

Test Number 123  
Test Series 102

**NOT FOR  
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Name \_\_\_\_\_

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

**EXPERIMENTAL**

**AS IS**

**APRIL 17, 2002**

**Morning 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. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the *Official Gazette*, or a notice in the *Federal Register*. Each question has only one most correct answer.. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer that will be accepted. Where two or more choices are correct, the most correct answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement that would make the statement *true*. If it is determined by the USPTO that there is more than one most correct answer to a question, each most correct answer will be accepted, but only one point will be given for the question. The presence of multiple most correct answers does not, in itself, render the question ambiguous. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

You may write anywhere on the examination booklet. However, do not remove any pages from the booklet. Only answers recorded in SECTION 1 of your Answer Sheet will be graded. **YOUR COMBINED SCORE OF BOTH THE MORNING AND AFTERNOON SESSIONS MUST BE AT LEAST 70 POINTS TO PASS THE REGISTRATION EXAMINATION.**

**DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO**

This examination addresses statutes and rules that have been changed as a result of the enactment of the American Inventors Protection Act of 1999, Pub. L. No. 106-113 (“Act”). The 8<sup>th</sup> Edition of the Manual of Patent Examining Procedure should be used. The examination will apply rules that are in effect as April 1, 2002. The rule changes are posted under the heading “Recent Patent-Related Notices” on the USPTO web site ([www.uspto.gov/web/offices/pac/dapp/ogsheet.html](http://www.uspto.gov/web/offices/pac/dapp/ogsheet.html)). A group of rule changes, published in 67 Federal Regulations 520 (January 4, 2002) under the name “Revision of the Time Limit for National Stage Commencement in the United States for Patent Cooperation Treaty Applications,” will be in effect on April 1, 2002. This rule change is also available at the USPTO web site cited above under the heading “Recent Patent Related Notices.”

1. Which of the following is the best way to recite a claim limitation so that it will be interpreted by the examiner in accordance with 35 U.S.C. § 112, paragraph 6?

- (A) dot matrix printer for printing indicia on a first surface of a label.
- (B) dot matrix printer means coupled to a computer.
- (C) means for printing indicia on a first surface of a label.
- (D) printer station for printing indicia on a first surface of a label.
- (E) All of the above.

2. Registered practitioner Pete received on September 13, 2001 a notice of allowance dated September 10, 2001 in a utility application filed December 5, 2000. The client for whom the application is being prosecuted has repeatedly stressed to counsel how valuable the invention is, and that it will remain so throughout the entire life of any patent that should issue. Pete is determined to take no chances with this application, particularly since patent term adjustment has been accumulated and the lack of any action or inaction by applicant that would cause loss of patent term adjustment. Thus, Pete is ready to pay the issue fee on the very day the Notice of Issue Fee Due is received. Before payment of the issue fee, the client faxes Pete information identifies prior art first cited on September 3, 2001 by the foreign office examining a foreign counterpart application. This prior art was not previously cited by another foreign patent office. The invention had been filed with a second foreign office that mailed the same prior art at a later date than the first foreign office. Also, this prior art was previously unknown to the client. The client is very desirous of having this cited art made of record in the file. Which of the following alternatives would best achieve the client's objectives of maximizing patent term and having the foreign cited prior art considered by the USPTO?

- (A) Pete should file a petition for withdrawal from issue of the allowed application for consideration of a request for continued examination based on an information disclosure statement (IDS) and include in the petition an offer to file the request and IDS upon the petition being granted.
- (B) As it is still within three months from the date cited by the foreign office, Pete can submit the prior art in the allowed application up to the last day of the three month period making any required statements and fee payments.
- (C) Pete should submit an IDS citing the prior art in the allowed application within 30 days of the September 3, 2001 mailing by the foreign office with any appropriate fees and statements.
- (D) If, Pete could use the date of mailing by the second foreign office to file the IDS in the allowed application within three months of the communication of prior art by the second foreign office thereby allowing the client extra time to evaluate the allowed claims and still have the IDS entered.
- (E) (B) and (D).

3. Belle Bordeaux files a French patent application for a rejuvenating lotion in the French Patent Office on January 10, 2000. On January 10, 2001, she files a PCT Chapter I Request in the EPO Receiving Office, in which she requests that the European Patent Office act as the International Searching Authority. In her PCT application, Bordeaux claims priority to the French application, and indicates the U.S. as a designated state. Bordeaux makes an appointment to meet with you on June 8, 2001, to discuss filing a patent application in the USPTO on the rejuvenating lotion, in which she wants to claim priority not only to the PCT application, but also the French application. In preparing for your meeting with Bordeaux, you realize that she has several options here, and so you prepare an analysis of the various options, which are detailed below. Before entering the U.S. national stage, Bordeaux wishes to have an official international preliminary search report that indicates claims having the best chance of being patentable. Which of the following will achieve Bordeaux's objective in accordance with proper USPTO practice and procedure?

- (A) Bordeaux should enter the national stage by filing an application under 35 U.S.C. § 371 on or before September 10, 2001.
- (B) Bordeaux should file an application under 35 U.S.C. § 111(a) on or before September 10, 2001, claiming priority under 35 U.S.C. § 120 to the PCT application, and claiming priority under 35 U.S.C. § 119 to the French application.
- (C) Bordeaux should first file a PCT Chapter II Demand in the USPTO on or before August 10, 2001, and then file a provisional application under 35 U.S.C. § 111 on or before September 4, 2001.
- (D) Bordeaux should first file a PCT Chapter II Demand in the USPTO on or before August 10, 2001, and then enter the national stage by filing an application under 35 U.S.C. § 371 on or before July 10, 2002.
- (E) All of the above.

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

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

5. Registered practitioner Joe files a design patent application under 37 CFR 1.53(b) having one claim on May 6, 1999. The USPTO sends Joe a notice of allowance dated November 10, 2000. Joe pays the issue fee on November 15, 2000. On November 23, 2000, Joe learns about a publication (the “Smith Reference”) which he knows to be material to patentability of the claim, but which was not considered by the examiner during prosecution of the application. Joe prepares an information disclosure statement that complies with the provisions of 37 CFR 1.98, listing the Smith reference. Which of the following actions, if taken by Joe on November 24, 2000, will result in a request for continued examination of the application being granted in accordance with USPTO rules and procedure?

- (A) Filing a request for continued examination of the application with the information disclosure statement listing the Smith Reference, without the fee set forth in 37 CFR 1.17(e).
- (B) Filing a request for continued examination of the application with the information disclosure statement listing the Smith Reference, and the fee set forth in 37 CFR 1.17(e).
- (C) Filing a request for continued examination of the application with the information disclosure statement listing the Smith Reference, the fee set forth in 37 CFR 1.17(e), and a petition under 37 CFR 1.313 with the fee set forth in 37 CFR 1.17(h).
- (D) (B) or (C) above.
- (E) None of the above.

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

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

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

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

8. On March 20, 2000, Patsy Practitioner filed a patent application on widget Y for the ABC Company based on a patent application filed in Germany for which benefit of priority was claimed. The sole inventor of widget Y is Clark. On September 13, 2000, Patsy received a first Office action on the merits rejecting all the claims of widget Y under 35 U.S.C. § 103(a) as being obvious over Jones in view of Smith. When reviewing the Jones reference, Patsy notices that the assignee is the ABC Company, that the Jones patent application was filed on April 3, 1999, and that the Jones patent was granted on January 24, 2000. Jones does not claim the same patentable invention as Clark's patent application on widget Y. Patsy wants to overcome the rejection without amending the claims. Which of the following replies independently of the other replies would not be in accordance with proper USPTO practice and procedures?

- (A) A reply traversing the rejection by correctly arguing that Jones in view of Smith fails to teach widget Y as claimed, and specifically and correctly pointing out claimed elements that the combination lacks.
- (B) A reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.131 that antedates the Jones reference.
- (C) A reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.132 containing evidence of criticality or unexpected results.
- (D) A reply traversing the rejection by stating that the invention of widget Y and the Jones patent were commonly owned by ABC Company at the time of the invention of widget Y, and therefore, Jones is disqualified as a reference via 35 U.S.C. § 103(c).
- (E) A reply traversing the rejection by perfecting a claim of priority to Clark's German application, filed March 21, 1999, disclosing widget Y under 35 U.S.C. § 119(a)-(d).

9. Which of the following is not in accord with proper USPTO practice and procedure?

- (A) A written description as filed in a nonprovisional patent application is presumed adequate under 35 U.S.C. § 112 in the absence of evidence or reasoning to the contrary.
- (B) An examiner may show that a written description as filed in a nonprovisional patent application is not adequate by presenting a preponderance of evidence why a person of ordinary skill in the art would not recognize in the applicant's disclosure a description of the invention defined by the claims.
- (C) A general allegation of "unpredictability in the art" is sufficient to support a rejection of a claim for lack of an adequate written description.
- (D) When filing an amendment, a practitioner should show support in the original disclosure for new or amended claims.
- (E) When there is substantial variation within a genus, an applicant must describe a sufficient variety of species to reflect the variation within the genus.

10. A nonprovisional patent application was filed by a registered practitioner in the USPTO with a declaration under 37 CFR 1.63. The declaration named the individuals known to the practitioner to be the inventors of the claimed invention, but the declaration was not signed by any of the individuals. Within two weeks of the filing the application, the practitioner discovered that there is one more individual, who was not named on the unexecuted declaration, who is an inventor in the claimed invention. Which of the following actions, if undertaken by the practitioner, would properly correct the inventorship in the patent application?

- (A) File a new declaration under 37 CFR 1.63, identifying all the inventors including the newly discovered inventor, which is signed by each of the inventors.
- (B) File only a letter requesting that the inventorship be changed to add the newly discovered inventor.
- (C) File a petition under 37 CFR 1.48(a) for correction of inventorship. The petition contains only a request to add the newly discovered inventor. File with the petition (1) a new oath or declaration identifying and signed by only the newly discovered inventor, and (2) the petition fee set forth in 37 CFR 1.17(i).
- (D) File a petition under 37 CFR 1.48(a) for correction of inventorship consisting only of a request to add the newly discovered inventor, a statement by the newly discovered inventor that the error occurred without deceptive intention on his part and a petition fee set forth in 37 CFR 1.17(i).
- (E) All of the above.

Questions 11 and 12 are based on the following factual background. Consider questions 11 and 12 independently of each other.

Applicant files a patent application in Japan on February 28, 1996. Applicant files a PCT international application designating the United States on February 27, 1997, based on the Japanese application. The international application is published in English on August 28, 1997. The international application enters the national stage in the United States on August 28, 1998. The USPTO publishes the application on June 7, 2001 at the request of the applicant. The application issues as a United States patent on December 4, 2001.

