

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

NOVEMBER 3, 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

1. Your client, Smith, invents a composition for adhering metal to glass. You prepare a patent application including a specification and several claims of varying scope. Your specification includes a detailed description of Smith's invention, which sets forth the following: the composition is made from, among other things, a combination of A, B, and C; the composition is at least 20% A but can be up to 30% A; the composition works best if it is 24% to 26% A; and the composition contains substantially equal portions of B and C. Your specification also includes guidelines for determining what would constitute substantially equal portions of B and C in the composition. Furthermore, your specification includes a detailed explanation of why it is preferable to use 24% to 26% A. Among the following claims drawn to Smith's invention, which is the broadest claim that is unlikely to be properly rejected under 35 U.S.C. 112, second paragraph?

- (A) A composition comprising 20 to 30% A, and substantially equal portions of B and C.
- (B) A composition comprising 20 to 30% A, preferably 24% to 26% A.
- (C) A composition comprising 20 to 30% A, 30% B, and 30% C.
- (D) A composition comprising 24% A, and substantially equal portions of B and C.
- (E) A composition comprising 20 to 30% A, and equal portions of B and C.

2. On August 17, 1999, you filed a reissue application to enlarge the scope of the claims directed to an electrical device in a patent granted to your client on January 20, 1998. In the patent, as well as the patent application on which the patent was granted, the broadest disclosure (including the specification and the original claim) regarding the resistance of the device is that "the device's resistance is .02 to 1.5 ohms." The examiner issued a non-final first Office action containing a rejection of several claims in the reissue application. Your reply to the first Office action includes presentation of an amendment to the specification adding the following disclosure: "The device can have a resistance of 3.0 to 4.5 ohms." No petition and fee requesting entry of the amendment was filed. In accordance with PTO practice and procedure,

-
- (A) the amendment will be entered, and if the examiner objects to the amendment to the specification as being new matter, you should traverse the objection on the grounds that the patent owner is entitled to enlarge the scope of the content of the patent.
 - (B) the amendment will not be entered because the amendment to the specification does not enlarge the scope of the claim.
 - (C) the amendment will not be entered because a petition and necessary fee requesting entry of the amendment was not filed.
 - (D) the amendment will be entered, and if the examiner objects to the amendment to the specification as being new matter, you should file another amendment canceling "The device can have a resistance of 3.0 to 4.5 ohms."
 - (E) the amendment will be entered because it does not introduce new matter.

3. Smith received a second Office action in his pending application finally rejecting pending claims 1-20 on prior art grounds. Claims 1 and 11 are presented in independent form, claims 2-10 depend from claim 1, and claims 12-20 depend from claim 11. To continue prosecution, Smith submitted an Amendment After Final Rejection narrowing the scope of independent claims 1 and 11. Smith believed the Amendment placed the application in condition for allowance and, accordingly, requested entry of the Amendment and allowance of the application. However, the Examiner denied entry on the ground that the Amendment presented new issues requiring further consideration or search. Rather than appeal the rejection, Smith filed a request for a Continuing Prosecution Application (CPA), and asked that the Amendment After Final be entered as a Preliminary Amendment. The Examiner issued a first Office action in the CPA allowing claims 1-10 and finally rejecting claims 11-20 on substantially the same grounds that these claims had been rejected in the parent application. Which of the following statements regarding the first Office action in the CPA is correct?

- (A) The Examiner cannot properly allow claims 1-10 because a determination was made in the parent application that the Amendment After Final Rejection presented new issues requiring further consideration or search.
- (B) The Examiner is precluded from rejecting claims 11-20 on substantially the same grounds that these claims had been rejected in the parent application because a determination was made in the parent case that the Amendment After Final Rejection presented new issues requiring further consideration or search.
- (C) The Amendment After Final Rejection cannot be entered as a Preliminary Amendment in the CPA application.
- (D) The finality of the rejection of claims 11-20 is improper.
- (E) (B) and (D).

4. After filing a proper appeal brief for an application you are prosecuting, you begin to have doubts as to how convincing your arguments would be to the Board of Patent Appeals and Interferences (“Board”). After further consideration, you agree to the examiner’s suggestions. You file an amendment incorporating all of the examiner’s suggestions after you filed the appeal brief and before an examiner’s answer is mailed in this patent application. In accordance with PTO practice and procedure, the amendment _____

- (A) may be entered if the amendment obviously places the application in condition for allowance and there is a showing of good and sufficient reasons why it was not earlier presented.
- (B) will not be entered as it was not sent prior to or with the appeal brief.
- (C) will not be entered because it was not in the form of a petition.
- (D) will be entered and appended to the appeal brief for the Board’s consideration.
- (E) will not be entered because a petition should have accompanied it since it was filed after the appeal brief.

5. On March 1, 1995, applicant filed a nonprovisional patent application for a stool. The original disclosure set forth that a base member of the stool was generally elliptical and, in particular, could be circular (a special kind of ellipse). It also stated that all leg members must be parallel to each other. The only claim included in the application stated as follows:

1. A stool for sitting on, comprising a circular shaped base member having a top surface and a bottom surface; said bottom surface having a center portion and three circular holes equally spaced about said center portion; and three leg members connected to said bottom surface, each hole having a leg member protruding therefrom.

In a first Office action rejection, the examiner rejected claim 1 under 35 U.S.C. § 102(e) as unpatentable over a U.S. Patent to Pigeon. The Pigeon patent specified that each of the leg members formed a thirty degree angle with each of the other leg members. Applicant filed a timely response to the Office action, amending the specification to state that the leg members could be substantially parallel and including guidelines for determining what would be considered “substantially parallel.” Applicant also amended claim 1 as follows:

1. (once amended) A stool for sitting on, comprising a circular shaped base member having a top surface and a bottom surface; said bottom surface having a center portion and three circular holes equally spaced about said center portion; and three leg members connected to said bottom surface, each hole having a leg member protruding therefrom, wherein the leg members are parallel to each other.

The examiner allowed Claim 1 as amended and a patent was granted to applicant on January 5, 1997. On January 5, 1999, applicant filed a reissue application, including a proper declaration pursuant to 37 CFR § 1.175. Assume that there is no other relevant prior art. In accordance with PTO rules and procedure, which of the following statements concerning the reissue application is true?

- (A) Any amendment to claim 1 so as to broaden its scope will likely be considered untimely.
- (B) If applicant amends claim 1 to replace “a circular shaped member” with “an elliptical shaped member,” then the amendment should be considered untimely since the amendment would broaden the scope of the claim.
- (C) If applicant amends claim 1 to delete “wherein the leg members are parallel to each other,” then the amended claim should be allowed.
- (D) If applicant amends claim 1 to replace “parallel” with “substantially parallel,” then the amended claim will likely be allowed.
- (E) None of the above.

6. If each of the following claims is in a different utility patent application, and each claim is fully supported by the disclosure in preceding claims or in the application in which the claim appears, which claim properly presents a process claim?

