

Test Number 123
Test Series 200

Name _____

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

OCTOBER 18, 2000

Morning Session (50 Points)

Time: 3 Hours

DIRECTIONS

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

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

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

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

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO

This examination does not address or test any changes to the Patent Statute or regulations brought about by the enactment of the American Inventors Protection Act of 1999, Pub. L. No. 106-113 (“Act”). This is necessary inasmuch as final rules implementing the Act have not been adopted. Accordingly, do not read the questions or answers as involving or being affected by the Act. The questions will apply the statute and rules in place as of November 28, 1999, regardless of any date(s) appearing in the questions.

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

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

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.

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

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

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

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

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

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

6. Evidence that a claim may not comply with the second paragraph of 35 U.S.C. § 112 occurs in accordance with proper USPTO practice and procedure where:

- (A) Remarks filed by applicant in a reply or brief regarding the scope of the invention differ and do not correspond in scope with the claim.
- (B) There is a lack of agreement between the language in the claims and the language set forth in the specification.
- (C) The scope of the claimed subject matter is narrowed during pendency of the application by deleting the originally much broader claims, and presenting claims to only the preferred embodiment within the originally much broader claims.
- (D) Claims in a continuation application are directed to originally disclosed subject matter (in the parent and continuation applications) which applicants did not regard as part of their invention when the parent application was filed.
- (E) All of the above.

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

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

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

- (E) Completely rewrite the written description and claims as part of a new application and file it as a continuation application, including a color photograph as Figure 1, ink drawings as Figures 2-4, a new inventor's declaration and a small entity filing fee.

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).

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

- (A) Inasmuch as the Defensive Publication Program was removed from the rules in view of the applicant's ability to obtain a Statutory Invention Registration, a defensive publication is not available as prior art.
- (B) An application from which a defensive publication has been prepared may be used as a reference under 35 U.S.C. § 102(a) effective only from the date of publication of the defensive application.
- (C) A defensive publication may be cited as prior art only if used alone, but not in combination with other prior art in rejecting claims under 35 U.S.C. § 102 and 35 U.S.C. § 103.
- (D) Abbreviations contain specific portions of the disclosures of abandoned applications and were discontinued in 1965. They may be cited as prior art only if used in combination with other prior art in rejecting claims under 35 U.S.C. § 102 and 35 U.S.C. § 103.
- (E) Abstracts include a summary of the disclosure of an abandoned application. Publication of such abstracts was discontinued in 1953. These publications may be cited as prior art alone or in combination with other prior art in rejecting claims under 35 U.S.C. § 102 and 35 U.S.C. § 103.

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

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

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

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

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

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

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

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

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

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

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

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.

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

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

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

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

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.

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.

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.

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.

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

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

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.

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.

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

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

25. In June 1997, Jack and Jill, a married couple, are vacationing in Vietnam (not a WTO country) when they encounter a man selling bamboo knives for cleaning fish. The particular curvature of the bamboo both lends support to the knife to prevent it from bending and breaking and facilitates cleaning inside the fish. Jill takes a picture of Jack with the knife cleaning the fish. Subsequently, in November 1997, when Jack returns to the United States he begins to make and sell a identical knife to the one seen in Vietnam. In July 1998, he files a patent application claiming the nearly identical knife. Jack discloses no prior art during the prosecution of his application and fails to mention the knife he saw in Vietnam. The examiner finds no prior art similar to the claimed knife, and Jack is awarded a patent in December 1999. Meanwhile, Jill divorces Jack, and associates with Sam. Unfortunately, Sam is penniless. To raise cash, Sam and Jill begin selling a knife identical to the one Jack produces, only Sam and Jill make their knife out of plastic. The knives of Sam and Jill sell like hotcakes. Jack sues for infringement. Jill and Sam come to you for advice. Which of the following is not true?

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

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.

27. 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 C.F.R. § 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.

28. Which of the following is true?

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

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.

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

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

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

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

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

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

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

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

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

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

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

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

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

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.

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

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

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.

