

Test Number 123
Test Series 201

Name _____

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

OCTOBER 17, 2001

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. 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 USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the *Official Gazette*, or a notice in the *Federal Register*. 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 that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement 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 addresses provisions of the Patent Statute, regulations and MPEP which were not changed as a result of the enactment of the American Inventors Protection Act of 1999, Pub. L. No. 106-113 (“Act”). This examination also does address and test changes to the Patent Statute or regulations brought about by the enactment of the Act. Some, but not all, questions use the statute and rules, comments to the rules, and guidelines in place subsequent to November 28, 1999, including the following rule changes and guidelines in effect on or before January 20, 2001:

- ? Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule. 65 FR 50092 (Aug. 16, 2000) (including the adoption of changes set forth in Interim Rule, 65 FR 14865 (Mar. 20, 2000) to §§ 1.7, 1.17(e) and (i), 1.53(d)(1), 1.78(a)(3), 1.97(b), 1.104(c)(4), 1.113, 1.116, 1.198, 1.312, and 1.313(a), (b), (c)(1), (c)(3), and (d)).
- ? Changes to Permit Payment of Patent and Trademark Fees by Credit Card; Final Rule. 65 FR 33452 (May 24, 2000).
- ? Revision of Patent Fees for Fiscal Year 2001; Final Rule. 65 FR 49193 (Aug. 11, 2000).
- ? Changes To Implement the Patent Business Goals; Final Rules. 65 FR 54604 (Sept. 8, 2000).
- ? Changes to Implement the Patent Business Goals; Final Rule and corrections to final rules. 65 FR 78958 (Dec. 18, 2000).
- ? Changes to Implement Patent Business Goals; Final Rule, Correction. 65 Fed. Reg. 80755 (Dec. 22, 2000).
- ? Changes To Implement Patent Term Adjustment Under Twenty-Year Patent Term; Final Rules. 65 FR 56366, (Sept. 18, 2000).
- ? Changes to Implement Eighteen-Month Publication of Patent Applications; Final Rule. 65 FR 57024 (Sept. 20, 2000).
- ? Changes To Implement Eighteen-Month Publication of Patent Applications; Correction. Final Rule; correction. 65 FR 66502 (Nov. 6, 2000).
- ? Treatment of Unlocatable Patent Application and Patent Files; Final Rule. 65 FR 69446 (Nov. 17, 2000).
- ? Simplification of Certain Requirements in Patent Interference Practice; final Rule. 65 FR 70489 (Nov. 24, 2000).
- ? Reestablishment of the Patent and Trademark Office as the United States Patent and Trademark Office, 65 Fed. Reg. 17858 (April 5, 2000).
- ? Guidelines Concerning the Implementation of Changes to 35 U.S.C. 102(g) and 103(c) and the Interpretation of the Term “Original Application” in the American Inventors Protection Act of 1999, 1233 O.G. 54-56 (April 11, 2000).
- ? Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, para. 6, 65 Fed. Reg. 38510-38516 (June 21, 2000); 1236 O.G. 98-104 (July 25, 2000).
- ? Guidelines Setting Forth a Modified Policy Concerning the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 U.S.C. 103(c), 1241 O.G. 96-97 (December 26, 2000).
- ? Assignment of Confirmation Number and Time Period for Filing a Copy of an Application by EFS for Eighteen-Month Publication Purposes, 1241 O.G. 97-98 (December 26, 2000).
- ? Utility Examination Guidelines, 66 F.R. 1092-1099 (January 5, 2001).
- ? Guidelines for Examination of Patent Applications Under the 35 U.S.C. Sec. 112, para. 1 “Written Description” Requirement 66 F.R. 1099-1111 (January 5, 2001).

1. Office policy has consistently been to follow *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), in the consideration and determination of obviousness under 35 U.S.C. § 103. Each of the following are the four factual inquiries enunciated therein as a background for determining obviousness except:

- (A) Determining the scope and contents of the prior art.
- (B) Resolving any issue of indefiniteness in favor of clarity.
- (C) Ascertaining the differences between the prior art and the claims in issue.
- (D) Resolving the level of ordinary skill in the pertinent art.
- (E) Evaluating evidence of secondary considerations.

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

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

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

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

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

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

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

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

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

6. In connection with the utility of an invention described in a patent application, which of the following conforms to proper USPTO practice and procedure?

- (A) A deficiency under 35 U.S.C. § 101 also creates a deficiency under 35 U.S.C. § 112, first paragraph.
- (B) To overcome a rejection under 35 U.S.C. § 101, it must be shown that the claimed device is capable of achieving a useful result on all occasions and under all conditions.
- (C) A claimed invention is properly rejected under 35 U.S.C. § 101 as lacking utility if the particular embodiment disclosed in the patent lacks perfection or performs crudely.
- (D) To overcome a rejection under 35 U.S.C. § 101, it is essential to show that the claimed invention accomplishes all its intended functions.
- (E) A claimed invention lacks utility if it is not commercially successful.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

The following facts apply to Questions 16 and 17.

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

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

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

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

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

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

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

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

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

- (A) Satisfaction of the enablement requirement of the first paragraph of 35 U.S.C. § 112 by the disclosure in a specification also satisfies the written description requirement of the second paragraph of 35 U.S.C. § 112
- (B) A claim to a process consisting solely of mathematical operations, *i.e.*, converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a process eligible for patent protection.
- (C) A claim for a machine can encompass only one machine, such as a single computer, for performing the underlying process.
- (D) A claim that recites nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, *per se*, and as such are statutory natural phenomena.
- (E) A composition of matter is a single substance, as opposed to two or more substances, whether it be a gas, fluid, or solid.

19. Mr. Adams was touring the central Mexican highland desert when he came across a small tequila production facility. While touring the facility, Adams saw a unique machine for squeezing the sap from the blue agave plant and preparing the sap for fermentation. The machine, which had been in operation for more than three years, was highly efficient and helped produce excellent tequila from a minimal number of agave plants. The owner of the production facility had sold a number of identical machines to other local tequila producers over the past two years. All of the machines remained local and none of the producers sold their tequila outside the local area. Aware that the blue agave plant was becoming increasingly rare, Adams immediately recognized the commercial possibilities of such an efficient machine. Adams returned to the facility under cover of night and took numerous photographs of the machine. Upon Adams' return to the United States, he worked from the photographs to make detailed technical drawings of the machine. He then promptly filed a patent application directed to the machine. Which of the following statements is correct?

- (A) Adams may not obtain a patent on the machine because it was known by others in a NAFTA country before Mr. Adams made technical drawings of the machine.
- (B) Adams may not obtain a patent on the machine because the machine had been sold more than a year before Adams' application filing date.
- (C) Adams is entitled to a patent because all sales of the machine and the tequila produced by the machine were in Mexico; a goal of the patent system is public disclosure of technical advances; and the machine likely would not have been disclosed to the United States public without Adams.
- (D) Adams may not obtain a patent on the machine because the machine was in public use more than a year before Adams' application filing date.
- (E) Statements (A), (B), (C) and (D) are each incorrect.

20. Which of the following is true?

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

21. An inventor, working with prior art subject matter, changes the subject matter, and thereafter files a patent application only claiming the changed subject matter. Which of the following changes might render the claimed subject matter patentable?

- (A) Where the only difference between the prior art device and the claimed device was a recitation of relative dimensions of the claimed device and the claimed device would not perform differently than the prior art device.
- (B) Where the only difference between the prior art device and the claimed device is the configuration of the claimed device, and the configuration is a matter of choice without significance regarding the use of the device.
- (C) Where the difference between the prior art, an impure material, and the claimed subject matter, the purified form of the impure material, is the purity of the material and the utility of the purified material, which differs from the impure material.
- (D) Where the only difference between the prior art device and the claimed device is a reversal of the parts that move relative to each other, and without any unexpected results.
- (E) Where the only difference between the prior art device and the claimed device is elimination of an element and its function, and elimination of the function was desired, required, or expected.

22. Tony, an inventor/client in several pending applications which you have filed, comes to you with several publications and patents which he has discovered for the first time while cleaning out his brother-in-law's attic last week. Tony's brother-in-law was not an individual within the scope of 37 CFR 1.56. Tony's brother-in-law has what appears to be material prior art for four of Tony's applications, A, B, C and D. Tony wants to know if it is too late to file information disclosure statements to have the examiner consider the information. Tony also wants to know if he does file an information disclosure statement, is he making a statement that a search has been conducted and that the items he discovered are material? Application A was filed two months ago and no Office action has issued. Application B was filed six months ago and a first, non-final, action has issued. In Application C, a Notice of Allowability has issued and the issue fee has not been paid. In Application D, a Notice of Allowability has issued and the issue fee has been paid. Which of the following is not true with respect to the proper USPTO procedure in relation to Tony's applications, all of which were filed on or after January 1, 2001?

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

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

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

24. Able and Baker conceived an improved gas grille for cookouts. Using elements A, B, C, D, E and F found in their backyards, as well as elements G, H, I, J, K, L, M and N purchased at a local hardware store, they successfully constructed and used a gas grille conforming to their concept. The grille includes subcombination of elements K, L and M conceived by Able, and subcombination C, D, F, G and M conceived by Baker. Able and Baker conceived their respective subcombinations separately and at different times. Able and Baker retain you to prepare and file a patent application for them. You are considering whether and what can be claimed in one patent application. Which of the following is true?

- (A) For Able and Baker to properly execute an oath or declaration under 37 CFR 1.63 in a patent application claiming not only the grille, but also the two subcombinations, Able and Baker must be joint inventors of the grille, and each of the two subcombinations.
- (B) A characteristic of U.S. patent law that is generally shared by other countries is that the applicant for a patent must be the inventor.
- (C) If Able and Baker execute an oath or declaration under 37 CFR 1.63 as joint inventors and file an application claiming the grille (a combination of elements A, B, C, D, E, F, G, H, I, J, K, L, M and N), the existence of the claim to the grille is evidence of their joint inventorship of the individual elements.
- (D) Able and Baker may properly execute an oath or declaration under 37 CFR 1.63 as joint inventors and file an application containing claims to the grille (a combination of elements A, B, C, D, E, F, G, H, I, J, K, L, M and N), claims to the subcombination conceived by Able, and claims to the subcombination conceived by Baker.
- (E) Able and Baker could not properly claim the combination unless they successfully and personally reduced the grille to practice.

