangular molded plastic seat portion supported by four adjacent vertical tubular steel legs connected to the underside of the seat portion. A set of four horizontal tubular steel support members connects adjacent tubular steel legs to brace the legs. The barstool further includes a plastic back member connected to the topside of the plastic seat portion. The application states that wood could be used in place of tubular steel for the legs and horizontal support members. No alternative to plastic is mentioned in the application for use in the seat portion, but it is well known in the art that plastic and wood are interchangeable. As originally filed, Baker's application included the following Claim 1:

- Claim 1. A barstool comprising:
- (i) a rectangular seat portion having four vertical edges, an underside and a topside;
 - (ii) means for supporting said seat portion such that said underside is substantially horizontal; and
 - (ii) a back member connected to one of the vertical edges of said seat portion, said back member being substantially perpendicular to the topside of said seat portion.

The Examiner rejects the claim under 35 U.S.C. § 102 as being anticipated by a 1997 publication by Baker showing a three-legged wooden barstool with a rectangular seat, a back and arms. The Examiner cites, but does not apply against Claim 1, a 1996 patent to Charlie that discloses a four-legged wooden barstool with a round wooden seat. The Charlie patent states that in barstools the use of plastic and/or tubular steel is equivalent to the use of wood. Able responds to the rejection by amending his claim to require that the seat portion be formed of plastic, and by arguing that Baker does not disclose the recited “supporting means” because Baker utilizes only three legs, which is less stable than four legs. The examiner finds a 1980 Wilson patent that structurally equates three legged barstools to four-legged barstools. Which of the following is in accordance with proper PTO practices and procedures?

- (A) The anticipation rejection is withdrawn only because Baker does not disclose a plastic seat portion. An obviousness rejection is then made based on Baker in view of Charlie since Charlie suggests replacing a wood seat with a plastic seat. Able’s argument concerning the recited “supporting means” of Claim 1 does not provide a basis for overcoming the anticipation rejection.
- (B) The anticipation rejection should be withdrawn because Baker does not disclose a plastic seat portion and because Baker does not disclose a four legged supporting means. An obviousness rejection is then made based on Baker in view of Charlie because Charlie suggests modifying Baker to utilize a plastic seat and four legs.
- (C) The anticipation rejection is maintained because one of ordinary skill in the art would understand that a plastic seat could readily replace a wood seat. Furthermore, Able’s argument that the “supporting means” of Claim 1 is not disclosed because Baker utilizes only three legs is unsupported by any limitation in the Claim.
- (D) The anticipation rejection is withdrawn because Baker does not disclose a plastic seat. However, a rejection is made under 35 USC §112, paragraph 1 as being based upon an inadequate disclosure because the specification does not specify that the use of a plastic seat is critical to the invention.
- (E) (B) and (D).

November 3, 1999 AM

47. A patent application includes the following Claim 1:

Claim 1. A method of making an electrical device comprising the steps of:

- (i) heating a base made of carbon to a first temperature in the range of 1800°C to 2000°C;
- (ii) passing a first gas over said heated base, said first gas comprising a mixture of hydrogen, SiCl₄, phosphorus, and methane, whereby said first gas decomposes over said heated base and thereby forms a first deposited layer of silicon, phosphorus and carbon on said heated base;
- (iii) heating said base having said deposited layer to a second temperature of approximately 1620°C; and
- (iv) passing a second gas over said base heated to said second temperature, said second gas consisting of a mixture of hydrogen, SiCl₄, AlCl₃, and methane, whereby said second gas decomposes over said heated base to form a second deposit layer adjacent said first layer, said second layer comprising silicon, aluminum and carbon.

Assuming proper support in the specification, which of the following claims, if presented in the same application, is a proper claim?

- (A) Claim 2. The method of claim 1, wherein said first temperature is in the range of 1875°C to 1925°C, and preferably between 1895°C and 1905°C.
- (B) Claim 3. The electrical device of claim 1, wherein said first gas further comprises an inert gas such as Argon.
- (C) Claim 4. The method of claim 1, wherein said second gas further consists of Argon.
- (D) Claim 5. The method of claim 1, wherein said first gas further comprises an inert gas such as Argon.
- (E) Claim 6. The electrical device of claim 1, wherein said heated base has a first layer comprising silicon, phosphorus, and carbon.

November 3, 1999 PM

2. On August 17, 1999, you filed a reissue application to enlarge the scope of the claims directed to an electrical device in a patent granted to your client on January 20, 1998. In the patent, as well as the patent application on which the patent was granted, the broadest disclosure (including the specification and the original claim) regarding the resistance of the device is that “the device’s resistance is .02 to 1.5 ohms.” The examiner issued a non-final first Office action containing a rejection of several claims in the reissue application. Your reply to the first Office action includes presentation of an amendment to the specification adding the following disclosure: “The device can have a resistance of 3.0 to 4.5 ohms.” No petition and fee requesting entry of the amendment was filed. In accordance with PTO practice and procedure, _____

- (A) the amendment will be entered, and if the examiner objects to the amendment to the specification as being new matter, you should traverse the objection on the grounds that the patent owner is entitled to enlarge the scope of the content of the patent.
- (B) the amendment will not be entered because the amendment to the specification does not enlarge the scope of the claim.
- (C) the amendment will not be entered because a petition and necessary fee requesting entry of the amendment was not filed.
- (D) the amendment will be entered, and if the examiner objects to the amendment to the specification as being new matter, you should file another amendment canceling “The device can have a resistance of 3.0 to 4.5 ohms.”
- (E) the amendment will be entered because it does not introduce new matter.