40. You are a partner in a prestigious Virginia intellectual property law firm, and Mr. Laden is a newly hired associate, having recently passed the patent registration examination and been registered as a patent attorney. Shortly after joining your firm, the Supreme Court of Virginia issued an order, dated November 10, 1998, suspending Mr. Laden on ethical grounds from practicing law in Virginia for a period of 3 years from the date of the order. On July 11, 2000, a Fortune 500 company retains your services to continue prosecution of a case in which the joint inventors are obligated to assign to the Fortune 500 company. You immediately mail a paper, signed by the joint inventors, revoking the power of attorney of the present patent counsel giving you a power of attorney as sole attorney of record. On July 17, 2000, you are requested by the Apex Steel Co., one of your most important clients, to immediately file a patent infringement suit against a competitor. Which of the following actions does not accord with proper practice and procedure, and would not permit timely copying of the Fortune 500 case file without detracting from your litigation time?

- (A) File a power to inspect over your signature with the USPTO identifying the Fortune 500 patent application to be inspected, and authorizing Mr. Laden to inspect the application.
- (B) File a power to inspect signed by you with the USPTO identifying the Fortune 500 patent application to be inspected, and your secretary as authorized to have access.
- (C) File a written authority under your signature with the USPTO appointing a registered agent of your firm as an associate in the Fortune 500 patent application to be inspected.
- (D) Record the obligation of assignment to the Fortune 500 company of the patent application to be inspected and instruct the legal representative of the Fortune 500 company to provide proof of identity when requesting access.
- (E) Instruct one of the joint inventors to provide proof of identity when orally requesting access.

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.

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.

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

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

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

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

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

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

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

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

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

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

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

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

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

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.

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.

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United States Patent and Trademark Office
Registration Examination for Patent Attorneys and Agents
October 18, 2000

Morning Session Model Answers

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

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)).

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

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

5. ANSWER: (E) is the correct answer. MPEP § 706.02 points out the distinction between rejections based on 35 U.S.C. §§ 102 and 103. For anticipation under 35 U.S.C. § 102 the reference must teach every aspect of the claimed invention either explicitly or impliedly. (A), (B), (C), and (D) are each incorrect because each reply does not address the lack of anticipation

by Bud. (A) is further incorrect. It is proper to take official notice without citing a reference until the practitioner challenges the examiner to provide support. Until seasonably challenged, the examiner would not have to provide support for the official notice. MPEP § 2144.03. (B) is further incorrect because a § 102(e) reference can properly have a patent date after the filing date of an application. (C) is further incorrect because no amendment is necessary. (D) is further incorrect because a prima facie case of obviousness is not necessary in a rejection under 35 U.S.C. § 102.

6. ANSWER: (A). In accordance with MPEP § 2172, part II, evidence that shows a claim does not correspond in scope with that which applicant regards as applicant's invention may be found, for example, in contentions or admissions contained in briefs or remarks filed by applicant. *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969). (B) is incorrect. MPEP § 2172, part II, states, "As noted in *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA 1979) agreement, or lack thereof, between the claims and the specification is properly considered only with respect to 35 U.S.C. 112, first paragraph; it is irrelevant to compliance with the second paragraph of that section." (C) is incorrect. MPEP § 2172, part III indicates that the second paragraph of 35 U.S.C. 112 does not prohibit applicants from changing what they regard as their invention during the pendency of the application. *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971) (Applicant was permitted to claim and submit comparative evidence with respect to claimed subject matter which originally was only the preferred embodiment within much broader claims (directed to a method). (D) is incorrect. MPEP § 2172, part III indicates that the fact that claims in a continuation application were directed to originally disclosed subject matter which applicants had not regarded as part of their invention when the parent application was filed was held not to prevent the continuation application from receiving benefits of the filing date of the parent application under 35 U.S.C. 120. *In re Brower*, 433 F.2d 813, 167 USPQ 684 (CCPA 1970). (E) is incorrect because (B), (C), and (D) are incorrect.

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

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.

9. All Answers accepted.

10. ANSWER: (A) is the correct answer. MPEP § 2173.05(e). Claim 2 is indefinite because "said pipe" lacks antecedent basis. Claim 3 is definite, as "the outer surface" is an inherent part of the pipe and would not require antecedent recitation. Therefore, (B), (D), and (E) are

incorrect. Claim 4 is definite as there is antecedent basis for “said plastic valve.” Therefore, (C) is incorrect.