25. Ada invented a computer memory retrieval system in the United States. In June 1999, at the request of MC Computer Corp. and with the benefit of an export license, Ada demonstrates her invention at a testing facility in England. MC Computer Corp. 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 Ada, MC Computer Corp. installs the computer memory retrieval system on its MC computers and begins selling its computers in England in September 1, 1999, with Ada's memory retrieval system. The first sale in the United States of MC Computer Corp.'s computers with Ada's memory retrieval system occurs on October 1, 1999. On August 1, 2000, MC Computer Corp. publishes an advertisement in the United States, and files a U.S. patent application that discloses but does not claim the memory retrieval system invented by Ada. The MC Computer Corp.'s patent issues on October 1, 2001. On September 12, 2000, Ada files a patent application. On October 15, 2001, the examiner rejects all the claims in Ada's application based upon MC Computer Corp.'s advertisement published on August 1, 2000. Which of the following is true?

- (A) Since the MC Computer Corp. misappropriated the invention and since Ada did not authorize the sales in England on September 1, 1999, or the advertisement on August 1, 2000 in the United States, the rejection may be overcome by showing that the idea was misappropriated by MC Computer and the sales were not authorized by Ada.
- (B) Ada is not entitled to a patent since the invention was on sale more than one year prior to the date of the application for patent in the United States.
- (C) Ada may file a declaration pursuant to 37 CFR 1.131 to antedate MC Computer Corp.'s published advertisement.
- (D) Ada may file a request for reexamination of the MC Computer Corp.'s patent on the grounds that her idea was misappropriated.
- (E) The MC Computer Corp.'s patent is invalid for breach of the confidentiality agreement and disclosing the invention of another.

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

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

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

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

28. Which of the following is true?

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

The following facts apply to Questions 29 through 32.

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

Kat comes to you in September 2001 and asks you to prepare and file a patent application on her behalf. She informs you that she has shown the golfer's aid only to her caddie and only under terms of strict confidentiality, and that she finalized the design on June 5, 2001. Her golfer's aid has not been sold or offered for sale. She also informs you that she derived the general idea for the golfer's aid, in part, from (1) an article appearing in the July 2000 edition of a golf magazine concerning a commercial distance finder and (2) a customized personal digital assistant (PDA) she saw on a store shelf while traveling in Thailand in April 2001. The distance finder has been available for sale in the United States since August 2000. The customized PDA was first offered for sale in the United States on June 8, 2001, but has not been disclosed in any publication or patent document. You prepare a patent application with claims that you believe are likely to be found patentably distinct over the commercially available distance finder and the golf magazine article, either alone or in combination. The application is filed with the USPTO on September 17, 2001.

29. Which of the following statements is most true?

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

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

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

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

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

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

Claim 8. An aid for assisting a golfer comprising:

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

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

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

Which of the following best completes claim 8?

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

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

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

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

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

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

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

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

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

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

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

37. An application includes independent claims 1 and 2. Which of the following, in a reply to a non-final Office action, provides the proper basis for a rejection under 35 U.S.C. § 112, first paragraph?

- (A) Applicant amends claim 2 of the originally filed application by adding a limitation which was previously written only in claim 1 of the originally filed application, and one of ordinary skill in the art is enabled by the original disclosure to make and use the invention as claimed in amended claim 2.
- (B) Applicant amends claim 1 of the originally filed application by adding a limitation that was written in the original disclosure of the application, but the original disclosure does not enable one of ordinary skill in the art to make or use the invention as claimed in amended claim 1.
- (C) Applicant amends and broadens claim 2 by removing a limitation which was written in the original disclosure of the application, and one of ordinary skill in the art is enabled by the original disclosure to make and use the invention as claimed in amended claim 2.
- (D) Applicant adds new matter to the disclosure, but does not amend the claims of the originally filed application, and one of ordinary skill in the art is enabled by the original disclosure to make and use the invention as described in each of the claims.
- (E) None of the above.

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

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

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

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

40. Mike and Alice, who are not related, are shipwrecked on a heretofore uninhabited and undiscovered island in the middle of the Atlantic Ocean. In order to signal for help, Mike invents a signaling device using bamboo shoots. Alice witnesses but does not assist in any way in the development of the invention. The signaling device works and a helicopter comes and rescues Alice. However, Mike remains on the island due to overcrowding on the helicopter. Unfavorable weather conditions have prevented Mike's rescue to date. Alice comes to you, a registered patent practitioner, to file an application for a patent and offers to pay you in advance. Which of the following is true?

- (A) Since Mike invented the invention, Alice cannot properly file an application for a patent in her name even though Mike is unavailable.
- (B) Since Mike is unavailable, you may properly file an application for a patent without his consent. You can accept the money from Alice as payment for the application.
- (C) Since Mike is not available and cannot be reached, Alice may properly sign the declaration on his behalf since she has witnessed the invention and knows how to make and use it.
- (D) Alice should file an application in her name since she has witnessed the invention and knows how to make and use it. Subsequently, when Mike becomes available, the inventorship may be changed to the correct inventorship.
- (E) Even though Mike and Alice are not related, Alice may properly file an application on Mike's behalf.

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

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

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

Claim 1. A doughnut making machine comprising:

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

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

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

43. Which of the following establishes a statutory bar under 35 U.S.C. § 102 to patentability of Applicant's claimed invention?

- (A) To further develop the invention, Applicant's invention was tested and experimented with in the United States more than one year prior to applicant's effective U.S. filing date, but the invention at the time was not fit for its intended purpose and important modifications concerning the claimed features resulted from the experimentation. The first actual reduction to practice occurred after the effective U.S. filing date.
- (B) Applicant's invention was sold in a WTO member country outside the United States more than one year prior to applicant's effective U.S. filing date, and the sale was merely market testing of the invention to determine product acceptance.
- (C) Applicant's invention is rendered obvious by the combination of two U.S. patents, both of which were patented more than one year prior to applicant's effective filing date.
- (D) Applicant's invention was sold outside the United States in a non-WTO member country, more than one year prior to applicant's effective U.S. filing date, but the sale was merely an attempt at market penetration.
- (E) None of the above.

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

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

45. Which of the following statements accords with proper USPTO practice and procedure?
- (A) A request for publication of a provisional application on a certain date will be treated as a request for publication as soon as possible.
 - (B) If an applicant filed an application in a foreign country and the description of the invention in the foreign application is less extensive than the description of the invention in the application filed in the USPTO, the applicant may submit a redacted copy, eliminating the description not contained in the foreign application, for publication within 12 months after the filing date for which a benefit is sought under 35 U.S.C.
 - (C) Early publication of a reissue application may be honored only if accompanied by a copy of the application in compliance with the Office electronic filing system requirements.
 - (D) If an applicant filed an application in a foreign country and the description of the invention in the foreign application is more extensive than the description of the invention in the application filed in the USPTO, the applicant may submit a redacted copy, eliminating the description not contained in the foreign application, for publication within 14 months after the filing date for which a benefit is sought under 35 U.S.C.
 - (E) Re-publication of a patent application is available where the Office makes a material mistake apparent from the records and the request for re-publication is filed within 3 months from the date of the patent application publication.

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

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

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

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

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

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

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

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

50. 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 CFR 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) The explicit admission by the registered practitioner, who formerly represented Stan, that the Acme patent constituted prior art is binding on Stan in any later proceeding involving the patent.
- (C) 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.
- (D) Since the 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 the registered practitioner 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).

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Test Number 456
Test Series 201

Name _____

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

OCTOBER 17, 2001

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. 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 USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the *Official Gazette*, or a notice in the *Federal Register*. 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 that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement 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 addresses provisions of the Patent Statute, regulations and MPEP which were not changed as a result of the enactment of the American Inventors Protection Act of 1999, Pub. L. No. 106-113 (“Act”). This examination also does address and test changes to the Patent Statute or regulations brought about by the enactment of the Act. Some, but not all, questions use the statute and rules, comments to the rules, and guidelines in place subsequent to November 28, 1999, including the following rule changes and guidelines in effect on or before January 20, 2001:

- ? Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule. 65 FR 50092 (Aug. 16, 2000) (including the adoption of changes set forth in Interim Rule, 65 FR 14865 (Mar. 20, 2000) to §§ 1.7, 1.17(e) and (i), 1.53(d)(1), 1.78(a)(3), 1.97(b), 1.104(c)(4), 1.113, 1.116, 1.198, 1.312, and 1.313(a), (b), (c)(1), (c)(3), and (d)).
- ? Changes to Permit Payment of Patent and Trademark Fees by Credit Card; Final Rule. 65 FR 33452 (May 24, 2000).
- ? Revision of Patent Fees for Fiscal Year 2001; Final Rule. 65 FR 49193 (Aug. 11, 2000).
- ? Changes To Implement the Patent Business Goals; Final Rules. 65 FR 54604 (Sept. 8, 2000).
- ? Changes to Implement the Patent Business Goals; Final Rule and corrections to final rules. 65 FR 78958 (Dec. 18, 2000).
- ? Changes to Implement Patent Business Goals; Final Rule, Correction. 65 Fed. Reg. 80755 (Dec. 22, 2000).
- ? Changes To Implement Patent Term Adjustment Under Twenty-Year Patent Term; Final Rules. 65 FR 56366, (Sept. 18, 2000).
- ? Changes to Implement Eighteen-Month Publication of Patent Applications; Final Rule. 65 FR 57024 (Sept. 20, 2000).
- ? Changes To Implement Eighteen-Month Publication of Patent Applications; Correction. Final Rule; correction. 65 FR 66502 (Nov. 6, 2000).
- ? Treatment of Unlocatable Patent Application and Patent Files; Final Rule. 65 FR 69446 (Nov. 17, 2000).
- ? Simplification of Certain Requirements in Patent Interference Practice; final Rule. 65 FR 70489 (Nov. 24, 2000).
- ? Reestablishment of the Patent and Trademark Office as the United States Patent and Trademark Office, 65 Fed. Reg. 17858 (April 5, 2000).
- ? Guidelines Concerning the Implementation of Changes to 35 U.S.C. 102(g) and 103(c) and the Interpretation of the Term “Original Application” in the American Inventors Protection Act of 1999, 1233 O.G. 54-56 (April 11, 2000).
- ? Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, para. 6, 65 Fed. Reg. 38510-38516 (June 21, 2000); 1236 O.G. 98-104 (July 25, 2000).
- ? Guidelines Setting Forth a Modified Policy Concerning the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 U.S.C. 103(c), 1241 O.G. 96-97 (December 26, 2000).
- ? Assignment of Confirmation Number and Time Period for Filing a Copy of an Application by EFS for Eighteen-Month Publication Purposes, 1241 O.G. 97-98 (December 26, 2000).
- ? Utility Examination Guidelines, 66 F.R. 1092-1099 (January 5, 2001).
- ? Guidelines for Examination of Patent Applications Under the 35 U.S.C. Sec. 112, para. 1 “Written Description” Requirement 66 F.R. 1099-1111 (January 5, 2001).

