

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

**OCTOBER 16, 2002**

**Morning Session (50 Points)**

**Time: 3 Hours**

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**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 PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the *Official Gazette*, or a notice in the *Federal Register*. Each question has only one most correct answer. 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 that 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 that would make the statement *true*. If it is determined by the USPTO that there is more than one most correct answer to a question, each most correct answer will be accepted, but only one point will be given for the question. The presence of multiple most correct answers does not, in itself, render the question ambiguous. 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**

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

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

2. To satisfy the written description requirement of the first paragraph of 35 USC 112, an applicant must show possession of the invention. An applicant’s lack of possession of the invention may be evidenced by:

- (A) Describing an actual reduction to practice of the claimed invention.
- (B) Describing 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) Requiring an essential feature in the original claims, 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.
- (D) Amending a claim to add a limitation that is supported in the specification through implicit or inherent disclosure.
- (E) Amending a claim to correct an obvious error by the appropriate correction.

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

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

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

Claim 1. A doughnut making machine comprising:

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

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

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

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

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

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

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

7. Paul, a registered patent practitioner and counsel for Superior Aircraft, Inc. (“Superior”), filed a patent application naming chief engineer Davis as sole inventor, and claiming a titanium and aluminum alloy designed for use in advanced gas turbine engines in aircraft. The application described the alloy as having unexpectedly excellent and improved room temperature ductility. The application was filed with an assignment document transferring all right, title and interest in the application to Superior. During prosecution of the application, the examiner had an interview with Paul and Davis of Superior. The examiner noted the existence of a prior art publication that disclosed test data demonstrating that the claimed alloys exhibited poor room temperature ductility, and stated that he had personal knowledge that the alloy was old and well known. Davis agreed with the examiner, and stated that such information was “old hat,” but that they overcame the ductility problem by simply resorting to a 3-step process of microstructure refinement. Paul concurred and pointed to the fact that not only had they disclosed the process in the application, but that microstructure refinement of alloys to improve ductility was so well-known that the technique was even taught in metallurgy courses in college. Which of the following statements is false?

- (A) The examiner may reject the alloy claims on the basis of the prior art publication.
- (B) The examiner may not reject the alloy claims on the basis of the prior art publication, because the alloys of the application are characterized by unexpected, improved ductility properties.
- (C) The examiner may rely upon the chief engineer’s statement as an admission against patentability.
- (D) The examiner may rely upon the patent counsel’s statement as an admission against patentability.
- (E) The examiner, having facts within his or her personal knowledge, may rely on the facts in rejecting the alloy claims.

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

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

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

- (A) The title of the invention should be placed at the top of the first page of the specification unless it is provided in the application data sheet.
- (B) The title need not be technically accurate, but should be descriptive and should contain fewer than 10 words.
- (C) Inasmuch as the words “improved,” “improvement of,” and “improvement in” are not considered as part of the title of an invention, these words should not be included at the beginning of the title of the invention and will be deleted when the Office enters the title into the Office’s computer records, and when any patent issues.
- (D) If a satisfactory title is not supplied by the applicant the examiner may, at the time of allowance, change the title by examiner’s amendment. If the change to the title is the only change being made by the examiner at the time of allowance, a separate examiner’s amendment need not be prepared and the examiner is to indicate the change in title in the file.
- (E) A title in a U.S. application need not be identical to the corresponding foreign filed application.

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

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

11. In accordance with MPEP § 1500, relating to design patent applications:
- (A) the invention may be properly represented in a single application by both an ink drawing and a black and white photograph.
  - (B) the invention may be properly represented in a single application by a black and white photograph disclosing environmental structure by broken lines, in lieu of an ink drawing if the invention is shown more clearly in the photograph.
  - (C) the invention may be properly represented in a single application by both an ink drawing and a color photograph, and the application should be accompanied by the required petition, fee, three sets of color photographs, and an amendment to the specification.
  - (D) the invention may be properly represented by a color photograph disclosing environmental structure by broken lines, in lieu of an ink drawing if the invention is not capable of being illustrated in an ink drawing.
  - (E) the invention may be properly represented by a color photograph if the invention is not capable of being illustrated in an ink drawing, and if the application is accompanied by the required petition, fee, and an amendment to the specification is presented to insert required language regarding the color photographs, and three sets of color photographs.
12. Inventor A filed a patent application and assigned the entire interest in the application to his employer, MegaCorp. The application issued as a utility patent on July 9, 2002. In June 2004, MegaCorp's management first learns that a second inventor, Inventor B, should have been named as a co-inventor with respect to at least one claim of the issued patent. There was no deceptive intent in failing to name Inventor B in the original application. Inventor A, who is unfamiliar with patent law and concepts of inventorship, incorrectly believes that he should be the sole named inventor on the patent, and refuses to cooperate with any effort by MegaCorp to change the named inventive entity. The issued patent contains no other error. In accordance with the Manual of Patent Examining Procedure, which of the following procedures is/are available for MegaCorp to seek correction of the named inventive entity without any agreement, cooperation or action from Inventor A?
- (A) File, on or before July 9, 2004, a reissue application, made by MegaCorp only, that seeks to add Inventor B.
  - (B) File, after July 9, 2004, a reissue application, made by MegaCorp only, that seeks to add Inventor B.
  - (C) Request a Certificate of Correction to add Inventor B as a named inventor.
  - (D) Submit in the issued patent file: a Request for Correction of Inventorship Under the Provisions of 37 CFR 1.48 that sets forth the desired inventorship change; a statement by Inventor B that the error in inventorship occurred without deceptive intention on her part; an oath or declaration executed by Inventor B; all required fees; and the written consent of MegaCorp.
  - (E) A and B are each available procedures.