- (A) A process of utilizing a filter comprising electrical components, placing a plurality of electrodes on the human body, receiving electrical signals from the electrodes, and passing the signals through the filter which comprises electrical components.
- (B) A process of polymerizing an organic compound by combining in a reaction vessel a catalyst and reactants dissolved in a solvent, heating the mixture in the vessel to a high temperature to start the reaction, separating an upper organic layer from the remaining materials, and evaporating the solvent.
- (C) The use of a water repellant paint as a sealant for wooden patio furniture.
- (D) (A) and (B).
- (E) (A), (B), and (C).

7. You were drafting a patent application claiming a widget invented by your client Able. While drafting the application, you looked through a recent *Official Gazette* and noticed a patent, No. 888,888,888, directed to a widget that appears to be the same as the widget you are claiming. You obtained a copy of the patent and discovered that the patent was granted on May 4, 1999, to your client's strongest competitor, QED Incorporated. Claim 5 in the QED patent is the same widget Able invented. Claim 6 in the QED patent is an improvement to Able's widget. The QED patent was granted on a patent application filed on December 22, 1997. You have evidence that Able invented his widget before December 22, 1997. You copied, as claim 9 in Able's application, QED claim 5. Today, November 3, 1999, you are about to file, in the PTO, Able's nonprovisional patent application containing claim 9, and an information disclosure statement (IDS) listing several patents, including the QED patent, and publications. Which of the following would be the most proper course of action to take to comply with your duties to your client and the PTO?

- (A) In the IDS, state and explain why the identified patents may be relevant, and state that the burden has shifted to the examiner to find and disclose other pertinent or relevant prior art.
- (B) Identify the QED patent in bold in the list in the IDS, and include the following explanation about the QED patent: "QED discloses a relevant type of widget."
- (C) In the IDS, state, "The QED patent discloses a relevant type of widget," and provide a copy of the patent.
- (D) In the IDS, state, "Claim 9 in this application has been copied from claim 5 in the QED patent," and provide a copy of the patent.
- (E) In the IDS, state, "Claim 9 in this application has been copied from a claim in a QED patent," and argue that "Claim 6 in the QED patent is an obvious improvement to the instant invention," and provide a copy of a QED patent.

8. Jones' patent application was filed in the PTO in January 1999, claiming an invention Jones conceived and reduced to practice in the United States. Claim 1 in the application was rejected under 35 U.S.C. § 102 as being unpatentable over a U.S. patent to Smith. Smith did not derive anything from Jones, or visa versa. Smith and Jones were never obligated to assign their inventions to the same employer. In which of the following situations should a declaration by Jones under 37 CFR § 1.131 overcome the rejection in accordance with proper PTO practice and procedure?

- (A) The rejected claim is drawn to a genus. The Smith patent issued in March 1998, on an application filed in June 1994. The patent discloses, but does not claim, a single species of the genus claimed by Jones. The declaration shows completion in April 1994, of the same species disclosed by Smith.
- (B) The rejected claim is drawn to a species. The Smith patent issued in March 1998 on an application filed in June 1994. The patent discloses, but does not claim, the species claimed by Jones. The declaration shows completion in April 1994, of a different species.
- (C) The rejected claim is drawn to a genus. The Smith patent issued in March 1998, on an application filed in June 1994. The patent discloses, but does not claim, several species within the genus claimed by Jones. The declaration shows completion in April 1994, of a species different from the reference's species and the species within the scope of the claimed genus.
- (D) The rejected claim is drawn to a genus. The Smith patent issued in March 1997, on an application filed in June 1994. The patent discloses, but does not claim, several species within the genus claimed by Jones. The declaration shows completion in April 1994, of one or more of the species disclosed in the patent.
- (E) The rejected claim is drawn to a genus. The Smith patent issued in November 1998, on an application filed in June 1994, and the patent discloses and claims several species within the genus claimed by Jones. The declaration shows completion in April 1994, of each species claimed in the Smith patent.

9. A personal interview with an examiner to discuss the merits of the claims **may not** be properly conducted by:

- (A) the inventor, even though the attorney of record is present at the interview.
- (B) a registered practitioner who does not have power of attorney in the application, but who is known to the examiner to be the local representative of the attorney of record in the case.
- (C) an unregistered attorney who is the applicant in the application.
- (D) an unregistered attorney who has been given the associate power of attorney in the particular application.
- (E) a registered practitioner who is not an attorney of record in the application, but who brings a copy of the application file to the interview.

10. Which of the following claim phrases may be used in accordance with proper PTO practice and procedure?

- (A) R is selected from the group consisting of A, B, C, or D.
- (B) R is selected from the group consisting of A, B, C, and D.
- (C) R is selected from the group comprising A, B, C, and D.
- (D) R is selected from the group comprising A, B, C, or D.
- (E) R is A, B, C, and D.

11. A final rejection, with a mailing date of Thursday, February 4, 1999, was received Saturday, February 6, 1999. The examiner set a three month shortened statutory period for reply. Which of the following will be considered as being timely filed?

- (A) A reply, mailed using the U.S. Postal Service, first class mail, on Friday, August 6, 1999, and received by the PTO on Monday, August 9, 1999 accompanied by a petition and appropriate fee for a three-month extension of time, and a certificate of mailing stating, "I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on August 6, 1999." The certificate of mailing was signed by and contained the printed name of one who reasonably expected the response to be mailed in the normal course of business by another no later than August 6, 1999.
- (B) A reply, mailed using the U.S. Postal Service, on Tuesday, May 4, 1999 and received by the PTO on Thursday, May 6, 1999 accompanied by a copy of a U.S. Postal Service certificate of mailing, which states "One piece of ordinary mail addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231." The certificate of mailing contained an official U.S. Postal Service date stamp of May 4, 1999, and the printed name of one who reasonably expected the response to be mailed in the normal course of business no later than May 4, 1999.
- (C) A reply, mailed using the U.S. Postal Service, first class mail, on Wednesday, August 4, 1999, and received by the PTO on Monday, August 9, 1999, accompanied by a petition and the appropriate fee for a three-month extension of time, and a certificate of mailing stating, "I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on August 6, 1999." The certificate of mailing was signed by and contained the printed name of one who reasonably expected the response to be mailed in the normal course of business by another no later than August 4, 1999.
- (D) (A) and (C).
- (E) None of the above.

12. Which of the following statements is true concerning terms of degree (relative terms, e.g., such as, “hotter”) used in claim language?

