



New Exam Question Post – Updated  
June 3<sup>rd</sup>!

**Post Date: May 23<sup>rd</sup>, 2011**

Hi All,

New questions found on this exam:

1. After the decision has been made by the board, a copy is mailed to the appellant. Once the copy of the decision has been mailed, the applicant will have how many months to request a rehearing:

Answer: 2 months.

2. In what situation is the time period to file an amendment after a decision by the board extendable under 37 CFR §1.136(b) or 37 CFR § 1.550(c):

Answer: In the case of a reexamination.

3. In a rehearing where the board decides that no claims stand allowed, the application is:

Answer: taken out of its pending status and considered abandoned.

4. If the appellant submits an argument without either an appropriate amendment or new evidence as to any of the claims rejected by the Board, it will be treated as what under 37 CFR 41.50(b)(2):

Answer: a request for rehearing.

5. Permission to inspect the application may be given the competitor by the Director under what circumstance:

Answer: Where an applicant relied on his or her application as a means to interfere with a competitor's business or customers.

6. When may an applicant file a Notice of Appeal that is accompanied by the required fee, within the specified time period:

Answer: after a claim has been twice rejected.

7. When an appellant files an Appeal Brief without filing a Notice of Appeal, the Office will treat the brief as both as long as:

Answer: it is filed in the time period set in the last Office action.

8. When can an amendment introduce new arguments that were not present in either the appeal brief or reply brief and still be considered by the board:

Answer: if it relates to a new Federal Circuit case that is on point.

9. To pass the threshold eligibility inquiries of § 101 for patent protection, a claimed invention must be:

Answer: directed to statutory subject matter and must be useful.

**Post Date: May 16<sup>th</sup>, 2011**

Hi All,

New questions found on this exam:

1. One of the criteria for determining subject matter eligibility that must be satisfied is:

Answer: the claimed invention must not be wholly directed to subject matter encompassing a judicially recognized exception.

2. Where the asserted specific and substantial utility is not credible, which of the following is an element of the required prima facie showing:

Answer: An evaluation of all relevant evidence of record, including utilities taught in the closest prior art.

3. Which of the following is not considered to be a new application:

Answer: RCE.

4. A method comprising the steps of: doing research; collecting results; analyzing results; and making a recommendation. The Examiner rejects per 101. Which is most appropriate to overcome the rejection:

Answer: Incorporate a machine such that it does some meaningful transformation.

5. An application concerning drug dispensing machine with touch screen. The examiner rejects under 103 per X and Y. X teaches drug-BV dispensing machine, Y teaches touch screen, suggesting that drug dispensing machines could benefit from a touch screen. How should the examiner properly reject application:

Answer: use the teaching as a rationale to support an obviousness rejection.

6. Under 112, which of the following is true:

Answer: algorithm disclosed via PROSE, flowchart, etc.

7. An application for compound Z to treat cancer. No disclosure of how to make Z. Prior art discloses Z but also does not disclose how to make Z. How can the examiner make a 112, 1<sup>st</sup> paragraph rejection for enablement:

Answer: 112 enablement and 112 written description, because the specification and the prior art does not enable phosita.

8. Which one is in accord with the MPEP, laws, and regulations in regards to EPAS:

Answer: Inserting an electronic signature is an act that affirms/certifies that such act of insertion was performed by the person whose signature is represented.

9. The speed of producing a product can be used to:

Answer: determine the skill level of people of ordinary skill in the art.

10. Regarding assignments, which of the following is not required by the Office:

Answer: the original assignment or true copy.

11. A French patent filing date April 28, 2001. French patent issue date April 29, 2002. US patent filing date April 30 2002. What is reference available under:

Answer: 102 a and d

12. By filing an appeal to the Fed Circuit, failure to prosecute the appeal, such as by an applicant's failure to file a brief, result in:

Answer: the dismissal of the appeal by the court.

**Post Date: May 9<sup>th</sup>, 2011**

Hi All,

New questions found on this exam:

1. Mexico company, what to do the following on International application to US Receiving Office: "Sole Applicant" is the company head, who is a resident of US and national of Mexico. The "Sole Inventors" are two Mexican nationals, on the last day to enter national phase, the copy of International application is transferred from the International Bureau, translation not available, filed national fee by "Express mail office to address", can it have a filing date:

Answer: yes because national fee is submitted within 30 month from priority

2. Applicant forgot to designate states in International application filing on 1/03. Then he faxed the designation on the last day:

Answer: Applicant cannot get the filing date because he cannot use a fax to get a designation for the filing date since it is filed before 1/04.