1. A U.S. patent application discloses a first embodiment of an invention, a composition made of known materials in equal amounts by weight of A, B, and C. The application discloses a second embodiment of the invention comprising equal amounts by weight of A, B, and C, and an effective amount of D, a known material, to reduce excess moisture from the composition. The application also discloses a third embodiment of the invention comprising equal amounts by weight of A, B, and C, and an effective amount of D to reduce the acidity of the composition. The application fully discloses guidelines for determining an effective amount of D to reduce excess moisture from the composition, and determining an effective amount of D to reduce the acidity of the composition. The application discloses that the amount of D needed to reduce excess moisture from the composition differs from the amount of D needed to reduce the acidity of the composition. Which of the following claims, if included in the application, provides a proper basis for a rejection under 35 U.S.C. § 112, second paragraph?

- (A) Claim 1. A composition comprising: equal amounts by weight of A, B, and C, and an effective amount of D to reduce the acidity of the composition.
- (B) Claim 1. A composition comprising: equal amounts by weight of A, B, and C, and an effective amount of D.
- (C) Claim 1. A composition comprising: equal amounts by weight of A, B, and C, and an effective amount of D to reduce excess moisture from the composition.
- (D) Claim 1. A composition comprising: equal amounts by weight of A, B, and C.
- (E) None of the above.

2. Able conceived the invention claimed in a patent application. In conceiving the invention, Able used and adopted ideas and materials known in the art and invented by others. Ben, Able's employee, reduced the invention to practice at Able's request and totally pursuant to Able's suggestions. Being unable to afford a patent practitioner's fees to prepare and prosecute the application, Able convinced John to pay for the practitioner's services in return for an interest in the invention. John did nothing more than provide the funds for the practitioner. Which of the following is in accordance with proper USPTO practice or procedure?

- (A) Able need not be the one to reduce the invention to practice so long as the reduction to practice occurred on his or her behalf. Able can be properly named as inventor in the application.
- (B) To be named an inventor, it is not necessary for John to have contributed to the conception of the invention. Ben, not Able, can be named as inventor in the application.
- (C) In conceiving the invention, Able may not consider and adopt ideas and materials derived from any sources, such as ideas of previous inventors. Able cannot be properly named as inventor in the application.
- (D) John and Able may be properly named as joint inventors of the invention in the application.
- (E) John, Ben, and Able may be properly named as joint inventors of the invention in the application.

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

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

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

- A) The witnessing of the fishhook by Charlie in June 2001 constitutes knowledge of the invention, and claims directed to Sydney's invention could be properly rejected under 35 U.S.C. §102(a).
- B) Use of the device in Wisconsin constitutes public use and since Sydney cannot establish prior invention through activities at the North Pole, he is precluded from antedating the date of the first public use in the United States.
- C) Since Sydney invented the fishing device in 1996, he is the prior inventor and can overcome the first date of public use by Charlie by filing a 37 CFR 1.131 affidavit or declaration.
- D) Since Charlie first used the fishing device in the United States, Charlie may file a patent application.
- E) Since Charlie's public use in Wisconsin was not authorized, Sydney may still file a patent application on the fishing device.

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

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

6. An examiner has advanced a reasonable basis for questioning the adequacy of the enabling disclosure in the specification of your client's patent application, and has properly rejected all the claims in the application. The claims in the application are drawn to a computer program system. In accordance with proper USPTO practice and procedure, the rejection should be overcome by submitting _____

- (A) factual evidence directed to the amount of time and effort and level of knowledge required for the practice of the invention from the disclosure alone.
- (B) arguments by you (counsel) alone, inasmuch as they can take the place of evidence in the record.
- (C) an affidavit under 37 CFR 1.132 by an affiant, who is more than a routineer in the art, submitting few facts to support his conclusions on the ultimate legal question of sufficiency, *i.e.*, that the system "could be constructed."
- (D) opinion evidence directed to the ultimate legal issue of enablement.
- (E) patents to show the state of the art for purposes of enablement where these patents have an issue date later than the effective filing date of the application under consideration.

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

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

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

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

9. Bill was working toward a Ph.D. in physics from a university in Japan. As part of his doctoral program, Bill prepared (in Japanese) a thesis directed to his work in the semiconductor field. Following approval of the thesis by his faculty advisor on December 21, 2000, the sole copy of Bill’s thesis was placed on the shelves of the university library on January 29, 2001, where it was accessible to the faculty and students of the university as well as to the general public. At that time, the thesis was indexed in a general user’s catalog maintained locally at the university library by author, title and subject. On March 4, 2001, the general user’s catalog was made freely available on an Internet web page maintained by the university. Which of the following statements is most correct?

- (A) Bill’s thesis may be used under 35 U.S.C. § 102(b) as a prior art printed publication against a United States application for patent filed January 4, 2002.
- (B) Bill’s thesis may be used under 35 U.S.C. § 102(b) as a prior art printed publication against a United States application for patent filed February 19, 2002.
- (C) Bill’s thesis may be used under 35 U.S.C. § 102(b) as a prior art printed publication against a United States application for patent filed March 6, 2002.
- (D) Each of statements (B) and (C) is correct.
- (E) Because the thesis was written in Japanese, it cannot be a prior art printed publication against a United States application for patent.

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

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

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

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

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

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

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

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

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

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

13. Which of the following statements about the disclosure of the utility of an invention is true in accordance with proper USPTO practice and procedure?

- (A) A claimed utility invention that is disclosed to be neither a machine, an article of manufacture, a composition, nor a process is patentable in accordance with the patent law.
- (B) In a patent application claiming a compound, a disclosure by the applicant that the compound may be useful in treating unspecified disorders would be sufficient to define a specific utility for the compound.
- (C) In a patent application claiming a compound, a disclosure by the applicant that the compound has "useful biological" properties, would be sufficient to define a specific utility for the compound.
- (D) In a patent application claiming a compound, a disclosure by the applicant that the compound has a specific biological activity and reasonably correlates that activity to a disease condition would be sufficient to define a specific utility for the compound.
- (E) If a claimed invention does not have utility, the specification nevertheless can enable one to use it.

The following facts apply to Questions 14 through 16.

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

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

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

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

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

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

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

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

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

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

17. There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." Which of the following are among the factors for determining whether necessary experimentation is "undue"?

- (A) The breadth of the claims.
- (B) The nature of the invention.
- (C) The state of the prior art.
- (D) The level of one of ordinary skill.
- (E) (A), (B), (C) and (D).

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

Claim 1. An apparatus for sitting comprising:

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

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

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

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

19. In accordance with proper USPTO practice and procedure, which of the following statements is true?

- (A) Where sole patent applicant Able claims his invention in a Jepson-type claim, and the specification discloses that the subject matter of the preamble was invented by Baker before applicant's invention, the preamble is properly treated as prior art.
- (B) Where the sole patent applicant Able claims his invention in a Jepson-type claim, and the specification makes it clear that the claimed invention is an improvement on Able's own prior invention, which Able discovered less than one year before the filing date of the application, the preamble in the claim is properly treated as prior art.
- (C) Where the sole patent applicant Able claims his invention in a Jepson-type claim, and the specification makes it clear that the claimed invention is an improvement on an invention that Able discovered and publicly used and commercially sold by Able in Texas for several years before the filing date of the application, the preamble in the claim cannot properly be treated as prior art.
- (D) Where the sole applicant, Baker, states that something is prior art, the statement can be taken as being admitted prior art only if corroborated by objective evidence proffered by Baker, or found by the examiner.
- (E) No claim, including a Jepson-type claim, carries with it an implied admission that the elements in the preamble are old in the art.

20. Which of the following is true?

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

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

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

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

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

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

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

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

- (A) Pete's protest against Sol's pending application will be referred to the examiner having charge of the subject matter involved provided Pete can adequately identify the application. Protests that do not adequately identify a pending patent application will be returned to the protestor and will not be further considered by the Office.
- (B) Pete's protest, provided it adequately identifies Sol's application, will be entered in the application file if: (1) the protest is submitted prior to the date the application was published or the mailing of a notice of allowance under § 1.311, whichever occurs first; and (2) the protest is either served upon Sol in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible.
- (C) If Pete submits evidence that his wife gave Sol a copy of the Popular Golf article and contends that Sol fraudulently copied the device from that disclosed in the article, the examiner will generally not comment on the issues related to fraud.
- (D) Pete's protest, provided it adequately identifies Sol's application and is submitted prior to the date the application was published or the mailing of a notice of allowance under § 1.311, and which is either served upon Sol in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible, will be considered by the Office if the application is still pending when the protest and application file are brought before the examiner, and the protest includes: (1) a listing of the patents, publications, or other information relied upon; (2) a concise explanation of the relevance of each listed item; (3) a copy of each listed patent or publication or other item of information in written form or at least the pertinent portions thereof; and (4) an English language translation of all the necessary and pertinent parts of any non-English language patent, publication, or other item of information in written form relied upon.
- (E) If Pete files the protest before the final office action, Sol has a duty to respond to the issues raised by Pete's protest even in the absence of a request by the USPTO for comments. If such issues are not addressed, the issues will be deemed admitted.