- (A) Definiteness of claim language using terms of degree should not be analyzed using a claim interpretation that would be given by one possessing the ordinary level of skill in the art, and only the specification should be used to interpret the claim.
- (B) A claim may be rendered indefinite even if the specification uses the same term of degree as the claim language, if the term of degree is not understandable by one of ordinary skill in the art when the term of degree is read in light of the specification.
- (C) If the specification includes guidelines which would enable one of ordinary skill in the art to determine the scope of a claim having a term of degree, then the language of the guidelines must be included in the claim in order to render the claim definite.
- (D) If the original disclosure does not include guidelines which would enable one of ordinary skill in the art to determine the scope of a claim having a term of degree, then as long as the term of degree in the claim was part of the original disclosure, the claim will be properly rendered definite by amending the specification to provide guidelines concerning the term of degree which would enable one of ordinary skill in the art to determine the scope of the claim.
- (E) None of the above.

13. You are a registered patent agent prosecuting a patent application filed on behalf of Harry. You received an Office action having a mailing date of August 13, 1999, in which the examiner set a three month shortened statutory period for reply and rejected all of the claims in the application under 35 U.S.C § 112 for failing to particularly point out and distinctly claim the invention. After receiving the Office action, you discovered a recently issued U.S. patent that you believe discloses and claims your client’s invention. On September 28, 1999, you filed an amendment copying some of the claims from the patent for the purpose of provoking an interference and notify the examiner that you have copied specific claims from the patent. In a second Office action dated October 13, 1999, the examiner rejected the copied claims under 35 U.S.C. § 112 as being based on a non-enabling disclosure and set a three month shortened statutory period for reply. If no requests for an extension of time are filed, the last day(s) for filing replies to the first and second Office actions, is(are):

- (A) Monday, November 15, 1999.
- (B) Monday, November 15, 1999, and Thursday, January 13, 2000, respectively.
- (C) Monday, November 29, 1999, and Wednesday, January 12, 2000 respectively.
- (D) Tuesday, December 28, 1999.
- (E) Thursday, January 13, 2000.

14. Claim 1 in a patent application states the following:

1. A modular telephone plug crimping tool comprising:
 - (i) a pair of body parts comprising first and second body parts, each having a fixed length;
 - (ii) a flexible member connecting an end of the first body part to an end of the second body part;
 - (iii) a hand lever;
 - (iv) a pivot pin connecting the hand lever to the first body part;
 - (v) an interchangeable crimping punch removably seated in the first body part and guided relative to an interchangeable crimping anvil removably seated in the second body part;
 - (vi) a roller mounted on the pivot pin for engaging the crimping punch; and
 - (vii) a guide pin being fixed in said second body part and extending in aligned bores in said pair of body parts.

Which, if any, of the following claims, if presented in the application, is a proper dependent claim in accordance with PTO rules and procedure.

- (A) 2. The modular telephone according to claim 1, wherein said crimping punch comprises integral contact and strain relief punch portions.
- (B) 2. The modular telephone plug crimping tool according to claim 1, wherein said second body part has an adjustable length.
- (C) 2. A process for using the modular telephone plug crimping tool of claim 1 to connect a telephone to a telephone line.
- (D) 2. The modular telephone plug crimping tool according to claim 1, further comprising: a free end on each of said first and second body parts; first and second stripping blades adjustably and detachably provided at said free ends of said first and second body parts, respectively; and at least one severing blade held in cooperating relationship with a severing anvil, said severing blade and severing anvil being provided on said first and second body parts, respectively.
- (E) None of the above.

15. You are prosecuting an application for inventor Smith that receives a rejection under 35 U.S.C. § 102(b) based on a U.S. patent to Jones that discloses and claims the same invention. Which of the following, if any, will overcome the rejection?

- (A) An affidavit or declaration showing that Jones is not the true inventor.
- (B) An affidavit or declaration showing commercial success of the Smith invention.
- (C) An affidavit or declaration containing an argument that the invention claimed in the Smith application provides synergistic results.
- (D) An affidavit or declaration swearing back of the Jones patent.
- (E) None of the above.

Questions 16 and 17 are based on the following facts. Answer each question independently of the other.

A patent application contains a single independent claim:

1. A process for manufacturing water soluble crayons which comprises (i) preparing one or more water soluble alkoxylation products by contacting an organic compound selected from the group consisting of alcohols and carboxylic acids, with an alkylene oxide in the presence of an effective amount of a catalyst under alkoxylation conditions; (ii) preparing a water soluble crayon composition by adding a coloring agent to the one or more water soluble alkoxylation products; (iii) pouring said water soluble crayon composition into a mold; and (iv) solidifying said water soluble crayon composition by cooling.

The coloring agents disclosed in the specification include pigments selected from the group consisting of titanium dioxide, red iron oxide and carbon black. These pigments are used in an amount of about 1 to 30 weight percent or greater, preferably about 4 to about 25 weight percent, of the total weight of the crayon composition. As disclosed in the specification, preferred organic compounds useful in the process of this invention also include alcohols, carboxylic acids, and amines. The specification also discloses that the water soluble crayon compositions harden readily upon cooling, i.e. when exposed to a temperature of from about 10°C. to 15°C.

16. Which of the following choices would be a proper dependent claim which could be added to the application by amendment and be supported by the specification?

- (A) 2. A process according to Claim 1 wherein said water soluble crayon composition is exposed to a temperature of at least 10°C.
- (B) 2. A process as set forth in Claim 1 wherein said coloring agent is titanium dioxide.
- (C) 2. A process for manufacturing water soluble crayons as set forth in Claim 1 wherein said coloring agent is 1 to 30 weight percent of the total weight of the crayon composition.
- (D) 2. A process as set forth in Claim 1 wherein said organic compound further comprises amines.
- (E) (B) and (C).

17. Which of the following amendments to Claim 1 are in accordance with PTO policy and procedure and are supported by specification?

- (A) In Claim 1, line 3, before “alcohols” delete “monohydric”.
- (B) In Claim 1, line 4, after “alcohols” insert “amines”.
- (C) In Claim 1, line 6, delete “a coloring agent” and insert “titanium dioxide”.
- (D) In Claim 1, line 7, after “cooling” insert “to a temperature of 13°C.”
- (E) (B) and (C).

18. Bill wishes to amend the sole, original Claim 1 of the patent granted to him and obtain the following amended Claim 1. The amended Claim 1 set forth below is fully supported by the original disclosure in the application:

- 1. A computer processor comprising:
 - a. a plurality of registers divided into a global port subset and a local pool subset;
 - b. means for distinguishing a successful [unconditional] interruptable jump operation;
 - c. means for receiving interrupts or exceptions; and
 - d. an interrupt or exception handler for handling the interrupts or exceptions in response to distinguishing the [unconditional] interruptable jump operation [from the local pool subset].

In the absence of questions of recapture, novelty, obviousness, and utility, which of the following statements, if any, is true?