3. A third party submission with everything in compliance except:

Answer: Prior to filing a submission under 37 CFR 1.99, the patents or publications being submitted must be served upon the applicant pursuant to 37 CFR 1.248.

4. Where equivalence prior art can be used for obviousness:

Answer: equivalence from applicant's own disclose cannot be used. MPEP 2144.06

5. In an appeal, board affirm the rejection, what happens to the objected claims based on their dependency on the rejected independent claims, which otherwise is allowable:

Answer: MPEP 1214 - NO CLAIMS STAND ALLOWED

6. If claims 1-2 are pending, and the Board affirms a rejection of claim 1 and claim 2 was objected to prior to appeal as being allowable except for its dependency from claim 1, the examiner should hold the application as:

Answer: abandoned.

7. If the Board or court affirms a rejection against an independent claim and reverses all rejections against a claim dependent thereon, after expiration of the period for further appeal, the examiner should proceed in one of two ways:

Answer: Convert the dependent claim into independent form by examiner's amendment, cancel all claims in which the rejection was affirmed, and issue the application; or Set a 1-month time limit in which appellant may rewrite the dependent claim(s) in independent form. Extensions of time under 37 CFR 1.136(a) will not be permitted. If no timely reply is received, the application is abandoned since no claims stand allowed.

8. In what situation can 102(f) rejection stand:

Answer: MPEP 2137. While derivation will bar the issuance of a patent to the deriver, a disclosure by the deriver, absent a bar under 35 U.S.C. 102(b), will not bar the issuance of a patent to the party from which the subject matter was derived. Where there is a published article identifying the authorship or a patent identifying the inventorship that discloses subject matter being claimed in an application undergoing examination, the designation of authorship or inventorship does not raise a presumption of inventorship with respect to the subject matter disclosed in the article or with respect to the subject matter disclosed but not claimed in the patent so as to justify a rejection under 35 U.S.C. 102(f).

**Post Date: May 2<sup>nd</sup>, 2011**

Hi All,

New questions found on this exam:

1. Where on an application can you claim foreign priority:

Answer: any of the specification first sentence, ADS or oath/declaration

2. The rapidity of producing a product can be used to what:

Answer: it can be used to determine the skill level of people of ordinary skill in the art

3. On what basis can obviousness be used to reject a drug dispenser and a touch screen:

Answer: KSR Reaffirms the Graham Analysis for Obviousness

4. Use of an electric signature by applicant, is this allowed:

Answer: Inserting an electronic signature is an act that affirms/certifies that such act of insertion was performed by the person whose signature is represented. MPEP 501, 37 CFR 1.4 (d)(2) S-signature.

5. Assignment document, choose that the Office does not require:

Answer: original assignment or true copy – is not required

6. In which situation can the choice below not stand alone as a prima facie rejection rebuttal :

Answer: when prior art teachings are not all in agreement.

7. If ADS has all the information, the actual application does not need to include any of the information shown on ADS, except citizenship:

Answer: false.

8. Question about name and residence of the inventors on an executed oath, one is wrong, how to correct:

Answer: Under 37 CFR 1.48(a) requires that an amendment accompanied: (1) a request to correct the inventorship that sets forth the desired inventorship change; (2) a statement from each person being added and from each person being deleted as an inventor that the error occurred without deceptive intention on his or her part; (3) an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47; (4) the fee set forth in 37 CFR 1.17 (i); and (5) the written consent of any existing assignee, if any of the originally named inventors has executed an assignment.

9. Several situations presented where CFR 1.131 affidavit can and cannot be used:

Answer: 102(g) cannot be overcome by CFR 1.131.

10. Fax the reply from Germany, which is several hour ahead of USPTO to meet the deadline:

Answer: this is allowed.

**Post Date: April 26<sup>th</sup>, 2011**

Hi All,

We found 11 new questions in total on the latest patent bar exam - 2 on KSR, Bilski, and the new 112 guidelines, and 3 on Chapter 700, 4 on Chapter 1800, 2 on Chapter 2100.

**April 26<sup>th</sup> Question Break Down by Chapter**

Chapter	Number of Questions
100 Secrecy, Access, National Security, and Foreign Filing	2
200 Types, Cross-Noting, and Status of Application	1
300 Ownership and Assignment	1
400 Representative of Inventor or Owner	3
500 Receipt and Handling of Mail and Papers	1
600 Parts, Form, and Content of Application	1
700 Examination of Applications	19
800 Restriction in Applications Filed Under 35 U.S.C. 111; Double Patenting	1
900 Prior Art, Classification, Search	1
1000 Matters Decided by Various Patent and Trademark Office Officials	0
1100 Statutory Invention Registration (SIR) and Pre-Grant Publication (PG Pub)	1
1200 Appeal	14
1300 Allowance and Issue	2
1400 Correction of Patents	14
1500 Design Patents	1
1600 Plant Patents	0
1700 Miscellaneous	0
1800 Patent Cooperation Treaty	19
1900 Protest	1
2000 Duty of Disclosure	1
2100 Patentability	13
2200 Citation of Prior Art and Reexamination of Patents	5
2300 Interference Proceedings	1
2400 Biotechnology	0
2500 Maintenance Fees	1
2600 Optional Inter Partes Reexamination	1
2700 Patent Terms and Extensions	1
KSR, Bilski, and the new 112 guidelines	5