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

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

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

- (A) Mailing to the USPTO, using a certificate of mailing under 37 CFR 1.8, dated August 14, 2001, a petition and fee for an extension of three months, a request for a continued prosecution application, and the fee for a request for a continued prosecution application. The foregoing is received by the USPTO on August 17, 2001.
- (B) Mailing to the USPTO, using a certificate of mailing under 37 CFR 1.8, dated August 14, 2001, a petition and fee for an extension of three months, a request for continued examination with a submission that meets the reply requirements of 37 CFR 1.111, and the fee for a request for continued examination. The foregoing is received by the USPTO on August 17, 2001.
- (C) Mailing to the USPTO, using a certificate of mailing under 37 CFR 1.8, dated August 14, 2001, a petition and fee for an extension of three months. The foregoing is received by the USPTO on August 17, 2001. Also, telephoning the examiner on August 14, 2001 to discuss the rejections of claims in the final Office action, but without reaching an agreement with the examiner.
- (D) Mailing to the USPTO a petition and fee for an extension of three months, a request for continued examination with a reply that states, "Applicant requests that objections as to form be held in abeyance until allowable subject matter is indicated, at which time Applicant will reply to the rejection of claim 1," and the fee for a request for continued examination. The foregoing is received by the USPTO on August 14, 2001.
- (E) Each of items (A), (B), (C) and (D) would ensure that the application does not go abandoned on Wednesday, August 15, 2001.

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

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

28. In which of the following instances is the reference properly available as prior art under 35 U.S.C § 102(d)?

- (A) A U.S. patent application is filed within the one year anniversary date of the filing date of the foreign application. The reference is the foreign application.
- (B) The applicant files a foreign application, later timely files a U.S. application claiming priority based on the foreign application, and then files a continuation - in - part (CIP) application, and the claims in the CIP are not entitled to the filing date of the U.S. parent application. The foreign application issues as a patent before the filing date of the CIP application and is used to reject the claims directed to the added subject matter under 35 U.S.C. §§ 102(d)/103. The reference is the foreign application.
- (C) The applicant files a foreign application, and later timely files a U.S. application claiming priority based on the foreign application. The examined foreign application has been allowed by the examiner and has not been published before the U.S. application was filed. The reference is the foreign application.
- (D) The reference is a defensive publication.
- (E) All of the above.

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

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

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

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

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

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

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

32. Which of the following is true?

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

The following facts pertain to questions 33 and 34.

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

Claim 1. An apparatus for converting solar energy into electrical energy comprising:

- (i) a metallic parabolic reflector;
- (ii) a steam engine having a boiler located at the focal point of the metallic parabolic reflector; and
- (iii) an electrical generator coupled to the steam engine.

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

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

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

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

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

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

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

36. Upon examination of your client's patent application, the patent examiner is considering whether and what rejections to apply to the claims. One or more of the limitations in the claims is indefinite or lacks supporting disclosure. The examiner may not properly take which of the following actions or inactions?

- (A) If the claim is subject to plural interpretations due to a limitation being indefinite, the examiner may disregard any possibility of multiple interpretations.
- (B) If a claim is subject to more than one interpretation due to a limitation being indefinite, at least one of which would render the claim unpatentable over the prior art, the examiner should reject the claim as indefinite under 35 U.S.C. § 112, second paragraph, and should reject the claim over the prior art based on the interpretation of the claim that renders the prior art applicable.
- (C) If no reasonably definite meaning can be ascribed to certain claim language, the examiner should reject the claim as indefinite under 35 U.S.C. § 112, second paragraph, and not reject the claim as obvious.
- (D) When evaluating claims for obviousness under 35 U.S.C. § 103, all the limitations of the claims, including new matter lacking supporting disclosure in the originally filed specification, must be considered and given weight.
- (E) (C) and (D).

37. Which of the following is true?

- (A) A claim to a process omitting a step in a disclosed 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 only for the process which includes the essential step.
- (B) 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.
- (C) 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.
- (D) Where 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) The best mode requirement is the same as the enablement requirement of the first paragraph of 35 U.S.C. § 112.

38. Your clients, Able and Baker, filed a patent application. In accordance with proper USPTO practice and procedure, in which of the following instances, absent additional facts, is the reference or event either prior art or an act that may not be properly applied to reject claims in your client's application?

- (A) The patent application was filed on Tuesday, June 26, 2001 in the USPTO. The reference is an article in a trade magazine published on November 10, 2000. Able, Baker and McGeiver are the authors of the article. The article fully discloses the claimed invention and how to make and use it.
- (B) The patent application was filed on Monday, June 25, 2001 in the USPTO. Able and Baker placed the invention on sale in the United States on Monday, June 26, 2000. The public came into possession and understands the invention the day it is placed on sale. Your clients have disclosed this information when they filed the application.
- (C) The patent application was filed on Monday, June 25, 2001, in the USPTO. McGeiver, a friend of Baker, publicly used the invention in Hawaii on April 15, 2000. The public use was not experimental and was without Baker's knowledge or consent. The public came into possession of the invention the day it was used by McGeiver.
- (D) The patent application was filed on Monday, June 25, 2001, in the USPTO. The invention became known to the public in the United States in April 2000 as a result of disclosure on the Internet by Wilson, a party unknown to Able and Baker. The invention was not placed on sale or in public use prior to the filing date of the application.
- (E) More than one year prior to the filing in the USPTO of a patent application on Monday, June 25, 2001, in the USPTO, the invention, a machine, was used secretly by John, another inventor, to make a product. The details of the invention are ascertainable by inspection or analysis of the product made by John that was sold and publicly displayed.

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

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

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

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

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

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

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

43. A claim in your client's patent application has been rejected as being anticipated by a prior art reference. In which of the following instances is the claim not necessarily anticipated?

- (A) The prior art is a U.S. patent issued five years before the effective date of your client's application. In your client's application, the claim is a generic claim. The prior art clearly discloses a species falling within the claimed genus in your client's application.
- (B) The prior art is a U.S. patent issued two years before the effective date of your client's application. In your client's application, claim 4 is directed to a species. The prior art discloses forty-six species. The species claimed in claim 4 is clearly disclosed by name in the prior art. The remaining forty-five species disclosed in the prior art do not anticipate or render obvious any subject matter claimed in your client's application.
- (C) The prior art is a U.S. patent issued two years before the effective date of your client's application. In your client's application, claim 1 is directed to "composition comprising copper oxygen, and 10 to 20 mg of sulfur." The prior art discloses a composition "comprising copper, oxygen and 15 mg. of sulfur."
- (D) The prior art is a U.S. patent issued two years before the effective date of your client's application. Claim 1 in your client's application is drawn to a composition of gases, and contains a narrow range of the amount of oxygen. The prior art discloses composition of the same gases, and a broad range of the amount of oxygen that is inclusive of the claimed narrow range, but does not disclose specific examples falling within the claimed narrow range. Your client not only discloses a different utility for the claimed invention, but also unexpected results achieved within the narrow range.
- (E) (A), (B), (C) and (D).

44. A condition for patentability is that an inventor is entitled to a patent unless he has abandoned the invention. Your client has engaged in conduct or omissions that may or may not be construed as abandonment of her invention. In which of the following situations would it be proper for a patent examiner to conclude, in an *ex parte* proceeding, that an inventor has abandoned the invention?

- (A) From the inventor's inaction, following conception, to do anything over a period of time to develop or patent his or her invention, the inventor's ridicule of another person's attempts to develop that invention, and the inventor's active show of interest in promoting and developing the invention only after successful marketing by another of a device embodying that invention.
- (B) When acts of another can be imputed to the inventor as an intent to abandon the invention.
- (C) From the inventor's delay alone in filing a first patent application for the invention.
- (D) From an inventor's delay in reapplying for patent after abandonment of a previous patent application.
- (E) From the inventor's act of disclosing but not claiming the subject matter in a previously issued patent, even though the inventor claims the subject matter in another patent application that is filed within one year after the patent issued.

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

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

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

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

47. Claims in your client's patent application have been rejected as unpatentable over prior art. In accordance with proper USPTO practice and procedure, which, if any, of the following statements is true?

- (A) The prior art is a U.S. patent issued five years before the effective date of your client's application. The claims are properly rejected under 35 U.S.C. § 102(b) of the disclosure in the patent that anticipates the claimed invention. Evidence of secondary considerations, such as unexpected results or commercial success, is relevant to the rejection and thus can overcome the rejection.
- (B) The prior art is a U.S. patent issued five years before the effective date of your client's application. The claims are properly rejected under 35 U.S.C. § 102(b) over the disclosure in the patent that anticipates the claimed invention. The rejection can be overcome by arguing that the alleged anticipatory prior art is "nonanalogous art."
- (C) The prior art is a U.S. patent issued five years before the effective date of your client's application. The claims are properly rejected under 35 U.S.C. § 102(b) over the disclosure in the patent that anticipates the claimed invention. The rejection can be overcome by arguing that the alleged anticipatory prior art teaches away from the invention.
- (D) The prior art is a U.S. patent issued five years before the effective date of your client's application. The claims are properly rejected under 35 U.S.C. § 102(b) over the disclosure in the patent that anticipates the claimed invention. The rejection can be overcome by arguing that the alleged anticipatory prior art is not recognized as solving the problem solved by the claimed invention.
- (E) None of the above.

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

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

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

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

50. On February 15, 2000, Debbie conceived a new, useful and nonobvious improvement in saddles for horses. Debbie spent the next four months working regularly on the idea and she built a prototype that implemented the concept on June 17, 2000. The prototype worked perfectly for its intended purpose. The next day, Debbie visited a patent attorney, Ginny, and asked her to prepare a patent application on Debbie's behalf. Ginny explained that her workload would prevent her from working on the application for at least four months. Ginny therefore declined representation of Debbie and gave her the names of a number of other qualified patent practitioners. Debbie, however, did not contact any of the individuals recommended by Ginny. Debbie visited Ginny again on December 1, 2000. At that time Ginny agreed to represent Debbie. A patent application was filed in the Patent Office on December 11, 2000.

