Test Number 456
Test Series 199

NAME_____

U. S. DEPARTMENT OF COMMERCE
UNITED STATES PATENT AND TRADEMARK OFFICE
REGISTRATION EXAMINATION
FOR PATENT ATTORNEYS AND AGENTS

APRIL 21, 1999

Afternoon Session (50 Points) **Time: 3 Hours**

DIRECTIONS

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

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

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

Answer questions 1 and 2 based on the following facts:

Registered patent attorneys, Will, Able and Fleet, are partners in their own California law firm specializing in patent law. As luck would have it, a PTO filing deadline falls due for each partner on Friday, February 12, 1999. Having to forego their weekly Friday afternoon discussion of the MPEP, all three partners are scrambling to finish their papers. Will is drafting a Continued Prosecution Application (CPA) under 37 CFR § 1.53(d) which must be filed by Friday, February 12, 1999. Having just received the client's instructions that morning, Able is replying to a Final Office action dated August 12, 1998, which set a three month shortened statutory period for reply. Fleet, working hard to satisfy a forgetful, new client, is putting the finishing touches on a nonprovisional patent application based on a provisional application his new client had filed on February 12, 1998. Finishing their work at 8:30 p.m. Pacific time, all three partners head to the mailroom. There is only one facsimile machine. With their deadline fast approaching, Will and Able begin to argue about who should use the facsimile machine first to send their papers to the PTO. A complete transmission of Able's amendment would take fifteen minutes. A complete transmission of Will's CPA would take ten minutes. Thankful that they had been studying their MPEP, Will and Able come to an agreement. At exactly 8:40 p.m. Pacific time, a first facsimile transmission is sent to the PTO from Will and Able's firm.

1. Which one of the following choices outlines the best course of action taken by Will and Able so that both Will and Able's documents received a Friday, February 12, 1999, filing date?

(A) Will files his CPA via facsimile at 8:40 p.m. Pacific time with all the necessary papers including a Certificate of Transmission. The CPA is received in the PTO exactly ten minutes later. Able files his amendment via facsimile at 8:50 p.m. Pacific time with all the necessary papers including a Certificate of Transmission which states the date of transmission. Able's amendment is received in the PTO exactly fifteen minutes after he sent it.

(B) Able files his amendment via facsimile at 8:40 p.m. Pacific time with all the necessary papers including a Certificate of Transmission. The amendment is received in the PTO exactly fifteen minutes later. Will files his CPA via facsimile at 8:55 p.m. Pacific time with all the necessary papers including a Certificate of Transmission which states the date of transmission. Will's CPA is received in the PTO exactly ten minutes after he sent it.

(C) Will files his CPA via facsimile at 8:40 p.m. Pacific time with all the necessary papers including a Certificate of Transmission. The CPA is received in the PTO exactly ten minutes later. After a quick conference call with his client about the amendment, Able files the amendment via facsimile at 9:10 p.m. Pacific time with all the necessary papers but fails to include a Certificate of Transmission. Able's CPA is received in the PTO exactly fifteen minutes after he sent it.

(D) (A) and (B).

(E) None of the above.

2. At 8:45 p.m. Pacific time that same day, Fleet rushes to the nearest United States Post Office (USPS) down the street to send his nonprovisional patent application with all the necessary papers to the PTO. What is the best action for Fleet to take to receive a Friday, February 12, 1999, filing date?

(A) Send the application with a Certificate of Mailing via first class mail no later than 11:59 p.m. Pacific time on Friday.

(B) Deposit the application directly with an employee of the U.S. Postal Service by "Express Mail Post Office to Post Office" at 8:59 p.m. Pacific time.

(C) Deposit the application directly with an employee of the U.S. Postal Service by "Express Mail Post Office to Addressee" no later than 11:59 p.m. Pacific time.

(D) Send the application via "Federal Express" before 11:59 p.m. Pacific time.

(E) (B) and (C).

3. In addition to complying with 37 CFR § 1.4(d)(2), which of the following documents, if any, must also contain a separate verification statement?

(A) Small entity statements.

(B) An English translation of a non-English-language document.

(C) A claim for foreign priority.

(D) Petition to make an application special.

(E) None of the above.

4. In early 1997, Goforgold, a company based in Australia, developed a widget with increased reflective properties. Goforgold filed a patent application in the Australian Patent Office on January 8, 1997, and filed a corresponding application in the USPTO on January 5, 1998. All research activities for the inventions disclosed and claimed in the U.S. and Australian applications took place in Australia. The U.S. patent application contains five claims:

1. A widget comprising elements A and B.
2. A widget according to Claim 1 wherein the widget further includes element D.
3. A widget comprising elements A and C.
4. A widget according to Claim 3 wherein the widget further includes element E.
5. A widget comprising elements A, B, and C.

The Australian application only supports claims 1, 2, and 5 of the U.S. application. During the course of prosecution of the U.S. application, the examiner properly rejected all of the claims under 35 U.S.C. § 102(e) as being anticipated by a U.S. patent assigned to Gotthesilver. The Gotthesilver patent was granted on October 6, 1998, on a U.S. application filed on June 15, 1997. The Gotthesilver patent specifically describes, but does not claim, the widget in claims 1-5 of the U.S. application filed by Goforgold. The subject matter of the Gotthesilver patent was reduced to practice in Flushing, New York as of February 12, 1997. Which of the following proposed arguments or actions would properly overcome the examiner's § 102(e) rejection with respect to all the claims?