- (A) A claim so amended is properly presented during a reexamination proceeding where a request for reexamination was filed on September 9, 1999, and a certificate of reexamination may be issued where reexamination is sought of a patent granted on July 15, 1997.
- (B) A claim so amended is properly presented in a reissue application filed on September 9, 1999, and a reissue patent is grantable where reissuance is sought of a patent granted on July 15, 1997.
- (C) A claim so amended is properly presented in a reissue application filed on September 9, 1999, and a reissue patent is grantable where reissuance is sought of a patent granted on November 18, 1997.
- (D) A claim so amended is properly presented in a request for reexamination filed on September 9, 1999, and a certificate of reexamination may be issued where reexamination is sought of a patent granted on November 18, 1997.
- (E) A claim so amended is properly presented in a reissue application filed any time before expiration of the term of the patent inasmuch as the scope of Claim 1 in the original patent is narrowed by replacing the word “unconditional” with the word “interruptable.”

19. Which of the following requirements of 35 U.S.C. § 112 does not apply to design patent claims?

- (A) The written description requirement of the first paragraph.
- (B) The best mode requirement of the first paragraph.
- (C) The requirement in the second paragraph to distinctly claim the subject matter which the applicant regards as his invention.
- (D) The requirement in the third paragraph for an independent claim.
- (E) None of the above.

20. Inventors Moe and Jeff originally gave attorney Curly a power of attorney to prosecute their application before the PTO. At this time, inventor Jeff has decided that he no longer wants attorney Curly to represent him. Instead, inventor Jeff wants you to represent him. Thus, Jeff wants the power of attorney to Curly revoked. Moe does not agree and wants Curly to continue. How, if at all, should the revocation and appointment of a new power of attorney be properly handled?

- (A) Papers revoking Curly's power of attorney with regard to Jeff, and giving you a new power of attorney need to be signed by Jeff and must include a statement from Moe indicating that Moe wishes to retain Curly.
- (B) Papers revoking Curly's power of attorney with regard to Jeff, and giving you a new power of attorney cannot be accepted without concurrence by Curly.
- (C) Papers revoking Curly's power of attorney with regard to Jeff, and giving you a new power of attorney signed only by you should be accompanied by a petition giving good and sufficient reasons as to why such papers should be accepted upon being filed together with an appropriate fee.
- (D) Papers revoking Curly's power of attorney with regard to Jeff, and giving you a new power of attorney signed only by Jeff should be accompanied by a petition giving good and sufficient reasons for acceptance should be filed together with an appropriate fee.
- (E) Papers revoking Curly's power of attorney with regard to Jeff, and giving you a new power of attorney cannot be accepted without concurrence of Moe and Curly.

21. Which of the following files is ordinarily not open to the public?

- (A) A substitute application.
- (B) An interference proceeding file involving a U.S. patent.
- (C) A reissue application.
- (D) A reexamination proceeding file.
- (E) All of the above.

22. You are preparing a patent application for filing in the PTO. The application describes a microcomputer having several components. You have drafted the following independent claim:

1. A micro-computer comprising:
 - (i) a central processing unit for processing information;
 - (ii) a memory unit for storing information;
 - (iii) an input device for entering information characterized by a keyboard;
 - (iv) an output device for viewing information consisting of a video monitor; and
 - (v) a bus for interconnecting the central processing unit to the memory unit, the input device and the output device.

In the absence of issues of supporting disclosure, and following proper PTO practices and procedures, which of the following dependent claim(s) is (are) an improper dependent claim?

- Claim 2. The micro-computer of Claim 1, wherein the memory unit contains random access memory.
- Claim 3. The micro-computer of Claim 1 or 2, wherein the input device includes a light pen.
- Claim 4. The micro-computer in any one of the preceding claims, wherein the output device is a printer or a video monitor.
- Claim 5. The micro-computer of Claim 4, wherein the memory unit contains read-only memory.

- (A) Claim 2.
- (B) Claim 2 and Claim 3.
- (C) Claim 3.
- (D) Claim 5.
- (E) Claim 4 and Claim 5.

23. To avoid a proper rejection of a claim for being indefinite, which of the following expressions in the claims must be supported by a specification disclosing a standard for ascertaining what the inventor means to cover?

- (A) “relatively shallow.”
- (B) “of the order of.”
- (C) “similar” in the following claim preamble: “A nozzle for high-pressure cleaning units or similar apparatus.”
- (D) “essentially” in the following phrase following the claim preamble: “a silicon dioxide source that is essentially free of alkali metal.”
- (E) All of the above.

24. Claims 1 through 5 in a patent application read as follows:

1. A computer comprising:
 - (i) a microprocessor having a maximum clock rate of 350 megahertz;
 - (ii) a random access memory chip coupled to said microprocessor;
 - (iii) a read only memory chip coupled to said microprocessor; and
 - (iv) a case enclosing said microprocessor, said random access memory chip, and said read only memory chip.
2. The computer of claim 1, wherein said case has an outer surface comprised of plastic.
3. The computer of claims 1 or 2, further comprising a peripheral controller chip coupled to said microprocessor.
4. The computer of claim 1, wherein said memory chip has eight million storage locations.
5. The computer of claim 2, wherein said microprocessor has a maximum clock rate of 400 megahertz.

Which of the following is/are proper dependent claims(s) in accordance with 37 CFR §1.75?

- (A) Claims 2 and 3.
- (B) Claim 4 only.
- (C) Claims 2 and 5.
- (D) Claim 2 only.
- (E) None of the above.

25. Gonnagetrich Corporation asked you to represent, before the PTO, some of its employees who have invented an apparatus. On Tuesday, August 17, 1999, you deposited a nonprovisional patent application containing a specification with ten claims drawn to the apparatus via hand delivery to the PTO. At that time, you neither supplied the names of any of the actual inventors with the application, nor did you file with the application drawings necessary to understand the invention. The specification refers to the drawings. You sent the drawings by first class mail to the PTO on Wednesday, September 13, 1999, and the PTO received them on Wednesday, September 15, 1999. On Wednesday, September 29, 1999, using the "Express Mail Post Office to Addressee" service of the U.S. Postal Service, and so certifying in compliance with 37 CFR § 1.10, you deposited with the U.S. Postal Service a declaration pursuant to 37 CFR § 1.63 signed by all the actual inventors. On Friday, October 1, 1999, the PTO received the signed declaration. What will be the earliest filing date given to the application by the PTO?

- (A) August 17, 1999.
- (B) September 13, 1999.
- (C) September 15, 1999.
- (D) September 29, 1999.
- (E) October 1, 1999.

26. X invented a laminate which is most broadly disclosed in a patent application as containing a transparent protective layer and a light-sensitive layer, without an intermediate layer. The prior art included a laminate containing a transparent protective layer and a light-sensitive layer held together by an intermediate adhesive layer. Which of the following claims would overcome a 35 USC § 102 rejection based on the prior art?

- (A) 1. A laminate comprising a transparent protective layer and a light-sensitive layer.
- (B) 1. A laminate comprising a transparent protective layer and a light-sensitive layer which is in continuous and direct contact with the transparent protective layer.
- (C) 1. A laminate comprising a transparent protective layer and a light-sensitive layer, but not including an adhesive layer.
- (D) (A) and (B).
- (E) (B) and (C).