13. Which of the following statements concerning reliance by an examiner on common knowledge in the art, in a rejection under 35 USC 103 is correct?

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

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

14. 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 USC 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 USC 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 USC 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 USC 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.

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

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

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

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

17. Which of the following statements is true?

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

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

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

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

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

20. 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).

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

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

22. Which of the following is not in accordance with provisions of the MPEP?
- (A) In return for a patent, the inventor gives a complete disclosure of the invention for which protection is sought.
  - (B) Amendments filed after the filing date that lack descriptive basis in the original disclosure involve new matter.
  - (C) If during the course of examination of a patent application, an examiner notes the use of language that could be deemed offensive to any race, religion, sex, ethnic group, or nationality, he or she should object to the use of the language as failing to comply with the Rules of Practice.
  - (D) The examiner should object to application drawings that include depictions or caricatures that might reasonably be considered offensive to any race, religion, sex, ethnic group or nationality.
  - (E) Where an amendment is filed with a patent application that has no signed oath or declaration, a subsequently filed oath or declaration must refer to both the application and amendment, but in any case the amendment will not be considered as part of the original disclosure and will be treated as new matter.
23. Which of the following is the best way to recite a claim limitation so that it will be interpreted by the examiner in accordance with 35 USC 112, paragraph 6?
- (A) dot matrix printer for printing indicia on a first surface of a label.
  - (B) dot matrix printer means coupled to a computer.
  - (C) means for printing indicia on a first surface of a label.
  - (D) printer station for printing indicia on a first surface of a label.
  - (E) All of the above.
24. Which of the following is not in accordance with Office practice under 35 USC 42?
- (A) The Director may refund any fee paid by mistake or any amount paid in excess of that required.
  - (B) A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent for which the fee was paid, including an application, an appeal or a request for an oral hearing, will not entitle a party to a refund of such fee.
  - (C) Even if an applicant specifically requests a refund, the Office will not refund amounts of twenty-five dollars or less.
  - (D) Any refund of fee paid by credit card will be by a credit to the credit card account to which the fee was charged.
  - (E) If an applicant mistakenly files an application, the filing fee is not considered a fee paid by mistake.

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

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

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

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

27. 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 USC 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.

The following facts apply to Questions 28 and 29.

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

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

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

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

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

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

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

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

30. In accordance with the MPEP, and USPTO rules and procedure, a patent application may be made by someone other than the inventor in certain situations. In which of the following situations would an application not be properly made by someone other than the inventor?

- (A) The inventor is deceased, and the application is made by the legal representative of the deceased inventor.
- (B) The inventor is deceased, and the application is made by one who has reason to believe that he or she will be appointed legal representative of the deceased inventor.
- (C) The inventor is a minor (under age 18) who understands and is willing to execute the declaration, but the application is made by the minor's legal representative.
- (D) The inventor is insane, and the application is made by the legal representative of the insane inventor.
- (E) The inventor is legally incapacitated, and the application is made by the legal representative of the legally incapacitated inventor.

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

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

32. A product-by-process claim is properly rejected over a reference under 35 USC 102(b). Which of the following statements is incorrect?

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

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

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

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

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

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

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

36. 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 consisting of the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (B) 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.
- (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 characterized by the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (E) (C) and (D).

