

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

**August 27, 1997**

**Morning Section (100 Points)**

**Time: 3 Hours**

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**DIRECTIONS**

This section 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 section 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 (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 section of the examination consists of fifty (50) multiple choice questions, each worth two (2) points. Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant or design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

You may write anywhere on this examination booklet. However, do not remove any pages from the booklet. Only answers recorded in SECTION 1 of your Answer Sheet will be graded. **YOU MUST SCORE AT LEAST 70 POINTS TO PASS THIS SECTION OF THE REGISTRATION EXAMINATION.**

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

1. On March 20, 1997, inventor B filed a patent application in the PTO claiming invention X. Inventor B did not claim priority based on a foreign application filed by inventor B on June 3, 1996, in the Patent Office of Germany. In the foreign application, inventor B disclosed and claimed invention X, which inventor B had conceived on October 10, 1995, and reduced to practice on January 5, 1996, all in Germany. The patent examiner issued an Office action where all the claims in the patent application were properly rejected under 35 U.S.C. § 102(a) and (e) as being anticipated by a U.S. patent granted to inventor Z on November 5, 1996, on a patent application filed in the PTO on February 6, 1995. There is no common assignee between Z and B, and they are not obligated to assign their inventions to a common assignee. Moreover, inventor Z, independently of inventor B, invented invention X, and did not derive anything from inventor B. The U.S. patent discloses, but does not claim, invention X. Which of the following is/are appropriate response(s) which could overcome the rejections under § 102(a) and (e) when timely filed?

- (A) Amend the claims to require particular limitations disclosed in inventor B's application, but not disclosed or suggested in inventor Z's patent, and argue that the limitations patentably distinguish the claimed invention over the prior art.
- (B) File an antedating affidavit or declaration under 37 CFR § 1.131 showing conception on October 10, 1995, and reduction to practice on January 5, 1996, all in Germany.
- (C) File a claim for the right and benefit of foreign priority wherein the German application is correctly identified, file a certified copy of the original German patent application, and argue that as a result of the benefit of foreign priority, the U.S. patent is no longer available as a prior art reference against the claims.
- (D) (A), (B) and (C).
- (E) (A) and (C) only.

2. Which of the following scenarios is most likely to bar X and Y from being joint inventors in an application?

- (A) X and Y worked on the invention during the same time frame but in different physical locations.
- (B) X's contribution was solely to claim 1, whereas inventor Y's contribution was solely to claim 2.
- (C) X discovered that the source of the trouble with the operation of his paper press was its slow speed and concluded that a slight change in wire slope might improve the speed. When informed of this, inventor Y, who was very skeptical at first, made the change in the slope of the wire and found to his surprise that a significant improvement in speed did in fact occur.
- (D) X and Y worked on the invention while in the employ of different employers.
- (E) X's contribution to the invention amounted to about 95%, whereas Y's contribution amounted to only about 5 %.

3. Inventors Apple and Cherry are employed by Fruit Company, each with knowledge of the other's work, and with an obligation to assign inventions to Fruit Company. Apple invented A in September 1996. On October 30, 1996, Cherry modified A to AB, an obvious improvement of A. Apple filed a patent application in the PTO on November 6, 1996, claiming invention A. Cherry filed a patent application in the PTO on February 11, 1997, claiming AB. In an Office action in Cherry's application, the claims to AB are provisionally rejected under 35 U.S.C. § 102(e)/103 over Apple's application, and provisionally rejected for double patenting over Apple's application. These are the only remaining rejections. In order to properly overcome the rejections and ensure that Fruit Company can sue an alleged infringer of claims to AB, Cherry should:

- (A) File a terminal disclaimer and appropriate fee.
- (B) File an affidavit or declaration under 37 CFR § 1.131 showing a date of invention for AB prior to the invention of A.
- (C) File an affidavit or declaration under 37 CFR § 1.131 showing October 30, 1996, to be the date of invention of AB, a petition under 37 CFR § 1.183 to waive the prohibition of the use of 37 CFR § 1.131 affidavits or declarations where the same patentable invention is being claimed, and a terminal disclaimer and appropriate fee.
- (D) File an affidavit or declaration under 37 CFR § 1.131 showing the date of invention of AB to be prior to the filing date of Apple's application, a petition under 37 CFR § 1.183 to waive the prohibition of the use of 37 CFR § 1.132 affidavits or declarations where substantially the same patentable invention is being claimed, and a disclaimer of any patent which may issue and the appropriate fee.
- (E) File an affidavit or declaration under 37 CFR § 1.131 showing the date of invention of AB to be prior to the filing date of Apple's application.