### **New Questions**

1. If the application is ready for its first Office Action but it is then discovered to be impractical to give a complete action on the merits because of an informal or insufficient disclosure, which of the following procedures may be followed:

A) A reasonable search should be made of the invention so far as it can be understood from the disclosure, objects of invention, claims and any apparently pertinent art cited. In the rare case in which the disclosure is so incomprehensible as to preclude a reasonable search, the Office action will inform applicant that no search was made.

B) Informalities noted by the Office of Initial Patent Examination (OIPE) and deficiencies in the drawing should be pointed out by means of attachments to the Office action;

C) A requirement should be made that the specification be revised to conform to idiomatic English and US patent practice.

D) The claims should be rejected as failing to define the invention in the manner required by 35 USC § 112 if they are informal. A blanket rejection is usually sufficient.

E) All of the above.

Answer: E. See MPEP 702

2. A person shall be entitled to a patent unless:

Answer: the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent (see 706).

3. A continuation application is filed for an earlier filed US application. What is the effective filing date?

Answer: the effective filing date is the same as the earliest filing date of the continuation application (see 706).

4. Question on International application amendments.

Answer: MPEP 1853 - The applicant has one opportunity to amend the claims only of the international application after issuance of the Search Report.

5. Question on the signature requirement for an international application.

Answer: MPEP 1820 - An international application must be signed by the applicant(s) or each of their assigns.

6. Question regarding a license request for foreign filing.

Answer: MPEP 1832 - A license for foreign filing is not required to file an international application in the US Receiving Office.

7. A question concerning the difference between the national stage and a domestic application.

Answer: MPEP 1893, a national stage application is submitted later (normally 30 months from the claimed priority date, compared to 12 months for a domestic application claiming priority)

8. A question involving inventorship in a patent application.

Answer: MPEP 2137, as long as the inventor maintains intellectual dominion over making the invention, ideas, suggestions, and materials may be adopted from others.

9. A question regarding which of the following are required in a specification.

Answer: MPEP 2171, The claims must set forth the subject matter that applicants regard as their invention; and distinctly define the subject matter that will be protected by the patent grant.

10. A question worded "Each of the following is a correct statement about the patent law concerning obviousness, except".

Answer: the TSM test and the machine-or-transformation test were the exclusive tests for obviousness.

11. A question worded "Each of the following is a correct statement about the patent law concerning patentable subject matter, except".

Answer: the TSM test and the machine-or-transformation test were the exclusive tests for patentable subject matter.



**Post Date: April 16<sup>th</sup>, 2011**

Hi All,

We found 10 new questions in total on the latest patent bar exam - 4 on KSR, Bilski, and the new 112 guidelines, and 2 on Chapter 1200, 2 on Chapter 1400, 2 on Chapter 2100. The remainder of the questions can be found in our Question Bank, Previous Post, or in one of our 8 Full-Length exams.

**April 16<sup>th</sup> Question Break Down by Chapter**

Chapter	Number of Questions
100 Secrecy, Access, National Security, and Foreign Filing	1
200 Types, Cross-Noting, and Status of Application	1
300 Ownership and Assignment	2
400 Representative of Inventor or Owner	2
500 Receipt and Handling of Mail and Papers	0
600 Parts, Form, and Content of Application	2
700 Examination of Applications	11
800 Restriction in Applications Filed Under 35 U.S.C. 111; Double Patenting	2
900 Prior Art, Classification, Search	2
1000 Matters Decided by Various Patent and Trademark Office Officials	0
1100 Statutory Invention Registration (SIR) and Pre-Grant Publication (PG Pub)	0
1200 Appeal	16
1300 Allowance and Issue	0
1400 Correction of Patents	7
1500 Design Patents	0
1600 Plant Patents	0
1700 Miscellaneous	0
1800 Patent Cooperation Treaty	22
1900 Protest	0
2000 Duty of Disclosure	0
2100 Patentability	13
2200 Citation of Prior Art and Reexamination of Patents	7
2300 Interference Proceedings	2
2400 Biotechnology	0
2500 Maintenance Fees	0
2600 Optional Inter Partes Reexamination	3

2700 Patent Terms and Extensions	0
KSR, Bilski, and the new 112 guidelines	8

### New Questions

1. Q. Examiner reviews the 3 of 7 claims in a patent application and rejects it based upon two of these claims. Applicant appeals the rejection. What result?