November 3, 1999 PM

4. After filing a proper appeal brief for an application you are prosecuting, you begin to have doubts as to how convincing your arguments would be to the Board of Patent Appeals and Interferences (“Board”). After further consideration, you agree to the examiner’s suggestions. You file an amendment incorporating all of the examiner’s suggestions after you filed the appeal brief and before an examiner’s answer is mailed in this patent application. In accordance with PTO practice and procedure, the amendment _____

- (A) may be entered if the amendment obviously places the application in condition for allowance and there is a showing of good and sufficient reasons why it was not earlier presented.
- (B) will not be entered as it was not sent prior to or with the appeal brief.
- (C) will not be entered because it was not in the form of a petition.
- (D) will be entered and appended to the appeal brief for the Board’s consideration.
- (E) will not be entered because a petition should have accompanied it since it was filed after the appeal brief.

November 3, 1999 PM

Questions 16 and 17 are based on the following facts. Answer each question independently of the other.

A patent application contains a single independent claim:

- 1. A process for manufacturing water soluble crayons which comprises
 - (i) preparing one or more water soluble alkoxylation products by contacting an organic compound selected from the group consisting of alcohols and carboxylic acids, with an alkylene oxide in the presence of an effective amount of a catalyst under alkoxylation conditions;
 - (ii) preparing a water soluble crayon composition by adding a coloring agent to the one or more water soluble alkoxylation products;
 - (iii) pouring said water soluble crayon composition into a mold; and (iv) solidifying said water soluble crayon composition by cooling.

The coloring agents disclosed in the specification include pigments selected from the group consisting of titanium dioxide, red iron oxide and carbon black. These pigments are used in an amount of about 1 to 30 weight percent or greater, preferably about 4 to about 25 weight percent, of the total weight of the crayon composition. As disclosed in the specification, preferred organic compounds useful in the process of this invention also include alcohols, carboxylic acids, and amines. The specification also discloses that the water soluble crayon compositions harden readily upon cooling, i.e. when exposed to a temperature of from about 10°C. to 15°C.

16. Which of the following choices would be a proper dependent claim which could be added to the application by amendment and be supported by the specification?

- (A) 2. A process according to Claim 1 wherein said water soluble crayon composition is exposed to a temperature of at least 10°C.
- (B) 2. A process as set forth in Claim 1 wherein said coloring agent is titanium dioxide.
- (C) 2. A process for manufacturing water soluble crayons as set forth in Claim 1 wherein said coloring agent is 1 to 30 weight percent of the total weight of the crayon composition.
- (D) 2. A process as set forth in Claim 1 wherein said organic compound further comprises amines.
- (E) (B) and (C).

17. Which of the following amendments to Claim 1 are in accordance with PTO policy and procedure and are supported by specification?

- (A) In Claim 1, line 3, before “alcohols” delete “monohydric”.
- (B) In Claim 1, line 4, after “alcohols” insert “amines”.
- (C) In Claim 1, line 6, delete “a coloring agent” and insert “titanium dioxide”.
- (D) In Claim 1, line 7, after “cooling” insert “to a temperature of 13°C.”
- (E) (B) and (C).

November 3, 1999 PM

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

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

General Answers

April 15, 2003 AM

7. ANSWER: (E) is the most correct answer. (A) is incorrect since facts within the knowledge of the examiner may be used whether or not the examiner qualifies as an expert. 37 CFR § 1.104(c)(3). (B) is incorrect since the waiver is only effective against those named in the statutory registration. (C) is incorrect since on sale activities is not proper subject matter for reexamination, and inequitable conduct cannot be resolved or absolved by reexamination. (D) is not correct since a statutory bar cannot be overcome by acquiring the patent.

April 15, 2003 AM

38. ANSWER: (E) is the most correct answer. As to (B), see 35 U.S.C. §§ 151; 154(b)(2)(ii) and (iii); 37 CFR § 1.704(c)(3); MPEP § 1306. As to (C) see MPEP §§ 2203 and 2212. As to (D), the claim for priority is not required, as a person may not wish to do so in order to increase the term of his or her patent. As to (A) deferral under 37 CFR § 1.103 is not available following the notice of allowance. Since (B) and (C) are correct, (E) is the best answer.

October 16, 2002 AM

25. ANSWER: (B). MPEP § 716.01(a). Affidavits or declarations containing objective evidence of criticality, unexpected results, commercial success, long-felt but unsolved needs, failure of others, skepticism of experts, is considered by an examiner. (A) is incorrect. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); MPEP § 716.01(c), subsection styled “Attorney Arguments Cannot Take The Place of Evidence”; 2145, part I. Arguments of counsel cannot take the place of factually supported objective evidence. (C) is incorrect. MPEP § 2145. The burden shifts to the applicant to come forward with arguments and/or evidence to rebut the prima facie case. *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). (D) is incorrect. *In re Soni*, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995); MPEP § 2144.05, subsections II and III. (E) is incorrect. *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979) (finding that mere recognition of latent properties in the prior art does not render a known invention unobvious); MPEP § 2145, subsection II.