On May 15, 2000, Billie conceived an idea substantively identical to Debbie's. Billie immediately prepared a detailed technical description including drawings and visited a patent attorney. Billie filed a patent application on June 14, 2000. Later, on July 9, 2000, Billie built a prototype that implemented the concept and had fully and successfully tested it by August 11, 2000.

With regard to a priority contest between Debbie and Billie, which of the following statements is most correct?

- (A) Debbie will be awarded priority only if she can establish diligence for the entire time between May 14, 2000 and her actual reduction to practice in June 2000, and can establish that she did not suppress, abandon or conceal the invention.
- (B) Debbie will be awarded priority only if she can establish diligence for the entire time between her conception in February 2000 and actual reduction to practice in June 2000, and can establish that she did not suppress, abandon or conceal the invention.
- (C) Debbie will be awarded priority if she can establish diligence for the entire time between May 14, 2000 and her patent filing in December 2000, and can establish that she did not suppress, abandon or conceal the invention.
- (D) To encourage prompt disclosure of inventions to the public, priority is always awarded to the first to file an application, in this case Billie.
- (E) Billie must be awarded priority because his patent application established a constructive reduction to practice prior to Debbie's actual reduction to practice, even if Debbie was diligent in reducing her invention to practice.

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United States Patent and Trademark Office
Registration Examination for Patent Attorneys and Agents
October 17, 2001

Morning Model Answers
Examination for Registration to Practice in Patent Cases
Before the United States Patent and Trademark Office
October 17, 2001

1. ANSWER: The most correct answer is (B). 35 U.S.C. § 103; *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966); MPEP § 2141. Resolving any issue of indefiniteness in favor of clarity is not among the factual inquiries enunciated in *Graham*. The four factual inquiries are set forth in answers (A), (C), (D), and (E).
2. ANSWER: (B) is the most correct answer. The application number of each U.S. patent is not required to be listed by 37 CFR 1.98(b)(1), which provides “(b)(1) Each U.S. patent listed in an information disclosure statement must be identified by inventor, patent number, and issue date.” The elements of (A) are found in 37 CFR 1.98 (a)(3)(ii). The elements of (C) are found in 37 CFR 1.98 (b)(5). The elements of (D) are found in 37 CFR 1.98(c). The elements of (E) are found in 37 CFR 1.98(d).
3. ANSWER: (D) is the most correct answer. The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. § 119(b) or PCT Rule 17 must, in any event, be filed before the patent is granted, not before the examiner allows the claims, as is required by 37 CFR 1.55 (Claim for foreign priority), subparagraph (a)(2), which states “(2) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed before the patent is granted...” As to (B), (B) contains the elements of 37 CFR 1.55 (a)(2), which states “...If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by the processing fee set forth in § 1.17(i), but the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323.” As to (C), (C) contains the elements of 37 CFR 1.55 (a)(1)(ii), which provides “(ii) In an application that entered the national stage from an international application after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT.” As to (A), (A) contains the elements of 37 CFR 1.14(c)(1)(i), which states “[i]f a U.S. patent application publication or patent incorporates by reference, or includes a specific reference under 35 U.S.C. 119(e) or 120 to, a pending or abandoned application, a copy of that application-as-filed may be provided to any person upon written request including the fee set forth in § 1.19(b)(1).” As to (E), (E) contains all of the elements of 37 CFR 1.14(c)(1)(ii), which states “If an international application, which designates the U.S. and which has been published in accordance with PCT Article 21(2), incorporates by reference or claims priority under PCT Article 8 to a pending or abandoned U.S. application, a copy of that application-as-filed may be provided to any person upon written request including a showing that the publication of the application in accordance with PCT Article 21(2) has occurred and that the U.S. was designated, and upon payment of the appropriate fee set forth in § 1.19(b)(1).”
4. All answers accepted.

5. ANSWER: The most correct answer is (B). 37 CFR 1.84(a)(2), MPEP § 608.02; Notice (Interim Waiver of Parts of 37 CFR 1.84 and 1.165, and Delay in the Enforcement of the Change in 37 CFR 1.84(e) to No Longer Permit Mounting of Photographs) in Official Gazette May 22, 2001, 1246 OG 106 (“In summary, the USPTO has *sua sponte* waived 37 CFR 1.84(a)(2)(iii) and 1.165(b) and is no longer requiring a black and white photocopy of any color drawing or photograph”). (A) is wrong because a petition under 37 CFR 1.84 is required to avoid an objection to the color photographs. Also, since small entity status was properly established at the time of filing, the inventor is entitled to maintain small entity status until any issue fee is due. 37 CFR 1.27(g)(1). (C) – (E) are also wrong because they do not provide for the required petition under 37 CFR 1.84. In (D), the change in small entity status after the application was filed does not require the inventor to retroactively pay a large entity filing fee. Additionally, (E) is wrong because the inventor would be required to file a large entity filing fee and a continuation application therefore does not achieve the stated goal of avoiding unnecessary government fees.

6. ANSWER: The most correct answer is (A). As stated in MPEP § 2107.01 (IV). A deficiency under 35 U.S.C. § 101 also creates a deficiency under 35 U.S.C. § 112, first paragraph. See *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995); *In re Jolles*, 628 F.2d 1322, 1326 n.10, 206 USPQ 885, 889 n.11 (CCPA 1980); *In re Fouche*, 439 F.2d 1237, 1243, 169 USPQ 429, 434 (CCPA 1971) (“If such compositions are in fact useless, appellant’s specification cannot have taught how to use them.”). (B) is not correct. MPEP § 2107 (II), and see *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1571, 24 USPQ2d 1401, 1412 (Fed. Cir. 1992); and *E.I. du Pont De Nemours and Co. v. Berkley and Co.*, 620 F.2d 1247, 1260 n.17, 205 USPQ 1, 10 n.17 (8th Cir. 1980). (C), (D) and (E) are not correct. MPEP § 2107 (II), and see *E.I. du Pont De Nemours and Co. v. Berkley and Co.*, 620 F.2d 1247, 1260 n.17, 205 USPQ 1, 10 n.17 (8th Cir. 1980).

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

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

9. ANSWER: (B) is the most correct answer, and (A) and (C) are wrong. MPEP § 715.05 (“If the patent is claiming the same invention as the application and its issue date is one year or more prior to the presentation of claims to that invention in the application, a rejection of the claims of the application under 35 U.S.C. § 135(b) should be made. See *In re McGrew*, 120 F.3d 1236,

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

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

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

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

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

14. ANSWER: (C), not being in accord with proper USPTO practice and procedure, is the most correct answer. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1107 (Jan. 5, 2001), middle column, “A general allegation of ‘unpredictability in the art’ is not a sufficient reason to support a rejection for lack of adequate written description”; MPEP § 2163, paragraph III. A. (pg. 2100-166) (8th Ed.). (A), being in accord with proper USPTO practice and procedure, is not correct. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1107 (Jan. 5, 2001), left column, “A description as filed is presumed to be adequate...” MPEP § 2163, paragraph III. A. (pg. 2100-166) (8th Ed.). (B), being in accord with proper USPTO practice and procedure, is not correct. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1107 (Jan. 5, 2001), “A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption.⁶⁵ ...The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.⁶⁶” (footnotes not reproduced); MPEP § 2163, paragraph III. A. (pg. 2100-166) (8th Ed.). (D), being in accord with proper USPTO practice and procedure, is not correct. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1107 (Jan. 5, 2001), left column, “[W]hen filing an amendment, applicant should show support in the original disclosure for new or amended claims.⁵⁹” Footnote 59 states, “See MPEP §§ 714.02 and 2163.06 (‘Applicant should...specifically point out the support for any amendments made to the disclosure.’)”; MPEP § 2163, paragraph III. A. 3. (b) (pg. 2100-165) (8th Ed.). (E), being in accord with proper USPTO practice and procedure, is not correct. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1106 (Jan. 5, 2001), right column, “[W]hen there is substantial variation within a genus, an applicant must describe a sufficient variety of species to reflect the variation within the genus”; MPEP § 2163, paragraph III. A. 3. (a)(ii) (pg. 2100-164) (8th Ed.).

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

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

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

18. ANSWER: The most correct answer is (B). MPEP § 2106 (IV)(B)(2)(b)(ii) (Computer Related Process ...), "If the 'acts' of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. Thus, a claim to a process consisting solely of mathematical operations, i.e., converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a statutory process." (A) is not correct. MPEP § 2106 (V)(B)(1), and see *In re Barker*, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), cert. denied, *Barker v. Parker*, 434 U.S. 1064 (1978) (a specification may be sufficient to enable one skilled in the art to make and use the invention, but still fail to comply with the written description requirement). See also *In re DiLeone*, 436 F.2d 1404, 1405, 168 USPQ 592, 593 (CCPA 1971). Also, the written description requirement is in the first paragraph, not the second paragraph, of 35 U.S.C. § 112. (C) is not correct. MPEP § 2106 (IV)(B)(2)(a) (Statutory Product Claims). (D) is not correct. MPEP § 2106 (IV)(B)(1)(c) (Natural Phenomena Such As Electricity or Magnetism), and see *O'Reilly v. Morse*, 56 U.S. (15 How.) at 112 - 114. (E) is incorrect. MPEP § 2106 (IV)(B)(2) (Statutory Subject Matter), and see *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 206 USPQ 193, 197 (1980); and *Shell Development Co. v. Watson*, 149 F. Supp. 279, 280, 113 USPQ 265, 266 (D.D.C. 1957), *aff'd per curiam*, 252 F.2d 861, 116 USPQ 428 (D.C. Cir. 1958).

19. ANSWER: The correct response is (E). Adams is not entitled to a patent because he did not himself invent the subject matter sought to be patented. 35 U.S.C. § 102(f). Therefore, statement (C) cannot be correct. Statement (A) is incorrect because, although the machine was known by others, it was not known by others in this country as required under 35 U.S.C. § 102(a). It does not matter that Mexico is a NAFTA country. Similarly, statements (B) and (D) are incorrect because, even if there was a sale or public use more than a year before Adams' filing date, it was not "in this country" as required by 35 U.S.C. § 102(b). Again, it does not matter that Mexico is a NAFTA country.

