



New Exam Topic & Question Post

POST DATE: JANUARY 14TH, 2011

EXAM TOPICS

Below are the main MPEP topics that we have encountered on our exams since April 16th, 2011 (immediately after the April 14, 2011 exam source material changes took effect). The percentages next to each topic represent the average proportional appearance of that topic in each of our exams. The topics are listed in order of importance. "Others" represents topics that have appeared less than 2% of the time on our exams. This mix should not change significantly once the January 31st, 2012 changes take place. You are expected to master your understanding of these topics using our Lecture and MPEP Summary material.

1. PCT (8%)
2. Appeal (7%)
3. 102 rejections (6%)
4. 103 rejections (6%)
5. 35 U.S.C. 101 Eligibility (6%)
6. Reissue (6%)
7. Amendments (6%)
8. Assignment of parent application and its application to a divisional application (5%)
9. RCE (4%)
10. Reexamination (4%)
11. Restriction (4%)
12. Double patenting (4%)
13. New matter (4%)
14. Claiming small entity status (4%)
15. Inventorship (4%)
16. Interviews (3%)
17. Petition to make special (3%)
18. CIP applications (3%)
19. KSR and Bilski (3%)
20. Other (10%)

POST DATE: APRIL 16TH, 2011

NEW QUESTIONS

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: APRIL 26TH, 2011

NEW QUESTIONS

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, 1st 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 2ND, 2011

NEW QUESTIONS

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 9TH, 2011

NEW QUESTIONS

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: MAY 16TH, 2011

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: JUNE 2ND, 2011

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.

POST DATE: AUGUST 16TH, 2011

NEW QUESTIONS

1. multiple reference 35 USC 102 rejection:

(A) Examiner must only rely on a single reference to make 102 rejection

(B) Multiple references may be used by the examiner to prove that the primary reference contains an “enabled disclosure;”

(C) Examiner may use other references to expand the meaning of a term used in the primary reference;

(D) Multiple references may be used but only to show that a characteristic not disclosed in the primary reference is inherent

(E) Multiple references may be used to prove that the primary reference contains an “enabled disclosure” and to expand the meaning of a term used in the primary reference;

Answer: B

2. A design patent was filed in France in June 7, 2003, applicant wanted to file a US design patent application and claim the priority of French filing. How can the applicant make such claim?

a: file US application within 6 months

b: file US application with 12 months

c: file application within 12 months and claim the priority within 16 months

d:....

e: None of the above

Answer: e. (because 119(a)-(d) is not available to design patent. see MPEP 201.13)

3. Practitioner paid full application fee, later found that the application may assert small entity status, how can he get refund?

Answer: assert small entity status and make a refund request within 3 months from the payment of the filing fee.

4. what amendment made on or after notice of appeal but before appeal brief will be accepted

a: request an unofficial review by the examiner

b: convert dependent claim into independent claim

c: rewrite the claim to make it more persuasive without accepting examiner’s advice

d: add new matter ...

e:

Answer: c.

5. calculate the number of dependent claims for fee: Claim 1 is independent claim; Claim 2 depends on Claim 1; Claim 3 depends on Claim 2, Claim 4 depends on Claims 2 and 3; Claim 5 depends on Claim 3; Claim 6 depends on claims 2, 3 and 5

a: 5

b: 7

c: 8

d: 9

e: none of above

Answer: c

6. US provisional design patent application filed on D1, applicant filed a non-provisional design patent D2, applicant wanted to file a continuing application to claim priority of both applications,

a: filed on D3

b: filed no later than D4

c: ...

d:...

e: can't claim priority of provisional application

Answer: e (119(e) is not available to design patent)

POST DATE: OCTOBER 17TH, 2011

NEW QUESTIONS

1. A question about obviousness, where the call of the question was , which was incorrect.

Answer : where the rejection was based on KSR and neglecting TSM.

2. 102 (f) Question.

Answer: 35 U.S.C. 102(f) does not require an inquiry into the relative dates of a reference and the application, and therefore may be applicable where subsections (a) and (e) are not available for references having an effective date subsequent to the effective date of the application being examined. Beware of this question, one other choice stating something out of the MPEP but with a minor change which can be misleading.