October 16, 2002 AM

28. ANSWER: (C) is the correct answer. Claim 3 in answer (C) employs improper multiple dependent claim wording. MPEP § 608.01(n)(I)(B). (A), (B), (D), and (E) are incorrect as each uses acceptable multiple dependent claim wording. MPEP § 608.01(n)(I)(A).

October 16, 2002 AM

29. ANSWER: (C) is the correct answer. 35 U.S.C. § 102(b). MPEP § 2111.02 provides that the preamble generally is not accorded patentable weight where it merely recites the intended use of a structure. (A) is incorrect because it does not disclose an oxygen sensor. (B) is incorrect because the patent is not more than one year prior to the date of the Ted’s application. (D) is incorrect because the Japanese patent application issued after the date of Ted’s application. 35 U.S.C. § 102(d). (E) is incorrect because (C) is correct.

October 16, 2002 PM

1. ANSWER: (D) is the best answer as the inventions must be the same in the foreign and U.S. applications. As to (A) through (C), see MPEP § 605.07 at p. 600-49, right column. As to (E), see 35 U.S.C. § 119 which provides that the previously filed application must have been filed in a country that affords similar privileges in the case of applications filed in the United States or to citizens of the United States or in a WTO member country.

October 16, 2002 PM

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

April 17, 2002 AM

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

April 17, 2002 AM

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

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

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

April 17, 2002 AM

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

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

The patent term will be measured from the filing date of the provisional application. See MPEP § 201.04(b), page 200 (D) is false because (A) and (B) are false. (E) is false because (C) is true.

April 17, 2002 PM

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

April 17, 2002 PM

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

April 17, 2002 PM

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

April 17, 2002 PM

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

April 17, 2002 PM

24. 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.

April 17, 2002 PM

35. ANSWER: (D) is correct and (A), (B), (C), and (E) are wrong. Under 37 C.F.R. § 1.211: (b) Provisional applications under 35 U.S.C. § 111(b) shall not be published, and design applications under 35 U.S.C. chapter 16 and reissue applications under 35 U.S.C. chapter 25 shall not be published under this section. Emphasis added.

October 17, 2001 AM

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

October 17, 2001 AM

16. ANSWER: (C) is the correct answer. Claim 3 in answer (C) employs improper multiple dependent claim wording. MPEP § 608.01(n)(I)(B). (A), (B), (D), and (E) are incorrect as each uses acceptable multiple dependent claim wording. MPEP § 608.01(n)(I)(A).

October 17, 2001 AM

17. ANSWER: (C) is the correct answer. 35 U.S.C. § 102(b). MPEP § 2111.02 provides that the preamble generally is not accorded patentable weight where it merely recites the intended use of a structure. (A) is incorrect because it does not disclose an oxygen sensor. (B) is incorrect because the patent is not more than one year prior to the date of the Ted’s application. (D) is incorrect because the Japanese patent application issued after the date of Ted’s application. 35 U.S.C. § 102(d). (E) is incorrect because (C) is correct.

October 17, 2001 AM

28. ANSWER: (D). See 37 CFR 1.196(b); MPEP § 1214.01. As to (A) see MPEP § 1204 under Special Case. As to (B), the recapture doctrine prevents claims from being recaptured. See MPEP § 1412.02. As to (C) see 37 CFR 1.196(d) and MPEP § 1212 where it states that failure to respond in time will result in dismissal of the appeal. As to (E), third party may not appeal. 35 U.S.C. § 306; MPEP § 2273; *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 11 USPQ2d 1866, 1869 (Fed. Cir. 1989)(a reexamination is conducted *ex parte* after it is instituted); *In re Opprecht*, 10 USPQ2d 1718 (Fed. Cir. 1989) (third parties do not participate before the USPTO). See also MPEP § 2279.

October 17, 2001 AM

29. ANSWER: The most correct answer is (C). Regardless of whether the customized PDA or the golf magazine article qualifies as prior art under 35 U.S.C. § 102(a) and/or § 102(b), and despite the belief that the claims are patentably distinct, Kat's derivation of the idea for the golfer's aid from those sources raises a possible obviousness rejection under 35 U.S.C. § 103/102(f). See 37 CFR 1.56. Moreover, the go lf magazine article published more than a year before Kat's filing date and is therefore available as prior art under at least 35 U.S.C. § 102(b).

October 17, 2001 AM

30. ANSWER: The most correct answer is (C). The level of ordinary skill in the art is one of the factors that must be considered in any obviousness determination. *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). (A) is not the best answer because 35 U.S.C. § 103 specifically states that patentability shall not be negated by the manner in which the invention was made. (B) is not the best answer because economic unfeasibility is not a basis for a determination of nonobviousness. See MPEP § 2145 VII. (D) is directed to the issue of enablement, not obviousness. (E) is wrong because the commercial success of the prior art distance finder is not relevant (although commercial success of Kat's invention would be relevant).

October 17, 2001 AM

31. ANSWER: The best answer is (E). The effective prior art date of Nichols' U.S. patent under 35 U.S.C. §§ 102(a) and 102(b) is September 18, 2001. Therefore, answers (A), (B) and (C) are incorrect. The provisions of § 102(d) do not apply to Kat's application at least because Nichols' German application was not filed by Kat. (D) is therefore incorrect.