(A) File an affidavit under 37 CFR § 1.132 swearing behind the claims of the Gotthesilver patent by relying on the 1997 research activities of Goforgold in Australia.
(B) File a claim for a right of priority based on the application filed in Australia along with a certified copy of the Australian patent application and canceling Claims 3 and 4.
(C) File a claim for a right of priority based on the application filed in Australia along with a certified copy of the Australian patent application.
(D) File an affidavit under 37 CFR § 1.132 swearing behind the February 12, 1997, reduction to practice date of the Gotthesilver patent.
(E) File a terminal disclaimer.

5. In which of the following situations would a petition to make special **not** be granted?

(A) The applicant files a petition with the petition fee requesting special status and stating that small entity status has been established; that the subject of the biotechnology patent application is a major asset of the small entity; and that the development of the technology will be significantly impaired if examination of the application is delayed, including an explanation of the basis for making the statement.

(B) Applicant's invention materially enhances the quality of the environment. Applicant files a petition that the application be accorded special status and includes a statement explaining how the invention contributes to the restoration of a basic life-sustaining element. No fee is included.

(C) Applicants have filed a request that their application which is directed to an invention for a superconductive material be accorded special status. Applicants' request is accompanied by a statement that the invention involves superconductivity. No fee is included.

(D) Applicant's invention is directed to a system for detecting explosives. Applicant files a petition for special status which is accompanied by a statement explaining how the invention contributes to countering terrorism. No fee is included.

(E) None of the above.

6. Which of the following fees are reduced for small entities?

I. Patent application filing fees
II. Petition for an extension of time fees
III. Petition to suspend the rules fees
IV. Patent Issue fees
V. Certificate of Correction fees

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

The answer to each of questions 7-11 is based upon the facts set forth in the paragraph below. Answer each question independently of the others.

You are a registered patent agent with an office in Buffalo, New York. On January 13, 1998, Murphy, a resident of Canada, came to your office for purpose of obtaining a U.S. patent on her invention. She tells you that she first conceived her invention at her home in Ontario on December 18, 1996, and that she reduced it to practice on January 10, 1997, at her home. On January 13, 1998, Murphy provided you with a detailed written description fully disclosing her invention. You diligently proceeded to prepare the application. You filed the application in the PTO on February 12, 1998. Consider each of the situations presented in the questions below in light of the facts presented above and determine which paragraph of 35 U.S.C. § 102, if any, would prevent Murphy from obtaining a U.S. patent.

7. Murphy's invention is described and claimed in a U.S. patent to O'Malley granted on February 9, 1999, on a national stage application filed in the United States on February 17, 1998, based on a PCT international application filed in France on November 13, 1997. O'Malley satisfied the requirements of 35 U.S.C. § 371(c)(1), (2), and (4) on February 17, 1998.

(A) 35 U.S.C. § 102(b).
(B) 35 U.S.C. § 102(c).
(C) 35 U.S.C. § 102(e).
(D) 35 U.S.C. § 102(f).
(E) None of the above.

8. Murphy patented her invention in Canada on December 30, 1997 on a Canadian patent application filed on February 10, 1997.

(A) 35 U.S.C. § 102(a).
(B) 35 U.S.C. § 102(b).
(C) 35 U.S.C. § 102(d).
(D) 35 U.S.C. § 102(e).
(E) None of the above.

9. In January of 1997, Murphy sold prototypes of her invention in Canada.

(A) 35 U.S.C. § 102(a).
(B) 35 U.S.C. § 102(b).
(C) 35 U.S.C. § 102(f).
(D) 35 U.S.C. § 102(g).
(E) None of the above.

10. After the application was filed in the U.S., Murphy admitted that in order to make the claimed invention operative, the mechanic who built the prototype of Murphy's invention added a novel feature without consulting Murphy which is included in all the claims of the application.

(A) 35 U.S.C. § 102(a).
(B) 35 U.S.C. § 102(b).
(C) 35 U.S.C. § 102(f).
(D) 35 U.S.C. § 102(g).
(E) None of the above.

11. Murphy's invention is described and claimed in a German Gebrauchsmuster petty patent granted on February 11, 1998, based on an application filed by Murphy on February 2, 1997. The German Gebrauchsmuster patent was published on February 14, 1998.

(A) 35 U.S.C. § 102(b).
(B) 35 U.S.C. § 102(c).
(C) 35 U.S.C. § 102(d).
(D) 35 U.S.C. § 102(e).
(E) None of the above.

12. Which of the following statements, if any, regarding Secrecy Orders are **false**?

(A) A Secrecy Order remains in effect for a period of one year from its date of issuance.
(B) If the Secrecy Order is applied to an international application, the application will not be forwarded to the International Bureau as long as the Secrecy Order remains in effect.
(C) If, prior to or after the issuance of the Secrecy Order, any significant part of the subject matter or material information relevant to the application has been or is revealed to any person in a foreign country, the principals must promptly inform such person of the Secrecy Order and the penalties for improper disclosure.
(D) Use of facsimile transmissions to file correspondence in a Secrecy Order case is permitted so long as it is transmitted to the Office in a manner that would preclude disclosure to unauthorized individuals and is properly addressed.
(E) (C) and (D).

13. On January 19, 1999, inventor B filed a patent application in the PTO claiming invention X. Inventor B did not claim priority based on a foreign application filed by inventor B on April 3, 1998, in the Patent Office in Japan. In the foreign application, inventor B disclosed and claimed invention X, which inventor B had conceived on August 11, 1997, and reduced to practice on November 5, 1997, all in Japan. The U.S. patent examiner issued an Office action where all the claims in the patent application were properly rejected under 35 U.S.C. § 102(a) and (e) as being anticipated by a U.S. patent granted to inventor Z on September 1, 1998, on a patent application filed in the PTO on December 5, 1997. There is no common assignee between Z and B, and they are not obligated to assign their invention to a common assignee. Moreover, inventors Z and B, independently of each other, invented invention X, and did not derive anything from the other. The U.S. patent to Z discloses, but does not claim, invention X. Which of the following is/are appropriate reply(replies) which could overcome the rejections under §§ 102(a) and (e) when timely filed?