3. Marionette obviousness question. There were 6 strings on a handle for purpose X. The examiner found prior art (a French patent) from many years ago showing the same structure but no purpose was stated. The practitioner responds by saying that there was no purpose, and hence no utility etc. Should the examiner maintain the rejection?

Answer: 4 choices said no and 1 choice said yes (the answer). Similar to many older test questions, where the prior art does not have to state the same purpose, as long as it shows the exact structure.

4. Notice of allowance/allowability – when examiner statement is not required.

Answer: when the examiner has made it clear in the file record and there is no ambiguity. Allowability MPEP 1300.

5. Restriction practice - where is the restriction practice not useful.

Answer: when the divisional patent which results from the election could have been a double patenting rejection if it was another separate application.

6. Combination and subcombinations – extremely convoluted. The call of the question was again – when is restriction not proper.

Answer: when the combination requires the subcombination. MPEP 800, section regarding AB(br)/B(sp). If both the combination and subcombination don't absolutely require each other and can be shown to have separate utility and patentability – restriction is absolutely required.

7. PCT question concerning the 30 month rule.

Answer: the key to this is to remember that if the US acted as the RO for the PCT – then only the fee is due by 30 months, there is no need to resubmit the application to meet the entry requirements to the national stage.

POST DATE: NOVEMBER 15TH, 2011

NEW QUESTIONS

1. Who can sign a disclaimer, all of the following are correct except:

- A) inventor only where inventor has not assigned
- B) inventor + assignee of part interest
- C) assignee of part interest
- D) assignee of entire interest
- E) cannot remember this one

Answer: C

2. Japanese PCT application is filed properly in the US, but in Japanese. The person filing is a resident of the US. Does the US forward it to the IB?

- a. Send it to the correct place (forward to IB)
- b. Send it back to applicant
- c. Ask for a translation
- d. Something
- e. Something

Answer: A

3. Linked claim question with claim 1 and claim 2, and claim 3, how can you overcome the rejection?

Answer: (MPEP section 809.03)

4. Who can sign a disclaimer, all of the following are correct except:

- A) inventor only where inventor has not assigned
- B) inventor + assignee of part interest
- C) assignee of part interest
- D) assignee of entire interest
- E) cannot remember this one

Answer: A

5. Which of the following is not a new application?

- a. RCE
- b. CPA
- c. Something
- d. Something

Answer: A

6. Which of the following applies with a 103(c) rejection?

Answer: E. All of the above

7. Question about interviews (contacting examiner) Except:

Answer: Attorney should call whenever he wants

8. A patent firm gets very busy and decides to send a patent outside of its firm to India. The patent firm in India does all the work and then sends it back to the American firm. In accordance with the USPTO which of following is correct?

Answer: The PTO has indicated that it may be illegal to outsource invention information to a foreign county for the purposes preparing a US patent application.

A foreign filing license from the USPTO does not authorize the exporting of subject matter abroad for the preparation of patent applications to be filed in the United States.

Applicants who are considering exporting subject matter abroad for the preparation of patent applications to be filed in the United States should contact the Bureau of Industry and Security (BIS) at the Department of Commerce for the appropriate clearances.

POST DATE: DECEMBER 15TH, 2011

NEW QUESTIONS

1.) you submit executed oath by inventors ABCD and realize B's address is wrong – Which of the following is in accord with proper procedures to correct this?

I. new oath listing entire inventive entity and signed by all

II. new oath listing entire inventive entity and signed by B only

III. where A's address is also found to be wrong, new oath listing entire inventive entity and signed by A and B only

IV. submit an ADS

V. new oath listing B and signed by B only

Answer: you can do all of them except V; see 1.67(a)(2) and (a)(3)

2.) In accordance with the USPTO rules and the procedures set forth in the MPEP, all of the following is true, EXCEPT:

Answer: A minor (under age 18) inventor may NOT execute an oath or declaration when he is competent to sign and understands the document that he is signing — see MPEP 409 (a minor can sign under these circumstances)

3.) A third party submits a publication which raises a question of patentability and initiates ex parte reexam. Which of the following is in accord with the USPTO rules and the procedures?