October 17, 2001 AM

32. ANSWER: The best answer is (D). Answers (A), (B) and (C) do not provide antecedent basis for "said receiver" in part v of claim 8. Answer (E) does not provide antecedent basis for "said plurality of remote devices" in claims 9 and 10.

October 17, 2001 AM

33. ANSWER: (E) is correct because 37 CFR 1.321(a) states, in pertinent part, that "any patentee may disclaim or dedicate to the public...any terminal part of the term, of the patent granted." 35 U.S.C. § 173 states, "Patents for designs shall be granted for the term of fourteen years from the date of grant." (A) is wrong because such action would not permit

Igor to financially exploit any portion of the term of his patent, since 37 CFR 3.56 indicates that the result is a conditional assignment, which is regarded as an absolute assignment for Office purposes. (B) is wrong because 37 CFR 1.321(a) provides for dedication to the public of “the entire term, or any terminal part of the term” only. “[T]he first five years of the patent term” does not qualify as a terminal part of the term. (C) is wrong because Igor would not achieve his objective of dedicating at least a portion of his patent term to the public, since the term of the design patent would expire on January 23, 2015. 35 U.S.C. § 173. (D) is wrong because 37 CFR 1.321(a) restricts a disclaimer to “any complete claim or claims” or “the entire term, or any terminal part of the term” of a patent. “Royalties received from licensing” are not addressed by 37 CFR 1.321(a).

October 17, 2001 AM

35. ANSWER: (D) is correct because 35 U.S.C. § 122(b)(2)(B)(iii) indicates that such action may avoid abandonment of the application. (A) is wrong because the action is being taken more than 45 days after filing of the corresponding application in the French Patent Office and thus will not avoid abandonment of the application. 35 U.S.C. § 122(b)(2)(B)(iii). (B) is wrong because 37 CFR 1.213(a)(4) requires that the request be signed in compliance with 37 CFR 1.33(b)(4), which requires that all applicants sign. (C) is wrong because such action will not avoid abandonment of the application pursuant to 35 U.S.C. § 122(b)(2)(B)(iii). (E) is wrong because Amy’s application has not issued as a patent, and reissue relates only to applications that have issued as patents.

October 17, 2001 AM

45. ANSWER: (B) is correct because 37 CFR 1.217(a) permits such action within 16 months after the filing date for which a benefit is sought under 35 U.S.C. § 119(a), and 12 months is within 16 months. (A) and (C) are wrong because provisional and reissue applications are excepted from the publication provisions of 37 CFR 1.211(a) by 37 CFR 1.211(b). (D) is wrong because the provisions for publication of a redacted application do not apply when the foreign application is more extensive than the US application. (E) is wrong because 37 CFR 1.221(b) limits the period for filing a request for re-publication under such circumstances to 2 months from the date of the patent application publication.

October 17, 2001 AM

49. ANSWER: (D) is correct and (A), (B), (C), and (E) are wrong. 37 CFR 1.215 (“(c) At applicant’s option, the patent application publication will be based upon the copy of the application...as amended during examination, provided that applicant supplies such a copy in compliance with the Office electronic filing system requirements within one month of the actual filing date of the application. ...(d)...If...the Office has not started the publication process, the Office may use an untimely filed copy of the application supplied by the applicant under paragraph (c) of this section in creating the patent application publication.”). The Office in a notice (“Assignment of Confirmation Number and Time Period for Filing a Copy of an Application by EFS for Eighteen-Month Publication Purposes”) in the Official Gazette on December 26, 2000, (1241 O.G. 97) advised that an electronic filing system (EFS) copy of an application will be used in creating the patent application publication even if it is submitted outside the period set forth in 37 CFR 1.215(c), provided that it is submitted within one month of the mailing date of the first Filing Receipt including a confirmation

number for the application. This procedure does not obtain in the circumstance described in (B) inasmuch as the EFS copy of the application was not filed within one month of the mailing date of the first Filing Receipt including a confirmation number for the application.

October 17, 2001 PM

14. ANSWER: The most correct answer is (E). Answer (A) is incorrect at least because the Patent Term Guarantee Act of 1999 applies to Thomas' application, which was filed after May 29, 2000. Answer (B) is incorrect because a failure to engage in reasonable efforts to conclude prosecution may reduce patent term adjustment, but is not a complete forfeiture of any adjustment. 37 CFR 1.704(b). Answer (C) is incorrect because the three year period set forth in 37 CFR 1.702(b) does not include time consumed by review by the Board of Appeals and Patent Interferences that was not favorable to applicant. 35 U.S.C. §154(b)(1)(c). Answer (D) is incorrect because any reduction is based on an expected reply within three months of the Office action, regardless of the deadline set by the USPTO. Thus, the reduction in any patent term adjustment due to the missing parts notice would be approximately two (2) months. See, 37 CFR 1.704(a) and "37 CFR Part 1 Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term; Final Rule," Federal Register Vol. 65, No. 181 at 56366 and 56370-71; MPEP § 2730 (pg. 2700-8 through 2700-9) (8th Ed.). Answer (E) is correct because each of the preceding statements is incorrect.

