

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

**APRIL 15, 2003**

**Afternoon Session (50 Points)**

**Time: 3 Hours**

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**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. 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, USPTO rules, and the procedures set forth in the Manual of Patent Examining Procedure (MPEP). 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**

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1. Harriet filed a nonprovisional patent application in the USPTO containing a written assertion of small entity status. Based upon the USPTO rules and the procedures set forth in the MPEP, which of the following statements is correct?

- (A) If Harriet files a related, continuing application wherein small entity status is appropriate and desired, it will not be necessary to specifically establish assertion of such status in the continuing application.
- (B) If Harriet files a related, reissue application wherein small entity status is appropriate and desired, it will be necessary to specifically establish assertion of such status in the reissue application.
- (C) If Harriet files a related, divisional application under 37 CFR 1.53, wherein small entity status is appropriate and desired, it will not be necessary to specifically establish assertion of such status in the divisional application.
- (D) If Harriet refiles her application as a continued prosecution application under 37 CFR 1.53(d), wherein small entity status is appropriate and desired, it will not be necessary to specifically establish assertion of such status in the continued prosecution application.
- (E) If Harriet subsequently assigns her rights to another party for whom small entity status is appropriate and desired, it will be necessary to specifically re-establish assertion of such status.

2. A U.S. patent application discloses a first embodiment of an invention, a composition made of known materials in equal amounts by weight of A, B, and C. The application discloses a second embodiment of the invention comprising equal amounts by weight of A, B, and C, and an effective amount of D, a known material, to reduce excess moisture from the composition. The application also discloses a third embodiment of the invention comprising equal amounts by weight of A, B, and C, and an effective amount of D to reduce the acidity of the composition. The application fully discloses guidelines for determining an effective amount of D to reduce excess moisture from the composition, and determining an effective amount of D to reduce the acidity of the composition. The application discloses that the amount of D needed to reduce excess moisture from the composition differs from the amount of D needed to reduce the acidity of the composition. Which of the following claims, if included in the application, provides a proper basis for a rejection under 35 USC 112, second paragraph in accordance with the USPTO rules and the procedures set forth in the MPEP?

- (A) Claim 1. A composition comprising: equal amounts by weight of A, B, and C, and an effective amount of D to reduce the acidity of the composition.
- (B) Claim 1. A composition comprising: equal amounts by weight of A, B, and C, and an effective amount of D.
- (C) Claim 1. A composition comprising: equal amounts by weight of A, B, and C, and an effective amount of D to reduce excess moisture from the composition.
- (D) Claim 1. A composition comprising: equal amounts by weight of A, B, and C.
- (E) None of the above.

3. In accordance with the USPTO rules and the procedures in the MPEP, in which of the following instances is the reference properly available as prior art under 35 USC 102(d)?

- (A) A U.S. patent application is filed within the one year anniversary date of the filing date of the foreign application. The reference is the foreign application.
- (B) The applicant files a foreign application, later timely files a U.S. application claiming priority based on the foreign application, and then files a continuation-in-part (CIP) application, and the claims in the CIP are not entitled to the filing date of the U.S. parent application. The foreign application issues as a patent before the filing date of the CIP application and is used to reject the claims directed to the added subject matter under 35 USC 102(d)/103. The reference is the foreign application.
- (C) The applicant files a foreign application, and later timely files a U.S. application claiming priority based on the foreign application. The examined foreign application has been allowed by the examiner and has not been published before the U.S. application was filed. The reference is the foreign application.
- (D) The reference is a defensive publication.
- (E) All of the above.

4. The Office mailed an Office action containing a proper final rejection dated July 8, 2002. The Office action did not set a period for reply. On January 7, 2003, in reply to the final rejection, a registered practitioner filed a request for continued examination under 37 CFR 1.114, a request for a suspension of action under 37 CFR 1.103(c) to suspend action for three months, and proper payment all required fees. No submission in reply to the outstanding Office action accompanied the request for continued examination. No other paper was submitted and no communication with the Office was held until after Midnight, January 8, 2003. Which of the following statements accords with the USPTO rules and the procedures set forth in the MPEP?

- (A) If an appropriate reply is submitted within the three month period of suspension permitted under 37 CFR 1.103(c), the application will not be held abandoned.
- (B) The application will not be held abandoned if an appropriate reply is submitted within the three month period of suspension and it is accompanied by a showing that the reply could not have been submitted within the period set in the final rejection. For example, the reply includes a showing based on an experiment that required 8 months to conduct.
- (C) No reply will prevent the application from being held abandoned.
- (D) If, on January 10, 2003, the primary examiner and applicant agree to an examiner's amendment that places the application in condition for allowance and a notice of allowance is mailed within the three month period of suspension, application X will not be held abandoned.
- (E) No other submission by applicant is necessary because application X is still pending. The examiner is required to act on the request for continued examination after expiration of the three month period of suspension.

5. Which of the following practices or procedures may be properly employed in accordance with the USPTO rules and the procedures set forth in the MPEP to overcome a rejection properly based on 35 USC 102(a)?

- (A) Perfecting a claim to priority under 35 USC 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 USC 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).

6. In accordance with the USPTO rules and the procedures of the MPEP, which of the following is true?

- (A) If after the filing of a reissue application no errors in the original patent are found, a reissue patent will be granted on the reissue application noting no change, and the original patent will be returned to the applicant.
- (B) In order to add matter not previously found in the patent, a continuation-in-part reissue application must be filed.
- (C) In a reissue application, additions and deletions to the original patent should be made by underlining and bracketing, respectively, except for changes made in prior Certificates of Correction and disclaimer(s) of claims under 37 CFR 1.321(a).
- (D) A dependent claim may be broadened in a reissue application only in the first two years of the enforceable life of the patent.
- (E) (A), (B), and (C).