(A) File an antedating affidavit or declaration under 37 CFR § 1.131 showing conception on August 11, 1997, and actual reduction to practice on November 5, 1997, all in Japan.
(B) File a claim for the right and benefit of foreign priority wherein the Japanese application is correctly identified, file a certified copy of the original Japanese patent application, and argue that as a result of the benefit of foreign priority, the U.S patent is no longer available as a prior art reference against the claims.
(C) Amend the claims to require particular limitations disclosed in inventor B's application, but not disclosed or suggested in inventor Z's patent, and argue that the limitations patentably distinguish the claimed invention over the prior art.
(D) (A) and (C).
(E) (B) and (C).

14. A Certificate of Correction **cannot** be used to correct:

(A) the failure to make reference to a prior copending application.
(B) an incorrect reference to a prior copending application.
(C) the omission of an inventor's name from an issued patent through error and without deceptive intent.
(D) the omission of a preferred embodiment in the original disclosure overlooked by the inventor which would materially affect the scope of the patent.
(E) (A), (B), and (D).

15. In responding to a final rejection of Claims 1 to 5 as being obvious, applicant's patent agent argued that the references applied in the rejection neither taught nor suggested the claimed invention. The examiner issued a Notice of Allowance which included a statement of reasons for allowance. In the statement, the examiner explained her reasons for allowance of the claims. Upon receipt of the statement from the examiner, which of the following, if any, describes the most appropriate course of action the agent may take in reply to the examiner's reasons for allowance?

(A) The agent may file a reply commenting on the examiner's statement, even though the failure to do so will not give rise to any implication that applicant agrees with or acquiesces in the examiner's reasoning.
(B) The agent should object to the examiner's statement to avoid any implication that applicant agrees with or acquiesces in the examiner's reasoning.
(C) Applicant may file comments on the reasons for allowance after payment of the issue fee upon submission of a petition for an extension of time.
(D) Under current Office policy and procedure, the agent cannot reply to the examiner's statement.
(E) The agent must file a timely reply to the examiner's statement to enable the examiner to reply to the comments submitted by applicant and to minimize processing delays.

16. Which of the following statements regarding plant patent applications is (are) **true**?

(A) Only one claim is necessary and only one claim is permitted.
(B) The oath or declaration required of the applicant, in addition to the averments required by 37 CFR § 1.63, must state that he or she has asexually reproduced the plant.
(C) A method claim in a plant patent application is improper.
(D) Specimens of the plant variety, its flower or fruit, should not be submitted unless specifically called for by the examiner.
(E) All of the above.

17. The last day of a three month shortened statutory period to reply to a non-final rejection occurs today, April 21, 1999. Your client is overseas and sends you a facsimile asking you to cancel all of the current claims in the application. There is no deposit account. She further advises you that a new set of claims to replace the current claims will be sent to you no later than April 29, 1999. Which of the following would be the most appropriate course of action to take with regard to the outstanding Office action?

(A) File a request for a one month extension of time today and pay the fee when you file the amendment.
(B) File an amendment today canceling all claims in accordance with your client's instructions.
(C) Await receipt of the new claims and then file the amendment and request for reconsideration with the appropriate fee for an extension of time, no more than 6 months from the date of the non-final rejection.
(D) File a request for reconsideration today and state that a supplemental amendment will be forthcoming.
(E) File a request for reconsideration today, stating that the rejection is in error because the claims define a patentable invention.

18. Which of the following statements is **true** respecting product-by-process claims?

(A) A lesser burden of proof may be required to make out a case of prima facie obviousness for product-by-process claims than is required to make out a prima facie case of obviousness when a product is claimed in the conventional fashion.
(B) It is proper to use product-by-process claims only when the process is patentable.
(C) It is proper to use product-by-process claims only when the product is incapable of description in the conventional fashion.
(D) Product-by-process claims cannot vary in scope from each other.
(E) Product-by-process claims may only be used in chemical cases.

19. Patent applicant Smith claims "a rotary vane pump having impellers coated with ceramic X for the purpose of preventing cavitation of the impellers." The examiner rejected the claim under 35 U.S.C. § 103 as being unpatentable over a patent to John in view of a patent to Alex. John teaches a rotary vane pump having impellers coated with epoxy resin for the purpose of preventing corrosion of the impellers. Alex teaches a mixing device having agitator blades coated with ceramic X for the purpose of preventing corrosion of the blades. Alex also suggests that the ceramic X coating material "is useful on various types of pumps for the purpose of preventing corrosion." The examiner determined that (i) it would have been obvious to one having ordinary skill in the art to substitute the ceramic X coating material taught by Alex for the epoxy resin coating material in John and (ii) the resultant rotary vane pump would have coated impeller blades which would inherently prevent cavitation. The combination of John and Alex:

(A) cannot support a *prima facie* case for obviousness unless the Alex reference contains a suggestion that ceramic X will cause cavitation.
(B) cannot support a *prima facie* case for obviousness inasmuch as the discovery that ceramic X prevents cavitation imparts patentability to a known composition.
(C) may support a *prima facie* case for obviousness even though the Alex reference does not disclose that ceramic X will prevent cavitation or can be used on the impellers of a rotary vane pump.
(D) cannot shift the burden of proof to the applicant to show that the prior invention lacked the newly discovered property asserted for the claimed invention unless one of the references discloses the property.
(E) can support a *prima facie* case for obviousness only if both references show or suggest that ceramic X can be used in a rotary vane pump.