October 17, 2001 PM

15. ANSWER: The most correct answer is (C). In this case, an appeal brief was due two months after the filing of the Notice of Appeal. 37 CFR 1.192. Thomas' Notice of Appeal was filed October 21, 2002 and the Appeal Brief was initially due December 21, 2002 (effectively Monday, December 23). This non-statutory time period could be extended under 37 CFR 1.136(a). Since Thomas filed the Appeal Brief on April 18, 2003, a four-month extension of time was required. Answers (A) and (B) are incorrect because they would insufficiently extend the time to February 18th and March 18th, respectively. Answer (D) is incorrect because the two-month period for filing the appeal brief is measured from the time that Thomas filed the Notice of Appeal and the six-month statutory time period does not apply. Answer (E) is incorrect at least because the premise that the Appeal Brief was filed more than six months after the Notice of Appeal was filed is factually incorrect.

October 17, 2001 PM

16. ANSWER: The most correct answer is (D). Nonpublication of the application does not affect the patent term adjustment provisions of the Patent Term Guarantee Act of 1999. Thus, statement (C) is true. The patent term adjustment provisions of 37 CFR 1.702 *et seq.* are separate and independent of the eighteen-month publication provisions. There is no support for statement (B). An applicant may rescind a nonpublication request at any time. 37 CFR 1.213(b), and see "37 CFR Parts 1 and 5 – Changes To Implement Eighteen-Month Publication of Patent Applications; Final Rule," Federal Register Vol. 65, No. 183 (9/20/2000) at 57024. Thus, statement (A) is also true. Accordingly, the best answer is (D).

October 17, 2001 PM

32. ANSWER: (E). As to (B), see 35 U.S.C. §§ 151; 154(b)(2)(ii) and (iii); 37 CFR 1.704(c)(3); MPEP § 1306. As to (C) see MPEP §§ 2203 and 2212. As to (D), the claim for priority is not required, as a person may not wish to do so in order to increase the term of his or her patent. As to (A) deferral under 37 CFR 1.103 is not available following the notice of allowance. Since (B) and (C) are correct, (E) is the best answer.

October 17, 2001 PM

33. ANSWER: (D) 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 (E) are each incorrect because each response does not address the lack of anticipation by the Foreign patent. (A) is further incorrect because an applicant can be barred under 35 U.S.C. § 102(d). (B) is further incorrect because the facts do not present the necessity of such an amendment. (C) is further incorrect because a prima facie case of obviousness is not necessary in a rejection under 35 U.S.C. § 102.

October 17, 2001 PM

34. ANSWER: (D) is the correct answer because it is a dependent claim which fails to further limit the subject matter of claim 1, as it seeks to remove the limitation that the parabolic reflector is metallic. MPEP § 608.01(n)(II) and 37 CFR 1.75(c). (A), (B), (C), and (E) are incorrect because each of these claims further limits claim 1 and therefore do not support on objection under § 1.75(c).

April 18, 2001 AM

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

April 18, 2001 AM

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

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21. ANSWER: (D) is the most correct answer. 35 U.S.C. § 132(a); 37 C.F.R. § 1.114. “In those instances in which an applicant seeks to add new matter to the disclosure of an application, the procedure set forth in § 1.114 is not available, and the applicant must file a continuation-in-part application under § 1.53(b) containing such new matter.” *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50095, right column (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (A) is not the most correct answer. At a minimum, corrected drawings suitable for reproduction are required. 37 C.F.R. § 1.85(b). (B) is not the most correct answer. As stated in 37 C.F.R. § 1.85(c), “If...a drawing does not comply with § 1.84 at the time an application is allowed, the Office may notify the applicant and set a three month period of time from the mail date of the notice of allowability within which the applicant must file a...formal drawing in compliance with § 1.84 to avoid abandonment. This time period is not extendable

under § 1.136(a) or § 1.136(b).” See also 37 C.F.R. § 1.136(b). (C) is not the most correct answer. 35 U.S.C. § 119(e)(2) has been amended to eliminate the copendency requirement. (E) is not the most correct answer. 37 C.F.R. § 1.78(a)(4). For a nonprovisional application to properly claim the benefit of the filing date of a provisional application the provisional application must be entitled to a filing date and the basic filing fee set forth in 37 C.F.R. § 1.16(k) must be paid within the time period set forth in 37 C.F.R. § 1.53(g). See also, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50094, left column (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000).

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32. ANSWER: (E) is the most correct answer. 37 C.F.R. §§ 1.114 and 1.116(b) and (c). *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50097, middle column, second complete paragraph, 50101, Comment 19 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (A) is not the most correct answer. 37 C.F.R. § 1.313(a), third sentence. A petition under § 1.313 is not required if a request for continued examination is filed prior to payment of the issue fee. (B) is not the most correct answer. 37 C.F.R. § 1.312, in pertinent part, provides, “Any amendment filed pursuant to this section must be filed before or with the payment of the issue fee.” *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50097, middle column, fourth complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (C) is not correct. *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50097, right column, second complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). *See also* 37 CFR § 1.313(d). (D) is not the most correct answer. “The Office will not suspend action in an application when a reply by the applicant is outstanding. 35 U.S.C. 133 requires the applicant to ‘prosecute the application’ within six months of an Office action (or a shorter period as set in the Office action) to avoid abandonment of the application. If an applicant files a request for continued examination but does not also provide any submission (in reply to the prior Office action) within the period for reply to the prior Office action, the application is abandoned by operation of law. (35 U.S.C. 133).” *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50102, left column, Comment 20 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000).