7. In accordance with the USPTO rules and the procedures set forth in the MPEP, for a nonprovisional application to receive a filing date in the USPTO under 37 CFR 1.53(b), all of the following must be filed except:

- (A) An oath or declaration under 37 CFR 1.51(b)(2).
- (B) A specification as prescribed by the first paragraph of 35 USC 112.
- (C) A description pursuant to 37 CFR 1.71.
- (D) At least one claim pursuant to 37 CFR 1.75.
- (E) Any drawing required by 37 CFR 1.81(a).

8. A complete continuation application by the same inventors as those named in the prior application may be filed under 35 USC 111(a) using the procedures of 37 CFR 1.53(b) by providing, in accordance with the USPTO rules and the procedures set forth in the MPEP:

- (A) A copy of the prior application, including a copy of the signed declaration in the prior application, as amended.
- (B) A new and proper specification (including one or more claims), any necessary drawings, a copy of the signed declaration as filed in the prior application (the new specification, claim(s), and drawings do not contain any subject matter that would have been new matter in the prior application), and all required fees.
- (C) A new specification and drawings and a newly executed declaration. The new specification and drawings may contain any subject matter that would have been new matter in the prior application.
- (D) A new specification and drawings, and all required fees.
- (E) (A), (B), (C) and (D).

9. Inventors B and C are employed by Corporation D, which authorized registered practitioner E to prepare and file a patent application claiming subject matter invented by B and C. Inventor B signed the oath, an assignment to Corporation D, and a power of attorney authorizing practitioner E to prosecute the application. Inventor C refused to sign the oath and any assignment documents for the application. The employment contract between inventor C and Corporation D contains no language obligating C to assign any invention to Corporation D. A patent application was properly filed in the USPTO under 37 CFR 1.47 naming B and C as inventors, but without inventor C signing the oath. C has now started his own company competing with Corporation D producing a product with the invention in the application. Inventor B is a friend of inventor C and wants C to have continued access to the application. Which of the following statements is in accordance with the USPTO rules and the procedures set forth in the MPEP?

- (A) Inventor C, who has not signed the oath or declaration, may revoke the power of attorney to practitioner E and appoint practitioner F to prosecute the application.
- (B) Inventor C cannot be excluded from access to the application because inventor B has not agreed to exclude inventor C. In order to exclude a co-inventor from access to an application, all the remaining inventors must agree to exclude that co-inventor.
- (C) Inasmuch as one of the named joint inventors has not assigned his or her rights to Corporation D, the corporation is not an assignee of the entire right and interest, and therefore cannot exclude inventor C from access to the application.
- (D) An inventor who did not sign the oath or declaration filed in an application can always be excluded from access to an application.
- (E) An assignee filing an application can control access to an application and exclude inventors who have not assigned their rights and other assignees from inspecting the application.

10. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following is true?

- (A) There is no practical difference between an objection and rejection of a claim.
- (B) If the form of the claim (as distinguished from its substance) is improper, an objection is made.
- (C) An objection, if maintained by an examiner, is subject to review by the Board of Patent Appeals and Interferences.
- (D) An example of a proper objection is where the claims are refused because they fail to comply with the second paragraph of 35 USC 112.
- (E) An example of a proper rejection is a rejection of a dependent claim for being dependent on a claim that has been rejected only over prior art, where the dependent claim is otherwise allowable.

11. A registered practitioner properly recorded an assignment document for application A identifying XYZ Company as the assignee. The document assigns to XYZ Company the “subject matter claimed in Application A.” A proper restriction requirement was made by a primary examiner in application A between two distinct inventions, and the practitioner elected to prosecute one of the inventions. Application A was prosecuted, and later became abandoned. Before the abandonment date of application A, the practitioner filed a complete application B as a proper divisional application of application A. Application B claimed the nonelected invention of Application A, and was published as a U.S. application publication. XYZ Company remains the assignee of application A. What must the practitioner do in accordance with the USPTO rules and the procedures set forth in the MPEP to ensure that XYZ Company is listed as the assignee on the face of any patent issuing from application B?

- (A) File a proper assignment document in application B identifying XYZ Company as the assignee.
- (B) File a proper assignment document in application B identifying XYZ Company as the assignee, and confirm that USPTO’s bibliographic data for application B identifies XYZ Company as the assignee by checking the filing receipt for application B, the U.S. application publication of application B, or the USPTO’s Patent Application Information Retrieval (PAIR) system data for application B, depending on when the practitioner filed the assignment document in application B.
- (C) Confirm that XYZ Company is identified as the assignee on the U.S. application publication of application B.
- (D) File a proper assignment document in application B identifying XYZ Company as the assignee, and confirm that XYZ Company is identified as the assignee on the U.S. application publication of application B.
- (E) Upon allowance of application B, the practitioner must identify XYZ Company as the assignee in the appropriate space on the Issue Fee Transmittal form for specifying the assignee for application B.

12. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following is true?

- (A) Interferences will generally be declared even when the applications involved are owned by the same assignee since only one patent may issue for any given invention.
- (B) A senior party in an interference is necessarily the party who obtains the earliest actual filing date in the USPTO.
- (C) Reexamination proceedings may not be merged with reissue applications since third parties are not permitted in reissue applications.
- (D) After a reexamination proceeding is terminated and the certificate has issued, any member of the public may obtain a copy of the certificate by ordering a copy of the patent.
- (E) None of the above.