4. Independently of each other, M and Z invented the same tennis racket in the United States. A U.S. patent was granted to M on February 18, 1997, on an application filed on April 12, 1995, claiming the same tennis racket. On March 10, 1997, Z filed a patent application in the PTO claiming the same tennis racket. There is no common assignee between M and Z, and they are not obligated to assign their inventions to a common assignee. M and Z filed their respective patent applications diligently shortly after each conceived the tennis racket invention. Under which of the following provisions of 35 U.S.C. § 102 is the U.S. patent to M prior art with regard to the tennis racket claimed by Z?

- (A) 35 U.S.C. § 102(a).
- (B) 35 U.S.C. § 102(e).
- (C) 35 U.S.C. § 102(g).
- (D) (A) and (B) only.
- (E) (A), (B), and (C).

5. X invented a glass cutter. On June 20, 1994, X filed a first patent application in the PTO wherein X disclosed and claimed the glass cutter. On September 20, 1995, X filed a second patent application in the PTO, again disclosing and claiming the glass cutter. The disclosure in the second application is identical to the disclosure in the first application, but the second application did not refer to the first application, or otherwise indicate that the second application was a continuation of the first application. The first application was expressly abandoned on September 21, 1995. On January 15, 1997, X filed a third application in the PTO, disclosing and claiming the glass cutter. In the first sentence of the specification of the third application, X stated that the third application was a continuation application of the second application. The second application was expressly abandoned on January 16, 1997. X later amended the first sentence of the third application to state that the second application was "now abandoned." In an Office action dated May 5, 1997, the claims in the third application were rejected as being anticipated under 35 U.S.C. § 102(b) by a foreign patent published on August 1, 1994. There is no difference between the glass cutter described in the foreign patent and the glass cutter which is claimed. The foreign patent provides an enabling disclosure to make the claimed glass cutter. At the time it is made, the rejection is

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- (A) improper because the third application has the benefit of the filing date of the second application which, in turn, has the benefit of the first application which, in turn, antedates the reference.
- (B) improper because the third application has the benefit of the filing dates of the first and second applications, and the foreign patent is antedated by the filing date of the first application.
- (C) improper because the foreign patent is effective as a publication after the filing date of the first application.
- (D) proper because the third application has the benefit of the filing date of the second application, but not the first application, and the foreign patent was published more than one year before the filing date of the second application.
- (E) proper because the effective filing date of the third application is January 15, 1997, which is more than one year after the publication date of the foreign patent.

6. A Demand for International Preliminary Examination must be filed with:

- (A) The Receiving Office.
- (B) The International Bureau.
- (C) The International Preliminary Examining Authority.
- (D) The International Searching Authority.
- (E) Any of the above.

7. X invented a chemical composition. On June 20, 1994, X filed a first patent application in the PTO wherein X disclosed and claimed the same composition, and claimed benefit of priority of a British application. The patent examiner twice rejected the claims in the first application under 35 U.S.C. § 112, first paragraph, for lack of an enabling disclosure. The examiner maintained the rejection in a final rejection. On appeal to the Board of Patent Appeals and Interferences, the rejection was affirmed in a decision dated February 4, 1997. On March 31, 1997, X filed a second application disclosing and claiming the same chemical composition, and containing an enabling disclosure of how to make the composition. The first sentence of the specification of the second application contains a specific reference to the first application. On April 1, 1997, X expressly abandoned the first application, and amended the first sentence of the second application to state that the first application was "now abandoned." X did not seek judicial review of the Board's decision. In an Office action dated May 5, 1997, all the claims in the second application were rejected as being anticipated under 35 U.S.C. § 102(b) over an article in Composition Magazine which was published and on newsstands in the United States and Great Britain in June 1995. The article provides a full and enabling description of the claimed chemical composition, and provides readers with addresses in the United States and Great Britain where the composition may be purchased. The rejection is

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- (A) improper because the claims of the second application have the benefit of the filing date of the first application which, in turn, antedates the reference.
- (B) proper because the claim of the second application have no benefit of the filing date of the first application, and the article was published and the invention was offered for sale in the United States more than one year before the filing date of the second application.
- (C) improper because the article constitutes an offer for sale of the chemical composition in Great Britain as well as in the United States.
- (D) improper because the article is effective as a publication only after the filing date of the first application.
- (E) proper because the article offers the chemical compositions for sale in Great Britain which, pursuant to GATT, is in this country for purposes of 35 U.S.C. § 102.

8. To comply with the statutory requirements for a specification in a U.S. patent application, the specification must include all of the following except:

- (A) The best mode contemplated by the inventor of carrying out his or her invention.
- (B) A written description of an actual reduction to practice of the claimed invention.
- (C) A written description of the invention.
- (D) The manner and process of making the invention.
- (E) The manner and process of using the invention.