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

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

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

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

39. Which of the following is not in accordance with the provisions in the MPEP?
- (A) A continuation-in-part is an application filed during the lifetime of an earlier nonprovisional application by the same applicant, which repeat either some substantial portion or all of the earlier nonprovisional application, and adds matter not disclosed in the said earlier nonprovisional application.
  - (B) A continuation-in-part application may only be filed under 37 CFR 1.53(b).
  - (C) A continuation-in-part application cannot be filed as a continued prosecution application (CPA) under 37 CFR 1.53(d).
  - (D) An application claiming the benefits of a provisional application under 35 USC 119(e) should not be called a “continuation-in-part” of the provisional application.
  - (E) One of the formal requirements of 35 USC 120 is that a continuation-in-part application must be “filed before a notice of allowance or abandonment is mailed in the prior application.”
40. Which of the following is not a USPTO recommendation or requirement?
- (A) Product and process claims should be separately grouped.
  - (B) Claims should be arranged in order of scope so that the first claim presented is the least restrictive.
  - (C) Every application should contain no more than three dependent claims.
  - (D) A claim which depends from a dependent claim should not be separated from that dependent claim by any claim which does not also depend from the dependent claim.
  - (E) Each claim should start with a capital letter and end with a period.
41. The following statements relate to “multiple dependent claims.” Which statement is not in accord with proper USPTO practice and procedure?
- (A) A multiple dependent claim contains all the limitations of all the alternative claims to which it refers.
  - (B) A multiple dependent claim contains in any one embodiment only those limitations of the particular claim referred to for the embodiment under consideration.
  - (C) A multiple dependent claim must be considered in the same manner as a plurality of single dependent claims.
  - (D) Restriction may be required between the embodiments of a multiple dependent claim.
  - (E) The limitations or elements of each claim incorporated by reference into a multiple dependent claim must be considered separately.

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

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

43. 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 USC 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 USC 112, second paragraph, and not reject the claim as obvious.
- (D) When evaluating claims for obviousness under 35 USC 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).

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

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

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

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

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

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

47. 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.

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

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

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

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

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

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

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**United States Patent and Trademark Office**  
**Registration Examination for Patent Attorneys and Agents**  
**October 16, 2002**

**Morning Session Model Answers**

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

2. ANSWER: (C) 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.” (A) 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. (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. (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.” (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.”

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

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

5. ANSWER: (C) is most correct. 37 C.F.R. § 1.181; MPEP § 706.07(c). (A) and (B) are wrong. 37 C.F.R. § 1.181(a)(1); MPEP § 706.07(c). Prematureness of a final rejection is not appealable. 37 C.F.R. § 1.191(a). (D) and (E) are wrong because MPEP § 706.07(c) states,

“Any question as to prematureness of a final rejection should be raised, if at all, while the application is still pending before the primary examiner.” MPEP § 1210 indicates that jurisdiction is before the Board at the times set forth in (D) and (E).

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

7. ANSWER: (B) is best choice because it is a false statement. MPEP § 2112.01 cites *Titanium Metals Corp. v. Banner*, 778 F.2d 660, 227 USPQ 773 (Fed. Cir. 1985), as stating, “it was immaterial what properties the alloys had...because the composition is the same and thus must necessarily exhibit the properties.” (A) is not correct because it is a true statement. (C), (D) and (E) are incorrect because the stated reliance is permitted. 37 C.F.R. § 1.104(c)(3); MPEP § 706.

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

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

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

11. ANSWER: (E) is correct. The statement finds support in MPEP § 1503.02, V. “Photographs and Color Drawings.” (A) and (C) are wrong because 37 C.F.R. § 1.152 states, “Photographs and ink drawings are not permitted to be combined as formal drawings in one

application.” Reproduced in MPEP § 1503.02. (B) and (D) are wrong because 37 C.F.R. § 1.152 states, “Photographs submitted in lieu of ink drawings in design patent applications must not disclose environmental structure but must be limited to the design claimed for the article.” Reproduced in MPEP § 1503.02.

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

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

14. 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).

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

16. ANSWER: (E) is the most correct answer. 37 C.F.R. § 1.121(c) and (d), and MPEP § 714, page 700-169 through 172 (8<sup>th</sup> Ed.) (*Amendments, Applicant’s Action*). (A) is incorrect. MPEP § 714.22, page 700-196, 197 (8<sup>th</sup> Ed.) (*Entry of Amendments*). Applicant may resubmit the amendment within any remaining period of time (set in the final rejection). No further extension of time or new time periods which might serve to extend the six month statutory period will be set in the advisory action. If time remains in the period set in the final rejection, applicants may resubmit the amendment, or request an extension of time (with appropriate fee) in which to do so, but will not be able to obtain an extension beyond the six-month statutory deadline. (B) is incorrect. MPEP § 714.22(a), page 700-198, (*Amendments Consolidating All Claims*). Applicants have the opportunity to consolidate all previous versions of pending claims from a

series of separate amendment papers into a single clean version in a single amendment paper. This may be done at any time during prosecution of the application, though the entire clean claim set is subject to the provisions of 37 C.F.R. §§ 1.116(b) and 1.312. (C) is incorrect. MPEP § 714, page 700-169 through 172 (8<sup>th</sup> Ed.) (*Amendments, Applicant's Action*) While the first portion of the answer is correct because amendments to the drawings must be submitted on a separate paper showing the proposed changes in red for to the specification including the claims must be made by replacement paragraph/section/claim in clean form. This requirement is regardless of the mailing date of the Office action.