20. Claim 1 is independent. Claim 2 depends from Claim 1. Claim 3 depends from Claim 2. Claim 4 depends from Claims 2 or 3. Claim 5 depends from Claim 3. Claim 6 depends from Claims 2, 3 or 5. The application contains one independent claim. How many dependent claims are there for fee calculation purposes?

(A) 5
(B) 7
(C) 8
(D) 9
(E) 11

Answer questions 21 and 22 based on the following facts:

Registered patent practitioner P prepares and files a patent application for his Japanese client, XYZ Corp., on October 5, 1998. The application claims a banana peeler device. A Notice to File Missing Parts dated December 7, 1998, is received by P on December 10, 1998. P submits an executed oath, along with the surcharge, in order to fully reply to the Notice to File Missing Parts which is received by the PTO on December 23, 1998. In the first Office action dated January 6, 1999, the examiner rejects all of claims 1-5 as being anticipated by the disclosure of a U.S. patent to Apple. The Apple patent discloses, but does not claim, a banana peeler. The Apple patent issued October 7, 1997, and is based on an application filed on June 26, 1996. On January 20, 1999, P faxes a copy of the Office action and the Apple patent to his client in Japan. There is no common ownership between the prior art patent and XYZ's patent application. On March 20, 1999, XYZ faxed instructions to P which distinguish the claims from the Apple patent and includes a reference to a U.S. patent to Zucchini. XYZ discovered the Zucchini patent in February 1999. The Zucchini patent issued on January 12, 1993, and contradicts the teachings of the Apple patent.

21. On March 20, 1999, XYZ instructs P to file an Information Disclosure Statement (IDS) which includes the Zucchini patent, ten Japanese patents, and a November 13, 1998, magazine article. The magazine article and the ten patents were received from the Japanese Patent Office in XYZ's counterpart foreign application on February 1, 1999. Which of the following actions, if any, taken by P would best comply with PTO practice and procedure?

(A) File a properly drafted IDS via "Express Mail" in accord with 37 CFR § 1.10 on March 30, 1999, with the fee set forth in 37 CFR § 1.17(p).

(B) File a properly drafted IDS via first class mail with a Certificate of Mailing dated March 30, 1999, with the required fee and a statement that each item of information was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the IDS.

(C) File a properly drafted IDS via facsimile with a Certificate of Transmission on March 23, 1999, along with a legible copy of each reference.

(D) (B) and (C).

(E) None of the above.

22. Which of the following most correctly sets forth the sections of Title 35 U.S.C. under which XYZ **would not be entitled** to a U.S. patent based on the Apple patent?

(A) 102(a)
(B) 102(c)
(C) 102(d)
(D) 102(f)
(E) 102(g)

23. In a first action on the merits dated February 12, 1997, the examiner (1) rejected all of the claims under 35 U.S.C. § 112, second paragraph; (2) objected to new matter added to the specification by a preliminary amendment; and (3) required a substitute specification that includes a revised summary of invention, abstract, and an additional drawing showing the prior art. You, as a patent practitioner prosecuting the application, disagree with the propriety of the rejection, objection and requirement. Which of the following would be the most appropriate course of action to take to reply to the examiner's action?

(A) File a petition with the Group Director requesting withdrawal of the examiner's objection to the specification, and suspension of further action on the claims until three months after the petition has been decided.
(B) File a request for reconsideration and present arguments distinctly and specifically pointing out the supposed errors in the examiner's requirement, rejection, and objection, and otherwise fully reply to the rejection and objection.
(C) Appeal the objection and requirement of the examiner to the Board of Patent Appeals and Interferences, and request that the final rejection of the claims be suspended until the appeal is decided.
(D) Amend the claims to overcome the examiner's rejection under 35 U.S.C § 112, and file a motion to the Board of Patent Appeals and Interferences appealing the examiner's objection to the specification.
(E) Change the summary of invention to conform to the broadest claim, request reconsideration of the requirement for a substitute specification, request that the requirement for submission of the additional drawings be held in abeyance until after allowance of the application, and generally allege that the claims define a patentable invention.

24. Which of the following statements correctly sets forth the manner in which Inventor Ann, a U.S. citizen, may file documents regarding her international patent application with the United States Receiving Office?

(A) Where the document is the PCT international application and Ann needs to receive an April 1, 1999, filing date, Ann should file her PCT international application via first class mail with the United States Post Office and include a Certificate of Mailing dated April 1, 1999.
(B) Where the document is a Demand for international preliminary examination, two weeks before the deadline, Ann should file her Demand by facsimile transmission with a dated Certificate of Transmission.
(C) Where the document is the PCT international application and Ann needs to receive an April 12, 1999, filing date, Ann should file a copy of her international application via facsimile transmission with a Certificate of Transmission dated April 12, 1999.
(D) Where the documents are substituted drawing sheets due on April 15, 1999, Ann should file her substitute drawing sheets via facsimile on April 15, 1999.
(E) All of the above.

25. A multiple dependent claim _____

(A) may indirectly serve as a basis for another multiple dependent claim.
(B) may directly serve as a basis for a multiple dependent claim.
(C) shall be construed to incorporate by reference all the limitations of each of the particular claims to which it refers.
(D) added by amendment should not be entered until the proper fee has been received by the PTO.
(E) (C) and (D).