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

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

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.

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

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

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."

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.

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.

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.

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.

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

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)

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.

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

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

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.

27. 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 **the a** known invention unobvious); MPEP § 2145, subsection II.

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

29. All Answers Accepted.

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

31. ANSWER: (D). See MPEP § 2128 under the subheading “Date of Availability,” of the heading “Electronic Publications As Prior Art.” (A) is wrong. See MPEP § 2129 under the heading “A Jepson Claim Results In An Implied Admission That Preamble Is Prior Art.” (B) is wrong. See MPEP § 2128.02. A journal article or other publication becomes available as prior art on date it is received by at least one member of the public. (C) is wrong. See MPEP § 2128.01 under the heading “A Thesis Placed In A University Library May Be Prior Art If Sufficiently Accessible To The Public.” (E) is wrong. See *In re Nomiya*, 184 USPQ 607, 610 (CCPA 1975); 35 U.S.C. § 102(d); MPEP § 2129 under the heading “Admissions By Applicant Constitute Prior Art.”

32. ANSWER: (D). “It is not necessary in order to establish a prima facie case of obviousness...that there be a suggestion or expectation from the prior art that the claimed [invention] will have the same or a similar utility as one newly discovered by the applicant.” *In re Dillon*, 919 F.2d 688, 692, 16 USPQ2d 1897, 1900 (Fed. Cir. 1990) (emphasis in original). Thus, “[i]t is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant.” MPEP § 2144 (“Rationale Different from Applicant’s is Permissible”). Here, T suggests the combination with P to achieve a different advantage or result, i.e., waterproofing, from that discovered by applicant, i.e., reducing breakage. Answers (A) - (C) are incorrect because the suggestion to combine does not need to

be for the same purpose as applicant discloses in the application. Dillon, 919 F.2d at 692, 16 USPQ2d at 1900; MPEP § 2144 (“Rationale Different from Applicant’s is Permissible”). Answer (E) is incorrect because an applicant is under no obligation to submit evidence of non-obviousness unless the examiner meets his or her initial burden to fully establish a prima facie case of obviousness. MPEP § 2142.

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

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

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

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.

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

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.

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.

40. All Answers Accepted.

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).

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

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

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.

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

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

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

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

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.

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.

Test Number 456
Test Series 200

Name _____

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

OCTOBER 18, 2000

Afternoon Session (50 Points)

Time: 3 Hours

DIRECTIONS

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

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

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

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

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO

This examination does not address or test any changes to the Patent Statute or regulations brought about by the enactment of the American Inventors Protection Act of 1999, Pub. L. No. 106-113 (“Act”). This is necessary inasmuch as final rules implementing the Act have not been adopted. Accordingly, do not read the questions or answers as involving or being affected by the Act. The questions will apply the statute and rules in place as of November 28, 1999, regardless of any date(s) appearing in the questions.

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

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

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

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

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.

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.

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.

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

- (A) Amending the claim by canceling elements B and C because the reference is concerned only with element A.
- (B) 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.”

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).

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

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

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.

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.

12. Which of the following is true?

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

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

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

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

- (A) Timely filing a reply traversing the rejection, arguing that claim 1 is patentably distinguished from the Dan reference.
- (B) Timely filing a reply traversing the rejection, arguing that since the date of the Dan reference falls on a Federal holiday, the Dan reference is not a statutory bar under 35 U.S.C. § 102(b).
- (C) Timely filing a reply with an affidavit under 37 C.F.R. § 1.131 showing prior invention by Sam.
- (D) Timely filing a reply traversing the rejection, arguing that the examiner did not demonstrate why one of ordinary skill in the art at the time the invention was made would have been motivated to modify the system disclosed by Dan.
- (E) Timely filing a reply including an amendment to the specification perfecting priority under 35 U.S.C. § 120, containing a specific reference in accordance with 37 C.F.R. § 1.78(a), to a U.S. application filed by Sam on July 3, 1997 that fully disclosed but did not claim a garage opener coupled to a computer and a video camera.

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

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

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

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

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

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

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

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

Which of the following is true?