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

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

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

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

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

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

23. ANSWER: (C) is the most correct answer. MPEP § 2181 expressly requires that for a claim limitation to be interpreted in accordance with 35 U.S.C. § 112, paragraph 6, that limitation must

(1) use the phrase “means for”, (2) the “means for” must be modified by functional language, and (3) the “means for” must not be modified by sufficient structure for achieving the specified function. In the above fact pattern, only answer choice (C) satisfies the above requirements. (A) is wrong because it does not use the phrase “means for” and recites structure for achieving the specified function (“printer”). (B) is wrong because it modifies the “means” with structure, and also fails to modify the “means” with functional language. (D) is wrong because it does not use the phrase “means for” and also recites structure modifying “mechanism.”

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

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

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

27. 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).

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

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

30. All answers accepted.

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

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

33. ANSWER: (C) is correct and (B) is wrong because MPEP § 706.07(f), part (H), states, "Where a complete first reply to a final Office action has been filed within 2 months of the final Office action, an examiner's amendment to place the application in condition for allowance may be made without the payment of extension fees even if the examiner's amendment is made more than 3 months from the date of the final Office action." (A), (D) and (E) are wrong because MPEP § 706.07(f), part (H), states, "Note that an examiner's amendment may not be made more than 6 months from the date of the final Office action, as the application would be abandoned at that point by operation of law." In (A), when an examiner's amendment is mailed exactly 5 months after Xavier's reply, the examiner's amendment would be made more than 6 months after the Office action.

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

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

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

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

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

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

40. ANSWER: (C) is the most correct answer. The USPTO does not require or recommend a minimum or maximum number of dependent claims. 37 C.F.R. § 1.75(c). (A) is a USPTO recommendation. See MPEP § 608.01(m) (“Similarly, product and process claims should be separately grouped.”). (B) is a USPTO recommendation. See MPEP § 608.01(m) (“Claims should preferably be arranged in order of scope so that the first claim presented is the least

restrictive.”). (D) is a PTO recommendation. See MPEP § 608.01(n), part IV. (E) is a USPTO requirement. See MPEP § 608.01(m) (“Each claim begins with a capital letter and ends with a period.”).

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

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

43. 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).

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

45. ANSWER: (C) is a false statement and therefore the correct answer. Under 35 U.S.C. § 261, “An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent and Trademark Office within three months from its date or prior to the date of such subsequent purchase or mortgage.” (C) is correct because ABC Corporation acquired all of John’s ownership rights in the original patent application, including the subcombination claimed in the original nonprovisional and divisional patent applications. The assignment of the rights to ABC Corporation was recorded in the USPTO prior to the subsequent acquisition of the subcombination by XYZ Corporation. U.S.C. § 261. ABC Corporation’s recordation of its assignment gave constructive notice to XYZ Corporation. MPEP § 306 recites that in the case of a division...application, a prior assignment recorded against the original application is applied to the division...application because the assignment recorded against the original application gives the assignee rights to the subject matter common to both applications. (A) and (B) are true statements and therefore wrong answers. John gave up his ownership rights when he executed the assignment to ABC Corporation. The assignment to ABC Corporation carries with it the transfer of the bundle of rights associated with subject matter common to the original patent

application, e.g., the divisional patent application. (D) and (E) are true statements and therefore wrong answers because XYZ Corporation acquired no rights in the original or divisional patent applications. MPEP § 306.

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

47. ANSWER: The most correct answer is (A). MPEP § 2106.02 (Affidavit Practice (37 C.F.R. § 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 C.F.R. § 1.132)), and see *In re Brandstadter*, 179 USPQ 286 (CCPA 1973). (D) is not correct. MPEP § 2106.02 (Affidavit Practice (37 C.F.R. § 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).

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

49. ANSWER: Choice (E) is the correct answer. MPEP § 502.01, and 37 C.F.R. § 1.6(d)(3). MPEP § 502.01 reads, “The date of receipt accorded to any correspondence permitted to be sent by facsimile transmission, including a continued prosecution application (CPA) filed under 37 C.F.R. § 1.53(d), is the date the complete transmission is received by an Office facsimile unit...An applicant filing a CPA by facsimile transmission must include an authorization to charge the basic filing fee to a deposit account or to a credit card.” Choice (A) is incorrect because 37 C.F.R. § 1.6(d) states, “Facsimile transmissions are not permitted and, if submitted, will not be accorded a date of receipt in the following situations: ... (5) A request for reexamination under § 1.510 or § 1.913.” Choice (B) is incorrect because 37 C.F.R. § 1.6(d) also states, “Facsimile transmissions are not permitted and, if submitted, will not be accorded a date of receipt in the following situations: ... (4) Drawings submitted under §§ 1.81, 1.83 through 1.85, 1.152, 1.165, 1.174, 1.437, 2.51, 2.52, or 2.72.” Choice (C) is incorrect because 37 C.F.R. § 1.6(d) also states, “Facsimile transmissions are not permitted and, if submitted, will not be

accorded a date of receipt in the following situations: ... (3) Correspondence which cannot receive the benefit of the certificate of mailing or transmission as specified in 1.8(a)(2)(i)(A)..." 37 C.F.R. § 1.8(a)(2)(i)(A) reads, "The filing of a national patent application specification and drawing or other correspondence for the purpose of obtaining an application filing date..." Choice (D) is incorrect because 37 C.F.R. § 1.6(d) also states, "Facsimile transmissions are not permitted and, if submitted, will not be accorded a date of receipt in the following situations: ... (6) Correspondence to be filed in a patent application subject to a secrecy order under §§ 5.1 through 5.5 of this chapter and directly related to the secrecy order content of the application."