11. When examining an application filed on or after November 29, 2000 or any application that has been voluntarily published, what is its earliest possible prior art date, for the June 7<sup>th</sup> U.S. published application in view of 35 U.S.C. § 102(e) as amended by the American Inventors Protection Act of 1999?

- (A) February 28, 1996.
- (B) February 27, 1997.
- (C) August 28, 1997.
- (D) August 28, 1998.
- (E) June 7, 2001.

12. For the United States patent, what is the patent's earliest date, for prior art purposes as a patent, in view of the amendment to 35 U.S.C. § 102(e) by the American Inventors Protection Act of 1999?

- (A) February 28, 1996.
- (B) February 27, 1997.
- (C) August 28, 1997.
- (D) August 28, 1998.
- (E) December 4, 2001.

13. Which of the following could never qualify as a small entity under 37 CFR 1.27 for certain fee reductions?

- (A) A nonprofit organization.
- (B) A two-person business concern with a \$4,000,000 income.
- (C) A federal government agency.
- (D) A university in Canada.
- (E) A person.

14. Which of the following is not in accord with proper USPTO practice and procedure regarding *ex parte* reexaminations filed in March 2001?

- (A) In every instance of an interview with an examiner in an *ex parte* reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner.
- (B) Third party requesters have the option of attending interviews, but their presence is not mandatory.
- (C) A patent owner's reply to an outstanding Office action after the interview does not remove the necessity for filing the written statement of the reasons presented at the interview as warranting favorable action.
- (D) The written statement must be filed as a separate part of a reply to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.
- (E) An interview does not remove the necessity for reply to Office actions as specified in 37 CFR 1.111.

15. Able is a registered solo practitioner. Ben asks Able to prepare and prosecute an application for a utility patent. As part of the application, Able prepares a declaration and power of attorney, which Ben reviews and signs. Able files the application, the declaration, and power of attorney with the USPTO. Able quickly recognizes that help is necessary and contacts another registered practitioner, Chris, who often assists Able in such instances. Able, with Ben's consent, sends a proper associate power of attorney to the Office for Ben's application and directs that correspondence be sent to Chris. The examiner in the application takes up the application in the regular course of examination and sends out a rejection in an Office action. Chris sends a copy of the action to Ben to obtain Ben's comments on a proposed response. Unfortunately, after the first Office action, Able becomes terminally ill and dies. Ben does not know what to do, so Ben calls the examiner at the number on the Office action and explains that A died and Ben is worried how to proceed. Which of the following statement(s) is/are true?

- (A) Chris should inform Ben that the Office will not correspond with both the registered representative and the applicant and therefore, Ben should not have any further contact with the Office and let Chris send in a proper response.
- (B) Ben should send in a new power of attorney for anyone Ben intends to represent him before the Office.
- (C) Ben should execute and sent to the USPTO a new power of attorney for any registered patent practitioner that Ben intends to have represent him before the Office.
- (D) (B) and (C).
- (E) None of the above.

16. Jill, a registered patent agent, receives a Notice of Allowance from the USPTO with a mail date of November 13, 2001, regarding a utility patent application for an improved garden hose which she had filed on behalf of one of her small entity clients. The Notice of Allowance specifies a sum that must be paid within three months of the mailing date to avoid abandonment. The sum specified includes both the issue fee and the publication fee. As a result of a small fire in her office building, Jill is unable to resurrect her files until the last day of the three month period. Jill mails a letter to the USPTO on February 13, 2002 using the U.S. Postal Service. Jill does not employ the procedures of 37 CFR 1.8 or 1.10 to mail the letter. The letter is received in the USPTO on February 15, 2002. The letter correctly identifies the application. The letter authorizes the USPTO to charge the proper issue fee for a small entity to her deposit account. The account has been identified in a previously filed authorization to charge fees. At the time the letter was filed in the USPTO, the account had a balance of \$1000.00 in funds. Nothing in the letter authorized payment of the publication fee, no petition for an extension of time was filed, and an Office-provided issue fee transmittal form was not filed. No postal emergency was involved in filing the letter. Which of the following statements accords with proper USPTO practice and procedure?

- (A) The application will become abandoned because Jill did not authorize payment of the publication fee.
- (B) The application will not become abandoned because the authorization to charge fees operates as a request to charge the correct fees to any deposit account identified in a previously filed authorization to charge fees.
- (C) The application will become abandoned because Jill's letter did not include a petition for an extension of time accompanied by the proper fee.
- (D) The application will become abandoned because a completed Office-provided issue fee transmittal form, PTOL-85B, did not accompany Jill's letter.
- (E) The application will become abandoned because Jill's letter was not timely filed in the USPTO and it was not mailed in accordance with the provisions of 37 CFR 1.8 or 1.10.

17. Which one of the following applications is eligible for Patent Term Adjustment under the Patent Term Guarantee Act of 1999?

- (A) A plant application filed June 8, 1995.
- (B) A utility application filed June 8, 1995.
- (C) A design application filed May 29, 2000.
- (D) A continued prosecution application (CPA) filed on June 6, 2001 where the CPA is based upon a plant application originally filed on February 2, 2000.
- (E) A utility application originally filed on February 2, 2000 when a request for continued examination (RCE) was filed on June 6, 2001.

18. To satisfy the written description requirement of the first paragraph of 35 U.S.C. § 112, an applicant must show possession of the invention. An applicant's lack of possession of the invention may be evidenced by:

- (A) Describing an actual reduction to practice of the claimed invention.
- (B) Describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.
- (C) Requiring an essential feature in the original claims, where the feature is not described in the specification or the claims, and is not conventional in the art or known to one of ordinary skill in the art.
- (D) Amending a claim to add a limitation that is supported in the specification through implicit or inherent disclosure.
- (E) Amending a claim to correct an obvious error by the appropriate correction.

19. On June 9, 2000, you file two complete patent applications on behalf of your client, ABC Inc. The subject matter of the patent applications relates to a new automotive body design. One of the applications is filed as a utility application (A#1), and other is filed as a design application (A#2). Prosecution of each application moves forward independently of each other, and you receive final office actions in each application rejecting the respective claim(s) in each application. Your client, in consultation with you, decides that she would rather pursue prosecution in each case rather than appeal the final rejections. Which of following options is available to you under the USPTO rules and procedures ?

- (A) File a request for continuing examination (RCE) for both A#1 and A#2.
- (B) File a request for continuing examination (RCE) for A#1 and a continuing prosecution application (CPA) for A#2.
- (C) File a request for continuing examination (RCE) for A#2 but not A#1.
- (D) File a continuing prosecution application (CPA) for both A#1 and A#2.
- (E) File a continuing prosecution application (CPA) for A#1 but not A#2.

20. J. Q. Practitioner represents the IMAKECOPY Corp., which is an importer of widgets into the USA. At the request of his client, J. Q. Practitioner is reviewing the prosecution history of a published patent application filed under 35 U.S.C. § 111, that contains process claims for making widgets and other claims directed to the widget products. The application lists Rob M. Blind as the inventor and Wesue Corp. as the assignee. Rob M. Blind is an employee of the Wesue Corp. which is a competitor of the IMAKECOPY Corp. The prosecution history of the published patent application contains a restriction requirement made by the examiner followed by an election of the process claims by the applicant, and cancellation of the non-elected product claims. No related patent applications are referenced in the published patent application or its prosecution history. A search of public USPTO databases indicates no divisional patent application has been published or issued as a patent. J. Q. Practitioner wants to obtain more information concerning the cancelled product claims. Which of the following statements is true?

- (A) J. Q. Practitioner cannot obtain other information because no information about pending unpublished applications is available under 35 U.S.C. § 122, except for previously filed applications.
- (B) J. Q. Practitioner may obtain a copy of the originally filed application and a copy of all unpublished divisional applications containing the non-elected product claims.
- (C) J. Q. Practitioner may obtain a copy of all unpublished applications including their prosecution histories for any patent application containing the non-elected product claims.
- (D) J. Q. Practitioner may file a written request for the File Information Unit (FIU) to ascertain if there are any earlier or subsequently filed applications claiming benefit under 35 U.S.C. § 120 of the published application and their status.
- (E) J. Q. Practitioner may request, either in person or in writing, that the File Information Unit (FIU) ascertain and disclose if there are any subsequently filed applications claiming benefit under 35 U.S.C. § 120 of the published application and their status.

21. Company X competes with Patentee Y. In response to an accurate notification from Company X, acting as a third party, that Patentee Y's patent contains a printing error, incurred through the fault of the USPTO, the USPTO:

- (A) must issue a certificate of correction.
- (B) must reprint the patent to correct the printing error.
- (C) need not respond to Company X.
- (D) should include Company X's notification in the patent file.
- (E) must notify Company X of any USPTO decision not to correct the printing error.

22. A patent application filed in the USPTO contains the following dependent claim:

Claim 2. The method of Claim 1, further consisting of the step of cooling the mixture to a temperature of 32° F.

Following proper USPTO practices and procedures, from which of the following claims does Claim 2 not properly depend?

- (A) Claim 1. A method of making liquid compound A consisting of the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (B) Claim 1. A method of making liquid compound A comprising the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (C) Claim 1. A method of making liquid compound A including the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (D) Claim 1. A method of making liquid compound A characterized by the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (E) (C) and (D).

23. An international application designating the United States is filed with the USPTO in its capacity as a Receiving Office, which properly accords the application an international filing date of 02 August 2001. The application properly claims priority solely to an earlier British application filed 02 August 2000. A Demand was not filed within 19 months from this priority date. On 10 April 2002, applicant filed a “Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Filing Under 35 U.S.C. § 371” (Form PTO-1390), which identified the international application, and was accompanied by payment in full of the basic national fee. An oath or declaration, as required under 35 U.S.C. § 371(c)(4), was not submitted. As of 10 April 2002, the U.S. national stage application was:

- (A) Abandoned for failure to submit the basic national fee within 20 months from the priority date.
- (B) Abandoned for failure to submit the basic national fee and copy of the international application within 20 months from the priority date.
- (C) Abandoned for failure to submit the basic national fee, copy of the international application, and oath or declaration within 20 months from the priority date.
- (D) Abandoned for failure to submit the basic national fee within 20 months from the international filing date.
- (E) Not abandoned.