13. Prior to filing a patent application for a client, a registered practitioner determined that the client was entitled to claim small entity status under 37 CFR 1.27. The practitioner filed a patent application for the client on November 1, 2002 together with a claim for small entity status under 37 CFR 1.27. On December 2, 2002, a Notice to File Missing Parts was mailed setting a two month period for reply and requiring the basic filing fee and the surcharge under 37 CFR 1.16(e). The practitioner timely submitted the small entity fees for the basic filing fee and the surcharge as required in the Notice. Shortly thereafter, the practitioner discovered that on October 31, 2002, the day before the application was filed, the client, without advising the practitioner, had assigned all rights in the invention that is the subject of the application to an entity that would not qualify for small entity status under 37 CFR 1.27. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following actions would be the best action for the practitioner to take?

- (A) File a continuing application under 37 CFR 1.53(b) with the large entity filing fee and then file a letter of express abandonment under 37 CFR 1.138 in the original application after the continuing application has been accorded a filing date.
- (B) Promptly file a notification of loss of small entity status under 37 CFR 1.27(g) and, thereafter, pay large entity fees whenever any subsequent fees are required.
- (C) Wait until a Notice of Allowance is received and then timely submit the large entity issue fee along with a notification of loss of small entity status under 37 CFR 1.27(g).
- (D) File a paper under 37 CFR 1.28(c) requesting that the good faith error in claiming small entity status be excused and complying with the separate submission and itemization requirements of 37 CFR 1.28(c) and including payment of the deficiency owed.
- (E) Pay the difference between the large entity filing fee and small entity filing fee and the difference between the large entity surcharge and small entity surcharge within two months from the mail date of the Notice to File Missing Parts.



14. Mark Twine obtains a patent directed to a machine for manufacturing string. The patent contains a single claim (Claim 1) which recites six claim elements. The entire interest in Twine's patent is assigned to the S. Clemens String Co., and Twine is available and willing to cooperate with S. Clemens String Co. to file a reissue application. A subsequent reissue application includes Claim 2, which is similar to original Claim 1. However, one of the elements recited in Claim 2 is broader than its counterpart element in the original claim. The remaining five elements are narrower than their respective counterpart elements in the original patent claim. Which of the following scenarios accords with the USPTO rules and the procedures set forth in the MPEP?

- (A) The S. Clemens String Co. files the reissue application more than 2 years after the issue date of the original patent application.
- (B) The S. Clemens String Co. files the reissue application less than 2 years after the issue date of the original patent but more than 2 years after original application filing date.
- (C) Mark Twine files the reissue application less than 2 years after the issue date of the original patent but more than 2 years after original application filing date.
- (D) Mark Twine files the reissue application more than 2 years after the issue date of the original patent.
- (E) Mark Twine and the S. Clemens String Co. jointly file the reissue application more than 2 years after the issue date of the original patent.

15. Able conceived the invention claimed in a patent application. In conceiving the invention, Able used and adopted ideas and materials known in the art and invented by others. Ben, Able's employee, reduced the invention to practice at Able's request and totally pursuant to Able's suggestions. Being unable to afford a patent practitioner's fees to prepare and prosecute the application, Able convinced John to pay for the practitioner's services in return for an interest in the invention. John did nothing more than provide the funds for the practitioner. Which of the following is in accordance with the USPTO rules and the procedures set forth in the MPEP?

- (A) Able need not be the one to reduce the invention to practice so long as the reduction to practice occurred on his or her behalf. Able can be properly named as inventor in the application.
- (B) To be named an inventor, it is not necessary for John to have contributed to the conception of the invention. Ben, not Able, can be named as inventor in the application.
- (C) In conceiving the invention, Able may not consider and adopt ideas and materials derived from any sources, such as ideas of previous inventors. Able cannot be properly named as inventor in the application.
- (D) John and Able may be properly named as joint inventors of the invention in the application.
- (E) John, Ben, and Able may be properly named as joint inventors of the invention in the application.

16. Claim 1 of an application recites “[a]n article comprising: (a) a copper substrate; and (b) a electrically insulating layer on said substrate.” The specification defines the term “copper” as being elemental copper or copper alloys. In accordance with USPTO rules and procedures set forth in the MPEP, for purposes of searching and examining the claim, the examiner should interpret the term “copper” in the claim as reading on:

- (A) Elemental copper only, based on the plain meaning of “copper.”
- (B) Copper alloys only, based on the special definition in the specification.
- (C) Elemental copper and copper alloys, based on the special definition in the specification.
- (D) Any material that contains copper, including copper compounds.
- (E) None of the above.

17. Rolland files a U.S. patent application fourteen months after he perfects an invention in Europe. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following would establish a statutory bar against the granting of a U.S. patent to Rolland?

- (A) A foreign patent issued to Rolland 11 months prior to the filing date of Rolland’s U.S. patent application. The foreign patent was granted on an application that was filed 23 months prior to the effective filing date of Rolland’s U.S. patent application. The foreign patent application and the U.S. patent application claim the same invention.
- (B) The invention was described in a printed publication in the United States, 11 months prior to the filing date of the U.S. patent application.
- (C) The invention was in public use in the United States, less than one year prior to the filing date of the U.S. patent application.
- (D) The invention was on sale in a foreign (NAFTA member) country, more than one year prior to the filing date of the U.S. patent application.
- (E) None of the above.

18. In accordance with the USPTO rules and the procedures set forth in the MPEP, in which of the following cases is the date of actual receipt by the USPTO not accorded as the application filing date?

- (A) Provisional application filed without claims.
- (B) Non-provisional application filed containing an error in inventorship.
- (C) Non-provisional application filed which fails to identify the inventor(s).
- (D) Non-provisional application with executed oath filed without any claim(s).
- (E) Non-provisional application filed using a certificate of mailing in accordance with 37 CFR 1.8.

19. In connection with the utility of an invention described in a patent application, which of the following conforms to the USPTO rules and the procedure set forth in the MPEP?