1. A. Appeal successful based upon Present USPTO Guidance (35 USC 101 Patent Prosecution after Bilski v. Kappos): “Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to the patent-eligibility requirement of 35 U.S.C. 101. Thus, Office Personnel should state all non-cumulative reasons and bases for rejecting claims in the first Office Action.”

2. Q. Examiner rejects claim based solely upon 35 USC 101 patent-eligibility inquiry. Applicant appeals. What result?

2. A. Appeal successful based upon Present USPTO Guidance (35 USC 101 Patent Prosecution after Bilski v. Kappos): “The §101 patent-eligibility inquiry is only a threshold test. Even if an invention qualifies ... the claimed invention must also satisfy ‘the conditions and requirements of this title.’ §101 Those requirements include that the invention be novel, see §102, nonobviousness, see §103, and fully and particularly described. see §112 ... therefore, Examiners should avoid focusing on issues of patent-eligibility under §101 to the detriment of considering an application for compliance with the requirements of §102, §103, and §112, and should avoid treating an application solely on the basis of patent-eligibility under §101 except in the most extreme cases. ”

3. Q. Claim fails the machine-or-transformation test, should examiner reject application?

3. A. No. Under 35 USC 101, after Bilski v. Kappos, It should be stressed that a claim may be patent-eligible (as long as it’s not an “abstract idea”) even if it does not satisfy the M-or-T test as the Supreme Court held that: “the Federal Circuit incorrectly concluded that this Court has endorsed the machine-or-transformation test as the exclusive test.”

4. Q. A practitioner receives a 35 USC 101 rejection which only states that the claim is not patent eligible because it does not satisfy the “machine-or-transformation” test without anything further. What result?

4. A. Rejection is invalid, For subject matter rejections under 35 USC 101, MPEP 2106 indicates that it is the Examiner who bears the initial burden in furthering a prima facie showing under 35 USC 101 (see MPEP 2106 – Patent Subject Matter Eligibility).

5. Q. Which of the following is not a necessary query in product claim primary inquiries?

A) Is the claim directed to a product?

B) Is a judicial exception recited in the claim?

C) Is the claim as a whole directed to a practical application of the judicially excepted material?

D) Is the claim directed to substantially all practical applications of the exception?

E) None of the above.

5. A. The answer is E) none of the above. See INTERIM EXAMINATION INSTRUCTIONS FOR EVALUATING SUBJECT MATTER ELIGIBILITY UNDER 35 U.S.C. § 101

6. Q. Which of the following factors does not weigh towards eligibility when analyzing a claim?

A) Transformation involves only a change in position or location of article.

B) Machine implements the claimed steps

C) The article undergoes a change in state or thing (e.g., objectively different function or use).

D) The article being transformed is particular.

E) The performance of the steps is observable and verifiable.

6. A. A) Transformation involves only a change in position or location of article. See 101 Method Eligibility Quick Reference Sheet.

7. Q. Inventor X recited a “machine” in the preamble of his application without further inclusion of a tangible recitation in the main body of the claim. What result?

7. A. the recitation of a machine in the preamble alone will not satisfy the USPTO guidelines (see exemplary method claim on page 20 of the Patent Subject Matter Guidelines document).

8. Q. An application discloses patentable subject matter but the claims in their present form cannot be allowed because of defects in form. The examiner should do what?

8. A. The examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive and offer a definite suggestion for correction. See MPEP 706.

9. Q. A written declaration of abandonment of the application is signed only by an attorney or agent of record, when the application sought to be formally abandoned is the subject of an interference proceeding under 35 U.S.C. 135. What result?

9. A. It is not effective to terminate the interference. See 711.01 Express or Formal Abandonment.

10. Q. An international application is filed after April 1, 2007, but fails to contain a description or claims. What is the effective date if the application originally contained a priority claim and a proper incorporation by reference statement.

10. A. The initial receipt date. See 1810, Filing Date Requirements.

11. Q. In accordance with the patent laws, rules and procedures as related in the MPEP, an international filing date is accorded:

11. A. The earliest date on which the requirements under PCT Article 11(1) were satisfied. See 1810.

12. Q. If a secrecy order is applied to an international application, what is the result?

12. A. The application will not be forwarded to the International Bureau as long as the secrecy order remains in effect. See 1832, License Request for Foreign Filing Under the PCT.