27. On April 21, 1998, a patent was issued to Belinda on a novel switching circuit. Shortly after receiving the patent grant, Belinda assigned 50% of her right, title and interest in her patent to Ace and 25% of the right, title and interest to Duce. After the assignments were recorded in the PTO, Belinda discovered that her claim coverage is too narrow because her patent attorney did not appreciate the full scope of her invention. Today, November 3, 1999, Belinda consults you about filing a reissue application. The reissue oath must be signed and sworn to by:

- (A) Belinda, Ace and Duce.
- (B) Belinda only.
- (C) Belinda and either Ace or Duce.
- (D) Ace and Duce only.
- (E) the attorney or agent of record.

28. A patent specification can be altered by interlineation before it is filed in the PTO. Such alterations are permitted if each interlineation is initialed and dated by the:

- (A) registered practitioner who prepared the specification, even if the applicant is available to sign the oath or declaration.
- (B) applicant, before the oath or declaration is signed by the registered practitioner.
- (C) applicant, at any time after the oath or declaration is signed.
- (D) applicant, before the oath or declaration is signed by the applicant.
- (E) registered practitioner who prepared the specification before the oath or declaration is signed by the applicant.

29. On January 2, 1999, Billie files a U.S. patent application that discloses forming a naturally occurring composition X by a chemical reaction of compounds A, B and C under specified ranges of temperature and pressure. The application includes a statement “The most common meaning of the term ‘fluid’ includes both gases and liquids. However, it has been determined that the present invention properly operates when B is in a gaseous, fluid, or solid state, so long as temperature of the solid B is above 2°C. Below that temperature, it is believed the chemical reaction will not occur. Thus, in the context of the present invention, the term ‘fluid’ means ‘gaseous’, ‘liquid’, and/or certain solid states.” However, research conducted in 1998 by Greene in England shows that the desired chemical reaction would occur with solid compound B at a temperature of 1°C. Greene also showed the reaction with compound B in a liquid and gaseous states. Greene submitted his research results to a British technical journal in November 1998, and they were published on January 5, 1999. Originally filed Claim 1 of Billie’s application is directed to “[a] method for forming composition X comprising mixing compound A with fluid compound B at a temperature between 0°C and 10°C”. Examiner Redd locates the published Greene research results that disclose the identical method set forth in Billie’s Claim 1. Which rejection of Claim 1 is in accordance with proper PTO practices and procedures?

- (A) Claim 1 is rejected under 35 U.S.C. § 112, paragraph 2 as being indefinite because the meaning of the term “fluid” is unclear. Billie is encouraged to clarify the claim by deleting “fluid” and inserting --liquid-- in its place.
- (B) Claim 1 is rejected under 35 U.S.C. § 102(a) as being anticipated by Greene because, although the research results were published after Billie’s filing date, the research results were submitted to the British technical journal before the filing date and were therefore known in the art.
- (C) Claim 1 is rejected under 35 U.S.C. § 112, paragraph 1 as being based on an insufficient specification because the claim does not specify a pressure at which A and B are mixed and, depending on that pressure, compound B could be either a gas or a liquid at the recited temperature range.
- (D) Claim 1 is rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter because composition X occurs naturally.
- (E) Claim 1 is rejected under 35 U.S.C. § 112, paragraph 2 as being based on an incorrect theory of operation because the theory of operation disclosed in the specification is inconsistent with the claim.

30. Which of the following may not properly apply for a patent on an invention?

- (A) A child.
- (B) A convicted felon.
- (C) A British subject.
- (D) A current employee of the PTO.
- (E) A scientist who has assigned to his employer all rights to the invention.

31. An international application under the Patent Cooperation Treaty (PCT), which designated the United States, was filed on November 1, 1996. The application claimed priority of a prior French national application filed on December 6, 1995. A copy of the international application was communicated to the United States as a designated office on June 20, 1997. A demand for international preliminary examination, in which the United States was elected, was filed on June 5, 1997. Accordingly, the thirty month period of PCT Article 39(1)(a) expired at midnight on June 6, 1998. The applicant submitted the basic national fee to enter the United States national stage on June 2, 1998. On August 3, 1998, the applicant timely submitted a translation of the international application and a declaration of the inventors in compliance with PCT regulations in reply to a Notice of Missing Requirements. Also, on August 10, 1998, the applicant timely submitted a translation of amendments under Article 19 of the PCT in reply to the Notice of Missing Requirements. On August 29, 1998, a Notice of Acceptance was mailed to the applicant. The national stage application issued as a U.S. patent on October 13, 1999. What is the effective date of the U.S. patent as a reference under 35 U.S.C. § 102(e)?

- (A) November 1, 1996.
- (B) June 2, 1998.
- (C) August 3, 1998.
- (D) August 10, 1998.
- (E) October 13, 1999.

32. A client comes to you and tells you that he has been informed by his competitor that he is infringing the competitor's patent. Your client tells you that the competitor's invention was well known in the field at the time the application for the patent was filed. Your client shows you several published articles, two United States patents, and two written statements by experts in the field which clearly support his conclusion. Upon further investigation, you find that the published articles and patents were not considered by the examiner during the prosecution of the patent application. Your client informs you that he would like to avoid litigation, and have the PTO take action to invalidate the patent. Which of the following choices would be an appropriate course of action to take on behalf of your client?

- (A) Petition the Commissioner of Patents and Trademarks to revoke the patent.
- (B) File a request and fee for reexamination of the claims in the patent relying on the published articles and the U.S. patents as the basis for reexamination, and include all statements, information, and documents required by PTO rules for initiating reexamination proceedings.
- (C) File a protest in the PTO with copies of the published articles, patents and the written statements from the experts, along with an explanation of their pertinence to the claims of the patent.
- (D) File in the PTO copies of all of the documents provided to you by your client and request that they be made of record in the patented file.
- (E) (B) and (C).

33. Ann invented an electrical signal filter for obtaining increased signal-to-noise ratios in certain electrical systems. Ann filed a first non-provisional patent application on May 1, 1997, fully disclosing and claiming one embodiment of her invention, a capacitor. The sole claim stated: “a capacitor for filtering electrical signals, comprising: a first terminal connected to a first plate; a second terminal connected to a second plate; and an electrical insulator between said first plate and said second plate.” The first application also disclosed that even better results could be obtained if the capacitor were coupled to a resistor. Ann wanted to file a second application in the future specifically claiming the combination of the capacitor and resistor. On February 1, 1999, while Ann’s first application was still pending, Ann filed a continuation application under 37 CFR § 1.53(b). The continuation application contains the following single claim: “a capacitor for filtering electrical signals, comprising: a first terminal connected to a first plate; a second terminal connected to a second plate; an electrical insulator between said first plate and said second plate; and a resistor, connected to said first terminal.” Ann received a non-final Office action wherein the claim in the continuation application was provisionally rejected under the judicially created doctrine of double patenting over the claim drawn to a capacitor in Ann’s copending first application. The rejection correctly stated that the subject matter claimed in Ann’s continuation application was fully disclosed in her copending first application and would be covered by a patent granted containing the claim in the first application. Neither application was ever assigned to anyone. The rejection may be properly overcome by a timely reply:

- (A) traversing the rejection and arguing that since the first application had not yet matured into a patent, a double patenting rejection was unfounded.
- (B) arguing that rejections of this type are no longer warranted for continuation applications, since any utility application filed on or after June 8, 1995, will expire 20 years from its filing date, and therefore Ann’s continuation application, which gets the benefit of the filing date of the first application, would expire at the same time as the first application, anyway.
- (C) arguing that the claim in the continuation application is patentably distinct and unobvious from the claim in the first application.
- (D) including a terminal disclaimer, signed by Ann, disclaiming any portion of the term of any patent granted on the continuation application beyond twenty years from May 1, 1997, and including a provision in the terminal disclaimer that any patent granted on the continuation application shall be enforceable only for and during such period that said patent is commonly owned with the first application.
- (E) including the filing of a terminal disclaimer, signed by Ann, disclaiming any portion of the term of any patent granted on the continuation application beyond twenty years from May 1, 1997.

34. Your client, Vada, disclosed the following information to you. While vacationing on a desert island, she discovered a salt lake where the water was a solution saturated with NaCl. Vada experimented with the solution and determined that it could be used to cure skin rashes if applied directly to the skin. By further experimentation, Vada determined that the best results could be obtained if the solution were first heated to an ideal temperature (T_i) equal to skin temperature (T_s) plus the square of the difference between room temperature (T_r) and skin temperature (T_s). Vada documented her findings in the form of the following equation: $T_i = T_s + (T_r - T_s)^2$. Vada further experimented and found that she could obtain the exact same solution that she discovered while vacationing, by mixing NaCl with water followed by heating the mixture to 212°F and cooling it to 80°F. You draft a patent application with a specification including all the information disclosed to you by Vada. Which, if any, of the following claims, included in the application, would provide the proper basis for a rejection pursuant to 35 U.S.C. § 101?

- (A) A composition comprising: water saturated with NaCl
- (B) A composition for restoring youth.
- (C) A composition and method for treating skin rashes, comprising: a solution of water saturated with NaCl; heating said solution to a temperature defined by skin temperature plus the square of the difference between room temperature and skin temperature; and applying said solution to skin rashes.
- (D) An expression comprising: $T_i = T_s + (T_r - T_s)^2$.
- (E) All of the above.

35. Which, if any, of the following statements is true according to PTO rules and procedure?

- (A) If a claim is cancelled by an amendment and a new claim is added in the amendment, then the new claim should be numbered using the number previously assigned to the canceled claim.
- (B) A claim which recites the best mode of carrying out the invention can only properly incorporate by reference the limitations having the essential material into the claim, for purposes of satisfying the requirements of 35 U.S.C. § 112, second paragraph, if the reference is made to a U.S. patent or U.S. patent application.
- (C) For fee calculation purposes, a multiple dependent claim which refers directly to independent claims and dependent claims will always be considered to be the number of independent claims to which direct reference is made therein.
- (D) The subject matter disclosed in a first claim which is part of the original disclosure in a nonprovisional patent application may be relied upon for purposes of enabling a second claim in the application in order to satisfy the requirements of 35 U.S.C. § 112, first paragraph, even if the detailed description and drawings, taken alone, are inadequate to satisfy the requirements of 35 U.S.C. § 112, first paragraph, with respect to the second claim.
- (E) None of the above.

36. A patent application includes a specification describing a mechanical fastener that attaches a rubber heel to the bottom of a shoe. The particular structure of the fastener allows the heel to maintain a secure attachment to the shoe while providing a cushioning effect when the shoe is worn. The specification includes a drawing clearly illustrating the fastener. The written portion of the specification accurately explains the structure of the fastener, the manner in which the fastener attaches the heel to the shoe, and how the cushioning effect is obtained. Additionally, the last paragraph of the specification states “It should be understood that the present invention is not limited to the preferred embodiment described above, and that changes may be made without departing from the spirit or scope of the invention. For example, an adhesive may be used in conjunction with the mechanical fastener to more securely attach the heel to the shoe.” No specific formulation of adhesive is given in the specification, but such adhesives are well known in the art. Claim 1 of the application reads:

1. A system for securely attaching a rubber heel to the bottom of a shoe and providing a cushioning effect when worn, said system comprising cushioning means for mechanically fastening said heel to said shoe.

Which of the following statements is correct?

- (A) Claim 1 is a “means plus function” claim subject to the provisions of 35 U.S.C. § 112, paragraph 6 and is therefore construed to cover the corresponding structure disclosed in the specification for performing the recited function and equivalent structures. Thus, claim 1 is properly construed to cover only the specific mechanical structure of the fastener described in the specification and equivalents of that mechanical structure.
- (B) Claim 1 is a “means plus function” claim subject to the provisions of 35 U.S.C. § 112, paragraph 6 and is therefore construed to cover the corresponding structure disclosed in the specification for performing the recited function and equivalent structures. Thus, claim 1 is properly construed to cover both (a) the specific mechanical structure of the fastener described in the specification and equivalents of that mechanical structure; and (b) the specific mechanical structure of the fastener described in the specification together with an adhesive and equivalents of that mechanical structure together with an adhesive.
- (C) Claim 1 is indefinite because it covers every conceivable means for achieving the stated result.
- (D) Claim 1 is not supported by an enabling specification because the claim covers every conceivable means for achieving the stated result.
- (E) Because claim 1 is drafted in means plus function language, proper claim interpretation under 35 U.S.C. § 112, paragraph 6 requires that there be a specific description in the specification of an acceptable adhesive formulation.

37. Fred files a patent application disclosing and claiming an electrical circuit. The disclosed circuit has, in series, (i) a DC current source capable of producing a variable current of 10-30 amperes, preferably 18-22 amperes; (ii) a resistor having a value in the range of 10-20 ohms, preferably 14-16 ohms; and (iii) a fixed capacitor in the range of 3-8 microfarads (mf), preferably 5-6 mf. The application includes the following four original claims:

- Claim 1. An electrical circuit comprising, in series, a DC current source, a resistor and a capacitor, wherein said DC current source is capable of producing current of 18-22 amperes, said resistor has a value in the range 10-20 ohms, and said capacitor has a value in the range of 5-6 mf.
- Claim 2. The electrical circuit of claim 1, wherein said resistor has a value in the range of 14-16 ohms.
- Claim 3. The electrical circuit of claim 1, wherein said capacitor has a value in the range of 3-8 mf.
- Claim 4. The electrical circuit of claim 1, wherein the DC current source produces variable current in the range of 18-22 amperes.

Barry's Canadian patent, published thirteen months before the effective filing date of Fred's application, discloses an electrical circuit having, in series, a DC current source which produces 20 ampere current, a 12 ohm resistor, and a 6 mf capacitor. Which of the following statements regarding the claims is correct?