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

17. A patent application filed in the USPTO contains the following original claim:

Claim 1. A talbecloth for protecting the finish of a table comprising:
a layer of cotton;
a layer of vinyl affixed to the layer of cotton; and
a backing of felt.

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

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

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

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

Please answer questions 19 and 20 based on the following facts:

Your client, Bill, disclosed to you the following. While hiking, he found a natural specimen of tree sap that had bonded rock material to a log, and was impervious to water. Bill realized that the sap would be an excellent roofing material for bonding asphalt shingles to wooden sheathing. Bill performed a chemical analysis of the sap and determined it was 10% A, 30% B, and 60% C. Bill experimented and found that he could synthetically produce the sap by mixing one part A by weight and three parts B by weight at 20 degrees Celsius, heating the mixture of A and B to 100 degrees Celsius, adding six parts C by weight, and cooling the mixture of A, B, and C to 20 degrees Celsius. Bill further experimented and found that if he added an effective amount of D to the mixture of A, B, and C, prior to cooling, the viscosity of the product would decrease, making it easier for roofers to apply it to wooden sheathing. You draft a patent application with a specification having all the information disclosed to you by Bill, including guidelines that explained that an effective amount of D for decreasing the viscosity is between 1% to 2% of the total weight of the mixture of A, B, and C, after cooling. The guidelines also explained that an effective amount of D for brightening the color of the composition is between 3% to 4% of the total weight of the mixture of A, B, and C, after cooling.

19. Which if any of the following claims, included in Bill's application, would not be properly rejected pursuant to 35 U.S.C. § 101?

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

Claim 2. A composition for bonding asphalt shingles to wood sheathing, comprising 10% A, 30% B, and 60% C.

Claim 3. A composition produced by the steps of: mixing one part A by weight with three parts B by weight at 20 degrees Celsius to form a mixture of A and B; heating the mixture of A and B to 100 degrees Celsius; adding six parts C by weight to form a mixture of A, B, and C; cooling the mixture of A, B, and C to 20 degrees Celsius; and adding an effective amount of D to decrease the viscosity of the composition.

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

20. Assuming that A, B, C, and D are known materials, which if any of the following claims, included in Bill's application, would not be properly rejected pursuant to 35 U.S.C. 112, second paragraph?

Claim 1. A composition produced by the steps of: mixing one part A by weight with three parts B by weight at 20 degrees Celsius to form a mixture of A and B; heating the mixture of A and B to 100 degrees Celsius; and adding six parts C by weight to the mixture of A and B.

Claim 2. A composition for bonding asphalt shingles to wood sheathing, comprising 10% A, 30% B, and 60% C.

Claim 3. A composition produced by the steps of: mixing one part A by weight with three parts B by weight at 20 degrees Celsius to form a mixture of A and B; heating the mixture of A and B to 100 degrees Celsius; adding six parts C by weight to form a mixture of A, B, and C; cooling the mixture of A, B, and C to 20 degrees Celsius; and adding an effective amount of D.

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

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

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

22. A rejection based on 35 U.S.C. § 102(a) cannot be overcome by:
- (A) Filing an affidavit under 37 C.F.R. § 1.132 showing that the reference invention is not by “another.”
 - (B) Perfecting a claim to priority under 35 U.S.C. § 119(a)-(d).
 - (C) Filing an affidavit under 37 C.F.R. § 1.131 “swearing back” of a U.S. patent which substantially shows or describes, and claims the same patentable invention as the rejected invention.
 - (D) Amending the claims to patentably distinguish over the prior art.
 - (E) Persuasively arguing that the claims are patentably distinguishable from the prior art.
23. Which of the following statements is correct regarding an antedating declaration or affidavit being used in accordance with proper USPTO practice and procedure?
- (A) Where the reference, a U.S. Patent, with a patent issue date less than one year prior to applicant’s effective filing date, shows but does not claim the same patentable invention.
 - (B) Where the reference publication date is more than one year before applicant’s effective filing date.
 - (C) Where the reference is a prior U.S. patent to the same entity, claiming the same invention.
 - (D) Where the subject matter relied on in the reference is prior art under 35 U.S.C. § 102(g).
 - (E) Where the effective filing date of applicant’s parent application or an International Convention-proved filing date is prior to the effective date of the reference.
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.