24. Mr. Brick, the inventor, files an application with the USPTO on January 2, 2001 containing a single claim for his invention: a new bouncing ball called “Y”. Brick receives a first Office action dated June 4, 2001 from the primary examiner handling Brick’s application. The examiner rejected Brick’s claim only under 35 U.S.C. § 103 on the grounds that Reference X teaches a bouncing ball called “Q,” and that although “Y” and “Q” are not the same, it would have been obvious to one of ordinary skill to make changes to the “Q” ball in order to obtain a ball just like Brick’s “Y” ball.

On August 2, 2001, Brick responds by stating that his new “Y” ball bounces unexpectedly higher than the “Q” ball described in Reference X. Brick includes a declaration, signed by Mrs. Kane, that includes extensive data comparing the bouncing results for the “Y” and “Q” balls and showing that the “Y” ball bounces unexpectedly higher than the “Q” ball. Brick argues that the rejection under 35 U.S.C. § 103 should be withdrawn because he has proven that, in view of the unexpectedly higher bounce of the “Y” ball as compared to the “Q” ball, it would not have been obvious to one of ordinary skill in the art to make changes to the “Q” ball to obtain Brick’s “Y” ball.

On October 2, 2001, Brick receives a final rejection from the examiner. The rejection states, in its entirety: “The response has been reviewed but has not been found persuasive as to error in the rejection. The claim is finally rejected under 35 U.S.C. § 103 for the reasons given in the first Office action.” Brick believes he is entitled to a patent to his new bouncing ball “Y.” How should Brick proceed?

- (A) Brick should give up because the declaration did not persuade the examiner of the merits of Brick’s invention.
- (B) Brick should timely file a Request for Reconsideration asking the examiner to reconsider the rejection on the basis of the Kane declaration and, as a precaution against the Request for Reconsideration being unsuccessful, also timely file a Notice of Appeal.
- (C) Brick should respond by submitting a request for reconsideration presenting an argument that Reference X does not provide an enabling disclosure for a new ball with the unexpectedly higher bounce of his “Y” ball.
- (D) Brick should respond by submitting a request for reconsideration presenting an argument that Reference X does not provide a written description for a new ball with the unexpectedly higher bounce of his “Y” ball.
- (E) Brick should respond by submitting a request for reconsideration presenting an argument the declaration data proves that the “Q” ball and the “Y” are not identical.

25. John filed a utility patent application for a high strength steel composition on June 9, 1997. During prosecution of the application, an interference under 35 U.S.C. § 135(a) was declared on June 9, 1998 between John's application and an unexpired patent. Subsequently, the interference was terminated in John's favor on June 9, 2000. The year 2000 was a leap year having 366 days. Ultimately, John's application was allowed and issued as a patent on June 12, 2001. Based on proper USPTO practice and procedure, and absent any other events necessitating adjustment of the patent term, when should John's patent expire?

- (A) Twenty (20) years from issue date.
- (B) Twenty (20) years and one day from filing date.
- (C) Twenty (20) years plus three years inasmuch as granting of the patent was delayed by the interference.
- (D) Twenty (20) years plus the number of days in the period beginning the date prosecution is suspended in another application that is not in the interference, but is related to the application in interference.
- (E) Twenty (20) years plus the period beginning on the date the interference was declared and ending on the date that the interference was terminated with respect to the application.

26. Which of the following is not in accord with proper USPTO practice and procedure?

- (A) If a practitioner, "by mistake," files an application and basic filing fee, the submission of the filing fee with the application is treated by the Office as not a fee paid by mistake, and the fee will not be refunded.
- (B) If, in April 2001, a practitioner files an application, properly establishes the applicant's small entity status, and "by mistake" pays the filing fee by submitting a check drawn in the amount that is twice the amount of the small entity filing fee, a refund of the excess fee may be obtained upon request filed any time during pendency of the application and life of any patent granted on the application.
- (C) The paragraphs of the specification of an original utility patent application filed in January 2001 may, but are not required to be numbered at the time the application is filed.
- (D) If a provisional application is filed in a language other than English, an English language translation of the non-English language provisional application will not be required in the provisional application.
- (E) If a table having more than 50 pages of text is submitted on compact disc, the specification of a patent application must contain an incorporation-by-reference of the material on a compact disc in a separate paragraph, identifying each compact disc by the names of the files contained on each compact disc, their date of creation, and their sizes in bytes.

Questions 27 through 29 are based on the following factual background. Consider questions 27 through 29 independently of each other.

James Salt developed an environmentally friendly technique for controlling deer overpopulation. Briefly, Salt discovered a non-hormonal substance XYZ (“Antiagra”) that efficiently suppresses sexual function in male deer with minimal side effects. Salt determined that the use of a non-hormonal substance eliminated adverse long-term health effects that may be experienced with hormonal substances. He then dissolved an effective amount of Antiagra in salt water, poured the resulting solution into a plurality of twenty-gallon tubs, and heated the tubs to evaporate the water. The resulting blocks of salt, throughout which Antiagra was evenly disbursed, were distributed in overpopulated areas during deer mating season to serve as salt licks. Stags that used the salt lick show no interest in mating, thereby lowering the pregnancy rate among does and helping to control the deer population. Salt has retained you to conduct a prior art search and, if appropriate, prepare and file a patent application. The only relevant prior art located during the prior art search is a patent to Deere that discloses a salt lick on which a hormonal substance is sprayed. A doe that uses the salt lick ingests the hormonal substance which, in turn, suppresses ovulation and thereby reduces the pregnancy rate. You prepare and file a patent application that provides a fully enabling disclosure and includes four claims sets. Claims 1-5 are directed specifically to the non-hormonal substance (Antiagra), claims 6-9 are directed to a salt lick laced with a non-hormonal substance that, when ingested by a male deer, suppresses sexual function in the male deer, claims 9-14 are directed to the method of forming the salt lick, and claims 14-20 are directed to a method for controlling deer population by distributing salt licks that are treated with an effective amount of XYZ to reduce pregnancy rates. You also properly establish small entity status on behalf of Salt at the time the application is filed.

27. Upon initial examination, the patent examiner issues a requirement for restriction on the basis that the application claims two or more independent and distinct inventions. Specifically, the examiner requires an election between (a) claims directed to the non-hormonal substance *per se* (claims 1-5); (b) claims directed to the salt lick and to the method of forming the salt lick (claims 6-14); and (3) claims directed to the method of controlling deer population by distributing salt licks that are treated with XYZ to reduce pregnancy rates (claims 15-20). The restriction requirement was set forth in an Office action dated December 12, 2001, and the examiner set a one month (not less than 30 days) shortened statutory period for response. December has 31 calendar days. Which of the following is most likely to be treated by the USPTO as a timely, fully responsive reply to the Office action.

- (A) You contact the examiner on the telephone on December 27, 2001 and make an oral election of the subject matter of claims 6-14 without traverse, and request cancellation of claims 1-5 and 15-20 without prejudice to resubmission of those claims in a continuation application. You do not, however, subsequently confirm the substance of the telephone conversation in writing and the examiner does not complete an Interview Summary Record.
- (B) On February 12, 2002, you file a Reply to Office Action, a Petition for One Month Extension of Time and all necessary fees. The Reply to Office Action traverses the restriction requirement on the basis that the requirement would force the small entity applicant to file multiple patent applications and is therefore unduly burdensome. The Reply to Office Action requests reconsideration of the restriction without making an election.
- (C) On February 12, 2002, you file a Reply to Office Action, a Petition for Two Month Extension of Time and all necessary fees. The Reply to Office Action does not make an election. Instead, the Reply to Office Action traverses the restriction requirement and requests reconsideration of the restriction without specifically pointing out the supposed errors in the examiner's action.
- (D) On February 14, 2002, you file a Reply to Office Action, a Petition for One Month Extension of Time and all necessary fees. The Reply to Office Action traverses the restriction requirement on the basis that the claims as originally presented in a single application do not pose a serious burden on the examiner, and therefore requests reconsideration of the election requirement. The Reply to Office Action provisionally elects the subject matter of claims 6-14. There is no authorization to charge a deposit account.
- (E) On February 12, 2002, you file a Reply to Office Action, a Petition for One Month Extension of Time and all necessary fees. The Reply to Office Action elects claims 6-14 without traverse.

28. Claim 6 of the application reads: “A composition for reducing the pregnancy rate among wild deer population, said composition comprising salt and a non-hormonal substance that, when ingested by a male deer, is operable to suppress sexual function in the male deer.” Claim 7 reads: “The composition of claim 6, wherein said non-hormonal substance is XYZ.” Claim 8 reads, “The composition of claim 6, wherein said composition is formed in a block and wherein said non-hormonal substance is interspersed substantially evenly throughout said block.” Each of these claims is fully supported by the specification. An Office action is mailed March 15, 2002. Claim 6 was rejected under 35 U.S.C. § 103 as being unpatentable over the Deere patent. Which of the following arguments, if presented in a timely reply to the March 15 Office action, is most likely to persuade the examiner to remove the § 103 rejection without presenting unpersuasive arguments?

- (A) “The invention of claim 6 provides an advantageous feature in that the substance that helps reduce the pregnancy rate is interspersed throughout the salt lick. Thus, the present invention is effective to reduce the pregnancy rate in deer so long as any portion of the salt lick is available to deer. In contrast, the Deere patent utilizes a substance that is sprayed on the outer surface of the salt lick and, therefore, is effective only so long as the outer portion of the salt lick is available.”
- (B) “The invention of claim 6 provides an advantageous feature in that the substance that helps reduce the pregnancy rate is interspersed throughout the salt lick. Thus, the present invention is effective to reduce the pregnancy rate in deer so long as any portion of the salt lick is available to deer. In contrast, the Deere patent utilizes a substance that is sprayed on the outer surface of the salt lick and, therefore, is effective only so long as the outer portion of the salt lick is available.”
- (C) “In contrast to the present invention, the Deere patent calls for the use of a hormonal substance that suppresses ovulation in female deer. Deere neither discloses nor suggests the use of a non-hormonal substance that, when ingested by a male deer, is operable to suppress sexual function in the male deer, as set forth in claim 6.”
- (D) “The present invention relates to a technique for reducing deer overpopulation by causing male deer to ingest a novel substance (XYZ) that is operable to suppress sexual function in the male deer. The Deere patent neither discloses nor suggests such a technique and, therefore, claim 6 is neither anticipated nor rendered obvious by the Deere patent.”
- (E) “Applicant was aware of the Deere patent prior to filing of the present application, and the claims were carefully drafted to distinguish the present invention over the Deere patent. Accordingly, reconsideration and withdrawal of the § 103 rejection of claim 6 is respectfully requested.”