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34. ANSWER: (D) is the most correct answer. *See*, 37 CFR §§ 1.702(e) and 1.703(e). Answer(A) is incorrect at least because the Patent Term Guarantee Act of 1999 applies to Joseph’s application, which was filed after May 29, 2000. Answer (B) is incorrect because a failure to engage in reasonable efforts to conclude prosecution may reduce patent term extension, but is not a complete forfeiture of any extension. Answer (C) is incorrect because the three year period set forth in 37 CFR § 1.702(b) does not include time consumed by review by the Board of Appeals and Patent Interferences or any delay in processing of the application that was requested by the applicant. Answer (E) is incorrect because any reduction is based on an expected reply within three months of the Office action, regardless of the deadline set by the USPTO. *See*, 37 CFR § 1.704(b) and “37 CFR Part 1 Changes to

Implement Patent Term Adjustment Under Twenty-Year Patent Term; Final Rule,” Federal Register Vol. 65, No. 181 at 56371.

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

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36. ANSWER: (D) is the most correct answer. In this case, an appeal brief was due two months after the filing of the Notice of Appeal. 37 CFR § 1.192. Joseph’s Notice of Appeal was filed September 19, 2002 and the Appeal Brief was initially due November 19, 2002. This nonstatutory time period could be extended under 37 CFR § 1.136(a). Since Joseph filed the Appeal Brief on March 18, 2003, a four-month extension of time was required. Answer (A) is incorrect because the two-month period for filing the appeal brief is measured from the time that Joseph filed the Notice of Appeal and the six month statutory time period does not apply. Answer (B) is incorrect at least because the premise that the Appeal Brief was filed more than six months after the Notice of Appeal was filed is incorrect.

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

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25. ANSWER: (C) is the most correct answer. 37 C.F.R. § 1.114 and 1.53(d). “An applicant in a utility application filed on or after June 8, 1995, and before May 29, 2000, may obtain further examination either by timely filing a request for continued examination under § 1.114, or by timely filing a continued prosecution application under § 1.53(d).” *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50096, middle column, first complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (A) is not the most correct answer. 37 C.F.R. § 1.114(a) and (c). The filing of a request for continued examination and payment of the fee for the request is not sufficient to toll the running of any time period set in the final rejection for reply to avoid abandonment of the application. If a reply to an Office action is due, a submission meeting the requirements of 37 C.F.R. § 1.111 must be timely received to continue examination of an

application. *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50095, middle column, second complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (B) is not the most correct answer. 37 C.F.R. § 1.114(a)(2). “Under the request for continued examination procedure..., a submission will be considered if the submission and the requisite fee is filed prior to the abandonment of the application.” *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50096, left column, second complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (D) is not the most correct answer. 35 U.S.C. § 154, Pub. Law 106-113, § 4405. The application is not entitled to patent term adjustment. “If...an applicant in a utility...application filed before May 29, 2000 (but on or after June 8, 1995) files a request for continued examination under § 1.114, the application being prosecuted is not an application filed on or after May 29, 2000, and is not entitled to the patent term adjustment provisions of Pub. L. 106-113.” *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50096, middle column, first complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (E) is not the most correct answer. 35 U.S.C. § 154, Pub. Law 106-113, § 4405. The CPA application is entitled to patent term adjustment. “If...an applicant in a utility...application filed before May 29, 2000, files a CPA under § 1.53(d) after May 29, 2000, the application being prosecuted (now a CPA) is an application filed on or after May 29, 2000, and is entitled to the patent term adjustment provisions of Pub. L. 106-113.” *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50096, middle column, first complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000).

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

by 37 C.F.R. § 1.16(e) if either the basic filing fee for a nonprovisional application, or the oath or declaration was not present on the filing date accorded the resulting nonprovisional application. A properly paid basic filing fee for a provisional application is not applied to the filing or other fees due for a nonprovisional application resulting from conversion of a provisional application. 37 C.F.R. § 1.53(c)(3), second sentence.

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16. ANSWER: (D). 35 U.S.C. § 102(a). As explained in MPEP § 901.01, the “matter canceled from the application file wrapper of a U.S. patent may be used as prior art as of the patent date in that it then constitutes prior public knowledge under 35 U.S.C. 102(a), *In re Lund*, 376 F.2d 982, 153 USPQ 625 (CCPA 1967). See also MPEP § § 2127 and § 2136.02.” (A) is incorrect. 35 U.S.C. § 102(e). As stated in MPEP § 901.01, “Canceled matter in the application file of a U.S. patent is not a proper reference as of the filing date under 35 U.S.C. 102(e), see *Ex parte Stalego*, 154 USPQ 52, 53 (Bd. App. 1966).” (B) is incorrect. As stated in MPEP § 901.02, “*In re Heritage*, 182 F.2d 639, 86 USPQ 160 (CCPA 1950), holds that where a patent refers to and relies on the disclosure of a copending abandoned application, such disclosure is available as a reference. See also *In re Lund*, 376 F.2d 982, 153 USPQ 625 (CCPA 1967).” (C) is incorrect. As MPEP § 901.02 indicates, where the reference patent claims the benefit of a copending but abandoned application which discloses subject matter in common with the patent, and the abandoned application has an enabling disclosure of the common subject matter and claimed matter in the reference patent, the effective date of the reference as to the common subject matter is the filing date of the abandoned application. *In re Switzer*, 77 USPQ 1, 612 O.G. 11 (CCPA 1948); *Ex parte Peterson*, 63 USPQ 99 (Bd. App. 1944); and *Ex parte Clifford*, 49 USPQ 152 (Bd. App. 1940).” (E) is incorrect. As stated in MPEP § 901.05, “In general, a foreign patent, the contents of its application, or segments of its content should not be cited as a reference until its date of patenting or publication can be confirmed by an examiner’s review of a copy of the document.”