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

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

**OCTOBER 16, 2002**

**Afternoon Session (50 Points)**

**Time: 3 Hours**

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**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 PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the *Official Gazette*, or a notice in the *Federal Register*. Each question has only one most correct answer. 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 that 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 that would make the statement *true*. If it is determined by the USPTO that there is more than one most correct answer to a question, each most correct answer will be accepted, but only one point will be given for the question. The presence of multiple most correct answers does not, in itself, render the question ambiguous. 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**

1. Which of the following is not in accordance with the provisions of the MPEP?
- (A) Where joint inventors are named, the examiner should not inquire of the patent applicant concerning the inventors and the invention dates for the subject matter of the various claims until it becomes necessary to do so in order to properly examine the application.
  - (B) Under 35 USC 119(a), the foreign priority benefit may be claimed to any foreign application that names a U.S. inventor as long as the U.S. named inventor was the inventor of the foreign application invention and 35 USC 119(a)-(d) requirements are met.
  - (C) Where two or more foreign applications are combined in a single U.S. application, to take advantage of the changes to 35 USC 103 or 35 USC 116, the U.S. application may claim benefit under 35 USC 119(a) to each of the foreign applications provided all the requirements of 35 USC 119(a)-(d) are met.
  - (D) One of the conditions for benefit under 35 USC 119(a) is that the foreign application must be for the same or a nonobvious improvement of the invention described in the United States application.
  - (E) If a foreign application for which priority is being claimed under 35 USC 119 is filed in a country which does not afford similar privileges in the case of applications filed in the United States or to citizens of the United States and the foreign country is not a WTO member country, any claim for the foreign priority thereto by a U.S. application will not be effective.
2. Assume that conception of applicant's complex invention occurred prior to the date of the reference, but reduction to practice occurred after the date of the reference. Which of the following is sufficient to overcome the reference in accordance with proper USPTO practice and procedure?
- (A) In a 37 CFR 1.131 affidavit or declaration, it is sufficient to allege that applicant or patent owner has been diligent.
  - (B) In a 37 CFR 1.131 affidavit or declaration, it is sufficient to clearly establish conception of the invention prior to the effective date of the reference, and diligence from just prior to the effective date of the reference to actual reduction to practice. The presence of a lapse of time between the reduction to practice of an invention and the filing of an application thereon is not relevant.
  - (C) In a 37 CFR 1.131 affidavit or declaration, it is sufficient to clearly establish conception of the invention prior to the effective date of the reference. Diligence need not be considered.
  - (D) In a 37 CFR 1.131 affidavit or declaration, it is sufficient to show conception and reduction to practice in any country.
  - (E) In a 37 CFR 1.131 affidavit or declaration, it is always sufficient to prove actual reduction to practice for all mechanical inventions by showing plans for the construction of the claimed apparatus.

3. Which of the following establishes a statutory bar under 35 USC 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.

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

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

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

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

6. An examiner has properly established a prima facie showing of no specific and substantial credible utility for the claimed invention in a patent application filed in February 2001. An applicant can sustain the burden of rebutting and overcoming the showing by:

- (A) Providing reasoning or arguments rebutting the basis or logic of the prima facie showing.
- (B) Amending the claims.
- (C) Providing evidence in the form of a declaration under 37 CFR 1.132 rebutting the basis or logic of the prima facie showing.
- (D) Providing evidence in the form of a printed publication rebutting the basis or logic of the prima facie showing.
- (E) All of the above.

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

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

8. 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 USC 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.

9. 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.

10. Which of the following is true?

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

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

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

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

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

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

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

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

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

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

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

Which of the following claims, presented in the application, provide the basis for a proper rejection under 35 USC 112, second paragraph?

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

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

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

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

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

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

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

Claim 1. An apparatus for sitting comprising:

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

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

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

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

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

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

19. 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 USC 101 also creates a deficiency under 35 USC 112, first paragraph.
- (B) To overcome a rejection under 35 USC 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 USC 101 as lacking utility if the particular embodiment disclosed in the patent lacks perfection or performs crudely.
- (D) To overcome a rejection under 35 USC 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.