29. Claim 15 of the application reads: “A method for reducing pregnancy rate in wild deer population comprising the step of placing at least one salt lick containing an effective amount of XYZ in a location accessible to wild male deer so that XYZ is ingested by said male deer.” The specification provides adequate disclosure as to what constitutes an “effective amount” of XYZ. In addition to the Deere patent, the examiner locates a prior art patent to John Doe that discloses the non-hormonal substance XYZ for use as a softening agent in skin cream. There is no disclosure or suggestion in the Doe patent of any other potential use for XYZ. Which of the following statements is most consistent with proper USPTO practice and procedure?

- (A) The Examiner may properly reject claim 15 under 35 U.S.C. §103 as being obvious over Deere in view of Doe because Deere teaches the method of distributing salt licks treated with a substance to reduce pregnancy rates and suppression of sexual activity in male deer is merely an inherent characteristic of a known substance XYZ.
- (B) The examiner may not rely on the Doe patent in a 35 U.S.C. § 103 obviousness rejection because there is no evidence that Salt was aware of its teachings at the time the invention was made and therefore the invention could not have been obvious to Salt at that time.
- (C) The examiner may rely on the Doe patent in making an obviousness rejection under 35 U.S.C. § 103 only if the Doe patent is in the field of Salt’s endeavor or, if not in that field, then reasonably pertinent to the problem with which Salt was concerned.
- (D) The examiner may properly reject claim 15 under the first paragraph of 35 U.S.C. § 112 because the specification is inadequate to enable a person skilled in the art to which it pertains to practice the invention.
- (E) The examiner may properly reject claim 15 under the second paragraph of 35 U.S.C. § 112 because the recitation of “an effective amount of XYZ” renders the claim indefinite.

30. The following statements relate to “multiple dependent claims.” Which statement is not in accord with proper USPTO practice and procedure?

- (A) A multiple dependent claim contains all the limitations of all the alternative claims to which it refers.
- (B) A multiple dependent claim contains in any one embodiment only those limitations of the particular claim referred to for the embodiment under consideration.
- (C) A multiple dependent claim must be considered in the same manner as a plurality of single dependent claims.
- (D) Restriction may be required between the embodiments of a multiple dependent claim.
- (E) The limitations or elements of each claim incorporated by reference into a multiple dependent claim must be considered separately.

31. Which of the following practices or procedures may be properly employed to overcome a rejection properly based on 35 U.S.C. § 102(a)?

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

32. Johnnie owns a supermarket store in Cleveland, Ohio, and is constantly frustrated when little children drop their chewing gum on Johnnie's clean floor in the supermarket. In her spare time, Johnnie develops an entirely novel type of coating material that she applies to floor tile. The coating material resists adhesion to chewing gum. In order to check out the effectiveness of the floor tile coating material, on December 31, 2000, she secretly covers the floor tiles in her supermarket with the new chewing gum resistant floor tile coating material. Johnnie is amazed at the results inasmuch as cleaning the floor was never easier. On January 30, 2001, Johnnie, satisfied with the experimental use results, ceased testing the use of the coating material. The ability of the coating material to withstand chewing gum adhesion continued unabated throughout the remainder of 2001. On January 1, 2002, one of Johnnie's many customers, James, remarked at how clean the floor looked. Johnnie then told James of her invention. James thinks for one moment and suggests that the floor tile coating material may be useful in microwave ovens, so that food will not stick to the interior sides of the microwave oven. James discusses getting patent protection with Johnnie. Which of the following is true?

- (A) Johnnie could never be entitled to a patent on a floor tile in combination with a coating material affixed to the outer surface of the tile.
- (B) James can be named as a coinventor with Johnnie in a patent application claiming a microwave oven wherein the internal surfaces of the oven are coated with the coating material.
- (C) Since for one year Johnnie told nobody that the floor tile in her supermarket contained the new chewing gum resistant coating material, she would never be barred from obtaining patent protection for the floor coating material.
- (D) Use of the floor tile coating material in microwave ovens would have been obvious to one of ordinary skill in the art, since James thought of it within seconds after first learning of the floor tile coating material, and James was not skilled in the art.
- (E) The floor tile having the coating material affixed to the outer surface of the tile, an article of manufacture, would not be patentable as of January 1, 2002 inasmuch as the article was in public use on the supermarket floor for one year.

33. Which of the following may properly be required to submit information in reply to a requirement for information under 37 CFR 1.105 in a patent application filed in December 2002?

- (A) A named inventor in the application.
- (B) An assignee of the entire interest in the application.
- (C) An attorney who prepares and prosecutes the application.
- (D) All of the above.
- (E) (A) or (C).

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

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

35. Joe Inventor received a patent in July 1999, containing claims to both an article and an apparatus. When filed in the USPTO, the application contained disclosure of a method, but the method was not claimed. The patent contained the same disclosure of the method, but the method had never been claimed in the application. In May 2001, Joe asks Pete Practitioner to file a reissue application to add claims to the method disclosed in the specification. Once filed, which of the following will most likely occur during the prosecution of the reissue application in accordance with published USPTO practice and procedure?

- (A) The examiner should reject the added method claims on the basis of not being for the invention claimed in the original patent, under 35 U.S.C. § 251, citing *In re Rowand*, 187 USPQ 487, and allow the original unamended article and apparatus patent claims in the reissue application.
- (B) Following a restriction requirement by the examiner in the reissue application, the original unamended article and apparatus patent claims will be constructively elected, examined, and, if found allowable, passed to issue, while the non-elected method claims should be filed in a divisional application.
- (C) Following a restriction requirement in the reissue application and the filing of a divisional application to claim the method, the applicant should request a duplicate copy of the original patent so that a copy of said patent can be surrendered in each reissue application.
- (D) Following a restriction requirement by the examiner in the reissue application, the original unamended article and apparatus patent claims will be considered constructively elected; if after examination they become allowable in unamended form, they will be held in abeyance in a withdrawn status inasmuch as no “error” under 35 U.S.C. § 251 exists, while Joe prosecutes the claims to the method in a divisional application.
- (E) A three-way restriction requirement among the article, apparatus and method claims should be made by the examiner in the reissue application, and an election made by applicant. Each invention should issue in a separate reissue patent.

36. Which of the following is not a USPTO recommendation or requirement?

- (A) Product and process claims should be separately grouped.
- (B) Claims should be arranged in order of scope so that the first claim presented is the least restrictive.
- (C) Every application should contain no more than three dependent claims.
- (D) A claim which depends from a dependent claim should not be separated from that dependent claim by any claim which does not also depend from the dependent claim.
- (E) Each claim should start with a capital letter and end with a period.

37. Select from the following an answer which completes the following statement, such that the completed statement accords with proper USPTO practice and procedure: “When the reference in question is a noncommonly owned U.S. patent claiming the same invention as applicant, and its issue date is \_\_\_\_\_”

- (A) less than one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of requesting an interference.
- (B) exactly one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of requesting an interference.
- (C) more than one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of requesting an interference.
- (D) less than one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of affidavit or declaration “swearing back” of reference.
- (E) less than one year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, is by way of affidavit or declaration traversing the ground of rejection.

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

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

39. You are deciding whether to file continued prosecution applications (CPA) for prior applications before the earliest of payment of any issue fee on the prior application (and absent any petition under 37 CFR 1.313(c)), abandonment of the prior application, or termination of proceedings on the prior application. In which of the following circumstances is it proper to use the CPA procedure to file the application?

- (A) To file a continuation-in-part application of a prior complete nonprovisional utility application filed under 35 U.S.C. § 111(a). The nonprovisional application has an actual filing date prior to November 29, 1999.
- (B) To file a divisional application of a prior complete provisional application for a utility invention filed under 35 U.S.C. § 111(b). The provisional application has an actual filing date after June 8, 1995.
- (C) To file a continuation utility application of a prior complete nonprovisional utility application filed under 35 U.S.C. § 111(a). The nonprovisional application has an actual filing date prior to May 29, 2000.
- (D) To file a continuation utility application of a prior complete CPA utility application. The prior CPA application has an actual filing date of June 1, 2000, and is a continuation application of a prior complete utility application filed under 35 U.S.C. § 111(a) having an actual filing date of November 28, 1999.
- (E) To file a divisional application of a prior complete nonprovisional plant application filed under 35 U.S.C. § 111(a). The nonprovisional application has an actual filing date after May 29, 2000.

40. Which of the following identifications of document(s) set forth in a return postcard that is stamped and returned by the USPTO will suffice for the postcard receipt to serve as *prima facie* evidence of the USPTO's receipt of the document(s) specified where the USPTO cannot locate the document(s)?

- (A) For all pages of a complete new application **B** an identification stating: "the items listed in the transmittal letter that accompanied the application", where the registered practitioner can furnish a copy of the transmittal letter, and where the transmittal letter contained a list of the component parts of a complete application.
- (B) For all pages of a complete new application **B** an identification stating: "a complete application".
- (C) For all pages of a complete new application containing the following components **B** an identification stating: "specification (including written description, claims and abstract), drawings, declaration".
- (D) For two sheets of drawings **B** an identification stating "2 sheets of drawings".
- (E) All of the above.

41. Regarding an affidavit or declaration filed pursuant to 37 CFR 1.131, which of the following statements is incorrect?

- (A) The affidavit or declaration may establish a date of completion of applicant's claimed invention before January 1, 1996 in a NAFTA country or before December 8, 1993 in a WTO member country other than a NAFTA country.
- (B) The affidavit or declaration cannot be used to overcome a rejection under 35 U.S.C. § 102(e) based on a U.S. patent which claims the same patentable invention as defined in 37 CFR 1.601(n).
- (C) The affidavit or declaration may be used to overcome a rejection under 35 U.S.C. § 103 based on reference to a foreign patent which qualifies as prior art under 35 U.S.C. § 102(a).
- (D) The affidavit or declaration containing references to notebook entries may properly include reproductions of the notebook entries, as opposed to the original notebook pages.
- (E) The affidavit or declaration must show facts establishing reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to subsequent actual reduction to practice or to the filing of the application.

42. Applicant Homer filed a nonprovisional utility application on December 3, 2001 with 3 sheets of drawings. He received a non-final Office action on the merits on March 1, 2002 rejecting all claims under 35 U.S.C. § 102(b) with reference A and including objections to the drawings. The Office action set a shortened statutory period of 3 months for reply. Homer wants to submit several references in an information disclosure statement (IDS) for the examiner's consideration. Under proper USPTO practices and procedures which of the following actions, if taken, would avoid abandonment?