- (A) A deficiency under 35 USC 101 also creates a deficiency under 35 USC 112, first paragraph.
- (B) To overcome a rejection under 35 USC 101, it must be shown that the claimed device is capable of achieving a useful result on all occasions and under all conditions.
- (C) A claimed invention is properly rejected under 35 USC 101 as lacking utility if the particular embodiment disclosed in the patent lacks perfection or performs crudely.
- (D) To overcome a rejection under 35 USC 101, it is essential to show that the claimed invention accomplishes all its intended functions.
- (E) A claimed invention lacks utility if it is not commercially successful.

20. Inventor Joe is anxious to get a patent with the broadest claim coverage possible for the invention. Joe retained a registered practitioner, Jane, to obtain the advantage of legal counsel in obtaining broad protection. Jane filed a patent application for the invention. The inventor heard that, although patent prosecution is conducted in writing, it is possible to get interviews with examiners. Joe believes an interview might hasten the grant of a patent by providing the examiner a better understanding of the true novelty of the invention. Which of the following are consistent with the USPTO rules and the procedures set forth in the MPEP regarding usage of interviews?

- (A) Prior to the first Office action being mailed the inventor calls the examiner to whom the application is docketed to offer help in understanding the specification.
- (B) After receiving the first Office action Jane calls the examiner for an interview for the purpose of clarifying the structure and operation of the invention as claimed and disclosed, because the examiner's analysis regarding patentability in the rejection is novel and suggests that the examiner is interpreting the claimed invention in a manner very different from the inventor's intent.
- (C) Jane has Larry, a registered practitioner in the Washington D.C. area, who is more familiar with interview practice to call the examiner. Jane gives Larry a copy of the first Office action, which suggests that the primary examiner's analysis is incorrect, and offers to explain why. Jane instructs Larry that because Larry is unfamiliar with the inventor, Larry should not agree to possible ways in which the claims could be modified, or at least indicate to the examiner that Jane would have to approve of any such agreement.
- (D) Jane calls the primary examiner after receiving the final rejection, demanding that the examiner withdraw the finality of the final action. When the examiner states that the final rejection is proper, Jane demands an interview as a matter of right to explain the arguments.
- (E) (B) and (D).

21. In accordance with the USPTO rules and the procedures set forth in the MPEP, a petition to make a patent application special may be filed without fee in which of the following cases?

- (A) The petition is supported by applicant's birth certificate showing applicant's age is 62.
- (B) The petition is supported by applicant's unverified statement that applicant's age is 65.
- (C) The petition is supported by applicant's statement that there is an infringing device actually on the market, that a rigid comparison of the alleged infringing device with the claims of the application has been made, and that applicant has made a careful and thorough search of the prior art.
- (D) The petition is accompanied by a statement under 37 CFR 1.102 by applicant explaining the relationship of the invention to safety of research in the field of recombinant DNA research.
- (E) The petition is accompanied by applicant's statement explaining how the invention contributes to the diagnosis, treatment or prevention of HIV/AIDS or cancer.

22. The Potter patent application was filed on June 6, 2002, claiming subject matter invented by Potter. The Potter application properly claims priority to a German application filed on June 6, 2001. In a first Office action all the claims of the Potter application are rejected under 35 USC 102(e) based on a U.S. patent application publication to Smith et al ("Smith"). A registered practitioner prosecuting the Potter application ascertains that the relevant subject matter in Smith's published application and Potter's claimed invention were, at the time Potter's invention was made, owned by ABC Company or subject to an obligation of assignment to ABC Company. The practitioner ascertains that the Smith application was filed on April 10, 2001 and that the Smith application was published on December 5, 2002. Smith and Potter do not claim the same patentable invention. To overcome the rejection without amending the claims which of the following replies would not comply with the USPTO rules and the procedures set forth in the MPEP to be an effective reply for overcoming the rejection?

- (A) A reply that only contains arguments that Smith fails to teach all the elements in the only independent claim, and which specifically points out the claimed element that Smith lacks.
- (B) A reply that consists of an affidavit or declaration under 37 CFR 1.131 properly proving invention of the claimed subject matter of the Potter application prior to April 10, 2001.
- (C) A reply that consists of an affidavit or declaration under 37 CFR 1.132 properly showing that Smith's invention is not by "another."
- (D) A reply that properly states that the invention of the Potter application and the Smith application were commonly owned by ABC Company at the time of the invention of the Potter application.
- (E) All of the above.

23. The claims in a patent application having been twice or finally rejected, the applicant files a timely Notice of Appeal on January 2, 2003. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following situations should the USPTO not notify the applicant that the Appeal Brief is defective and allow him an opportunity to correct the deficiency?

- (A) The Appeal Brief is filed on July 10, 2003, without a request for extension of time under 37 CFR 1.136.
- (B) The Appeal Brief is submitted unsigned.
- (C) The Appeal Brief states that the claims do not stand or fall together, and presents argument as to why the claims are separately patentable, but the primary examiner does not agree with the applicant's argument.
- (D) The Appeal Brief does not state whether the claims stand or fall together, but presents arguments why the claims subject to the same rejection are separately patentable.
- (E) The Appeal Brief does not address one of the grounds of rejection stated by the primary examiner.

24. Registered practitioner Joe duly files a non-provisional utility patent application on May 6, 1999. The USPTO sends Joe a notice of allowance dated November 13, 2000. On November 23, 2000, Joe learns about a publication ("Smith reference") which he knows to be material to patentability of the claims presented in the application, 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. In accordance with USPTO rules and procedure which of the following actions, if taken by Joe, will result in the examiner considering the Smith reference during prosecution of the application?