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

21. ANSWER: The most correct answer is (C). MPEP § 2144.04(VII), citing *In re Bergstrom*, 427 F.2d 1394, 166 USPQ 256 (CCPA 1970). (A) is not correct. MPEP § 2144.04(IV)(A),

citing *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). (B) is not correct. MPEP § 2144.04(IV)(B) citing *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). (D) is not correct. MPEP § 2144.04(VI)(A), citing *In re Gazda*, 219 F.2d 449, 104 USPQ 400 (CCPA 1955). (E) is not correct. MPEP § 2144.04(II)(A), citing *In re Larson*, 340 F.2d 965, 144 USPQ 347 (CCPA 1965); *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975); and *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989).

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

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

24. ANSWER: The most correct answer is (D). 35 U.S.C. § 116, first paragraph; MPEP § 2137.01, “Inventorship,” and see *Kimberly-Clark Corp. v. Procter & Gamble Distributing*, 23 USPQ2d 1921, 1925 - 26 (Fed. Cir. 1992); and *Moler v. Purdy*, 131 USPQ 276, 279 (Bd. Pat. Inter. 1960). (A) is not correct. MPEP § 2137.01 (Requirements for Joint Inventorship) and see *Kimberly-Clark Corp. v. Procter & Gamble Distributing*, 23 USPQ2d 1921, 1925 - 26 (Fed. Cir. 1992); and *Moler v. Purdy*, 131 USPQ 276, 279 (Bd. Pat. Inter. 1960). (B) is not correct. 35 U.S.C. §§ 101, 115; MPEP § 2137.01. (C) is not correct. MPEP § 2137.01. The inventor of an element, per se, and the inventor of a combination using that element may differ. See *In re DeBaun*, 214 USPQ 933, 936 (CCPA 1982); and *In re Facius*, 161 USPQ 294, 301 (CCPA 1969). (E) is not correct. There is no provision in the Patent Statute requiring the invention to be reduced to practice in order to file a patent application claiming the invention. Further, see MPEP § 2137.01; and see *In re DeBaun*, 214 USPQ 933, 936 (CCPA 1982).

25. ANSWER: (C). Ada may file an affidavit or declaration pursuant to 37 CFR 1.131. As to (A), 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)). However, the sale occurs in China and not in the United States as is required by 35 U.S.C. § 102(b). As to (B), the sale in China is not a bar. 35 U.S.C. § 102(b) requires the sales to be in the United States. As to (D), reexaminations are based solely upon patents and printed publications. (E) is incorrect since disclosure of another’s idea does not render a patent invalid and breach of the confidentiality agreement does not render the patent invalid.

26. All answers accepted.

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

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

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

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

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

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

33. ANSWER: (E) is correct because 37 CFR 1.321(a) states, in pertinent part, that "any patentee may disclaim or dedicate to the public...any terminal part of the term, of the patent granted." 35 U.S.C. § 173 states, "Patents for designs shall be granted for the term of fourteen years from the date of grant." (A) is wrong because such action would not permit Igor to financially exploit any portion of the term of his patent, since 37 CFR 3.56 indicates that the

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

34. ANSWER: (D) 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 (A) is incorrect because the transitional term “comprising” is inclusive or open-ended and does not exclude additional, unrecited steps. MPEP § 2111.03. Answers (B) and (C) are incorrect because the terms “including” and “characterized by” are synonymous with the term “comprising.” MPEP § 2111.03. Answer (E) is incorrect because Answer (B) and Answer (C) are incorrect.

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

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

37. ANSWER: The most correct answer is (B). MPEP § 2163.01. (A) is incorrect because the claims as filed in the original application are part of the disclosure, MPEP §§ 2163.03 and 2163.06(III), and claim 2 is enabled by the original disclosure. (C) is incorrect. The original disclosure enables claim 2. (D) is incorrect because although the specification should be objected to, the original disclosure enables each of the claims. MPEP § 2163.06(I). (E) is incorrect because (B) is correct.

38. ANSWER: (A) is the correct answer. 37 CFR 1.97(b)(4) and (c), effective date November 7, 2000; *see*, “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54630 (September 8, 2000); and 37 CFR 1.114, effective date August 16, 2000, “Request for

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

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

40. ANSWER: (A) is true since only the inventor may file for a patent. 35 U.S.C. § 101. As to answers (C) and (E), since Alice is not a joint inventor and she does not have sufficient proprietary interest in the invention, she may not file a patent application on Mike’s behalf. 35 U.S.C. § 116; 37 CFR 1.47(b). As to (B), you ordinarily may not accept payment from someone other than your client. 37 CFR 10.68(a)(1). As to (D), inventorship cannot be changed when there is deceptive intent.

41. ANSWER: (E) is the correct answer. 37 CFR 1.114 (effective August 16, 2000); “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 FR 50092, 50097 (August 16, 2000); MPEP § 706.07(h), paragraph I (pg. 700-69) (8th Ed.). (A) is a final action (37 CFR 1.113). 65 FR 50097, column 1, states in pertinent part, “...an action that otherwise closes prosecution in the application (e.g., an Office action under *Ex Parte Quayle*, 1935 Comm’r Dec. 11 (1935)).” Thus (A), (B), (C) and (D) are individually correct, and (E), being the most inclusive, is the most correct answer.

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

43. ANSWER: (E) is the correct answer. (A) is incorrect because it is permitted experimental testing. MPEP §§ 2133.03(e)(3) and (6). (B) and (D) are each incorrect because the sales occurred outside of the United States. 35 U.S.C. § 102(b); MPEP §§ 706.02(c) and 2133.03(d). (C) is incorrect as it provides the basis for a rejection under 35 U.S.C. § 103, but not 35 U.S.C. § 102(b).

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

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

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

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

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

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

50. ANSWER: (B) is the most correct answer. Admissions by applicant constitute prior art. 37 CFR 1.104(a)(3). 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 (B) is true, (D) is not true. Answers (A), (C) 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.

United States Patent and Trademark Office
Registration Examination for Patent Attorneys and Agents
October 17, 2001

Afternoon Model Answers

1. ANSWER: (B) is the correct answer. 35 U.S.C. § 112, second paragraph and MPEP § 2173.05(c)(III). The claim presented in (B) is improper as “an effective amount” has been held to be indefinite when the claim fails to state the function that is to be achieved and more than one effect can be implied from the specification. *In re Frederickson* 213 F.2d 547, 102 USPQ 35 (CCPA 1954). It is unclear whether “an effective amount” in (B) is an effective amount to reduce acidity or an effective amount to reduce moisture. The claims presented in (A) and (C) find support in the disclosure, which provides guidelines for determining “an effective amount” for each of the claims in (A) and (C). MPEP § 2173.05(c)(III). The claim presented in (D) is not indefinite, given that A, B, and C are known materials as set forth in the question and the composition can be determined by the claim language. (E) is incorrect because (B) is correct.

2. ANSWER: The most correct answer is (A). MPEP § 2137.01 (The Inventor Is Not Required To Reduce The Invention To Practice) citing *In re DeBaun*, 214 USPQ 933, 936 (CCPA 1982). (B) is not correct. MPEP § 2137.01 (An Inventor Must Contribute To The Conception Of The Invention) citing, *Fiers v. Revel*, 25 USPQ2d 1601, 1604 - 05 (Fed. Cir. 1993); and *In re Hardee*, 223 USPQ 1122, 1123 (Dep. Asst. Comm'r Pat. 1984). (C) is not correct. MPEP § 2137.01 (As Long As The Inventor Maintains Intellectual Domination Over Making The Invention, Ideas, Suggestions, And Materials May Be Adopted From Others) citing *Morse v. Porter*, 155 USPQ 280, 283 (Bd. Pat. Inter. 1965); and *New England Braiding Co., Inc. v. A.W. Chesterton Co.*, 23 USPQ2d 1622, 1626 (Fed. Cir. 1992). (D) and (E) are not correct. 35 U.S.C. § 116; MPEP § 2137.01 (Requirements For Joint Inventorship).

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

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

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

6. ANSWER: The most correct answer is (A). MPEP § 2106.02 (Affidavit Practice (37 CFR 1.132)). Factual evidence directed to the amount of time and effort and level of knowledge required for the practice of the invention from the disclosure alone can rebut a *prima facie* case of nonenablement. See *Hirschfield v. Banner, Commissioner of Patents and Trademarks*, 200 USPQ 276, 281 (D.D.C. 1978). (B) is not correct. MPEP § 2106.02 (Arguments of Counsel), and see *In re Budnick*, 190 USPQ 422, 424 (CCPA 1976); *In re Schulze*, 145 USPQ 716 (CCPA 1965); and *In re Cole*, 140 USPQ 230 (CCPA 1964). (C) is not correct. MPEP § 2106.02 (Affidavit Practice (37 CFR 1.132)), and see *In re Brandstadter*, 179 USPQ 286 (CCPA 1973). (D) is not correct. MPEP § 2106.02 (Affidavit Practice (37 CFR 1.132)), and see *Hirschfield v. Banner, Commissioner of Patents and Trademarks*, 200 USPQ 276, 281 (D.D.C. 1978). (E) is not correct. MPEP § 2106.02, (Referencing Prior Art Documents), and see *In re Budnick*, 190 USPQ 422, 424 (CCPA 1976); and *In re Gunn*, 190 USPQ 402, 406 (CCPA 1976).

7. ANSWER: (D) is the correct answer. MPEP § 608.04(c) (“Where the new matter is confined to amendments to the specification, review of the examiner’s requirement for cancellation is by way of petition. But where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one.”); see, also, MPEP § 706.03(o) (“In amended cases, subject matter not disclosed in the original application is sometimes added and a claim directed thereto. Such a claim is rejected on the ground that it recites elements without support in the original disclosure under 35 U.S.C. § 112, first paragraph.”). (A), (B), and (C) are incorrect. (E) is incorrect inasmuch as (A), (B) and (C) are incorrect.

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

When the reference in question is a noncommonly owned U.S. patent claiming the same invention as applicant and its issue date is less than 1 year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, must be by way of 37 CFR 1.608 instead of 37

CFR 1.131.... The reference patent can then be overcome only by way of interference.