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

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

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

26. In which of the following situations can the applicant overcome a rejection under 35 U.S.C. § 102(e) over a U.S. patent in accordance with proper USPTO practice and procedure?

- (A) An applicant can antedate the filing date of the patent used to reject claims under 35 U.S.C. § 102(e) by relying upon the filing date of applicant's prior abandoned nonprovisional patent application, which was filed before the effective date of the prior art. The abandoned application was not copending with the applicant's current patent application. The applicant did not file any other patent applications, and is not entitled to benefit of priority of the abandoned application.
- (B) An applicant can antedate the filing date of the patent used to reject claims under 35 U.S.C. § 102(e) if the applicant relies on the applicant's earlier foreign priority application, which conforms to the requirements of the first paragraph of 35 U.S.C. § 112 for all claims in the applicant's U.S. patent application, and all relevant provisions of 35 U.S.C. § 119 have been met. The foreign application has a filing date prior to the filing date of the patent.
- (C) An applicant can antedate the publication of his own invention more than one year before his first patent application was filed by showing that it is a publication of his own work.
- (D) An applicant can antedate the patent to a different inventive entity where the patent discloses but does not claim the applicant's invention, the patent describes the applicant's own work, and the applicant states that the different inventive entity derived the invention from him. The applicant files an affidavit disclosing the foregoing, but lacks evidence showing who invented the claimed subject matter.
- (E) (A), (B), (C) and (D).

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

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

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

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

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

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

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

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

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

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

32. Which of the following statements is not true?

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

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

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

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

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

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

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

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

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

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

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

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

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

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

Claim 1. An apparatus for sitting comprising:

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

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

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

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

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

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

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

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

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.

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.

43. An article in a popular scientific journal, dated January 13, 1998, fully discloses and teaches how to make a "Smart Shoe" wireless telecommunications device. The article discloses a shoe having a dialer in a rubber sole of the shoe. The article does not teach or suggest using a metallic shoelace as an antenna or for any other purpose. Which of the following claims in an application filed January 20, 1999 is/are anticipated by the journal article, and is/are not likely to be properly rejected under 35 U.S.C. § 112, second paragraph as indefinite?

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

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

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

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

44. Which of the following is true?

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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United States Patent and Trademark Office
Registration Examination for Patent Attorneys and Agents
October 18, 2000

Afternoon Session Model Answers

1. ANSWER: (D). 35 U.S.C. § 102(d). The foreign application need not be published, but the patent rights granted must be enforceable. MPEP § 706.02(e). (A), (B), (C), and (E) are required by 35 U.S.C. § 102(d).
2. ANSWER: (D) is the correct answer. MPEP § 608.01(p). (A) is incorrect because abandoned applications less than 20 years old can be incorporated by reference to the same extent as copending applications. (B) is incorrect because non-essential material may be incorporated by reference to patents or applications published by the United States. (C) is incorrect because material necessary to provide an enabling disclosure is essential material, which may be incorporated by reference to a U.S. patent. (E) is incorrect because non-essential material may be incorporated by reference to a U.S. patent which incorporates essential material.
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.
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.
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.

6. ANSWER: (C). 35 U.S.C. § 102(b); MPEP § 2173.05(h). Deletion of the anticipated element from the claim leaves an invention that is no longer anticipated by the reference. (A), (D), and (E) are incorrect despite the amendments because the claim remains anticipated since the claim is still directed to the invention described in the reference wherein X is element A. For example, in (D) and (E), element A would still be a member of the group and the claim would still be anticipated by the prior art. (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.

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.

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

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).

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.

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

12. ANSWER: (A). MPEP § 706.03(u). (B) is incorrect. MPEP § 706.03(w) Res Judicata should be applied only when the earlier decision was a decision of the Board of Appeals or any one of the reviewing courts and when there is no opportunity for further court review of the

earlier decision. (C) is incorrect. MPEP § 608.01(l) and 706.03(o). If subject matter capable of illustration is originally claimed and it is not shown in the drawing, the claim should not be rejected, but on that basis applicant is required to add it to the drawing. (D) is incorrect. As stated in MPEP § 706.03(a), “A thing occurring in nature, which is substantially unaltered, is not a ‘manufacture.’ A shrimp with the head and digestive tract removed is an example. *Ex parte Grayson*, 51 USPQ 413 (Bd. App. 1941).” (E) is incorrect. MPEP § 706.03(a) indicates that a scientific principle, divorced from any tangible structure, can be rejected as not within the statutory classes. *O’Reilly v. Morse*, 56 U.S. (15 Howard) 62 (1854).