- (A) Prior to Wednesday, February 14, 2001, filing a request for continued examination of the application, the information disclosure statement, and the fee for a request for continued examination, but not paying the issue fee.
- (B) Timely paying the issue fee, and thereafter filing a request for continued examination of the application together with the information disclosure statement, and the fee for a request for continued examination, but not submitting a petition under 37 CFR 1.313.
- (C) After Tuesday, February 13, 2001, filing a request for continued examination of the application together with the information disclosure statement, and the fee for a request for continued examination, but not paying the issue fee.
- (D) Timely paying the issue fee, and after the patent issues filing a request for continued examination of the application, the information disclosure statement, the fee for a request for continued examination, and a petition under 37 CFR 1.313.
- (E) None of the above.

25. The specification in a patent application has been objected to for lack of enablement. To overcome this objection in accordance with the USPTO rules and the procedures set forth in the MPEP, a registered practitioner 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.

26. Co-inventors Smith and Jones filed an application for a patent on a cell phone, on May 15, 2002. They received a first Office action from a primary examiner rejecting the claims under 35 USC 102(a) over a publication by Bell and Watson, published on April 5, 2002, describing a cell phone having all the same features as is claimed in the patent application. In reply, the co-inventors each submitted a declaration under 37 CFR 1.131 stating that they had actually reduced the invention to practice no later than March 13, 2002. However, the declarations failed to include two claimed features. Neither the particular antenna needed to enable the cell phone could receive transmissions from the local cellular transmitting tower, nor a detachable carrying strap was included in the declarations. As evidence of their prior reduction to practice, Smith and Jones submitted their co-authored journal article. The journal article contained a figure of the cell phone as described in the declarations. That is, the cell phone shown in the figure of the article lacked an antenna and a detachable strap. The article was received by the journal on March 13, 2002, and was published on April 30, 2002. The cell phones shown in the figure in the Bell and Watson publication, and in the Smith and Jones patent application have the particular antenna and a detachable strap. Which of the following actions, if taken by the examiner, would be the most proper in accordance with USPTO rules and the procedures set forth in the MPEP?

- (A) The examiner should maintain the rejection of the claims under 35 USC 102(a) and make the rejection final.
- (B) The examiner should withdraw the rejection and look for references which have a publication date prior to May 15, 2001.
- (C) The examiner should withdraw the rejection and notify Smith and Jones that their application is in condition for allowance.
- (D) The examiner should maintain the rejection, but indicate that the claims would be allowable if Smith and Jones provided an original copy of the figure published in their journal article as factual support for their declarations.
- (E) The examiner should maintain the rejection and inform Smith and Jones that the declarations are insufficient because they cannot “swear behind” a reference which is a statutory bar.

27. On January 2, 2001, a registered practitioner filed a patent application with the USPTO for inventor Bock. The application includes a specification and a single claim to the invention, which reads as follows:

1. A new string consisting only of material Z that has the ability to stretch to beyond its initial unstretched length.

On June 2, 2001, the practitioner received an Office action from the primary examiner rejecting the claim. The claim is solely rejected under 35 USC 102 in view of Patent A, which discloses a string consisting only of material Z. The Office action states, "Patent A discloses a string consisting only of material Z. Patent A does not expressly teach the stretchability property of the string. Nevertheless, the recited stretchability is inherent in the string of patent A. Accordingly, patent A anticipates the claimed string." Mr. Bock believes he is entitled to a patent to his new string and authorizes the practitioner to reply to the Office action by arguing that his string stretches to ten times its initial unstretched length, something that patent A does not teach. Since this is not expressly taught in Patent A, the practitioner argues, Patent A cannot anticipate the claimed string. In accordance with USPTO rules and procedures set forth in the MPEP, is the practitioner's reply persuasive as to error in the rejection?

- (A) Yes.
- (B) Yes, but the claim should now be rejected again, this time under 35 USC 103 as obvious over Patent A.
- (C) Yes, because the stretchability property is expressly taught by Patent A.
- (D) Yes, examiner nowhere addresses the claimed limitation of stretching the string beyond its initial unstretched length.
- (E) No.

28. Ben hires a registered practitioner to prosecute his patent application. The practitioner drafted an application having fifteen claims. Claim 1 is independent, and each of claims 2-15 are singularly dependent upon claim 1. A proper non-final Office action is mailed to the practitioner. Following consultation with Ben, the practitioner timely prepared, signed, and filed a reply to the Office action containing an amendment that does not add new matter, but does add claims 16-27. Each of claims 16-27 is directed to the same invention sought to be patented through claims 1-15. The dependency of each of claims 16-27 reads "any of claims 5-15." For purposes of fee calculation in accordance with the USPTO rules and the procedures set forth in the MPEP, how many total claims are contained in the application after the amendment is entered?

- (A) One hundred thirty-six.
- (B) One hundred thirty-five.
- (C) Twenty-seven.
- (D) One hundred forty-seven.
- (E) Fifteen.

29. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following statements regarding operability or enablement of a prior art reference is the most correct?

- (A) The level of disclosure required for a reference to be enabling prior art is no less if the reference is a United States patent than if it is a foreign patent.
- (B) A reference is not presumed to be operable merely because it expressly anticipates or makes obvious all limitations of an applicant's claimed apparatus.
- (C) A non-enabling reference may not qualify as prior art for the purpose of determining anticipation or obviousness of the claimed invention.
- (D) A reference does not provide an enabling disclosure merely by showing that the public was in possession of the claimed invention before the date of the applicant's invention.
- (E) All of the above are correct.

30. Joan goes to a registered practitioner wanting to know the status of the applications of her competitor Pete. During Joan's previous relationship with Pete she believes she may have been a coinventor on one of the applications filed by Pete. Pete owns Applications A, B, C and D. Application B is a continuation of Application A and a redacted copy of Application A has been published under 35 USC 122(b). Joan is listed as a coinventor on Application C. Pete has an issued patent that claims priority to Application D. Assume only the last six digits of the numerical identifier are available for Application D and Application D is abandoned. Which of the following, in accordance with the USPTO rules and the procedures set forth in the MPEP, is not true?