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18. ANSWER: The best answer is (D). (A), (B) and (E) are each wrong at least because action cannot be suspended in an application that contains an outstanding Office action or requirement awaiting reply by the applicant. 37 C.F.R. § 1.103; MPEP § 709. These recommendations, if followed, would likely lead to abandonment of the application. (C) is wrong at least because inventorship in an issued patent is properly corrected through 37 C.F.R. § 1.324, not § 1.48. Also, (C) is contrary to ManCo’s instructions that the matter is to be straightened out before the application is allowed to issue as a patent, and may raise questions concerning compliance with the duty of candor before the USPTO.

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19. ANSWER: (C). Correction of inventorship may be made under the provisions of 37 C.F.R. § 1.48 or by filing a continuation application. MPEP § 201.03, second paragraph. Since the original application was filed with an inventor’s declaration, correction cannot be made merely by submitting a correct declaration. See 37 C.F.R. § 1.48(a) and (f). Thus, (A) is incorrect. (B) is incorrect because there was no deceptive intention on the part of the omitted inventor, Leftout. Under the facts of the question, (D) is incorrect because it omits the written consent of ManCo required under 37 C.F.R. § 1.48(a)(4). MPEP § 201.03, under

the heading “37 CFR 1.48(a),” part D. (E) is incorrect because (D) is incorrect.

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38. ANSWER: (A). *See* 37 C.F.R. § 1.292; MPEP § 720. (B) is unreasonable at least because no employee at Ace can legitimately be identified as an inventor. (C) and (D) are unreasonable at least because re-examination may not be based on public use. (C) is also unreasonable in suggesting that nothing can be done because the application is maintained in confidence by the Patent Office. (E) is incorrect at least because a protest is not conducted as an *inter partes* proceeding. 37 C.F.R. § 1.291(c); MPEP § 1901.07.

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39. ANSWER: (E). 35 U.S.C. § 122; 37 C.F.R. §§ 1.11 and 1.14. Statements (A) and (B) are untrue because neither publication of a foreign counterpart application or disclosure of the U.S. patent application waives confidence under 35 U.S.C. § 122. (C) and (D) are wrong because § 122 controls the actions of the USPTO, not private parties.

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7. ANSWER: (B) is correct. *See* 35 U.S.C. § 151; MPEP § 1306. As to (A) see MPEP § 1306.01. As to (C) see MPEP § 2212. As to (D), the claim for priority is not required as a person may not wish to do so in order to increase the term of his or her patent. Since (A) and (C) are incorrect, (E) is incorrect.

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

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11. ANSWER: The best answer is (C). *See, e.g.,* 37 C.F.R. § 1.33(c); MPEP §§ 2222 and 403.

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41. ANSWER: (B) is not in accordance with proper USPTO practice and procedure, is the correct answer. A supplemental oath or declaration in a nonprovisional application other than a reissue application is not treated as an amendment of the specification or claims. MPEP § 603.01 and 714.16(d). (A), (C), (D), and (E), being in accordance with proper USPTO practice and procedure, are incorrect answers. 37 C.F.R. § 1.312; MPEP § 714.15 and 714.16.

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

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

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

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

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

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

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37. ANSWER: (A) is the most correct, being supported by the disclosure, and further limiting Claim 2. 35 U.S.C. § 112, first paragraph; 37 C.F.R. §§ 1.75(b), 1.75(c). (B) is not supported by the specification. 35 U.S.C. § 112, first paragraph. (C) is incorrect because it is identical to, and does not differ substantially from Claim 3. MPEP § 706.03(k). (D) and (E) are incorrect because they are not supported by the disclosure in the specification. 35 U.S.C. § 112, first paragraph. Also, (D) is an improper multiple dependent claims because it depends

on claims in the conjunctive (“and”), as opposed to the alternative (e.g., “or”). 37 C.F.R. 1.75(c); MPEP § 608.01(n), section I, subsection B, part 1. (E) is also an improper multiple dependent claim because it does not refer to a preceding claim. 37 C.F.R. 1.75(c); MPEP § 608.01(n), section I, subsection B, part 2.

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

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25. ANSWER: (B). MPEP 324, and 402.07. The submission may be signed by a person in the organization having apparent authority to sign on behalf of the organization – an officer. In (B), the submission is signed by the President, an office having apparent authority. (I) and (III) are incorrect since Joe is neither a registered practitioner nor an officer of the company. (III) also is incorrect since the assignment by Smith to Fix does not automatically operate as a revocation of the power of attorney. 37 C.F.R. § 1.36. Thus, (A), (C), and (D) are incorrect. (E) is incorrect since (B) is correct.