- (A) Each of Claims 1- 4 is patentable over Barry's Canadian patent.
- (B) Claim 1 is unsupported by a sufficient written description because the specification does not set forth the claimed combination of component values in a single disclosed embodiment.
- (C) Claim 2 is an improper dependent claim.
- (D) Claim 3 is an improper dependent claim.
- (E) Claim 4 is an improper dependent claim.

38. Assuming that each of the following claims is in a different utility patent application, and each claim is fully supported by the disclosure in the preceding claims or in the application in which it appears, which of the claims properly presents a process claim?

- (A) A process for using monoclonal antibodies to isolate and purify interferon.
- (B) A process of using paint to cover a surface comprising applying paint to a surface and removing any excess paint.
- (C) A use of a metallic fibrous compound having a proportion of metallic granules as a motor compression part subject to stress by sliding friction.
- (D) The use of a sustained release therapeutic agent in a human body wherein said sustained release therapeutic agent comprises a painkiller absorbed on a polymeric surface.
- (E) All of the above.

39. You prepared a patent application on behalf of inventors Jo and Tommie. Jo invented a new and unobvious technique for inexpensively manufacturing a known chemical compound. Tommie invented a new and unobvious technique that uses the chemical to clean-up toxic waste spills. Both inventions have been assigned to Ace Chemical Company. The patent application fully discloses and claims both inventions. Both inventors approve the application, but Tommie is unavailable to sign an inventors' oath before an upcoming statutory bar date. In accordance with instructions, you to immediately file the application under 37 CFR §1.53(b) without an executed oath, but with an information sheet to identify the application. Tommie was inadvertently left off the list of inventors on the information sheet, which listed Jo as a sole inventor. After receiving a Notice to File Missing Parts, you submit an oath executed by both Jo and Tommie. No paper was filed to change the named inventive entity. You later receive an Office action restricting the application between Jo's invention, and Tommie's invention. In response, you elect Jo's invention, cancel the claims directed to Tommie's non-elected invention, and immediately file a divisional application directed to Tommie's invention together with an inventor's oath executed by Tommie only. The divisional application includes a specific reference to the original application. Which of the following statements is correct?

- (A) Because the original application as filed named only Jo as an inventor, Tommie's divisional application is not entitled to the filing date of the original application because there is no common inventor between the original application and the divisional application.
- (B) The incorrect inventorship listed on the information sheet of the original application was never properly corrected and, therefore, any patent issuing on that application will be invalid under 35 U.S.C. § 116 unless the inventorship is later corrected.
- (C) After canceling the claims to Tommie's non-elected invention, it is necessary to change the named inventive entity in the original application by filing a petition including a statement identifying Tommie as being deleted and acknowledging that Tommie's invention is no longer being claimed in the application, and an appropriate fee.
- (D) Written consent of Ace Chemical Company is required before any change of inventorship can be made.
- (E) It is necessary in the divisional application to file a petition including a statement identifying Jo as being deleted as an inventor and acknowledging that Jo's invention is not being claimed in the divisional application, and the appropriate fee.

40. Which of the following factors would **not** be indicative of an experimental purpose for testing a utility invention?

- (A) Testing is conducted over a substantial period of time to determine the operativeness of the invention.
- (B) Testing is conducted under the supervision and control of the inventor.
- (C) Testing to determine product acceptance or market testing.
- (D) The nature of the invention was such that any testing had to be, to some extent, public.
- (E) The inventor regularly inspected the invention during the period of experimentation.

41. Your client has invented a miniature vacuum tube comprising a capacitor having a capacitance of 0.003 to 0.012 μf , preferably 0.006 μf . You draft a patent application directed to your client's invention and satisfying the requirements of 35 U.S.C. § 112. You draft the following independent claim:

1. A miniature vacuum tube comprising a capacitor having a capacitance of 0.003 to 0.012 μf .

Which of the following would not be a proper dependent claim if presented as an original claim in the application when the application is filed in the PTO?

- (A) 2. The miniature vacuum tube of Claim 1 wherein the capacitor has a capacitance of 0.006 μf .
- (B) 2. A miniature vacuum tube as in Claim 1 wherein the capacitor has a capacitance of 0.006 to 0.012 μf .
- (C) 2. A miniature vacuum tube as in Claim 1 wherein the capacitor has a capacitance of about 0.003 to 0.011 μf .
- (D) 2. The miniature vacuum tube of Claim 1 wherein the capacitor has a capacitance of between 0.005 and 0.012 μf .
- (E) (C) and (D).

42. A multiple dependent claim may not properly depend upon _____.

- (A) an independent claim.
- (B) another dependent claim.
- (C) any other multiple dependent claim.
- (D) a claim containing Markush language.
- (E) a claim which is in Jepson-type format.

43. In which of the following situations, considered independently of each other, does the event described below not constitute a statutory bar to the granting of a patent on an application filed August 30, 1999, claiming a bottle cap?

- (A) The inventor reduced the invention to practice in June, 1998, and sold the claimed bottle caps to a bottling company on July 30, 1998. The sale was conditioned on the bottling company's satisfaction. The inventor and the company are located in New York.
- (B) The inventor reduced the invention to practice in June, 1998, sold the claimed bottle caps to bottling companies beginning on July 30, 1998. Although the inventor sold the bottlecaps to commercially exploit his invention, the inventor's manufacturing and overhead costs exceeded his income from the sales and the inventor did not profit from the sales. The inventor and the companies are located in New York.
- (C) The inventor reduced the invention to practice in June, 1998, and on July 30, 1998, assigned to Company X his patent rights to the claimed bottle cap invention for good and valuable consideration. The inventor and Company X are located in New York.
- (D) The inventor reduced the invention to practice in June, 1998, and on July 30, 1998, the inventor offered to sell his inventory of the claimed bottle cap to a bottling company. The sale was not consummated until September 3, 1999. The inventor and the company are located in New York.
- (E) The inventor reduced the invention to practice in June, 1998, and the inventor's offer, on July 30, 1998, to sell the claimed bottle caps to a bottling company was delayed in the mail and not received by the company until September 10, 1998. The inventor and the company are located in New York.

44. G is the sole inventor in a patent application filed in the PTO describing and claiming a surgical instrument. H is the sole inventor in a patent application filed in the PTO describing G's surgical instrument, as well as describing and claiming a modified embodiment of G's surgical instrument. Following proper PTO practices and procedures, under which circumstance is it most likely that you will need to overcome a provisional 35 U.S.C. § 102(e)/103 rejection in G's application?

- (A) G's application is filed in the PTO before H's application, and they do not have a common assignee.
- (B) H's application is filed in the PTO before G's application, and they do not have a common assignee.
- (C) G's application is filed in the PTO on the same date as H's application, and they have a common assignee.
- (D) G's application is filed in the PTO after H's application, and they have a common assignee.
- (E) G's application is filed in the PTO before H's application, and they have a common assignee.