- (A) Joan may obtain status information for Application B that is a continuation of an Application A since Application A has been published under 35 USC 122(b).
- (B) Joan may be provided status information for Application D that includes the filing date if the eight-digit numerical identifier is not available and the last six digits of the numerical identifier are available.
- (C) Joan may obtain status information for Application D since a U.S. patent includes a specific reference under 35 USC 120 to Application D, an abandoned application. Joan may obtain a copy of that application-as-filed by submitting a written request including the fee set forth in 37 CFR 1.19(b)(1).
- (D) Joan may obtain status information as to Application C since a coinventor in a pending application may gain access to the application if his or her name appears as an inventor in the application, even if she did not sign the § 1.63 oath or declaration.
- (E) Joan may obtain access to the entire Application A by submitting a written request, since, notwithstanding the fact that only a redacted copy of Application A has been published, a member of the public is entitled to see the entire application upon written request.



31. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following is true?

- (A) When the subject matter of an appeal is particularly difficult to understand, a patentability report is prepared by an examiner in order to present the technical background of the case to the Board of Patent Appeals and Interferences.
- (B) In those appeals in which an oral hearing has been confirmed and either the Board of Patent Appeals and Interferences or the primary examiner has indicated a desire for the examiner to participate in the oral argument, oral argument may be presented by the examiner whether or not the appellant appears.
- (C) If a patent applicant files a notice of appeal which is unsigned, it will be returned for signature, but the applicant will still receive the filing date of the unsigned notice of appeal.
- (D) Statements made in information disclosure statements are not binding on an applicant once the patent has issued since the sole purpose of the statement is to satisfy the duty of disclosure before the Office.
- (E) None of the above.

32. On January 2, 2001, a registered practitioner filed a patent application with the USPTO for inventor Bloc. The application includes a specification and a single claim to the invention which reads as follows:

1. Compound Y.

In the specification, Bloc explains that compound Y is an intermediate in the chemical manufacture of synthetic Z. With respect to synthetic Z, the specification discloses its structural formula and further states that synthetic Z is modeled on the natural form of Z to give it the same therapeutic ability to alleviate pain. The specification goes on to state that synthetic Z is also a cure for cancer. On June 2, 2001, the practitioner received an Office action from the primary examiner rejecting the claim. The claim is rejected under 35 USC 101 as being inoperative; that is, the synthetic Z does not operate to produce a cure for cancer (*i.e.*, incredible utility). Bloc believes he is entitled to a patent to his compound Y. In accordance with USPTO rules and procedures set forth in the MPEP, how best should the practitioner reply to the rejection of the claim?

- (A) Advise Bloc that he should give up because a cure for cancer is indeed incredible and is unproven.
- (B) File a reply arguing that a cure for cancer is not incredible and he can prove it if given the chance.
- (C) File a reply arguing that whether or not a cure for cancer is incredible is superfluous since Bloc has disclosed another utility – alleviating pain, which is not incredible.
- (D) File a reply arguing that the claim is directed to compound Y, not synthetic Z.
- (E) File a reply arguing that synthetic Z is modeled on the natural form of Z.

33. Application No. A was published as U.S. Patent Application Publication No. B. A member of the public reviewed the listing of the file contents of the application on the Patent Application Information Retrieval system and determined that the application was still pending, that a final Office action was mailed, and that the application file is in the Technology Center where it is being examined. The member of the public does not have a power to inspect, but would like a copy of the final Office action as well as the other papers in the patent application. In accordance with the USPTO rules and the procedures set forth in the MPEP, can a copy of these papers be obtained by the member of the public, and if so, how can the copy be obtained?

- (A) No, a copy cannot be obtained because patent applications are maintained in confidence pursuant to 35 USC 122(a).
- (B) No, a copy cannot be obtained because the patent application is still pending.
- (C) Yes, a member of the public can go to the Technology Center and ask for the file for copying at a public photocopier.
- (D) Yes, the member of the public can complete a “Request for Access to an Application Under 37 CFR 1.14(e)” and, without payment of a fee, order the file from the File Information Unit. Upon the Unit’s receipt of the application, the member of the public can use a public photocopier to make a copy.
- (E) Yes, the member of the public can order a copy from the Office of Public Records, with a written request and payment of the appropriate fee.

34. A first Office action on the merits rejecting Claim 1 under 35 USC 103 as being obvious in view of reference A set a three month shortened statutory period for reply. A registered practitioner files a timely response (without an extension of time) to the first Office action amending Claim 1 to include a limitation not found in reference A or any other prior art of record. However, the limitation also lacks support in applicant’s original disclosure, *i.e.*, it is new matter. Which of the following courses of action, if taken by the primary examiner, would be in accord with the USPTO rules and the procedures set forth in the MPEP?

- (A) Hold the application abandoned after expiration of the three month shortened statutory period for reply because an amendment adding new matter to the claims is not a *bona fide* response.
- (B) Consider the new matter and reject Claim 1 under 35 USC 101 because a claim that recites new matter lacks utility.
- (C) Consider the new matter and treat Claim 1, determining whether the invention as claimed with the new matter, would have been obvious in view of reference A, and reject Claim 1 under 35 USC 112, first paragraph, for lack of support in the original disclosure for new matter.
- (D) Ignore the new matter and reject Claim 1 again under § 103 in view of reference A.
- (E) All of the above.

35. Which of the following is a proper basis for establishing a substantial new question of patentability to obtain reexamination in accordance with proper USPTO rules and the procedures set forth in the MPEP?