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

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

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

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

be relevant for overcoming a rejection under 35 U.S.C. § 103, cannot overcome a rejection under 35 U.S.C. § 102.

17. ANSWER: (E). A claim may be amended by specifying the exact matter to be deleted or added, and the precise point where the deletion or addition is to be made. 37 C.F.R. § 1.121(a)(2)(i). The amendments are limited to deletions and/or additions of no more than 5 words per claim or deletions. 37 C.F.R. §§ 1.121(a)(2)(i)(A) and 1.121(a)(2)(i)(B). Here, Answer (A) is improper because the amendment does not specify the precise point where the addition is to be made. Answer (B) is improper because the amendment adds more than 5 words to the claim, and amendments by deletion and/or addition are limited to no more than 5 words per claim. Answer (C) is improper because line 3 contains the word “layer” twice and the amendment does not specify whether the word “thin” is to be added before the first occurrence, second occurrence, or all occurrences of the word “layer.” Answer (D) is improper because the amendment does not specify the exact matter to be deleted and the exact matter to be inserted.

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

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

20. ANSWER: (D) is the correct answer. Claims 1 and 2 are drawn to a naturally occurring composition but do not provide the basis for a rejection under 35 U.S.C. § 112, second paragraph, even though they do provide the basis for a rejection under 35 U.S.C. § 101. MPEP § 2105. Therefore (A) and (B) are incorrect. Claim 3 is indefinite because it recites an “effective amount” without stating the function to be achieved. MPEP § 2173.05(c). Therefore (C) is incorrect. (E) is incorrect because (D) is correct.

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

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

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

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

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

26. ANSWER: (B). *In re Gosteli*, 10 USPQ2d 1614 (Fed. Cir. 1989); MPEP § 2136.05. (A) is incorrect. A prior abandoned application that was not copending with the application in issue cannot be used to antedate a reference. *In re Costello*, 219 USPQ 389 (Fed. Cir. 1983); MPEP § 2136.05. (C) is incorrect. 35 U.S.C. § 102(b). The one year time bar precludes antedating the publication. *In re DeBaun*, 214 USPQ 933 (CCPA 1982) (citing *In re Katz*, 215 USPQ 14 (CCPA 1982)); MPEP § 2136.05. (D) is incorrect. The applicant must produce evidence showing who invented the subject matter. *In re Whittle*, 172 USPQ 535, 537 (CCPA 1972); MPEP § 2136.05. (E) is incorrect inasmuch as (A), (C) and (D) are incorrect.

27. ANSWER: (A) is the correct answer. MPEP § 2133.03(e)(1) and 35 U.S.C. § 102(b). II does not create a statutory bar because it is permitted experimental testing. MPEP § 2133.03(e)(3) and (6). Therefore (B) is incorrect. III does not create a statutory bar because the sale did not occur in the United States. MPEP § 2133.03(d). Therefore, (C) and (D) are incorrect. (E) is incorrect because (A) is correct.

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

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

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

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

practice occurred. (E) is incorrect. MPEP § 715.07. Actual reduction to practice generally, but not always, requires a showing that the apparatus actually existed and worked, “There are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice. *In re Asahi/America Inc.*, 68 F.3d 442, 37 USPQ2d 1204 (Fed. Cir. 1995) (citing *Newkirk v. Lulegian*, 825 F.2d 1581, 3USPQ2d 1793 (Fed. Cir. 1987) and *Sachs v. Wadsworth*, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931). The claimed restraint coupling held to be so simple a device that mere construction of it was sufficient to constitute reduction to practice. Photographs, coupled with articles and a technical report describing the coupling in detail were sufficient to show reduction to practice.).