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

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

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

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

22. Which of the following is in accordance with the provisions in the MPEP?
- (A) In order to correct inventorship in a nonprovisional application where the statement of the lack of deceptive intent is not available from an inventor to be added, a petition under 37 CFR 1.181 may be properly filed.
  - (B) If a person A learns that a patent application has been filed by person B without naming A as coinventor, A may file in the USPTO a petition that protests inventorship and directs B to add A's name as a coinventor to the patent application.
  - (C) If the application is involved in an interference, and a petition under 37 CFR 1.48 is filed to correct inventorship, the Board of Patent Appeals and Interferences will remand the case to the primary examiner for consideration of the petition to ensure that a search of the relevant prior art is performed.
  - (D) When a second conversion under 37 CFR 1.48(a) is attempted by the practitioner, the conversion decision will be decided by the Technology Center Director.
  - (E) None of the above.
23. Which of the following statements relating to design patents does not accord with proper USPTO practice and procedure?
- (A) Both design and utility patents may be obtained on an article if the invention resides both in its utility and ornamental appearance.
  - (B) The design for an article consists of the visual characteristics embodied in or applied to an article.
  - (C) Design patent applications are included in the Patent Cooperation Treaty (PCT), and the procedures followed for PCT international applications are to be followed for design patent applications.
  - (D) A claim directed to a computer-generated icon shown on a computer screen complies with the "article of manufacture" requirement of 35 USC 171.
  - (E) A claimed design may encompass multiple articles or multiple parts within an article.
24. A claim, as required by the second through fifth paragraphs of section 112, shall not be required in a \_\_\_\_\_ patent application.
- (A) reissue
  - (B) design
  - (C) continuation
  - (D) provisional
  - (E) plant

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

35. Which of the following is not in accordance with the provisions of the MPEP?
- (A) If there is a discrepancy between the information submitted in an application data sheet and the information submitted elsewhere in the application, the application data sheet will control except for the naming of the inventors and the citizenship of the inventors, which is governed by the oath or declaration.
  - (B) A patent examiner should object to text of a patent application if it contains an embedded hyperlink and /or other form of browser-executable code.
  - (C) All patent applicants should use the English units of measurement followed by the equivalent metric units when describing their inventions in the specifications of patent applications.
  - (D) The paper used for patent applications must have a surface such that amendments may be written thereon in ink; so-called “Easily Erasable” paper having a special coating so that erasures can be made more easily may not provide a permanent copy as is required.
  - (E) The following documents may be submitted to the Office on a compact disc: a computer program listing, a sequence listing, and a table that has more than 50 pages of text.
36. The USPTO notifies John, a registered patent agent who is representing applicant A, that after a reasonable search, the USPTO has been unable to locate applicant A’s patent application. By which of the following procedures may John avoid abandonment of applicant A’s application within the time period set by the USPTO?
- (A) Provide the USPTO with a copy of his record of all the correspondence between his office and the USPTO, assuming the existence of such record.
  - (B) Provide the USPTO with a list of all the correspondence between his office and the USPTO, assuming the existence of such list, and a statement that the list is complete and accurate.
  - (C) Provide the USPTO with a statement that he does not possess any record of the correspondence between his office and the USPTO because his files were destroyed.
  - (D) Provide the USPTO with a record of all the correspondence between his office and the USPTO, and a statement that the papers produced are his complete record of all the correspondence between his office and the USPTO, assuming the existence of such record.
  - (E) Provide the USPTO with a copy of his record of all the correspondence between his office and the USPTO, assuming the existence of such record, a list of all such correspondence, and a statement that he is not aware of any correspondence between his office and the USPTO that is not among his records.

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

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

38. 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 USC 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 USC 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 USC 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 USC 112.

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

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

40. Which of the following does not represent prior art?

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

50. An applicant's claim stands rejected under 35 USC 103 as being obvious over Larry in view of Morris. Larry and Morris are references published more than one year before applicant's effective filing. Although the examiner cites no suggestion or motivation for combining the references, they are, in fact, combinable. Which of the following arguments could properly show that the claim is not obvious?

- (A) The inventions disclosed by Larry and Morris cannot be physically combined.
- (B) Neither Larry nor Morris provides an express suggestion to combine the references.
- (C) As recognized by businessmen, the high cost of Larry's device teaches away from combining it with the simpler device of Morris.
- (D) Absent a suggestion or motivation, the examiner has not shown that combining Larry's with Morris's device would have been within the level of ordinary skill of the art.
- (E) None of the above.

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**United States Patent and Trademark Office**  
**Registration Examination for Patent Attorneys and Agents**  
**October 16, 2002**

**Afternoon Session Model Answers**

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

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

3. 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).

4. ANSWER: (E) is correct and (A), (B), (C) and (D) are wrong. As a former employee of the USPTO, the former examiner is incapable of acquiring an interest, directly or indirectly, in a patent application in the manner described in the question during the period of appointment as an examiner, and for one year thereafter. 35 U.S.C. § 4; MPEP § 309. Inasmuch as the former examiner resigned from the USPTO on June 7, 2001, the former examiner is incapable of

acquiring an interest in the application in said manner until June 8, 2002. Registration as a practitioner does not affect the restrictions on the former examiner.