- (A) An admission *per se* by the patent owner of record that the claimed invention was on sale, or in public use more than one year before any patent application was filed in the USPTO.
- (B) A prior art patent that is solely used as evidence of an alleged prior public use.
- (C) A prior art patent that is solely used as evidence of an alleged insufficiency of disclosure.
- (D) A printed publication that is solely used as evidence of an alleged prior offer for sale.
- (E) None of the above.

36. Which of the following is not a policy underlying the public use bar of 35 USC 102(b)?

- (A) Discouraging the removal, from the public domain, of inventions that the public reasonably has come to believe are freely available.
- (B) Favoring the prompt and widespread disclosure of inventions.
- (C) Allowing the inventor(s) a reasonable amount of time following sales activity to determine the potential economic value of a patent.
- (D) Increasing the economic value of a patent by extending the effective term of the patent up to one year.
- (E) Prohibiting the inventor(s) from commercially exploiting the invention for a period greater than the statutorily prescribed time.

37. In accordance with the USPTO rules and the procedures set forth in the MPEP, a grant of small entity status entitles an applicant to which of the following?

- (A) Applicant will receive an accelerated examination by having the application advanced out of order.
- (B) Applicant can use a certificate of mailing under 37 CFR 1.8 to obtain a U.S. filing date that is earlier than the actual USPTO receipt date of the application.
- (C) Applicant will obtain a refund of all fees paid to the USPTO where applicant demonstrates: (i) a changed purpose for which the fees were paid, (ii) the fees were not paid by mistake, and (iii) the fees were not paid in excess of the amount required.
- (D) Applicant can pay a fee to file a request for continued examination pursuant to 37 CFR 1.114 that is less than the fee paid by other than a small entity.
- (E) None of the above.

38. In accordance with USPTO rules and the procedures set forth in the MPEP, an amendment filed with or after a notice of appeal under 37 CFR 1.191(a), but before jurisdiction has passed to the Board of Patent Appeals and Interferences, should be entered by the primary examiner where the amendment:

- (A) requests unofficial consideration by the examiner.
- (B) is less than six pages long.
- (C) removes issues from appeal.
- (D) presents more specific claims, because it is believed that they may have a better chance of being allowable even though the claims do not adopt the examiner's suggestions.
- (E) introduces new issues, allowing the examiner to rethink his position.

39. An examiner has properly established a *prima facie* showing of no specific and substantial credible utility for the claimed invention in a patent application filed in February 2001. An applicant can sustain the burden of rebutting and overcoming the showing in accordance with the USPTO rules and the procedures set forth in the MPEP by:

- (A) Providing reasoning or arguments rebutting the basis or logic of the *prima facie* showing.
- (B) Amending the claims.
- (C) Providing evidence in the form of a declaration under 37 CFR 1.132 rebutting the basis or logic of the *prima facie* showing.
- (D) Providing evidence in the form of a printed publication rebutting the basis or logic of the *prima facie* showing.
- (E) All of the above.

40. Which of the following is not a proper incorporation by reference in an application prior to allowance according to the USPTO rules and the procedures set forth in the MPEP?

- (A) Incorporating material necessary to describe the best mode of the claimed invention by reference to a commonly owned, abandoned U.S. application that is less than 20 years old.
- (B) Incorporating non-essential material by reference to a prior filed, commonly owned pending U.S. application.
- (C) Incorporating material that is necessary to provide an enabling disclosure of the claimed invention by reference to a U.S. patent.
- (D) Incorporating non-essential material by reference to a hyperlink.
- (E) Incorporating material indicating the background of the invention by reference to a U.S. patent which incorporates essential material.

41. Evidence that a claim may not comply with the second paragraph of 35 USC 112 occurs in accordance with the USPTO rules and the procedure set forth in the MPEP where:

- (A) Remarks filed by applicant in a reply or brief regarding the scope of the invention differ and do not correspond in scope with the claim.
- (B) There is a lack of agreement between the language in the claims and the language set forth in the specification.
- (C) The scope of the claimed subject matter is narrowed during pendency of the application by deleting the originally much broader claims, and presenting claims to only the preferred embodiment within the originally much broader claims.
- (D) Claims in a continuation application are directed to originally disclosed subject matter (in the parent and continuation applications) which applicants did not regard as part of their invention when the parent application was filed.
- (E) All of the above.

42. Paprika is a known product. A patent application discloses a composition which is made by subjecting paprika to processing steps X, Y and Z. The composition is disclosed to be useful in treating cancer. The application was filed June 1, 2002. A reference published May 1, 2001 discloses a food product made by subjecting paprika to processing steps X, Y and Z. The reference does not disclose that the resulting composition has any properties that would make it useful for treating cancer. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following claims is not anticipated by the reference?

- (A) A composition made by the process of subjecting paprika to processing steps X, Y and Z, wherein the composition is effective for treating cancer.
- (B) A composition for treating cancer, made by the process of subjecting paprika to processing steps X, Y and Z.
- (C) A method of making a cancer-treating composition, comprising subjecting paprika to processing steps X, Y and Z.
- (D) A method of treating cancer, comprising administering an effective amount of a composition made by subjecting paprika to processing steps X, Y and Z.
- (E) All of the above.

43. Which of the following definitions does not accord with proper USPTO rules and the procedures set forth in the MPEP relating to drawings in patent applications?

- (A) Original drawings are drawings submitted with the application when filed, and may be either formal or informal.
- (B) Formal drawings are stamped “approved” by the Draftsperson.
- (C) Drawings may be informal for reasons such as the size of reference elements.
- (D) A substitute drawing is usually submitted to replace an original formal drawing.
- (E) A drawing may be declared as informal by the applicant when filed.

44. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following, if any, is true?

- (A) The loser in an interference in the PTO is estopped from later claiming he or she was the first to invent in a Federal District Court since the loser must win in the USPTO or he/she will lose the right to contest priority.
- (B) A person being sued for infringement may file a request for reexamination without first obtaining the permission of the Court in which the litigation is taking place.
- (C) A practitioner may not represent spouses, family members or relatives before the USPTO since such representation inherently creates a conflict of interest and a practitioner is likely to engage in favoritism over his/her other clients.
- (D) Employees of the USPTO may not apply for a patent during the period of their employment and for two years thereafter.
- (E) None of the above.

45. AI files an application for a patent. After the Notice of Allowance is mailed and the issue fee has been paid AI discovers a prior art reference which is material to patentability. What should AI do in accordance with the USPTO rules and the procedures set forth in the MPEP?

- (A) AI should file a prior art statement under 37 CFR 1.501 that will be placed in the patent file upon issuance of the application as a patent.
- (B) Since the issue fee has been paid, AI no longer has a duty to disclose to the Office material prior art. He is under no obligation to submit the prior art reference to the Office.
- (C) Since the issue fee has been paid, it is too late to have the examiner consider the reference in this application. AI should file a continuation application to have the reference considered and allow the original patent application to issue as a patent.
- (D) AI should file a petition to have the application withdrawn from issuance, citing the finding of additional material prior art as the reason for withdrawal. A continuation application should also be filed with an information disclosure statement containing the reference in order to have the reference considered.
- (E) AI should file an amendment under 37 CFR. 1.312 deleting all of the claims which are unpatentable over the reference since an amendment deleting claims is entitled to entry as a matter of right.

46. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following is not a “printed publication” under 35 USC 102(b), with respect to a patent application filed June 1, 2002?

- (A) A paper that was orally presented at a meeting held May 1, 2001, where the meeting was open to all interested persons and the paper was distributed in written form to six people without restriction.
- (B) A doctoral thesis that was indexed, cataloged, and shelved May 1, 2001, in a single, university library.
- (C) A research report distributed May 1, 2001, in numerous copies but only internally within an organization and intended to remain confidential.
- (D) A reference available only in electronic form on the Internet, which states that it was publicly posted May 1, 2001.
- (E) A technical manual that was shelved and cataloged in a public library as of May 1, 2001, where there is no evidence that anyone ever actually looked at the manual.

47. John, unaware of the existence of Jane’s U.S. patent, which issued on Tuesday, July 11, 2000, files a patent application on Friday, January 11, 2001. John’s application and Jane’s patent are not commonly owned. On Thursday, July 11, 2001, in reply to an Office action rejecting all of his claims, John files an amendment canceling all of his claims and adding claims setting forth, for the first time, “substantially the same subject matter” as is claimed in Jane’s patent. The examiner rejects John’s claims on the basis of 35 USC 135(b). Which of the following statements accords with the USPTO rules and the procedures set forth in the MPEP?

- (A) The rejection is improper because 35 USC 135(b) relates to interferences.
- (B) The rejection is proper because 35 USC 135(b) is not limited to *inter partes* proceedings, but may be used as a basis for *ex parte* rejections.
- (C) Since John’s claims would interfere with Jane’s unexpired patent, the proper procedure is for the examiner to declare an interference rather than to reject John’s claims.
- (D) The rejection is proper merely by reason of the fact that John’s claims are broad enough to cover the patent claims.
- (E) The rejection is improper inasmuch as John is claiming “substantially the same subject matter” as is claimed in the patent.

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

- (A) Canceled matter in the application file of a U.S. patent is a prior art reference as of the filing date under 35 USC 102(e).
- (B) Where a patent refers to and relies on the disclosure of a copending subsequently abandoned application, such disclosure is not available as a reference.
- (C) Where the reference patent claims the benefit of an earlier filed, copending but subsequently abandoned application which discloses subject matter in common with the patent, and the abandoned application has an enabling disclosure for the common subject matter and the claimed matter in the reference patent, the effective date of the reference patent as to the common subject matter is the filing date of the reference patent.
- (D) Matter canceled from the application file wrapper of a U.S. patent may be used as prior art as of the patent date.
- (E) All foreign patents are available as prior art as of the date they are translated into English.

49. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following statements regarding claim interpretation during patent prosecution is incorrect?

- (A) A claim is to be given its broadest reasonable interpretation in light of the supporting disclosure in the specification.
- (B) Because a claim is read in light of the specification, the claim may properly be narrowed by interpreting it as including elements or steps disclosed in the specification but not recited in the claim.
- (C) If an applicant does not define a claim term in the specification, that term is given its ordinary meaning in the art.
- (D) When an explicit definition of a claim term is provided in an applicant's specification, that definition controls the interpretation of the term as it is used in the claims.
- (E) Means plus function language in claims which defines the characteristics of a machine or manufacture includes only the corresponding structures or materials disclosed in the specification and equivalents thereof.



50. A registered practitioner files a nonprovisional utility application in 2000. In 2002, the practitioner files a continuation-in-part application and claims benefit of the filing date of the 2000 application for the 2002 application. Thereafter, the practitioner amends the 2002 application to include claims that were not present in either the originally filed 2000 application or the originally filed 2002 application. The primary examiner properly concludes that the added claims are not supported by the original disclosure in either application. Which of the following is in accord with the USPTO rules and the procedures set forth in the MPEP?

- (A) The added claims are rejected for lack of written description under 35 USC 112, first paragraph.
- (B) The added claims are rejected as new matter under 35 USC 132.
- (C) The added claims are denied benefit of the filing date of the 2000 application.
- (D) (A) and (B).
- (E) (A) and (C).

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