32. ANSWER: (B). There must be a previously expressed desire by the applicant to receive benefits under a claim of priority before a Certificate of Correction request will be granted. While a continuation application can rely on a previously expressed desire to receive benefits under a claim of priority in a parent case, a parent case has no prior application to look to. MPEP § 201.16. (A) is incorrect because it is a true statement. See *Brenner v. State of Israel*, 158 USPQ 584 (D.C. Cir. 1968). (C) and (D) are true statements. Hence, they are incorrect answers. *In re Van Esdonk*, 187 USPQ 671 (Comm’r Pat. 1975). MPEP § 201.16 and 2258, respectively. (E) is a true statement, and therefore, is a wrong answer. MPEP § 201.15 (last paragraph).

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

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

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

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

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

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

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

40. ANSWER: (C). Admissions by applicant constitute prior art. As explained in *Tyler Refrigeration v. Kysor Industrial Corp.*, 777 F.2d 687, 227 USPQ 845 (Fed. Cir. 1985), the Fed. Circuit found that

the district court decided on two separate and independent grounds that the Aokage patent was such prior art. One basis was Tyler's admission of the Aokage reference as prior art before the PTO during the prosecution of the '922 Subera patent. The court found that, in a wrap-up amendment, the Tyler attorney admitted in his discussion as to "all the claims" of the three Subera applications, that "the most pertinent available prior art known to the Applicants and their representatives is the Aokage U.S. Patent 4,026,121 cited by the Examiner" (emphasis added). In view of this explicit admission, the district court's decision was proper and was sufficiently based on clear and convincing evidence. The controlling case law in this court recognizes this principle. See *Aktiebolaget Karlstads Mekaniska Werkstad v. ITC*, 705 F.2d 1565, 1574, 217 U.S.P.Q. (BNA) 865, 871 (Fed. Cir. 1983); *In re Fout*, 675 F.2d 297, 300, 213 U.S.P.Q. (BNA) 532, 536 (CCPA 1982), and *In re Nomiya*, 509 F.2d 566, 571, 184 U.S.P.Q. (BNA) 607, 612 (CCPA 1975). Thus, we must affirm the court's decision that the

Aokage patent was prior art and as such binding on Tyler. (Here again, we do not pass on the other grounds on which the court concluded that the Aokage was prior art within the meaning of 35 U.S.C. § 102.)

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

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.

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.

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

44. ANSWER: (B). As stated in MPEP § 2172.01, “a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968).” (A) is incorrect. As stated in MPEP § 2172.01, “A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. 112, first paragraph, as not enabling. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976); MPEP § 2164.08(c). (C) is incorrect. As stated in MPEP § 2165.02, “The best mode requirement is a separate and distinct requirement from the enablement requirement of the first paragraph of 35 U.S.C. 112. *In re Newton*, 414 F.2d 1400, 163 USPQ 34 (CCPA 1969). (D) is incorrect. MPEP § 2165.01, part V indicates that if there is no disclosure of the best mode contemplated by the inventor at the time the application is filed, such a defect cannot be cured by submitting an amendment seeking to put into the specification something required to be there when the patent application was originally filed. *In re Hay*, 534 F.2d 917, 189 USPQ 790 (CCPA 1976). Any proposed amendment of this type should be treated as new matter. MPEP § 2165.01. (E) is incorrect. As stated in MPEP § 2165, “Failure to disclose the best mode need not rise to the level of active concealment or grossly inequitable conduct in order to support a rejection or invalidate a patent. Where an inventor knows of a specific material that will make possible the successful reproduction of the effects claimed by the patent, but does not disclose it, speaking instead in terms of broad categories, the

best mode requirement has not been satisfied. *Union Carbide Corp. v. Borg - Warner*, 550 F.2d 555, 193 USPQ 1 (6th Cir. 1977)."

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

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

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

claim to the Ethernet cable made using the processes comprising the steps of A, B, C, and D. Answer (D) alone is not the most correct answer because even though canceling Claim 3 will overcome the rejection and provides protection for the Ethernet cable made by the process comprising the steps A, B, C, and D, it will also leave the application without a claim to the Ethernet cable made using the processes comprising the steps of A, B, and C.

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

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

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