26. A design patent application was filed on July 5, 1995, which issued as a design patent on December 3, 1996. On December 16, 1996, a proper reissue design application was filed. The reissue patent was granted on September 2, 1997. When will the first maintenance fee be due?

(A) December 2, 2000
(B) December 16, 1999
(C) December 3, 1999
(D) March 3, 2000
(E) None of the above

27. After one of your client's claims has been allowed, another claim in the same application stands objected to as being a substantial duplicate of the allowed claim, i.e. they both cover the same thing. You and your client agree that the claim is a substantial duplicate. Which of the following could **NOT** overcome the objection?

(A) Amending the claim objected to in a manner consistent with the specification to have a different scope.
(B) Amending the allowed claim consistent with the specification to have a different scope.
(C) Canceling the allowed claim to obviate the objection.
(D) Filing a divisional application that includes the objected claim.
(E) Canceling the claim objected to so as to permit issuance of the allowed claim.

28. Which of the following statements regarding reissue applications is **false**?

(A) If the file record is silent as to the existence of an assignee, it will be presumed that an assignee does exist.
(B) An examination on the merits of a reissue application will not be made without an offer to surrender the original patent, the actual surrender, or an affidavit or declaration to the effect that the original is lost or inaccessible.
(C) A broadened claim can be presented after two years from the grant in a broadening reissue which was filed within two years from the grant.
(D) The filing of a continued prosecution application (CPA) under 37 CFR § 1.53(d) of a reissue application will not be announced in the *Official Gazette*.
(E) When making amendments to the claims, patent claims must not be renumbered and the numbering of any claims added to the patent must follow the number of the highest numbered patent claim.

29. Employees Larry and Curly work for Taylor, Inc., each with knowledge of the other's work, and with obligations to assign to Taylor inventions conceived while employed by Taylor. Larry invented a novel coating apparatus which utilized a spring released mechanism that worked well at temperatures of at least 32° F. Larry discussed his invention with Curly during work at Taylor. After their discussion, Curly conceived of an improvement and developed a piston activated mechanism for use in Larry's novel coating apparatus. Curly's piston activated mechanism worked extremely well at temperatures between 45 to 60° F. On April 8, 1997, Curly filed a patent application in the PTO disclosing the fact that Larry invented a novel coating apparatus and claiming an improved coating apparatus with a piston activated mechanism. Curly's specification disclosed the excellent results obtained when the piston activated mechanism was used at temperatures between 45 to 60° F. On August 14, 1997, Larry's application claiming the coating apparatus with the spring released mechanism for use at temperatures of at least 32° F. was filed in the PTO. On December 29, 1998, a patent was granted to Larry. In an Office action dated March 18, 1999, the examiner rejected the claims in Curly's application under 35 U.S.C. §§ 102(g)/103 over Larry's patent in view of a patent granted to Moe on August 25, 1992. Larry's patent claims the coating apparatus with the spring released mechanism for operation at temperatures of at least 32° F. The patent to Moe discloses a piston activated mechanism (substantially similar to Curly's piston activated mechanism) in combination with a different coating apparatus. The Moe patent also discloses that the piston activated mechanism would only operate at temperatures below 32° F. The examiner properly found that substitution of the piston activated mechanism of Moe for the spring released mechanism in Larry's coating apparatus would have been obvious. As a registered practitioner hired by Taylor to prosecute both the Larry and Curly applications, which of the following best describes the course of action you should take to provide Taylor with all the patent protection it is entitled to receive?

(A) Traverse the rejection by arguing that the rejection is improper, and in support thereof, submit an affidavit under 37 CFR § 1.132 signed by an officer of Taylor, Inc. attesting to the fact that at the time the inventions were made, Larry and Curly were obligated to assign their inventions to Taylor, Inc.

(B) Traverse the rejection by arguing that the rejection is improper and provide an affidavit signed by Larry stating that Curly derived his work from Larry and that both Curly and Larry were under an obligation to assign their inventions to Taylor.

(C) Traverse the rejection and submit an affidavit signed by Curly under 37 CFR § 1.131 stating that he made his invention in the United States before Larry filed his patent application and that both Larry and Curly were obligated to assign their inventions to Taylor, Inc. at the time the inventions were made.

(D) Amend the Curly application to claim only a piston activated mechanism which operates at temperatures between 45 - 60° F., and delete the coating apparatus from the claims.
(E) File a terminal disclaimer to have any patent granted on Curly's application expire on the same date the Larry patent expires.

Questions 30 and 31 are based on the following facts. Each question should be answered independently of the other.

Horatio invented a new widget for vacuum cleaners. You prepared and filed a patent application containing claims 1 through 10 directed to the widget. In a second Office action dated September 10, 1998, the examiner rejected claims 1 through 10 for the second time and on the same grounds and set a three month shortened statutory period for reply. You filed a reply to the second Office action on December 9, 1998. On January 8, 1999, the examiner sent another Office action containing a final rejection of claims 1 through 10 and set a three month shortened statutory period for reply.

30. Horatio asked you to file a Notice of Appeal. In which of the following situations, would the Notice of Appeal be considered **acceptable**?

(A) A Notice of Appeal signed by you, and the appropriate appeal fee are filed on April 8, 1999. The Notice does not identify the rejected claims appealed.
(B) A unsigned Notice of Appeal and the appropriate appeal fee is filed on April 8, 1999, and the Notice identifies the rejected claims appealed.
(C) A Notice of Appeal, signed by you, with the necessary fee for appeal and extension of time, are filed on July 8, 1999, without identifying the rejected claims appealed.
(D) (A) and (B).
(E) (A), (B), and (C).