45. You have been asked to draft a patent application based on Figures 1 and 2 provided below. The inventor has provided you with a written disclosure which states that the invention is directed to a toy building element which may be mounted as a dump body on a toy vehicle. According to the inventor's description, the toy building element comprises an open container part and a bottom, said container part and bottom being hingedly interconnected, said bottom being moreover provided with coupling means for coupling with other toy elements. Referring to Figure 1, the inventor's description states that the toy building element (1), which is just called a dump body, consists of two parts which are interconnected via a hinge (2) viz a container part (3) and a bottom (4). The written description further provides that the container part (3) is formed by an upwardly open, box-like unit having a substantially square bottom and four side walls, one of which is considerably lower than the others. In the embodiment shown, the bottom of the container is provided with coupling studs (5) on which toy building elements may be coupled. As described by the inventor, the bottom (4), which is square in its base face, has a plane surface on which the container part (3) rests along its entire circumference when it is tilted down. The surface of the bottom (4) may be provided with well-known means for detachably retaining (not shown) the container part (3) so that "it just takes a small force to tilt the container part." Referring to Figure 2, the inventor's description states "Figure 2 shows the dump body (1) mounted to tilt rearwardly on a toy truck (6), which comprises a bottom (7), wheels (8), and a driver's cab (9)." It is further provided that "on the chassis at the rear end of the truck (6), the truck bottom (7) is equipped with a square, plane face provided with well-known coupling means (not shown) which meet with the well-known coupling means (not shown) positioned on the underside of the bottom (4) of the dump body (1).

Based on the drawings and description provided above, which of the following claims, if any, are in accordance with proper PTO practice and procedure?

- (A) A toy building element for use as a dump body (1) for a toy vehicle, said toy building element comprising an open container part (3) and a bottom (4).
- (B) A toy building element for use as a dump body (1) for a toy vehicle, said toy building element comprising an open container part (3) and a bottom (4), said container part (3) and bottom (4) being hingedly interconnected by a hinge (2).
- (C) A toy building element comprising an open container part and a bottom, said open container part and bottom being hingedly interconnected, said bottom being provided with coupling means for coupling with other toy building elements.
- (D) (A), and (B).
- (E) (A), (B), and (C).

46. On June 22, 1999, you receive a final Office action, dated June 17, 1999, rejecting numerous claims in a patent application that you filed in the PTO. The Office action did not set a shortened statutory period for reply. Following proper PTO practices and procedures, under which circumstances is it most likely your submission of new evidence under 37 CFR § 1.129(a) in support of patentability, along with the appropriate fee, will result in the automatic withdrawal of the finality of the final rejection?

- (A) The application is filed on June 8, 1995, it has an effective filing date of June 8, 1993, and you file the submission on October 14, 1999, one month after you file a Notice of Appeal to the Board of Patent Appeals and Interferences.
- (B) The application is filed on June 7, 1995, it has an effective filing date of June 8, 1993, and you file the submission on October 14, 1999, one month after you file an appeal brief to the Board of Patent Appeals and Interferences.
- (C) The application is filed on June 8, 1995, it has an effective filing date of June 7, 1993, and you file the submission on December 20, 1999.
- (D) The application is filed on June 7, 1995, it has an effective filing date of June 7, 1993, and you file the submission on the same day you file an appeal brief to the Board of Patent Appeals and Interferences.
- (E) (A) and (C).

47. You filed a patent application for a client containing a claim to a composition wherein X is defined as follows: "X is a member selected from the group consisting of elements A, B, and C." The claim is properly rejected under 35 U.S.C. § 102(b) as being anticipated by a reference describing the same composition invention wherein X is element A. The rejection may be properly overcome by:

- (A) Amending the claim by canceling elements B and C because the reference is concerned only with element A.
- (B) Arguing that the reference is not relevant because it lacks elements B and C.
- (C) Amending the claim by canceling element A from the Markush group.
- (D) Amending the claim by changing "consisting of" to "consisting essentially of."
- (E) Amending the claim to redefine X as "being a member selected from the group comprising elements A, B, and C."

48. Which of the following statements is in accordance with proper PTO practice and procedure?

- (A) A claim to a computer which recites that various components, such as motherboard and RAM, which are old in the art, as well as a novel disc drive, is unpatentable under 35 U.S.C. § 102(f) inasmuch as the inventor derived one or more components, and did not himself invent each of the components of the claimed computer.
- (B) Where a patent granted to Able discloses subject matter being claimed in an application filed by Baker undergoing examination, the designation of Able as the sole inventor in Able's patent raises a presumption of inventorship with respect to the subject matter disclosed but not claimed in the patent.
- (C) A terminal disclaimer overcomes a rejection under 35 U.S.C. § 102(e).
- (D) When Able's patent application, filed on June 2, 1999, is rejected based on unclaimed subject matter of a patent granted to Smith on July 6, 1999, on Smith's application filed on February 18, 1997, and the unclaimed subject matter is Able's own invention, Able may overcome a prima facie case by showing that the patent discloses Able's own previous work.
- (E) All of the above.

49. In preparing an application claiming only apparatus to be filed in the PTO, you inadvertently forgot to include a figure in the drawings. While, you did include a brief description of the figure in the written description of the invention in the specification nevertheless the invention of Claim 10 cannot be understood without the omitted figure in the drawings. Only after the application had been filed in the PTO did you realize that the figure was omitted. The application as filed included a proper declaration under 37 CFR § 1.63 signed by the inventor. What document(s), if any, must be filed in the PTO to obtain the original filing date in accordance with proper PTO practice and procedure?

- (A) An amendment deleting the description of the figure and Claim 10, and a petition with the proper fee to have the application accepted without the omitted figure.
- (B) An amendment filed before the first Office action deleting all references to the omitted figure and Claim 10 to have the application accepted without the omitted figure.
- (C) A petition and an amendment to add the figure to the application as soon as possible, and a supplemental declaration stating the omitted figure accurately illustrates and is part of the applicant's invention.
- (D) The omitted figure along with a supplemental oath or declaration stating that the omitted figure accurately illustrates and is part of the applicant's invention.
- (E) An amendment adding the figure to the application.

50. Prior art references have been combined to show obviousness of the claimed invention under 35 U.S.C. § 103. Which of the following most correctly completes the statement: “In establishing obviousness, _____

- (A) a suggestion to modify the art must be expressly stated in one of the references used to show obviousness.”
- (B) a suggestion to modify the art must be expressly stated in all the references used to show obviousness.”
- (C) a suggestion to modify the art may be inherently or implicitly taught in one of the references used to show obviousness.”
- (D) a suggestion to modify the art is unnecessary unless the patent applicant presents evidence or argument tending to show unobviousness.”
- (E) a suggestion to modify the art can come from recent nonanalogous prior art references.”

THIS PAGE INTENTIONALLY BLANK