I. a fourth party submits another publication which raises a different question of patentability and initiates ex parte reexam

II. the same 3rd party submits another publication which raises a different question of patentability and initiates ex parte reexam

III. the 3rd party can submit response within 1 month of patent owner's statement

Answer: all are true (I and II will be merged together under ; III – third party has 2 months from service to respond un MPEP 2251)

4.) Which of the following applications cannot serve as the basis for a continuation?

Answer: provisional

5.) Which of the following does not need to be submitted for recording of assignment?

Answer: the patent/application or copy thereof – patent/application does not need to be submitted, only identified.

5.) Question to identify which is false concerning a provisional

Answer: know that you cannot file IDS with provisional

6.) Which of the following is most correct for properly claiming domestic priority?

a. 1st sentence of specification only

b. ADS only

c. ADS or Oath

d. 1st sentence of specification and ADS

e. 1st sentence of specification or ADS

Answer: E

8.) When can an IDS be considered an appropriate submission with a RCE?

Answer: after allowance MPEP 706.07(h)

9.) Question about when restriction for combination/subcombination is appropriate.

Answer: (A) the inventions as claimed do not overlap in scope, i.e., are mutually exclusive;(B) the inventions as claimed are not obvious variants; and(C) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. MPEP 806.05

10.) Examiner sends requirement for information.

Answer: a petition to withdraw the requirement is possible but it is not an appropriate response to stay the response period

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

Answer: Canceled matter in the application file of a U.S. patent may serve as prior art reference as of the filing date under 35 USC 102(a).

12.) Question about computer related subject matter.

Answer: the invention is not patentable when the sole practical application of the algorithm was in connection with the programming of a general purpose computer. MPEP 2106

13.) Question involving adding new matter to the specification. The addition is not made to Claim 1, but affects it indirectly. New matter is made into Claim 2 and directly affects. What should the examiner do?

II. object to new matter addition in spec; Have practitioner cancel the new matter, Reject claim 1 under 35 U.S.C. 112, first paragraph

III. object to new matter addition in spec; Have practitioner cancel the new matter, Reject claim 2 under 35 U.S.C. 112, first paragraph

Answer: II+III

14.) Question about when an examiner does not need to give a reason for allowance

Answer: MPEP 1302.14, when the examiner believes that the record of the prosecution as a whole does NOT make clear his or her reasons for allowing a claim or claims, the examiner may set forth such reasoning .

15.) Question asking how to determine the distinctness of claimed inventions

Answer: MPEP 806

16.) Question involving a prior assignment document recorded against an original application.

Answer: the assignment document is applied to a divisional or continuation, but not applied to substitute or CIP (MPEP 306)

17.) French App April 28th 2002 turns to French patent April 29th 2003 then US app in april 30th 2003. Which 102 rejection may examiner use to reject prior art?

Answer: 102d

POST DATE: JANUARY 16TH, 2012

NEW QUESTIONS

1.) Question about accelerated examination with respect to a soil improving composition. It asked what you need, ADS, petition/fee.

Answer: MPEP 708.02(a)

2.) there was a question where a composition was 102b rejected because the same composition was claimed in the prior art, the patent was recommending it for a different use (hair growth).

Answer: the different utility does not matter because it would have been inherent in the original composition.

3.) In accordance with the USPTO rules and the procedures set forth in the MPEP, all of the following is true, EXCEPT:

Answer: A minor (under age 18) inventor may NOT execute an oath or declaration when he is competent to sign and understands the document that he is signing — see MPEP 409 (a minor can sign under these circumstances)

4.) A third party submits a publication which raises a question of patentability and initiates ex parte reexam. Which of the following is in accord with the USPTO rules and the procedures?

I. a fourth party submits another publication which raises a different question of patentability and initiates ex parte reexam

II. the same 3rd party submits another publication which raises a different question of patentability and initiates ex parte reexam

III. the 3rd party can submit response within 1 month of patent owner's statement

Answer: all are true (I and II will be merged together under ; III – third party has 2 months from service to respond under MPEP 2251)

6.) Which of the following applications cannot serve as the basis for a continuation?

Answer: provisional

7.) which of the following does not need to be submitted for recording of assignment?

Answer: the patent/application or copy thereof, a patent/application does not need to be submitted (only identified).