31. An acceptable Notice of Appeal is timely filed in the PTO on March 23, 1999. Absent extraordinary circumstances, which of the following is the **last day** that an appeal brief can be filed if a proper petition and the necessary fees for the brief and extension of time are filed with the brief?

(A) April 8, 1999
(B) Monday, October 25, 1999
(C) August 23, 1999
(D) Monday, May 24, 1999
(E) September 23, 1999

32. On a sunny January day in Minnesota, neighbors X and Y working together stumble across a novel means for melting snow with a device that X and Y have jointly invented. Being low on funds to market their invention, X and Y decide to save money and file their own patent application. X and Y decide to file a provisional patent application in order to have more time to market their invention. X and Y carefully prepare all the necessary papers for the filing of their provisional patent application and come up with the money to cover the filing fee. On Saturday, January 9, 1999, X and Y meet at their favorite coffee shop to take a final look at the specification and drawings they had prepared and to prepare a cover letter to accompany their application. In their eagerness to get to the Post Office after drinking two double mocha cappuccinos, the handwritten cover letter prepared by X and Y fails to identify X as an inventor. The cover letter only identifies the application as a provisional patent application; inventor Y's full name, residence and correspondence address; and the title of the invention. Unaware that X has not been identified as an inventor, X and Y make a copy of their application papers and mail the cover letter with the specification, drawings and the proper fee to the Patent and Trademark Office via first class mail that same morning. A huge winter storm is expected to hit Minnesota by dusk and X and Y hurry home to conduct further experiments with their snow melting invention. The papers are received in the Patent and Trademark Office on Monday, January 11, 1999.

Three weeks later, X and Y return to their favorite coffee shop to celebrate the outstanding success of their experiments with their snow melting device during the huge winter storm which hit Minnesota and to discuss the minor adjustment they made to their invention. In reviewing their application papers for the first time since they were mailed, X notices that the handwritten cover letter does not identify him as an inventor, and fails to include his residence and correspondence address. Which of the following is the best action to be taken by X and Y to correct these omissions from their handwritten cover letter in accordance with proper PTO practice and procedure?

(A) X and Y should timely file an amendment to the provisional patent application to add X as an inventor, accompanied by a petition stating that the error occurred without deceptive intent on the part of X and the appropriate fee.

(B) X and Y should file an amendment to their provisional patent application which describes the minor adjustment made to the snow melting device and sign the amendment naming X and Y as joint inventors.

(C) X and Y should file a request for a certificate of correction and with an explanation of how the error occurred without deceptive intent.

(D) X and Y should file a continuation application with a new declaration signed by X and Y.

(E) X and Y should timely file a new cover sheet during the pendency of their provisional application which identifies both X and Y as inventors, and provides the title of the

invention, as well as the residences of X and Y and the correspondence address.

33. The claim, "An alloy consisting of 70.5 to 77.5% iron, 15.0 to 17.0% cobalt, 0.5 to 1.0% carbon, up to 2.5% chromium, and at least 7.0% tungsten" is anticipated by a reference disclosing an alloy having:

(A) 76.0% iron, up to 15.0% cobalt, 0.5% carbon, and 8.5% tungsten.
(B) 71% iron, 15% cobalt, 1.0% carbon, 1% chromium, 8% tungsten, and 4% nickel.
(C) 71.3% iron, 15.2% cobalt, 0.9% carbon, 2.6% chromium, and 10% tungsten.
(D) 76% iron, 15% cobalt, 1.0% carbon, at least 2.0% chromium, and 6% tungsten.
(E) 72.0% iron, 16.5% cobalt, at least 2.0% carbon, 2.5% chromium, and up to 7.0% tungsten.

34. On January 6, 1999, Doe asked patent agent Bronson to prepare and file a patent application on an automobile jack which Doe had invented. Doe gave Bronson several sketches and a written description of the jack which described and showed the jack as utilizing only a scissors-type lifting mechanism. Bronson prepared a patent application disclosing the scissors-type lifting mechanism based on information provided by Doe. The claims of the patent application recited the lifting mechanism generically as "lifting means" since the specific type of lifting mechanism was not thought by Doe to be critical to the inventive feature of his jack. After Doe reviewed and signed the application, Bronson filed it in the PTO on February 3, 1999. On March 19, 1999, Doe discovered that his jack worked much better with a screw-type lifting mechanism as opposed to the scissors-type mechanism. The screw-type lifting mechanism is not disclosed in the application. Doe immediately informed Bronson of this fact. In reply to the first Office action, Bronson canceled all of the original claims and presented a new claim to the jack which included the provision of the screw-type lifting mechanism. Is the new claim proper at this stage of the prosecution?

(A) Yes, because the claim particularly points out and distinctly claims the subject matter which Doe regards as his invention or discovery.
(B) No, because the claim could be properly rejected under 35 U.S.C. § 112, first paragraph.
(C) Yes, because the claim sets forth the best mode contemplated by Doe for carrying out his invention.
(D) No, because the claim could be properly rejected under 35 U.S.C. § 132.
(E) No, because the claim could be properly rejected under 35 U.S.C. § 112, sixth paragraph.

35. On January 7, 1998, you filed a U.S. patent application containing Claims 1 through 8 on behalf of your client, Grumpy. In a first Office action, the examiner rejected Claims 1-8 under 35 U.S.C § 103 over a U.S. patent to Happy in view of a U.S. patent to Sleepy. The Happy patent issued on January 6, 1998, based on an application filed on June 11, 1996. The Sleepy patent issued in 1950. Which of the following responses would be the most persuasive in having the rejections withdrawn?