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

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

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

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

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

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

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

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50. ANSWER: (A), (B), or (E). As to (A) it is true that reissues may be filed within two years to correct errors made without deceptive intent. 35 U.S.C. § 251. Regarding (B), there is no limit on the number of parties or countries or winners. A given inventor may have reduced to practice certain counts without having reduced to practice others. As to (E), it too is true inasmuch as no facts are given that the request is filed for purposes of harassment. As has been stated in the see MPEP § 2240 regarding harassment of the patent owner wherein it states:

SECOND OR SUBSEQUENT REQUEST FILED DURING REEXAMINATION

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

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

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6. ANSWER: All answers are accepted.

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13 ANSWER: (A). 35 U.S.C. §§ 102, and 103. Anticipation requires that each and every limitation in the claim be shown in a single reference, either expressly or impliedly. MPEP §§ 706.02, and 2131. Here, Claim 1 has been amended to require that the seat portion be formed of plastic (see fifth and sixth lines following the claim). Baker does not disclose or imply a plastic seat. However, Baker does disclose the recited “supporting means” because under 35 U.S.C. § 112, paragraph 6, that claim language covers under its literal scope the disclosed structure (four legs) and equivalent structures (three legs), and Able’s argument is therefore unconvincing. MPEP § 2181. An obviousness rejection over Baker/Charlie is appropriate because Charlie suggests replacing wooden seats with plastic seats. MPEP §§ 706.02, and 2143.(B) is not the most correct answer because the rationale that “Baker does not disclose a fourlegged supporting means” does not distinguish Baker from the claimed subject matter. Under 35 U.S.C. § 112, paragraph 6, the “means for supporting” in Claim 1 is equivalent to the supporting means disclosed in Baker inasmuch as the claimed means is not limited to four legs. The “three legged” supporting means in Baker is within the literal scope of the claim, and anticipation is not avoided on that basis. (C) is not the most correct answer because the issue of whether one of ordinary skill in the art would recognize that plastic could be substituted for wood goes to obviousness, not anticipation. Maintaining the anticipation rejection is improper because the claim has been amended to require that the seat portion be formed of plastic (see fifth and sixth lines following the claim), a limitation not disclosed by Baker. (D) is incorrect because there is an adequate written description of the plastic seat in the application, and applicants commonly (and properly) limit claims to a preferred embodiment during prosecution. MPEP § 2172 (III. SHIFT IN CLAIMS PERMITTED). (E) is incorrect because (B) and (D) are both incorrect.

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47. ANSWER: All answers are accepted.

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2. ANSWER: (D). 35 U.S.C. § 251; 37 CFR §§ 1.111; 1.173; 1.176; and MPEP §§ 706.03(o), 1411.02, and 1440. (A) is wrong because the statute pertains to a patent wherein the “patentee [is] claiming...less than he had a right to claim,” as opposed to a patentee being entitled to enlarge the scope of the content of the patent. (35 U.S.C. § 251). (B) and (C) are wrong because the amendment will be entered even if it contains new matter, inasmuch as the reissue application is examined in the same manner as the original application and the amendment, being a reply to a non-final first office action, is entitled to be entered. (37 CFR §§ 1.111 and 1.176, and MPEP 1440). (C) is also wrong because no petition and fee are needed. (E) is wrong because the 3.0 to 4.5 ohm range is outside the scope of the broadest range of resistance disclosed in the patent.

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4. ANSWER: (A). MPEP § 714.13, and 1207.

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16. ANSWER: (E). Both (B) and (C) are proper dependent claims and are supported by the specification. 37 CFR § 1.75. (A) is incorrect. The use of the phrase “at least” has no upper limit and could include temperatures greater than that set forth in the specification, i.e. “when exposed to a temperature of from about 10°C. to 15°C.” MPEP § 2163.05. (D) is incorrect. MPEP § 2111.03 provides that “A claim which depends from a claim which ‘consists of’ the recited elements or steps cannot add an element or step.” As such, (D) seeks to add primary and secondary amines in violation of this caveat.

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17. ANSWER: (C). The amendment points out two words occurring in line 6 that are to be deleted, and two words that are to be inserted in place of the deleted words. 37 CFR § 1.121(a)(2)(i). (A) is incorrect because “dihydric” appears on line 4 and not line 3. (B) is incorrect because “alcohols” does not occur in line 4 of claim 1. (D) is incorrect because “cooling” appears on line 9 and not line 8. (E) is not correct because (B) is incorrect.

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47. ANSWER: (C). 35 U.S.C. 102(b); and MPEP §§ 715.03, 2111.03, and 2173.05(h). Deletion of the anticipated element from the claim leaves an invention, which is no longer anticipated by the reference. (A), (D), and (E) are incorrect because despite the amendments, the claim remains anticipated since the claim is still directed to the invention described in the reference wherein X is element A. For example, in (D) and (E), element A would still be a member of the group and the claim would still be anticipated by the prior art. (B) is incorrect because the argument does not change the fact that the claim remains anticipated by the same invention described in the reference wherein X is element A. (E) is incorrect because “comprising” cannot be used in a proper Markush group.