- (A) Homer timely files a continued prosecution application under 37 CFR 1.53(d) with an IDS and required fees.
- (B) Homer timely files a request for continued examination under 37 CFR 1.114 with an IDS and required fees.
- (C) Homer timely files a request for suspension of action under 37 CFR 1.103 with an IDS and required fees.
- (D) Homer timely files a photocopy of the originally filed claims with proposed amendments marked in red, arguments that support the claims are patentable over the reference, proposed drawing corrections, an IDS, and any required fees or certification.
- (E) Homer timely files conclusory arguments that the examiner's rejection is without merit and has no statutory basis.

43. The Commissioner may issue a certificate of correction to correct a mistake in a patent, incurred through the fault of the Office:

- (A) only if demanded by a third party having standing with the Office and the third party pays the fee required by 37 CFR 1.20(a).
- (B) without notifying the patentee, (including any assignee of record) if the correction is of a nature that the meaning intended is obvious from the context of the portion of the patent where the mistake occurs.
- (C) only if the request for correction relates to a patent involved in an interference.
- (D) acting *sua sponte*, after first notifying the patentee, for mistakes that the Office discovers.
- (E) only if patentee or the patentee's assignee makes a request.

44. An amendment filed in January 8, 2002, in an unassigned nonprovisional application seeks to cancel claims so that fewer than all of the currently named inventors are the actual inventors of the invention being claimed. The amendment includes a request to delete the names of the persons who are not inventors. In accordance with proper USPTO rules and procedure, the request may be signed by which of the following?

- (A) A registered practitioner not of record who acts in a representative capacity under 37 CFR 1.34(a).
- (B) All of the applicants (37 CFR 1.41(b)) for patent.
- (C) A registered practitioner of record appointed pursuant to 37 CFR 1.34(b).
- (D) (B) and (C).
- (E) (A), (B), and (C).

45. Which of the following practices or procedures may be properly employed to overcome a rejection properly based on 35 U.S.C. § 102(e)?

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

46. A product-by-process claim is properly rejected over a reference under 35 U.S.C. § 102(b). Which of the following statements is incorrect?

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

47. Xavier residing in Canada, a NAFTA country, files an application for a Canadian patent Monday, September 18, 2000. At the same time, Xavier forwards a copy of the Canadian application to registered practitioner Young in the United States, asking that Young prepare a U.S. application based on the Canadian application and claim the benefit of the Canadian filing. Young advises Xavier on the relative merits of filing a provisional versus a non-provisional application and Xavier decides to have Young initially file a provisional U.S. application. Young prepares the application and files it as a provisional application on Friday, January 19, 2001, claiming the benefit of the Canadian application. In August 2001, Young reminds Xavier that the filing was only provisional and that Xavier must decide whether to file a non-provisional application. In early January 2002, Xavier directs Young to get a non-provisional application, with a certified copy of the English language Canadian application, into the Office, which Young does on Friday January 11, 2002. Young files no other correspondence prior to the first Office action. Which of the following is true?

- (A) Because of the federal holiday, the filing of the non-provisional is timely to maintain a priority claim to the provisional application under 35 U.S.C. § 119(e), and therefore also to maintain a priority claim to the Canadian application filed less than 12 months before the initial US application.
- (B) If Young files the non-provisional application by converting the provisional application to a non-provisional application. The patent term will be measured from the date of conversion.
- (C) If Young files the non-provisional application by submitting a new application that claims the benefit of the provisional application and the Canadian application, in a first Office action rejection an examiner may apply a reference published September 19, 2000 as a prior art publication.
- (D) (A) and (B).
- (E) All of the above.

48. Engineers and scientists at Poly Tech Institute (PTI) have invented a new system for a wireless computer network. On November 9, 2001, they asked you to file a U.S. patent application for their invention. PTI is located in the United States, has an attendance of over 5,000 students, and (1) admits, as regular students, only persons having a certificate of graduation from a school providing secondary education, or the recognized equivalent of such a certificate, (2) is legally authorized within the jurisdiction in which it operates to provide a program of education beyond secondary education, (3) provides an educational program for which it awards a bachelor's degree or provides less than a 2-year program which is acceptable for full credit toward such a degree, (4) is a public institution, and (5) is accredited by a nationally recognized accrediting agency. You also find out that Poly Tech's research which led to the invention of the new system was funded by Atlantic Telcom Corporation (ATC) (a for profit corporation with over 500 employees and that does not meet the small business standard defined in 13 CFR 121) and a license agreement has been signed which would give ATC the right to participate in the prosecution of the patent application and also the right to make and use the invention, upon the payment of royalties, if the application ultimately issues as a patent. Based on the above facts, you should advise PTI that:

- (A) the application must be filed under large entity status because enrollment in the university exceeds 500.
- (B) the application must be filed under large entity status because PTI ~~has~~ entered into a license agreement.
- (C) the application may be filed under small entity status because the enrollment at PTI exceeds 5000 students.
- (D) the application may be filed under small entity status because PTI is an institution of higher education located in the United States.
- (E) None of the above.

49. Which of the following practices or procedures may be properly employed to overcome a rejection properly based on 35 U.S.C. § 102(e)?

- (A) Claiming priority under 35 U.S.C. § 119(a)-(d) based on a foreign application having a foreign priority filing date that antedates the reference.
- (B) Claiming priority under 35 U.S.C. §§ 119(e) or 120 by filing an application data sheet under 37 CFR 1.76 that contains a specific reference to the prior application in accordance with 37 CFR 1.78(a), where the prior application has a filing date prior to the reference.
- (C) Claiming priority under 35 U.S.C. §§ 119(e) or 120 by amending the specification of the application to contain a specific reference to a prior application having a filing date prior to the reference.
- (D) Amending the claims to patentably distinguish over the prior art.
- (E) (A), (B), (C), and (D).

50. Which of the following is not required in order for a foreign application that has matured into a foreign patent to qualify as a reference under 35 U.S.C. § 102(d)?

- (A) The foreign application must have actually been published before the filing of an application in the United States, but the patent rights granted need not be enforceable.
- (B) The foreign application must be filed more than 12 months before the effective filing date of the United States application.
- (C) The foreign and United States applications must be filed by the same applicant, his or her legal representatives or assigns.
- (D) The foreign application must have actually issued as a patent or inventor's certificate before the filing of an application in the United States. It need not be published but the patent rights granted must be enforceable.
- (E) The same invention must be involved.

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1. ANSWER: (C) is the most correct answer. MPEP § 2181 expressly requires that for a claim limitation to be interpreted in accordance with 35 U.S.C. § 112, paragraph 6, that limitation must (1) use the phrase “means for”, (2) the “means for” must be modified by functional language, and (3) the “means for” must not be modified by sufficient structure for achieving the specified function. In the above fact pattern, only answer choice (C) satisfies the above requirements. (A) is wrong because it does not use the phrase “means for” and recites structure for achieving the specified function (“printer”). (B) is wrong because it modifies the “means” with structure, and also fails to modify the “means” with functional language. (D) is wrong because it does not use the phrase “means for” and also recites structure modifying “mechanism.”

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2. ANSWER: (C) is the correct answer. 37 C.F.R. § 1.704(d) provides that submission of an information disclosure statement under §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) under 37 C.F.R. § 1.704(c)(10) (submission of a paper after a notice of allowance) if the communication was not received by any individual designated in 37 C.F.R. § 1.56 more than thirty days prior to the filing of the information disclosure statement. Submission of the information disclosure statement to the USPTO within 30 days from mailing by the foreign office would inherently meet the 30 day requirement for submission to the USPTO from receipt by a 37 C.F.R. § 1.56 party of the information from the foreign office. Meeting the 30 day period for filing the information disclosure statement after allowance will prevent a reduction of the patent term adjustment already accumulated. Answer (A) is not the best answer. A request for continued examination will delay the issuance of the patent over permitting the original application to issue with the information disclosure statement filed, pursuant to answer (A), thereby causing loss of a portion of the 20 year term as the patent term is measured from the earliest priority date claimed, 35 U.S.C. § 154(a)(2). Answer (B) is not the best answer. Complying with the three month period requirements under 37 C.F.R. § 1.97(d) will permit the information disclosure statement to be considered in the allowed application without the need to withdraw from issue and refile. Answer (B) provides that the information disclosure statement can be submitted up to the end of the three month period, which means that the 30 day period of 37 C.F.R. § 1.704(d) may not be met and a reduction in the accumulated adjustment period may result. Answer (D) is not correct. 37 C.F.R. § 1.97(e) provides that the three month period is to be measured from when information submitted in an information disclosure statement was first cited by a foreign office. A later second cite by another foreign office cannot be used to measure the three month period. Answer (E) is not the best answer as answer (B) is not the best answer and answer (D) is not correct.

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3. ANSWER: (D). This answer is correct because it would be the best option, as it would give Ms. Bordeaux the filing date of the PCT, specifically 1/10/01, as her U.S. filing date (for the purpose of determining whether information is prior art), it would give her a foreign priority date of 1/10/00, with no further need to provide the foreign priority document; it would also give her the full benefits of filing PCT applications, i.e., a search report and preliminary examination report on her invention(s) prior to filing a national application, so that she has an indication of which claims have the best chance of being determined to be patentable. (A) This answer is incorrect, as it would not give Belle Bordeaux the benefit of a preliminary examination report for her international application, prior to filing the national application. (B) This answer is incorrect because the procedure would not achieve the objective of obtaining an international preliminary search report. It would give Belle Bordeaux a later U.S. filing date, the filing date of the national application, e.g., 9/10/01; the invention(s) would be subject to U.S. restriction practice; and the applicant would have to provide a certified copy of the foreign priority document. (C) This answer is incorrect, as a provisional application is not entitled to the right of priority of any other application under 35 U.S.C. §§ 119 or 365(a), or to the benefit of an earlier filing date in the United States under 35 U.S.C. §§ 120, 121 or 365(c). (E) is not correct because (A), (B) and (C) are incorrect.

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

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5. ANSWER: (E) is the correct answer. 37 C.F.R. § 1.114(e), effective date August 16, 2000; see, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 FR 50092, 50097 (Aug. 16, 2000). (E) is correct since the provisions of 37 C.F.R. § 1.114 do not apply to design patent applications. Therefore, choices (A) through (D) are incorrect.