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

6. ANSWER: (E) is the most correct answer. For (A) *see*, “Utility Examination Guidelines,” 66 F.R. 1092, 1099, left column (Jan. 5, 2001). “The applicant can do this by... providing reasoning or arguments...” For (B), *see*, “Utility Examination Guidelines,” 66 F.R. 1092, 1099, left column (Jan. 5, 2001). “The applicant can do this by amending the claims...” For (C) *see*, “Utility Examination Guidelines,” 66 F.R. 1092, 1099, left column (Jan. 5, 2001). “The applicant can do this by...providing evidence in the form of a declaration under 37 C.F.R. § 1.132...rebutting the basis or logic of the prima facie showing.” For (D), *see*, “Utility Examination Guidelines,” 66 F.R. 1092, 1099, left column (Jan. 5, 2001). “The applicant can do this by...providing evidence in the form of a...printed publication...rebutting the basis or logic of the prima facie showing.” (A), (B), (C), and (D) alone are not the most correct answer inasmuch (E), referencing all of the above, is the most correct answer.

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

8. 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.

9. 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).

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

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

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

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

14. ANSWER: (D) is correct. (A), (B) and (C) are wrong because MPEP § 601.01(c) states, “Claiming priority is less expensive [than conversion] and will result in a longer patent term.”

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

15. ANSWER: (A) is accepted as the most correct answer. MPEP § 2173.05(e). Claim 2 is indefinite because it is not clear which “said pipe” the claim is referring to since claim 1 recites a copper pipe and an aluminum pipe. Accordingly, claim 2 provides the basis for a proper rejection under 35 U.S.C. § 112, second paragraph. In (B), claim 3 would be construed as definite, inasmuch as “the outer circumference” is an inherent part of the pipe and would not require antecedent recitation. Thus claim 3 does not provide a proper basis for the rejection. Therefore, (B) and (D) would be incorrect. Claim 4 is definite inasmuch as there is antecedent basis for “said plastic valve.” Therefore, (C) and (E) are incorrect.

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

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

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

19. 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 Fouché*, 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).

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

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

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

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

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

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

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

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

the most correct answer because even though canceling Claim 3 will overcome the rejection and provides protection for the Ethernet cable made by the process comprising the steps A, B, C, and D, it will also leave the application without a claim to the Ethernet cable made using the processes comprising the steps of A, B, and C. Answer (E) alone is incorrect because, even though canceling the claim will overcome the rejection, it will also leave the application without a claim to the Ethernet cable made using the processes set forth in either Claim 1 or Claim 2.

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

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

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

30. ANSWER: Choice (D) is the correct answer. MPEP § 812.01. Choices (A), (B), and (C) are each incorrect because MPEP § 812.01 reads, “If, on examination, the examiner finds the elected claims to be allowable and no traverse was made, the letter should be attached to the Notice of Allowability form PTOL-37 and should include cancellation of the nonelected claims, a statement that the prosecution is closed, and that a notice of allowance will be sent in due course.” Choice (E) is incorrect because only choice (D) is correct.

31. ANSWER: (B). MPEP § 608.01, subsection “Illustrations In the Specification.” 37 C.F.R. § 1.58(a) permits tables and chemical formulas in the specification in lieu of formal drawings. (A) is incorrect. MPEP § 608.01, subsection “Illustrations In the Specification.” Graphical illustrations, diagrammatic views, flowcharts, and diagrams in the descriptive portion of the specification do not come within the purview of 37 C.F.R. § 1.58(a). The examiner should object to such descriptive illustrations in the specification and request formal drawings in accordance with 37 C.F.R. § 1.81 when an application contains graphs in the specification. (C) is incorrect. MPEP § 608.01, subsection “Hyperlinks And Other Forms Of Browser-

Executable Code In The Specification.” USPTO policy does not permit the USPTO to link to any commercial sites since the USPTO exercises no control over the organization, views, or accuracy of the information contained on these outside sites. (D) is incorrect. 37 C.F.R. § 1.75(a). The specification must conclude with one or more claims. (E) is incorrect. 37 C.F.R. § 1.79. A reservation for a future application of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application.

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

33. ANSWER: (D) is correct. (A), (C), and (E) are wrong because MPEP § 706.07(f), paragraph (I), states, “Where a complete first reply to a final Office action has not been filed within 2 months of the final Office action, applicant’s authorization to make an amendment to place the application in condition for allowance must be made either within the 3 month shortened statutory period or within an extended period for reply that has been petitioned and paid for by applicant pursuant to 37 C.F.R. § 1.136(a).” (B) is wrong because MPEP § 706.07(f), paragraph (H), states, “Note that an examiner’s amendment may not be made more than 6 months from the date of the final Office action, as the application would be abandoned at that point by operation of law.”