(A) Argue that the claimed invention is patentably distinguishable over the combination of the Happy and Sleepy patents, pointing out the specific language in the claims that is not shown by the combination of the references.
(B) Argue that the Sleepy patent is outdated and that its teachings are so obsolete that it would no longer be read by one of ordinary skill in the art.
(C) Argue that the claimed invention is patentably distinguishable from Sleepy, and point out the specific language in the claims that is not shown by Sleepy.
(D) Argue that the devices disclosed by Sleepy and Happy are not physically combinable.
(E) Argue that the Happy patent is not prior art because it was not granted more than one year before Grumpy filed his patent application.

36. The specification shall conclude with one or more claims and must set forth:

(A) the manner of making the invention, the theory of why the invention works, and at least one working example showing how the invention works.
(B) the manner and process of making and using the invention, a written description of the invention, and the best mode of carrying out the invention.
(C) a description of the invention, how the invention is distinguishable over the most relevant prior art, and the best mode of carrying out the invention.
(D) only a full, clear, and concise description of the invention.
(E) a complete description of the invention, and how to use the invention so that a person having ordinary skill in the art to which the invention pertains would be able to practice the invention.

37. Which of the following statements, if any, is true?

(A) A claim for a "soap composition comprising a maximum of 0.2 parts by weight of X per part by weight of Y" is anticipated by a soap composition disclosed in a publication as having 5 parts by weight of X per part weight of Y.

(B) A claim for "a laminate circuit material comprising a sheet of adhesive film, and a sheet of conductive material disposed on said sheet of adhesive film" is **not** anticipated by an article of manufacture consisting of an adhesive film disposed on one surface of a sheet of conductive material and a glass reinforced adhesive film disposed on the opposite surface of said sheet of conductive material."

(C) An independent Claim 1 for an "article comprising a widget having a coating from 0.05 to 1 mm thickness," and a dependent Claim 2 for "an article according to Claim 1 wherein the coating is 0.3 mm thick," both are anticipated by "a widget having a coating of 0.5 mm thickness" described in a printed publication.

(D) A claim for a "nickel alloy comprising nickel, chromium, iron and at least one member selected from the group consisting of copper, silver and tin" is anticipated by a printed publication which discloses "an alloy consisting of nickel, silver, chromium, iron, copper, and cobalt."

(E) None of the above.

38. On Monday, April 5, 1999, an Office action was mailed to practitioner P. The Office action contained a rejection of all claims in the application and set a three month shortened statutory period for reply. The very last day for filing a reply without requesting an extension of time would be _____.

(A) July 2, 1999
(B) July 3, 1999
(C) July 5, 1999
(D) July 6, 1999
(E) August 3, 1999

39. Jones invented a widget. She disclosed to her patent agent that the widget can be any combination of colors, the most preferred embodiment being a widget having a blue, orange, yellow or purple color. The agent prepared a patent application which disclosed a widget having a blue, orange or purple color and which included the following claim: "1. A widget having a blue, orange or purple color." On January 8, 1999, Jones reviewed the application and signed the oath. Just after Jones left the agent's office, the agent remembered that Jones had also disclosed to him a yellow widget. The attorney immediately prepared a preliminary amendment which included instructions to amend the specification to also include a yellow widget and to rewrite Claim 1 as follows: "A widget having a blue, orange, yellow or purple color." The specification, oath, and the amendment were mailed to the PTO in the same envelope and were received in the PTO on January 12, 1999. Given these facts, which one of the following statements is true?

(A) Claim 1 cannot be properly rejected under 35 U.S.C. § 102(a) as being anticipated by a patent to Smith which was filed on March 2, 1997, and issued on August 13, 1998, and which discloses but does not claim, a widget having an orange color.
(B) Claim 1 can be considered to contain new matter even though the preliminary amendment was filed concurrently with the filing of the specification.
(C) Claim 1 can be properly rejected under 35 U.S.C. § 112, second paragraph, because the use of the word "or" renders the metes and bounds of the claim indeterminate.
(D) Claim 1 can be properly rejected on the ground of disclaimer.
(E) None of the above statements is true.

40. In order to calculate when an appeal brief must be filed, which of the following documents should be used to establish the date that a Notice of Appeal was filed?

(A) A separate letter sent from the Patent and Trademark Office which acknowledges receipt of your Notice of Appeal.
(B) A self-addressed postcard included with the filing of your Notice of Appeal which was date stamped and returned to you.
(C) A copy of the Certificate of Mailing you signed which states the date you deposited the Notice of Appeal via first class mail.
(D) (A), (B), and (C).
(E) (B) and (C).

41. Which of the following choices would be considered as independent grounds for filing a reissue application?

(I) The claims are too narrow or too broad.
(II) The disclosure contains inaccuracies.
(III) Applicant failed to or incorrectly claimed foreign priority.
(IV) The specification contains a plurality of obvious spelling and grammatical errors.
(V) Applicant failed to make reference to or incorrectly made reference to prior copending applications.

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

42. On April 19, 1999, Inventor Mary hires you for advice on a patent application. Mary informs you that she previously filed a provisional application for her invention on May 1, 1998. However, Mary has since made some improvements that were not described in her provisional application. To fully protect Mary's patent rights, what is the best course of action to recommend to Mary?