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

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

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8. ANSWER: The correct answer is (D). The prior art exception in 35 U.S.C. § 103(c) only applies to references that are only prior art under 35 U.S.C. § 102(e), (f), or (g). In this situation, the Jones patent qualifies as prior art under § 102(a) because it was issued prior to the filing of the Clark application. See MPEP § 706.02(I)(3). Also, evidence of common ownership must be presented, but has not been. Mere argument or a statement alleging common ownership does not suffice to establish common ownership. Answer (A) is a proper reply in that it addresses the examiner's rejection by specifically pointing out why the examiner failed to make a prima facie showing of obviousness. See 37 C.F.R. § 1.111. Answer (B) is a proper reply. See MPEP § 715. Answer (C) is a proper reply. See MPEP § 716. Answer (E) is a proper reply because perfecting a claim of priority to an earlier filed German application disqualifies the Jones reference as prior art.

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9. ANSWER: (C), not being in accord with proper USPTO practice and procedure, is the most correct answer. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1107 (Jan. 5, 2001), middle column, “A general allegation of ‘unpredictability in the art’ is not a sufficient reason to support a rejection for lack of adequate written description.” (A), being in accord with proper USPTO practice and procedure, is not correct. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1107 (Jan. 5, 2001), left column, “A description as filed is presumed to be adequate... .” (B), being in accord with proper USPTO practice and procedure, is not correct. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1107 (Jan. 5, 2001), “A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption.<sup>65</sup> ...The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.<sup>66</sup>” (footnotes not reproduced). (D), being in accord with proper USPTO practice and procedure, is not correct. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1107 (Jan. 5, 2001), left column, “[W]hen filing an amendment, applicant should show support in the original disclosure for new or amended claims.<sup>59</sup>” Footnote 59 states, “See MPEP §§ 714.02 and 2163.06 (‘Applicant should... specifically point out the support for any amendments made to the disclosure.’).” (E), being in accord with proper USPTO practice and procedure, is not correct. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1106 (Jan. 5, 2001), right column, “[W]hen there is substantial variation within a genus, an applicant must describe a sufficient variety of species to reflect the variation within the genus.”

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10. ANSWER: The correct answer is (A). See 37 C.F.R. § 1.48(f)(1) wherein the first submission of an executed oath or declaration under 37 C.F.R. § 1.63 by any of the inventors during the pendency of the application will act to correct the earlier identification of inventorship in the unexecuted declaration. Answer (B) is wrong because a new executed oath or declaration was not filed. Answer (C) is wrong because (1) a petition under § 1.48(a) is not required, (2) the petition is incomplete because it lacks a statement by the newly discovered inventor that the error occurred without deceptive intention on his part, and (3) the declaration fails to list the other two inventors. Answer (D) is wrong because (1) a petition under § 1.48(a) is not required and (2) the petition is incomplete because it lacks a new oath or declaration, which lists the newly discovered inventor in addition to the inventors already named. Answer (E) is incorrect because answers (B), (C) and (D) are incorrect.

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11. ANSWER: (B) is the most correct answer. 35 U.S.C. § 102(e)(1) provides that a USPTO published application, based on an earlier international application, has prior art effect as of its international filing date, if the international application designated the United States, and was published in English. Because in the above fact pattern, the international application designated the United States and was published in English, the USPTO published application is entitled to its international filing date of February 27, 1997 for prior art purposes. (A) is wrong because the Japanese filing date is relevant under 35 U.S.C. § 119 only for priority, but not for prior art purposes. (C) and (E) are wrong because they recite prior art dates that are later than February 27, 1997. (D) is wrong because the amendments to § 102(e) by the American Inventors Protection Act of 1999 make the national stage entry date irrelevant for prior art purposes.

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12. ANSWER: (E) is the most correct answer. 35 U.S.C. § 102(e)(2), as amended by the American Inventors Protection Act, provides that a United States patent is prior art as of its earliest filing date in the United States. Section 102(e)(2) also specifically notes that a patent is not entitled to any international application filing date for prior art purposes. Because in the above fact pattern, no application was ever filed in the United States, the patent is not entitled to any prior art date earlier than its issue date, December 1, 2001. (A) is wrong because the Japanese filing date is relevant under 35 U.S.C. § 119 only for priority and not prior art purposes. (B) is wrong because while a USPTO published application may be entitled to its international filing date under section 102(e)(1), a United States patent is not entitled to any international filing date under section 102(e)(2). (C) is wrong because while the publication of an international application in English has its own prior art effect as a reference, it is not relevant to the prior art effect of the United States patent. (D) is wrong because national stage entry of an international application is not to be confused with a United States filing date. While the version of section 102(e) that existed prior to the American Inventors Protection Act expressly provided for prior art effect as fulfillment of certain national stage requirements, the amended section 102(e) no longer provides for that prior art effect, thus making national stage entry irrelevant for 102(e) prior art purposes.

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13. ANSWER: (C) is the most correct answer. 35 U.S.C. § 41(e) reads “The Director may waive the payment of any fee for any service or material related to patents in connection with an occasional or incidental request made by a department or agency of the Government, or any officer thereof.” The statute, however, does not make a government agency a small entity. Choices (A), (B), (D) and (E) are not correct because 37 C.F.R. § 1.27(a) recites these four items as qualifying for small entity status.

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14. ANSWER: (B) is the most correct answer. Third party requesters do not have the option of attending interviews. See 37 C.F.R. § 1.560(a), which provides, in part, “[r]equests that reexamination requesters participate in interviews with examiners will not be granted.” As to (A) and (C) through (E), each item is founded on a portion of § 1.560(b), which states “(b) In every instance of an interview with an examiner in an ex parte reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111. Patent owner’s response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.”

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15. ANSWER: (C). MPEP § 406. Answer (C) is a true statement because the Ben may appoint a registered practitioner to represent him. Answer (A) is incorrect because the power of a principal attorney will be revoked or terminated by his or her death. Such a revocation or termination of the power of the principal attorney will also terminate the power of those appointed by the principal attorney. Therefore, Chris's associate power of attorney is revoked and Chris cannot continue representing Ben without a new power of attorney from Ben. Furthermore, the Office will send correspondence to both Chris and Ben in the event of notification of Able's death. (B) is not the best answer because it suggests Ben may appoint a non-practitioner to prosecute the application and because it does not require the power of attorney to be executed (cf. answer (C)). (D) is not the best answer because it includes (B). (E) is false because (C) is true.

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16. ANSWER: (E) is correct. A communication mailed within the time given for response in accordance with the procedure of 37 C.F.R. § 1.8 or 1.10 is considered timely filed even if it is received after the date a reply is due. In (E), the letter was not mailed in accordance with 37 C.F.R. § 1.8 or 1.10. Therefore, the letter would be considered filed when it is received in the USPTO. 37 C.F.R. § 1.311(a) states, "This three month period is not extendable." Without complying with 37 C.F.R. § 1.8 or 1.10, the filing date of the letter is the date it was received in the USPTO, i.e., February 15, 2002, which is after the due date for payment of the issue fee, February 13, 2002. (A) is wrong because the reason given for abandonment is incorrect. The application becomes abandoned for the reasons expressed in (E). Although 37 C.F.R. § 1.311(b) provides that the submission of an incorrect issue fee (or other post-allowance fees set forth in 37 C.F.R. § 1.18) operates as a request to charge the correct issue fee, it does not change the fact that Jill's letter is received by the USPTO after expiration of the non-extendable statutory three month period for payment of the issue fee. (B) is wrong because the application will become abandoned because Jill's letter will be received by the USPTO after expiration of the non-extendable statutory three month period. (C) is wrong because the period for payment of the issue fee was not extendable by petition. The period is set by statute. 35 U.S.C. § 151. Abandonment occurred because Jill's letter was received by the USPTO after expiration of the non-extendable statutory three month period. A petition for an extension of time was not available in this case. (D) is wrong because the reason for abandonment is wrong. Filing the form is optional. Although 37 C.F.R. § 1.311(b) provides that the submission of a completed Office-provided issue fee transmittal form, PTOL-85B, operates as a request to charge the correct issue fee (or other post-allowance fees set forth in 37 C.F.R. § 1.18) to any deposit account identified in a previously filed authorization to charge fees, it does not change the fact that Jill's letter was received by the USPTO after expiration of the non-extendable statutory three month period.

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17. ANSWER: (D) is correct. An original plant or utility application filed on or after May 29, 2000 is eligible for patent term adjustment. See 35 U.S.C. § 154(b), 37 C.F.R. § 1.702 and MPEP § 2730 . Since a continued prosecution application (CPA) filed under 37 C.F.R. § 1.53(d) is a new (continuing) application, a CPA filed on or after May 29, 2000 is eligible for patent term adjustment. See MPEP § 2730. Applications filed on or after June 8, 1995 may accrue patent term extension under 35 U.S.C. § 154(b), but patent term extension is much more limited than PTA and should not be confused with PTA. Accordingly, Answers (A) and (B) are wrong. Answer (C) is wrong because design applications are not eligible for patent term adjustment. See 37 C.F.R. § 1.702 and MPEP § 2730. Answer (E) is wrong because a request for continued examination (RCE) under 35 U.S.C. § 132(b) and 37 C.F.R. § 1.114 is not a new application and filing an RCE in an application filed before May 29, 2000 will not cause the application to become eligible for patent term adjustment. See MPEP § 2730.

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18. ANSWER: (C) is the most correct answer. See, "Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, 'Written Description' Requirement," 66 F.R. 1099, 1105 (Jan. 5, 2001) left column, first paragraph. "The claimed invention as a whole may not be adequately described if the claims require an essential or critical feature that is not described in the specification and is not conventional in the art or known to one of ordinary skill in the art." (A) is not the most correct answer. See, "Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, 'Written Description' Requirement," 66 F.R. 1099, 1104 (Jan. 5, 2001) right column, last paragraph. Describing an actual reduction to practice of the claimed invention is a means of showing possession of the invention. (B) is not the most correct answer. See, "Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, 'Written Description' Requirement," 66 F.R. 1099, 1104 (Jan. 5, 2001) right column, last paragraph. (D) is not the most correct answer. See, "Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, 'Written Description' Requirement," 66 F.R. 1099, 1105 (Jan. 5, 2001), left column, second paragraph, which states, "While there is no in haec verba requirement, newly added claim limitations must be supported by in the specification through express, implicit, or inherent disclosure." (E) is not the most correct answer. See, "Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, ¶ 1, 'Written Description' Requirement," 66 F.R. 1099, 1105 (Jan. 5, 2001), left column, second paragraph, which states, "An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of the error in the specification, but also recognize the appropriate correction."

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19. ANSWER: (B). 37 C.F.R. § 1.153(d)(l)(i)(B). A design application is eligible for continuing prosecution application procedures. 37 C.F.R. § 1.114 (e)(4) explains that RCE procedure is not available for design applications, therefore (A) and (C) are wrong. Answer (D) is wrong because under 37 C.F.R. § 1.53(d) the filing date of the application (A#1) must be before May 29, 2000. Answer (E) is wrong for the same reason.