(B) and (C) are not the most correct answers. See MPEP § 715.05, which, in pertinent part, states:

If the patent is claiming the same invention as the application and its issue date is 1 year or more prior to the presentation of claims to that invention in the application, a rejection of the claims of the application under 35 U.S.C. 135(b) should be made. See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632, 1635 (Fed.Cir. 1997) (The court holding that application of 35 U.S.C. 135(b) is not limited to inter partes interference proceedings, but may be used as a basis for ex parte rejections.).

(E) is a wrong answer because an affidavit or declaration traversing a ground of rejection may be received only where the reference “substantially shows or describes but does not claim the same patentable invention.” 37 CFR 1.132.

9. ANSWER: The most correct response is (D). Bill’s thesis constitutes a printed publication as of January 29, 2001. *In re Hall*, 228 USPQ 453 (Fed. Cir. 1986). Since (B) and (C) are both correct statements, the most correct response is (D). The provisions of § 102(b) apply equally with regard to publications written in non-English languages.

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

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

application without a claim to the Ethernet cable made using the processes comprising the steps of A, B, and C.

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

13. ANSWER: The most correct answer is (D). MPEP § 2107(I), "‘Real World Value’ Requirement." The USPTO regards assertions falling within this category as sufficient to identify a specific utility for the invention. (A) is not correct. An invention that is not a machine, an article of manufacture, a composition, or a process cannot be patented. 35 U.S.C. § 101; MPEP § 2107; see *Diamond v. Chakrabarty*, 447 U.S. 303, 206 USPQ 193 (1980); and *Diamond v. Diehr*, 450 U.S. 175, 209 USPQ 1 (1981). (B) and (C) are incorrect. The USPTO regards assertions in choices (B) and (C) as insufficient to define a specific utility for the invention, especially if the assertion takes the form of a general statement that makes it clear that a "useful" invention may arise from what has been disclosed by the applicant. *Knapp v. Anderson*, 477 F.2d 588, 177 USPQ 688 (CCPA 1973). (E) is incorrect. 35 U.S.C. §§ 101, and 112; and see *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995).

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

15. ANSWER: The most correct answer is (C). In this case, an appeal brief was due two months after the filing of the Notice of Appeal. 37 CFR 1.192. Thomas' Notice of Appeal was filed October 21, 2002 and the Appeal Brief was initially due December 21, 2002 (effectively Monday, December 23). This non-statutory time period could be extended under 37 CFR 1.136(a). Since Thomas filed the Appeal Brief on April 18, 2003, a four-month extension of time was required. Answers (A) and (B) are incorrect because they would insufficiently extend the time to February 18th and March 18th, respectively. Answer (D) is incorrect because the two-month period for filing the appeal brief is measured from the time that Thomas filed the Notice

of Appeal and the six-month statutory time period does not apply. Answer (E) is incorrect at least because the premise that the Appeal Brief was filed more than six months after the Notice of Appeal was filed is factually incorrect.

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

17. ANSWER: The most correct answer is (E). MPEP § 2164.01(a).

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

19. ANSWER: (A) is true, and thus the most correct answer. As stated in MPEP § 2129, and see *In re Fout*, 675 F.2d 297, 300-01, 213 USPQ 532,535-36 (CCPA 1982). (B) is not true, and thus not correct. MPEP § 2129, and see *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 650, 223 USPQ 1168, 1172 (Fed. Cir. 1984). (C) is not true, and thus not correct because the admitted foundational discovery is a statutory bar. See the reasons discussed for answer (B). (D) is not true, and is thus incorrect. MPEP § 2129, and see *In re Nomiya*, 184 USPQ 607, 610 (CCPA 1975) (figures in the application labeled “prior art” held to be an admission that what was pictured was prior art relative to applicant’s invention.). (E) is not true. MPEP § 2129; and see *In re Ehrreich*, 590 F.2d 902, 909 – 910, 200 USPQ 504, 510 (CCPA 1979); *Sjolund v. Musland*, 847 F.2d 1573, 1577, 6 USPQ2d 2020, 2023 (Fed. Cir. 1988); *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 315, 227 USPQ 766, 770 (Fed. Cir. 1985); and *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 650, 223 USPQ 1168, 1172 (Fed. Cir. 1984).

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

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

22. ANSWER: (A) is the most correct answer. See, “Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1105 (Jan. 5, 2001) left column, first paragraph. “The claimed invention as a whole may not be adequately described if the claims require an essential or critical feature that is not described in the specification and is not conventional in the art or known to one of ordinary skill in the art”; MPEP § 2163, paragraph I. A. (pg. 2100-156) (8th Ed.). (B) is not the most correct answer. See, “Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1104 (Jan. 5, 2001) right column, last paragraph; MPEP § 2163, paragraph I. (pg. 2100-155) (8th Ed.). (C) is not the most correct answer. See, “Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1104 (Jan. 5, 2001) right column, last paragraph. Describing an actual reduction to practice of the claimed invention is a means of showing possession of the invention; MPEP § 2163, paragraph I. (pg. 2100-155) (8th Ed.). (D) is not the most correct answer. See, “Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1105 (Jan. 5, 2001), left column, second paragraph, which states, “While there is no in haec verba requirement, newly added claim limitations must be supported by in the specification through express, implicit, or inherent disclosure”; MPEP § 2163, paragraph I. B. (pg. 2100-157) (8th Ed.). (E) is not the most correct answer. See, “Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1105 (Jan. 5, 2001), left column, second paragraph, which states, “An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of the error in the specification, but also recognize the appropriate correction”; MPEP § 2163, paragraph I. B. (pg. 2100-157) (8th Ed.).

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

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

25. ANSWER: (E) is the correct answer. 37 CFR 1.114, effective date August 16, 2000, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 FR 50092, 50097; MPEP § 706.07(h) (8th Ed.). (A) and (B) are each incorrect because if prosecution in an application is closed, an applicant may request continued examination “prior to the earliest of: (1) Payment of the issue fee, unless a petition under 37 CFR 1.313 is granted; (2) Abandonment of the application; or ...” 37 CFR 1.114(a). (C) is incorrect because prosecution is not closed. 37 CFR 1.114(b). (D) is incorrect because the application is abandoned for failure to pay the issue fee. 37 CFR 1.316.

26. ANSWER: (B) is the correct answer. 37 CFR 1.8, and 1.114, effective date August 16, 2000, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 FR 50092, 50096; MPEP § 706.07(h), paragraph I. (pg. 700-69) (8th Ed.). Prosecution in the application is closed because the last Office action is a final action. 37 CFR 1.114(b). In (B), the facts given indicate that the submission meets the reply requirements of 37 CFR 1.111. Thus, according to 37 CFR 1.114(d), the Office will withdraw the finality of the Office action and the submission in (B) will be entered and considered. 65 FR 50096, columns 2-3, state, "There are a number of additional differences between request for continued examination procedure set forth in this notice with the CPA procedure set forth in §1.53(d) resulting from the fact that a CPA is the filing of a new application, whereas continued examination under §1.114 merely continues the examination of the same application...(4) a request for continued examination under §1.114 is entitled to the benefit of a certificate of mailing under § 1.8 (*cf.* 1.8(a)(2)(i)(A))...."; see also the comparison chart on pg. 700-78 to 700-81 of MPEP § 707.07(h) (8th Ed.). (A) is incorrect inasmuch as a continued prosecution application is not entitled to the benefit of a certificate of mailing under 37 CFR 1.8. 37 CFR 1.8(a)(2)(i)(A). Contrary to the desire to avoid abandonment of the application, filing an application filed under 37 CFR 1.53(d) would result in abandonment of the application inasmuch as the filing is a request to expressly abandon the prior application. 37 CFR 1.53(d)(2)(v). (C) is incorrect because the telephone call does not meet the reply requirements of 37 CFR 1.111. No reply under 37 CFR 1.114(d) to the Office action has been filed. All business must be conducted in writing. 37 CFR 1.2. (D) is incorrect because the reply does not reply to the rejection of claim 1 and therefore does not meet the reply requirements of 37 CFR 1.111 and is not a proper submission pursuant to 37 CFR 1.114(d). In (A), (C), and (D), the date of abandonment is August 15, 2001, i.e., after midnight of the date on which the set shortened statutory period, including any extensions under 37 CFR 1.136, expired. MPEP § 711.04(a). (E) is incorrect because (A), (C), and (D) are incorrect.

27. ANSWER: (E) is incorrect since an oath or declaration must be provided in accordance with 37 CFR 1.64. In 37 CFR 1.64(a) the use of word "made" implies signing or executing and is derived from §1.64. See 37 CFR 1.41(c). (A) contains the elements of 37 CFR 1.41(a). As to (B) the inventorship of a nonprovisional application is that inventorship set forth in the oath or declaration as prescribe by 37 CFR 1.63, except as provided for in 37 CFR§ 1.53(d)(4) and 1.63(d). If an oath or declaration as prescribed by § 1.63 is not filed during the pendency of a nonprovisional application, the inventorship is that inventorship set forth in the applications papers filed pursuant to § 1.53(b), unless applicant files a paper, including the processing fee set forth in § 1.17(I), supplying or changing the name or names of the inventor or inventors. Mary has not authorized Sam to inspect application B. Statement (C) is in accordance with 37 CFR 1.41(a)(2). Mary has not given Sam power to inspect the provisional application. (D) is in accordance with 37 CFR 1.41(a)(3). Mary did not authorized Sam to inspect the provisional application.