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

35. ANSWER: (C). As to (C), according to MPEP § 608.01 at p. 600-58, “In order to minimize the necessity in the future for converting dimensions given in the English system of measurements to the metric system of measurements when using printed patents as research and prior art search documents, all patent applicants should use the metric units (SI) followed by the equivalent English units when describing their inventions in the specifications of patent applications.” As to (A), see MPEP § 601.05 at p. 600-21 and 37 C.F.R. § 1.76 (d)(3), regarding

the oath or declaration controlling over the application data sheet. See also MPEP § 608.01(a) at p. 600-61. As to (B), see MPEP § 608.01(a) at p. 600-60 regarding hyperlinks. As to (D), see 37 C.F.R. § 1.52(a); and MPEP § 608.01. As to (E) see MPEP § 608.01 at p. 600-56 and 37 C.F.R. § 1.52.

36. ANSWER: (C) is correct. 37 C.F.R. § 1.251(a)(3). (C) is correct because there is compliance with 37 C.F.R. § 1.251(a)(3). (A) is wrong because along with a copy of the record, he is required to provide a list of all correspondence, and a statement that the copy is complete and accurate and that he is not aware of any correspondence between his office and the USPTO that is not among his records. 37 C.F.R. § 1.251(a)(1)(ii). (B) is wrong because along with a list of all correspondence and a statement that the copy of his record of all the correspondence is complete and accurate, he is required to provide a copy of his record of all the correspondence, and the statement must recite that he is not aware of any correspondence between his office and the USPTO that is not among his records. 37 C.F.R. § 1.251(a)(1)(i). (D) is wrong because the statement omits the recitation that he is not aware of any correspondence between his office and the USPTO that is not among his records. 37 C.F.R. § 1.251(a)(2)(ii). (E) is wrong because the statement omits the recitation that the copy of his record of all the correspondence is complete and accurate. 37 C.F.R. § 1.251(a)(1)(iii).

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

38. 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).

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

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

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

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

43. ANSWER: (D). “It is not necessary in order to establish a prima facie case of obviousness...that there be a suggestion or expectation from the prior art that the claimed [invention] will have the same or a similar utility as one newly discovered by the applicant.” *In re Dillon*, 919 F.2d 688, 692, 16 USPQ2d 1897, 1900 (Fed. Cir. 1990) (emphasis in original).

Thus, “[i]t is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant.” MPEP § 2144 (“Rationale Different from Applicant’s is Permissible”). Here, T suggests the combination with P to achieve a different advantage or result, i.e., waterproofing, from that discovered by applicant, i.e., reducing breakage. Answers (A) - (C) are incorrect because the suggestion to combine does not need to be for the same purpose as applicant discloses in the application. Dillon, 919 F.2d at 692, 16 USPQ2d at 1900; MPEP § 2144 (“Rationale Different from Applicant’s is Permissible”). Answer (E) is incorrect because an applicant is under no obligation to submit evidence of non-obviousness unless the examiner meets his or her initial burden to fully establish a prima facie case of obviousness. MPEP § 2142.

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

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

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

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

48. ANSWER: Choice (B) is the correct answer. MPEP § 402; 37 C.F.R. § 1.34. MPEP § 402 states that “Powers of attorney or authorizations of agent naming firms of attorneys or agents filed in patent applications will not be recognized.” (A) and (D) are each incorrect because according to 37 C.F.R. § 1.34(b), “A principal registered attorney or agent, so appointed, may appoint an associate registered attorney or agent who shall also then be of record.” (C) is incorrect. As stated in MPEP § 402, “Powers of attorney and authorizations of agent under 37 C.F.R. § 1.34(b) naming one or more registered individuals, or all registered practitioners associated with a Customer Number, may be made. See MPEP § 403 for Customer Number practice.” (E) is incorrect because, as set forth in MPEP § 402.07, “A power of attorney by the assignee of the entire interest revokes all powers given by the applicant and prior assignees if the assignee establishes their right to take action as provided in 37 C.F.R. § 3.73(b).”

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

50. ANSWER: (D) is correct. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP § 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). Here, the examiner fails to show that substituting Larry’s device for another type of device in Morris would have been desirable. (A) is incorrect. The test of obviousness is not whether the features or elements of the references are physically combinable. *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981); *In re Sneed*, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983). (B) is incorrect. “The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law.” MPEP § 2144 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)). Here, the argument overlooks the fact that a suggestion to combine Larry and Morris may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. (C) is incorrect. “The fact that a combination would not be made by businessmen for economic reasons does not mean that a person of ordinary skill in the art would not make the combination because of some technological incompatibility.” MPEP § 2145 (citing *In re Farrenkopf*, 713 F.2d 714, 718, 219 USPQ 1, 4 (Fed. Cir. 1983)). Here, the high cost of Barry’s device does not teach away from a person of ordinary skill in the art combining it with Lance’s device.