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20. ANSWER: The model answer is choice (E). 37 C.F.R. § 1.14(b)(4). MPEP § 102, "Information as to status of an Application." Under 37 C.F.R. § 1.14, the Office may provide status information for pending patent applications that claim the benefit of the filing date of an application for which status information may be provided. Hence information will only be available on this basis for subsequently filed applications. Answer (A) is incorrect because information may be available for subsequently filed applications. Answers (B) and (C) are incorrect because only status information, not copies of the application, are provided. Answer (C) is also incorrect because a claim for benefit under 35 U.S.C. § 120 must be made before status information will be provided. Answer (D) is incorrect because status information is only given for subsequent ly filed applications.

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21. ANSWER: (C) is the most correct answer. See 37 C.F.R. § 1.322(a)(2)(i) (“There is no obligation on the Office to act on or respond to a submission of information or request to issue a certificate of correction by a third party under paragraph (a)(1)(iii) of this section”). See MPEP § 1480. (A), (B) and (E) are incorrect because they indicate that the USPTO must take some mandatory action as a result of the third party notification, while 35 U.S.C. § 254 and 37 C.F.R. § 1.322(a)(2)(i) leave whether and how to respond to such a third party notification to the discretion of the USPTO Director. (D) is incorrect. See 37 C.F.R. § 1.322(a)(2)(ii) (“Papers submitted by a third party under this section will not be made of record in the file that they relate to nor be retained by the Office”).

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

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23. ANSWER: The correct answer is (E). PCT Article 22 was recently amended to permit applicant to delay entry into the national stage until 30 months from the earliest claimed priority date, regardless of whether a Demand was filed within 19 months from said date. The change is effective for international applications where the former Article 22 time limit of 20 months expired on or after 01 April 2002.

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24. ANSWER: (B) is the correct answer. It is inappropriate and injudicious to disregard any admissible evidence in any judicial proceeding. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). The examiner has not analyzed the data in the declaration nor provided an explanation as to why the declaration did not overcome the rejection. Furthermore, the rejection has not been reviewed anew in light of the declaration. The examiner should have reweighed the entire merits of the prima facie case of obviousness in light of the data. *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986). Accordingly, Block should ask that the rejection be reconsidered and file a Notice of Appeal to safeguard his interest for a review of the rejection by the Board of Patent Appeals and Interferences if the rejection is not reconsidered. 37 C.F.R. § 1.116. (A) is wrong because there is no evidence that the examiner made any review of the declaration. (C) is wrong because whether or not Reference X provides an enabling disclosure for Block's invention is immaterial to the question of obviousness. If there were to be a question of enabling disclosure for Reference X, it would be with respect to the "Q" ball relied upon by the examiner, not applicant's "Y" ball. (D) is wrong because whether or not Reference X provides a written description for Block's invention is immaterial to the question of obviousness raised by the examiner. (E) is wrong because the issue is one of obviousness under 35 U.S.C. § 103, not identity under 35 U.S.C. § 102. Given that the examiner has rejected the claim under 35 U.S.C. § 103 and not under § 102, the examiner has already conceded that the "Q" and "Y" balls are not the same.

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25. ANSWER: (E) is correct. (A), (B), (C), and (D) are wrong because 35 U.S.C. § 154(a)(2), in pertinent part, provides that a patent “grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States... .” An adjustment of the patent term due to examination delay for original patent applications filed on or after June 8, 1995, and before May 29, 2000, is provided by 37 C.F.R. § 1.701. As to (D), the period of adjustment for the application involved in the interference is not adjusted by the period prosecution is suspended in an application related to the application in interference. The period of adjust for the application in interference is governed by the provisions of 37 C.F.R. § 1.701(c)(1)(i), as opposed to the provisions of 37 C.F.R. § 1.701(c)(1)(ii), which pertain to adjustment of the term of an application wherein prosecution is suspended due to an interference proceeding not involving that application. As to (E), the adjustment involves extending the patent term from the expiration date of the patent by the period of the delay. The manner of calculating the period of the delay is provided in subsection 701(c)(1)(i), which recites:

With respect to each interference in which the application was involved, the number of days...in the period beginning on the date the interference was declared...to involve the application in the interference and ending on the date that the interference was terminated with respect to the application... .

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26. ANSWER: (B) is the most correct answer. Under 37 C.F.R. § 1.26(b), "Any request for refund must be filed within two years from the date the fee was paid." See, "Changes to Implement the Patent Business Goals, Final Rule," 65 F.R. 54604, 54608, middle column (September 8, 2000), 1238 O.G. 77 (Sept. 19, 2000). (A) is not the most correct answer. 37 C.F.R. § 1.26(a). See, "Changes to Implement the Patent Business Goals, Final Rule," 65 F.R. 54604, 54608, right column (September 8, 2000), 1238 O.G. 77 (Sept. 19, 2000). (C) is not the most correct answer. 37 C.F.R. § 1.52(b)(6) provides that other than in a reissue application, the paragraphs of the specification of an application may be numbered at the time the application is filed. See, "Changes to Implement the Patent Business Goals, Final Rule," 65 F.R. 54604, 54620 (left column), 54621 (Comments 22, 23, 24, and 25, and responses) (September 8, 2000), 1238 O.G. 77 (Sept. 19, 2000). (D) is not the most correct answer. 37 C.F.R. § 1.52(d)(2) provides for that an English language translation of the non-English language provisional application will not be required in the provisional application. (E) is not the most correct answer. 37 C.F.R. § 1.52(e)(5). See, "Changes to Implement the Patent Business Goals, Final Rule," 65 F.R. 54604, 54621, left column (September 8, 2000), 1238 O.G. 77 (Sept. 19, 2000).

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27. ANSWER: The best answer is (E). The original deadline for responding to the Office action was one month from December 12, 2001, i.e. January 12, 2002. A one-month extension of time would be required for a response filed from January 12, 2002 to February 12, 2002. Answers (B) and (D) are incorrect because the responses are not timely. Answer (B) is also incorrect because a proper reply must include an election even if the restriction requirement is traversed (MPEP § 818.03(b)). Furthermore, although small entity status entitles an applicant to pay reduced fees, small entity status does not change the manner in which restriction requirements are considered. Answer (A) is incorrect because the reply must be in writing. See, e.g., MPEP § 818.03(a). Answer (C) is incorrect because the Reply to Office Action does not make an election and because it does not specifically point out the supposed errors in the Examiner's action. See MPEP § 818.03(a).

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28. ANSWER: The best answer is (C). Answers (A) and (B) are incorrect because they attempt to distinguish the claim on the basis of a feature that is not recited in claim 6, i.e., the substance is interspersed throughout the salt lick. Cf. claim 8. Answer D similarly relies on a feature that is not set forth in claim 6, i.e., presence of substance XYZ. With regard to Answer (E), a mere conclusory statement that the claim was carefully drafted to distinguish over the prior art is unlikely to be persuasive without reference to distinguishing features set forth in the claim.

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29. ANSWER: The best answer is (C). MPEP § 2141.01(a). Answer A is incorrect because under the facts of the question there is no teaching or suggestion to combine the teachings of Deere and Doe. Moreover, what is inherent is not necessarily obvious. Answer B is incorrect because the test under § 103 is whether the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. The test is not whether it would have been obvious to the inventor. Answer (D) is incorrect at least because the background facts specifically state that the specification is fully enabling. Similarly, Answer (E) is incorrect because the question specifically states that the specification provides adequate disclosure as to what constitutes an “effective amount” of XYZ.

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

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

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32. ANSWER: (B). Since Johnnie developed the material and James thought of the idea to use it in microwave ovens, they rightfully could be considered coinventors of the new article of manufacture. As to (A) and (C), public use began on when the experimental use ended on January 30, 2001, and occurs even when the public is unaware that they were walking on the developed material since the material was used in a public place. As to (D), even though James only took a second to think of the idea, he is entitled to receive a patent unless it was obvious to one of ordinary skill in the art. Nothing in the prior art revealed that it was obvious to use the material in microwave ovens. As to (E), the article of manufacture is not barred even though the floor material itself cannot be patented. Johnnie conducted an experimental use of the article from December 31, 2000 through January 30, 2001. Thereafter, Johnnie had one year from the end date of the experimental use to file a patent application for the article. Johnnie may file a patent application before January 30, 2002.

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33. ANSWER: (D) is the most correct answer. 37 C.F.R. § 1.105, and 37 C.F.R. § 1.56(c). A named inventor, and an attorney who prepares and prosecutes the application, are identified in 37 C.F.R. § 1.56(c), and an assignee is specified in 37 C.F.R. § 1.105(a)(1). Therefore (D) is correct. (E) is incorrect because (D) is correct.

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34. ANSWER: (E) is the most correct answer. 37 C.F.R. § 1.121(c) and (d), and MPEP § 714, page 700-169 through 172 (8 th Ed.) (Amendments, Applicant's Action). (A) is incorrect. MPEP § 714.22, page 700-196, 197 (8 th Ed.) (Entry of Amendments). Applicant may resubmit the amendment within any remaining period of time (set in the final rejection). No further extension of time or new time periods which might serve to extend the six month statutory period will be set in the advisory action. If time remains in the period set in the final rejection, applicants may resubmit the amendment, or request an extension of time (with appropriate fee) in which to do so, but will not be able to obtain an extension beyond the six- month statutory deadline. (B) is incorrect. MPEP § 714.22(a), page 700-198, (Amendments Consolidating All Claims). Applicants have the opportunity to consolidate all previous versions of pending claims from a series of separate amendment papers into a single clean version in a single amendment paper. This may be done at any time during prosecution of the application, though the entire clean claim set is subject to the provisions of 37 C.F.R. §§ 1.116(b) and 1.312. (C) is incorrect. MPEP § 714, page 700-169 through 172 (8 th Ed.) (Amendments, Applicant's Action) While the first portion of the answer is correct because amendments to the drawings must be submitted on a separate paper showing the proposed changes in red for to the specification including the claims must be made by replacement paragraph/section/claim in clean form. This requirement is regardless of the mailing date of the Office action.