28. ANSWER: The most correct answer is (B). 35 U.S.C. §102(d); MPEP §2135.01, (A Continuation - In - Part Breaks The Chain Of Priority As To Foreign As Well As U.S. Parents). If an applicant files a foreign application, later files a U.S. application claiming priority based on the foreign application, and then files a continuation - in - part (CIP) application whose claims are not entitled to the filing date of the U.S. parent, the effective filing date of the CIP

application is the filing date of the CIP. The applicant cannot obtain the benefit of either the U.S. parent or foreign application filing dates. *In re van Langenhoven*, 173 USPQ 426, 429 (CCPA 1972); *Ex parte Appeal No. 242 - 47*, 196 USPQ 828 (Bd. App. 1976). (A) is incorrect. 35 U.S.C. § 102(d). (C) is not correct. 35 U.S.C. § 102(d); MPEP § 2135.01, (An Allowed Application Can Be A 'Patent' For Purposes Of 35 U.S.C. 102(d) As Of The Date Published For Opposition Even Though It Has Not Yet Been Granted As A Patent), citing *Ex parte Beik*, 161 USPQ 795 (Bd. App. 1968). An application must issue into a patent before it can be applied in a 35 U.S.C. 102(d) rejection. *Ex parte Fujishiro*, 199 USPQ 36 (Bd. App. 1977). (D) is not correct. 35 U.S.C. § 102(d); MPEP § 2136 (Defensive Publications Are Not Prior Art As Of Their Filing Date) citing *Ex parte Osmond*, 191 USPQ 334 (Bd. App. 1973). (E) is not correct inasmuch as (A), (C) and (D) are not correct.

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

30. ANSWER: (A) is correct and (B), (C), (D), and (E) are wrong. 37 CFR 1.28(c)(2)(i) ("The deficiency owed for each previous fee erroneously paid as a small entity is the difference between the current fee amount (for other than a small entity) on the date the deficiency is paid in full and the amount of the previous erroneous (small entity) fee payment...Where a fee paid in error as a small entity was subject to a fee decrease between the time the fee was paid in error and the time the deficiency is paid in full, the deficiency owed is equal to the amount (previously) paid in error.") The current basic fee of \$710 for other than a small entity less than the previously paid small entity basic fee of \$345 results in a deficiency of \$365. There was no error in the previously paid IDS fee since \$240 was the proper amount at the time of payment for

either a small entity or other than a small entity. Therefore, the IDS fee did not enter into the deficiency calculation.

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

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

33. ANSWER: (D) is the correct answer. MPEP § 706.02 points out the distinction between rejections based on 35 U.S.C. §§ 102 and 103. For anticipation under 35 U.S.C. § 102 the reference must teach every aspect of the claimed invention either explicitly or impliedly. (A), (B), (C), and (E) are each incorrect because each response does not address the lack of anticipation by the Foreign patent. (A) is further incorrect because an applicant can be barred under 35 U.S.C. § 102(d). (B) is further incorrect because the facts do not present the necessity of such an amendment. (C) is further incorrect because a prima facie case of obviousness is not necessary in a rejection under 35 U.S.C. § 102.

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

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

36. ANSWER: The most correct answer is (A). MPEP § 2143.03 (Indefinite Limitations Must Be Considered). (B) is not correct because it is proper procedure to be followed by an examiner. MPEP § 2143.03, (Indefinite Limitations Must Be Considered), and see *Ex parte Ionescu*, 222 USPQ 537 (Bd. Pat. App. & Inter. 1984). (C) is not correct because it is proper procedure to be followed by an examiner. MPEP § 2143.03, (Indefinite Limitations Must Be Considered), and see *In re Wilson*, 165 USPQ 494 (CCPA 1970) (if no reasonably definite meaning can be ascribed to certain claim language, the claim is indefinite, not obvious). (D) is not correct because it is proper procedure to be followed by an examiner. MPEP § 2143.03, (Limitations Which Do Not Find Support In The Original Specification Must Be Considered), and see *Ex*

parte Grasselli, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). (E) is incorrect because the examiner may properly take the actions set forth in (B), (C), and (D).

37. ANSWER: (C) is the most correct answer. 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). (B) 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).” (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 § 2165.02, “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).

38. ANSWER: The most correct answer is (B). 35 U.S.C. § 102(b). The on sale activity by the inventors was not a statutory bar since the one year anniversary ends on Tuesday, June 26, 2001. (A) is not the correct answer. 35 U.S.C. § 102(a). The reference, published before the filing date of the client’s application, is prior art under 35 U.S.C. 102(a). The inventive entity is Able and Baker. The authorship is “by others,” Able, Baker, and McGeiver. The reference is prior art “by others.” See MPEP § 2132 (‘Others’ Means Any Combination Of Authors Or Inventors Different Than The Inventive Entity), and MPEP § 2132.01. See also *In re Katz*, 215 USPQ 14 (CCPA 1982). (C) is not correct. 35 U.S.C. § 102(b). The invention was placed in public use more than one year before the filing date of the patent application. See MPEP § 2133 (The 1 – Year Time Bar Is Measured From The U.S. Filing Date); MPEP § 2133.03(a); and *Egbert v. Lippmann*, 104 U.S. 333, 336 (1881). (D) is not correct. Although public knowledge may not be a public use or sale bar under 35 U.S.C. 102(b), it can provide grounds for rejection under 35 U.S.C. 102(a). MPEP §§ 2132 and 2133.03(a)(C) (Use by Independent Third Parties). In this instance, the public knowledge is more than one year before the application filing date. (E) is not correct. 35 U.S.C. § 102(b). A “secret” use by another inventor of a machine to make a product is “public” if the details of the machine are ascertainable by inspection or analysis of the product that is sold or publicly displayed. *Gillman v. Stern*, 46 USPQ 430 (2d Cir. 1940); *Dunlop Holdings v. Ram Golf Corp.*, 188 USPQ 481, 483 - 484 (7th Cir. 1975); *W.L. Gore & Assocs. v. Garlock, Inc.*, 220 USPQ 303, 310 (Fed. Cir. 1983).

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

40. ANSWER: (B) is the most correct answer. As stated in “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092 (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000), “Section 4801 of the American Inventors Protection Act of 1999 contains no provision for according the resulting nonprovisional application a filing date other than the original filing date of the provisional application. Thus, under the patent term provisions of 35 U.S.C. § 154, the term of a nonprovisional application resulting from the conversion of a provisional application pursuant to 35 U.S.C. § 111(b)(5) will be measured from the original filing date of the provisional application (which is the filing date accorded the nonprovisional application resulting from the conversion under § 4801 of the American Inventors Protection Act of 1999);” MPEP § 201.04(b) (pg. 200-16) (8th Ed.). However, the pendency is counted against the patent term. 37 CFR 1.53(c)(3), fourth sentence. (A), being in accord with USPTO practice and procedure, is not the most correct answer. 37 CFR 1.53(c)(3), third sentence. See also, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50093 (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000); MPEP § 201.04(b) (pg. 200-16) (8th Ed.). (C) is not the most correct answer. 37 CFR 1.53(c)(3), fourth sentence. (D), being in accord with USPTO practice and procedure, is not the most correct answer. 37 CFR 1.53(c)(3). (E) is a correct statement, and therefore is not a correct answer. 35 U.S.C. § 119(e)(3).

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

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

43. ANSWER: The most correct answer is (D). MPEP § 2131.03 (Prior Art Which Teaches A Range Within, Overlapping, Or Touching The Claimed Range Anticipates If The Prior Art Range Discloses The Claimed Range With “Sufficient Specificity”). If the prior art discloses a range that touches, overlaps or is within the claimed range, but there is no disclosure of specific

examples falling within the claimed, a case by case determination must be made as to anticipation. To anticipate the claims, the claimed subject matter must be disclosed in the reference with “sufficient specificity to constitute an anticipation under the statute.” What constitutes a “sufficient specificity” is fact dependent. (A) is not correct. 35 U.S.C. § 102(b); MPEP § 2131.02 (A Species Will Anticipate A Claim To A Genus) citing *In re Slayter*, 125 USPQ 345, 347 (CCPA 1960); and *In re Gosteli*, 10 USPQ2d 1614 (Fed. Cir. 1989). (B) is not the correct answer. 35 U.S.C. § 102(b); MPEP § 2131.02 (A Reference That Clearly Names The Claimed Species Anticipates The Claim No Matter How Many Other Species Are Named) citing *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990). (C) is not the correct answer. 35 U.S.C. § 102(b); MPEP § 2131.03 (A Specific Example In The Prior Art Which Is Within A Claimed Range Anticipates The Range), and see *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985) (citing *In re Petering*, 301 F.2d 676, 682, 133 USPQ 275, 280 (CCPA 1962)).

44. ANSWER: The most correct answer is (A). 35 U.S.C. § 102(c); MPEP § 2134, and see *Davis Harvester Co., Inc. v. Long Mfg. Co.*, 149 USPQ 420, 435 - 436 (E.D. N.C. 1966). (B) is not correct. 35 U.S.C. § 102(c); MPEP § 2134, and see *Ex parte Dunne*, 20 USPQ2d 1479 (Bd. Pat. App. & Inter. 1991). (C) is not correct. 35 U.S.C. § 102(c); MPEP § 2134, and see *Moore v. U.S.*, 194 USPQ 423, 428 (Ct. Cl. 1977). (D) is not correct. 35 U.S.C. § 102(c); MPEP § 2134, and see *Petersen v. Fee Int'l, Ltd.*, 381 F. Supp. 1071, 182 USPQ 264 (W.D. Okla. 1974). (E) is not correct. 35 U.S.C. § 102(c); MPEP § 2134, and see *In re Gibbs*, 437 F.2d 486, 168 USPQ 578 (CCPA 1971).

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

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

47. ANSWER: The most correct answer is (E). (A), (B), (C) and (D) are not in accordance with proper USPTO practice and procedure. (A) alone is not correct. MPEP § 2131.04 and see *In re Wiggins*, 179 USPQ 421, 425 (CCPA 1973). (B), (C), and (D) are not correct. MPEP § 2131.05, and see *Twin Disc, Inc. v. U. S.*, 231 USPQ 417, 424 (Cl. Ct. 1986); *In re Self*, 213 USPQ 1, 7 (CCPA 1982).

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

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

50. ANSWER: The most correct response is (A). 35 U.S.C. § 102(g); *Mahurkar v. C.R. Bard, Inc.*, 38 USPQ2d 1288 (Fed. Cir. 1996). If statement (D) were correct, there would be no need for interference proceedings. Statement (B) is incorrect because Debbie need not establish diligence for the period from February 2000 until just before Billie’s conception on May 15, 2000. Statement (C) is incorrect because, so long as there has not been an abandonment, suppression or concealment of the invention, Debbie need not show diligence between the actual reduction to practice and the patent filing. Statement (E) is inconsistent with 35 U.S.C. § 102(g).