(A) File an amendment in the provisional application on or before May 1, 1999, which describes the improvements made by Mary.
(B) Immediately file a continued prosecution application based on the provisional application filed on May 1, 1998, and include a preliminary amendment which adds a description of the improvements made.
(C) File a second provisional patent application which claims the benefit of the May 1, 1998, filing date of the first provisional patent application.
(D) File a continuation-in-part application as soon as possible which adds a disclosure of the improvements made.
(E) None of the above.

43. A U.S. patent application to AuGratin, a French national, was filed in the U.S. Patent and Trademark Office on August 10, 1997. The application disclosed and claimed an apparatus having a combination of elements A, B, and C. AuGratin filed a claim for priority in his U.S. application based upon an application which he filed in the French Patent Office on September 16, 1996. AuGratin's U.S. patent application as filed is an exact English translation of his French application. AuGratin's French application was issued and published as French Patent No. 1,234,567 on March 20, 1998. On April 12, 1999, AuGratin filed a continuation-in-part application (CIP) containing disclosure of new element D in the apparatus. The CIP application included new claims to an apparatus comprising a new combination of elements A, B, C, and D. The examiner properly rejected the new claims in the CIP application as being obvious over AuGratin's French Patent No. 1,234,567 in view of a U.S. patent to Baker which clearly suggests modifying AuGratin's apparatus by adding element D to the combination of elements A, B, and C. The rejection is a *prima facie* case of obviousness. Can AuGratin's French patent be removed as a reference?

(A) Yes, because AuGratin can swear behind French Patent No. 1,234,567 since the publication date of AuGratin's French patent is less than one year prior to AuGratin's August 10, 1997, U.S. filing date.
(B) Yes, because the claims in the parent application are supported in the CIP application.
(C) No, because the new claims in the CIP are not entitled to the benefit of the filing date of the parent application since the combination of elements A, B, C, and D is not supported in the parent application.
(D) Yes, because AuGratin's French patent cannot be used as prior art in view of the claim for priority in the parent application.
(E) No, because the new claims are not supported in the CIP application.

44. A Customer Number in the USPTO may be used to do which of the following?

(A) Designate the fee address of a patent.
(B) Designate the correspondence address of a patent application.
(C) Serve as the Deposit Account Number to pay an extension of time fee.
(D) Submit a list of practitioners so that an applicant may in a Power of Attorney appoint those practitioners associated with the Customer Number.
(E) (A), (B), and (D).

45. Where a flat board and parallel legs are separate elements which are intended to be included in a claim to the combination of the flat board and legs, the combination is properly set forth in which of the following claims?

(A) A table having a flat board and parallel legs secured to the flat board.
(B) A table having a flat board capable of being connected to parallel legs.
(C) A table having a flat board and means for securing parallel legs to the flat board.
(D) A table having a flat board with means whereby parallel legs can be secured to the flat board.
(E) A table having a flat board for receiving parallel legs.

46. Which of the following statements regarding design patent applications is (are) **false?**

(A) The use of trademarks in design patent application specifications is permitted under limited circumstances.
(B) It is improper to use a trademark alone or coupled with the word "type" in the title of a design patent.
(C) A design patent and a trademark may be obtained on the same subject matter.
(D) It is the policy of the Patent and Trademark Office to prohibit the inclusion of a copyright notice in a design patent application.
(E) (A) and (B).

47. Which of the following statements concerning the confidentiality of patent applications before the Patent and Trademark Office is **true**?

(A) All documents filed as part of the Disclosure Document Program are open to the public two years after filing.
(B) All reissue applications are open to the public.
(C) Copies of any document contained in the application file for which the United States acted as the International Preliminary Examining Authority will be furnished in accordance with Patent Cooperation Treaty (PCT) Rule 94.2 or 94.3 upon payment of the appropriate fee.
(D) (B) and (C).
(E) (A) and (B).

48. Apple's claims have been properly rejected under 35 U.S.C. § 102(e) as being anticipated by Carrot. The rejection is based upon the disclosed, but unclaimed, subject matter in the Carrot patent. The Carrot patent issued six months after the filing date of Apple's application. The unclaimed subject matter in the Carrot patent was not invented by Carrot, but rather was disclosed to Carrot by Apple. Carrot's claimed invention is patentably distinct from Apple's claimed invention. The proper reply to obviate this rejection would be to:

(A) Copy the claims in the Carrot patent to provoke an interference.
(B) File an affidavit by Carrot establishing that Carrot derived his knowledge of the relevant subject matter from Apple.
(C) Argue that the Carrot patent is not prior art because the patent did not issue before Apple filed his application.
(D) File a terminal disclaimer signed by Apple.
(E) File a terminal disclaimer signed by Carrot.

49. In which of the following situations does the prohibition against double patenting rejections under 35 U.S.C. § 121 **not** apply?

(A) The applicant voluntarily files two or more cases without a restriction requirement by the examiner.
(B) The requirement for restriction was only made in an international application by the International Searching Authority or the International Preliminary Examining Authority.
(C) The requirement for restriction was withdrawn by the examiner before the patent issues.
(D) The claims of the second application are drawn to the "same invention" as the first application or patent.
(E) All of the above.

50. A patent application is filed with 10 claims. Claims 1, 2, and 3 are independent claims directed to a product. Claim 4 is an independent claim directed to a process for making the product. Which of the following would be acceptable form for a dependent Claim 5?

(A) A product as in claims 1-3, wherein ...
(B) A product as claimed in claims 1, 2, and 3, wherein ...
(C) A product as in claim 1, made by the process of claim 4.
(D) A product as claimed in any one of claims 1, 2, or 3 wherein ...
(E) A product as claimed in claim 6 or claim 7, wherein ...