8.) A patent had a covered range of 5-10% A and 90-95% B. The question asked how a reference of 4.9%A and 95.1%B should be handled.

Answer: an obviousness rejection because it's just outside the range.

9.) You file a reply within 2 months, advisory action WITHIN 3 months, when is extension of time calculated from?

Answer: The end of the Shortened Statutory Period, Not the advisory action mail date because it was sent within 3 months.

10.) 2 appeal questions related to a boards rejection.

Answer: Just remember that dependent claims that are objected to as dependent will die if their independent claims are rejected in appeal.

11.) Question about when an amendment can be filed in Appeal?

Answer: 3 months after appeal with no brief

12.) Question about when an IDS is appropriate with an RCE.

Answer: during an appeal.

13.) Question relating to when an examiner can submit new evidence after a brief and oral hearing, (or some combination like that).

Answer: if a pertinent court case comes to light after the combination of events, it can be submitted.

14.) Death of inventor assigned to partial assignee.

Answer: a partial assignee can continue prosecution.

15.) A question about continuation applications:

Answer: it doesn't have to be the same inventive entity, it just needs one common inventor.

16.) A question about 102(a):

Answer: "in this country" means U.S.A

17.) A third party submits a publication which raises a question of patentability and initiates ex parte reexam. Which of the following is in accord with the USPTO rules and the procedures?

I. a fourth party submits another publication which raises a different question of patentability and initiates ex parte reexam

II. the same 3rd party submits another publication which raises a different question of patentability and initiates ex parte re exam

III. the 3rd party can submit response within 1 month of patent owner's statement

Answer: answered all are true

18.) Which of the following does not need to be submitted for recording of assignment.

Answer: copy of application

19.) Question about when the examiner does not need to give reasons for allowance.

Answer: If the examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing a claim or claims, the examiner may set forth such reasoning.

20.) Question on Federal Court rejections.

Answer: Federal Court rejections are binding for office, but the office can still invalidate patents that the court finds valid because they have a different standard of review.

21.) Question on when an examiner can make restriction requests.

Answer: until final action.

22.) Question with a linking claim 3 and two distinct claims; examiner orders a restriction.

Answer: you elect either claim 1 or claim 2 and say that claim 3 will be in one or the other application, but you don't have to bother traversing the restriction requirement when there's a linking claim because if it's ultimately allowed, the restriction requirement is removed anyway

23.) Question on the 2 month rule. You reply within 2 months and the examiner sends an advisor action in less than the 3 month SSP, to what date do you measure your extension time and fees?

Answer: from the end of the SSP, since measuring it from the mailing of the advisory action would be a disadvantage in this case.

24.) Question on when trade secret information can be kept in an envelope away from the public when requested by the public in a FOIA request.

Answer: if a petition to expunge is filed before the issuance of the certificate of extension, the trade secret or confidential information will be expunged from the file and returned to the patent term extension applicant.

25.) Question about accelerated examination; this had to do with two issues, one getting information to the examiner ahead of time, including your own search for relevant documents; second, you qualified for making special status.

Answer: in this example, the person was a soil scientist so she would get the environmental special status without fee.

26.) Question on what claim would be 101 acceptable.

Answer: the most structurally defined claim even though all were based on an abstract/mathematical concepts.

27.) Question on PCT 102(e). The Japanese app was filed in the USPTO, designated US, and later published in English, so IA filing date was the 102(e) date

28.) Obviousness rejection when the prior art range does not overlap but close to the claimed range (34.9% and 35%)

29.) Question where a nucleotide was claimed in an application and the exact same nucleotide was claimed in a patent or published application but the proteins expressed in either case were claimed to have different properties; my answer was that this amounted to a different use for the same invention, so it didn't matter, still anticipated

30.) Question on regarding if a minor can sign an oath.

Answer: they can sign oaths and file for patents as long as they know what they're doing and are capable.

31.) Question on recording fees.

Answer: you do not get a small entity status reduction for recording fee.

32.) Question on when a Facsimile transmission not allowed.

Answer: for filing designation of contracting states in an IA

33.) Question on when a supplemental oath is treated as amendment.

Answer: when filed in a REISSUE application after the Notice of Allowance.

34.) Question on canceled matter.

Answer: public gets access to it after the patent is issued.