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35. ANSWER: The correct answer is (D). The practice is set out in MPEP § 1450. (A) is incorrect since the CAFC decision of *In re Amos*, 21 USPQ 2d 1271, held that reissue applicants have a right to claim any disclosed subject matter satisfying the first paragraph of 35 U.S.C. § 112. MPEP §1412.01. (A) and (B) are incorrect because the Office cannot reissue original unamended patent claims (where no error under 35 U.S.C. § 251 is corrected). (C) is incorrect because the original patent can only be surrendered once. USPTO has procedures for transferring the original patent grant from a reissue application to an divisional reissue application. USPTO procedures do not provide for surrendering a duplicate copy of an original patent grant. Reference may be made to the application in which it is surrendered. MPEP §1416(E) is incorrect since 37 C.F.R. § 1.176 only authorizes restriction between the originally claimed subject matter of the patent and previously unclaimed subject matter.

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36. ANSWER: (C) is the most correct answer. The USPTO does not require or recommend a minimum or maximum number of dependent claims. 37 C.F.R. § 1.75(c). (A) is a USPTO recommendation. See MPEP § 608.01(m) (“Similarly, product and process claims should be separately grouped.”). (B) is a USPTO recommendation. See MPEP § 608.01(m) (“Claims should preferably be arranged in order of scope so that the first claim presented is the least restrictive.”). (D) is a PTO recommendation. See MPEP § 608.01(n), part IV. (E) is a USPTO requirement. See MPEP § 608.01(m) (“Each claim begins with a capital letter and ends with a period.”).

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37. ANSWER: (A) is the most correct answer, while (D) is not the most correct answer. See MPEP § 715.05, which, in pertinent part, states:

When the reference in question is a noncommonly owned U.S. patent claiming the same invention as applicant and its issue date is less than 1 year prior to the presentation of claims to that invention in the application being examined, applicant's remedy, if any, must be by way of 37 C.F.R. § 1.608 instead of 37 C.F.R. § 1.131... . The reference patent can then be overcome only by way of interference.

(B) and (C) are not the most correct answers. See MPEP § 715.05, which, in pertinent part, states:

If the patent is claiming the same invention as the application and its issue date is 1 year or more prior to the presentation of claims to that invention in the application, a rejection of the claims of the application under 35 U.S.C. § 135(b) should be made. See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632, 1635 (Fed.Cir. 1997) (The court holding that application of 35 U.S.C. § 135(b) is not limited to inter partes interference proceedings, but may be used as a basis for ex parte rejections.).

(E) is a wrong answer because an affidavit or declaration traversing a ground of rejection may be received only where the reference "substantially shows or describes but does not claim the same patentable invention." 37 C.F.R. § 1.132.

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

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39. ANSWER: (C) is the most correct answer. Under 37 C.F.R. § 1.53(d), “(1) A continuation...application...of a prior nonprovisional application may be filed as a continued prosecution application provided that: (i) The prior nonprovisional application is either: a utility...application that was filed under 35 U.S.C. § 111(a) before May 29, 2000, and is complete as defined by § 1.51(b);...and (ii) The application under this paragraph is filed before the earliest of payment of: (A) Payment of the issue fee on the prior application, unless a petition under 37 C.F.R. § 1.313(c) is granted in the prior application; (B) Abandonment of the prior application; or (C) Termination of proceedings on the prior application.” (A) is not the most correct answer. 37 C.F.R. § 1.53(d)(1) does not authorize filing a divisional application as a CPA of a prior provisional application. (B) is not the most correct answer. 37 C.F.R. § 1.53(d)(1) does not authorize filing of a continuation- in-part application as a CPA of a prior complete nonprovisional utility application. (D) is not the most correct answer. Pursuant to 37 C.F.R. § 1.53(d)(1)(i)(A), the prior application must be filed prior to May 29, 2000. Since the prior CPA was actually filed on June 1, 2000, a further CPA cannot be filed off that CPA. The filing date of the first application (November 28, 1999) is not relevant to 37 C.F.R. § 1.53(d)(1)(i)(A), and is only used for identification purposes in the first CPA. See, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50093, right column, second paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (E) is not the most correct answer. 37 C.F.R. § 1.53(d)(1)(i)(A) does not authorize the filing of a divisional or continuation application as a CPA of a prior complete nonprovisional utility application filed on or after May 29, 2000.

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40. ANSWER: (D) is the most correct answer. (A) and (B) are incorrect because, pursuant to MPEP § 503, the return postcard itself must specifically itemize the component parts of the new application. (C) is incorrect because, pursuant to MPEP § 503, the number of pages of each of the component parts of an application must be specified to obtain prima facie evidence of what was filed. In light of (A), (B), and (C) being incorrect, (E) is also incorrect.

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41. ANSWER: Answer (A) is the best answer because it is an incorrect statement. See 37 C.F.R. § 1.131, which reads in relevant part:

(a)(2) A date of completion of the invention may not be established under this section before December 8, 1993, in a NAFTA country, or before January 1, 1996, in a WTO member country other than a NAFTA country.

(D) is correct statement. MPEP § 715.07. (B), (C) and (E) are also correct. 37 C.F.R. § 1.131. 35 U.S.C. § 104 (see history).

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42. ANSWER: (D) is the most correct answer. See MPEP § 714.03. Homer's reply is a bona fide attempt to advance the application to final action. The amendment will be considered as a non-responsive amendment because it does not comply with 37 C.F.R. § 1.121. The applicant will be given a new time period of one month or 30 days from the mailing date of the notice of non-compliance to correct the amendment. 37 C.F.R. § 1.135(c); MPEP § 714.03. Answer (A) is incorrect because the application filed on December 3, 2001 is not eligible for the CPA practice. See MPEP § 706.07(h), page 700-71. Answer (B) is incorrect because the prosecution in the application is not closed. A reply in compliance with 37 C.F.R. § 1.111 is missing. See 37 C.F.R. § 1.114(a); MPEP § 706.07(h). Answer (C) is incorrect because action cannot be suspended in an application which contains an outstanding Office action awaiting reply by the applicant. See 37 C.F.R. § 1.103; MPEP § 709. Answer (E) is incorrect because the reply does not meet the requirements of 37 C.F.R. § 1.111 and is not considered a bona fide attempt under 37 C.F.R. § 1.135(c). Also the response does not reply to the drawing objections.

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43. ANSWER: (D) is the most correct answer. 37 U.S.C. § 254, 37 C.F.R. § 1.322(a)(1)(ii), and MPEP § 1480, pages 1400-63 and 64, (8 th Ed.), (Certificates of Correction – Office Mistake). (A) is incorrect. 37 C.F.R. §1.322(a)(2), and MPEP § 1480, pages 1400-63 and 64, (8 th Ed.), (Certificates of Correction – Office Mistake). Third parties do not have standing to demand that the Office issue or refuse to issue a certificate of correction. (B) is incorrect. 37 C.F.R. § 1.322(a)(4), and MPEP § 1480, page 1400-63, (8 th Ed.), (Certificates of Correction – Office Mistake). The Office will not issue a certificate of correction under 37 C.F.R. § 1.322 without first notifying the patentee (including any assignee of record) at the correspondence address of record as specified in § 1.33(a) and affording the patentee or an assignee an opportunity to be heard. Additionally, the Office has the discretion to decline to issue a certificate of correction even though an Office mistake exists if the Office mistakes are of a nature that the meaning intended is obvious from the context. (C) is incorrect. 37 C.F.R. § 1.322(a)(3) and MPEP § 1480, pages 1400-63 and 64, (8 th Ed.), (Certificates of Correction – Office Mistake). A request for a certificate of correction to correct a mistake in a patent incurred through the fault of the Office may relate to any issued patent including those involved in interference. Where the request relates to a patent involved in an interference, the request must comply with the requirements of 37 C.F.R. § 1.322 and be accompanied by a motion under 37 C.F.R. § 1.635. (E) is incorrect. 37 C.F.R. § 1.322(a)(1), and MPEP § 1480, pages 1400-63 and 64, (8 th Ed.), (Certificates of Correction – Office Mistake). The Commissioner may also issue a certificate of correction to correct a mistake in a patent, incurred through the fault of the Office, acting sua sponte for mistakes that the Office discovers or acting on information about a mistake supplied by a third party.

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44. ANSWER: (E) is the correct answer. 37 C.F.R. § 1.48(b) (effective November 7, 2000); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54619 (September 8, 2000). As stated in 65 FR at 54619, middle column, “Sections 1.48(b) and (d) are revised to indicate that a request to correct the inventorship thereunder must be signed by a party as set forth in § 1.33(b)...” (A), (B), and (C) are provided for in 37 C.F.R. § 1.33(b). Thus (E), the most inclusive answer, is correct.

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

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

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47. ANSWER: (C). 35 U.S.C. §§ 111(b)(7), 119(e); 37 C.F.R. § 1.55,1.78(a)(4); MPEP § 201.04(b) – page 200-16, and 201.15. (C) is true because X is not entitled to the Canadian application priority date because the nonprovisional application was filed more than one year from the filing date of the Canadian application. Furthermore, a provisional application is not entitled to claim priority based on any other application under 35 U.S.C. §§ 119, 120, 121, and 365. The earliest date that the nonprovisional application is entitled to claim is the January 19, 2001 date. Where applicant is not entitled to a priority date, MPEP § 201.15 states that an examiner may make a rejection based on an intervening reference. (A) is false because priority may not be claimed to the Canadian application because over 12 months elapsed between the filing of the Canadian application and the filing of the non-provisional US application and no priority claim is available via the provisional application. (B) is false. The patent term will be measured from the filing date of the provisional application. See MPEP § 201.04(b), page 200-16. (D) is false because (A) and (B) are false. (E) is false because (C) is true.

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48. ANSWER: (B) is the most correct answer. 37 C.F.R. § 1.27 (a)(3)(i) & (ii) which prohibits claiming of small entity status if the nonprofit organization (a university) has assigned, granted, conveyed, or licensed any rights in the invention to any person, concern, or organization which would not qualify as a person, small business concern, or a nonprofit organization. In the example above, the licensee, ATC, does not qualify for small entity status. See also MPEP § 509.02 at pp. 500-32 to 500-34. Answer (A) is incorrect, because it does not matter that the university has over 500 students. A university can still qualify for small entity status even though it has more than 500 students. 37 C.F.R. § 1.27(a)(3)(ii)(A). Answer (C) is incorrect because the invention has been licensed to a large entity, and the size of the student body does not determine whether a university qualifies as a small entity. Answer (D) is incorrect because although PTI is an institution of higher education, there has been a license to an organization that does not qualify for small entity status. Answer (E) is incorrect because answer (B) is correct.

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49. ANSWER: All answers accepted.

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50. ANSWER: (A) is the most correct answer. 35 U.S.C. § 102(d). The foreign application need not be published, but the patent rights granted must be enforceable. MPEP § 706.02(e). (B), (C), (D) and (E) are required by 35 U.S.C. § 102(d).

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