9. X invented a compound Y useful for treating HIV patients. X attended a conference on AIDS in Chicago, Illinois on December 2, 1995, and gave an oral presentation specifically identifying compound Y and its method of use for treating HIV patients. An article was published in the *Chicago Tribune* newspaper on December 3, 1995, identically disclosing compound Y and its method of use for treating HIV, including teaching each and every element of compound Y. Neither X's paper nor the newspaper article disclosed how to make compound Y. X filed a patent application in the PTO on January 6, 1997, claiming compound Y. The examiner rejected the claim as being anticipated under 35 U.S.C. § 102(b) over the newspaper article in view of two U.S. patents issued in 1994. The patents teach methods of making compounds of the same general class of compounds as compound Y, and describe several methods by which compound Y can be made. The patents disclosed using the compounds disclosed therein to digest food. The rejection is \_\_\_\_\_

- (A) improper because it is never proper to use more than one reference in a 35 U.S.C. § 102 rejection.
- (B) improper in the absence of motivation to combine the references.
- (C) improper because the compounds in the patents and compound Y have different uses.
- (D) proper because the article describes compound Y, and the patents are evidence of what was in the public's possession before X's invention regarding how to make compound Y.
- (E) proper because the article describes compound Y, and the patents are superfluous inasmuch it is not necessary that the article describe how to make compound Y.

10. On January 7, 1997, practitioner P filed in the PTO a patent application wherein invention X is claimed. On January 8, 1997, practitioner S filed in the PTO a patent application wherein XY is the claimed invention. XY is disclosed in the later filed application to be an obvious improvement upon X. In which of the following situations would it be inappropriate for a provisional rejection of claims under 35 U.S.C. § 102(e)/103 to be made in the later filed patent application over the copending, earlier filed but issued patent application?

- (A) Neither of the copending applications contain a showing whether the applications have a common assignee, A is named as the inventor in the earlier filed application, and B is named as the inventor in the later filed application.
- (B) Neither of the copending applications contain a showing whether the applications have a common assignee, A is named as the inventor in the earlier filed application, and A and B are named as the inventors in the later filed application.
- (C) A is named as the inventor in the earlier filed application, A and B are named as the inventors in the later filed application, and the later filed application contains a showing that C is the common assignee of the two applications.
- (D) A is named as the inventor in the earlier filed application, B is named as the inventor in the later filed application, and the later filed application contains a showing that C is the common assignee of the two applications.
- (E) A is named as the inventor in the earlier filed application, A and B are named as the inventors in the later filed application, and the later filed application contains a showing that B is the common assignee of the two applications.

11. Which of the following is false regarding interviews?

- (A) Patent examiners are forbidden to hold interviews with an unregistered or disbarred attorney regarding a patent application, unless the attorney is the applicant.
- (B) A request for an interview on the merits prior to the filing of a first filed original patent application normally is permitted.
- (C) A request for an interview on the merits prior to a first action in a continuation or substitute application is ordinarily granted.
- (D) A complete written statement as to the substance of a face-to-face or telephone interview with regard to the merits of an application must be made of record in the application, whether or not agreement with the examiner has been reached.
- (E) If a registered practitioner, who is not an attorney or agent of record, seeks an interview and has in his or her possession a copy of the application filed, the examiner may accept the practitioner's statement that he or she is authorized to represent the applicant and may hold an interview with the registered practitioner.

12. On April 4, 1997, practitioner P filed a patent application for inventor S claiming a laminate of several layers. The examiner rejected the claims in the application as being anticipated under 35 U.S.C. § 102(a) and 102(e) over a U.S. patent granted on February 11, 1997, to Jones which describes the laminate in the specification, and how to make the laminate. Jones did not claim the laminate, or derive the laminate from S. The patent was granted to Jones on an application filed on November 2, 1994. The claims in the Jones patent are directed to a substrate having a single layer. S first conceived his invention on July 4, 1995. Which of the following would be (an) appropriate response(s) to overcome the rejection?

- (A) Amending the claim by adding limitations which are supported by the specification in S's application, and are not disclosed or suggested by the Jones patent, request reconsideration, and clearly point out the patentable novelty of the amended claim presented over Jones.
- (B) Produce evidence of secondary considerations such as unexpected results or commercial success.
- (C) Argue that the claimed invention in the Jones patent is non-analogous art or teaches away from the invention.
- (D) Argue that the Jones patent is not evidence that the invention was known "by others," as required by 35 U.S.C. § 102(a) since Jones is a single person, whereas "others" requires plural persons.
- (E) B and C.

13. Inventor Jones retained registered practitioner P to prepare and file a patent application claiming Jones' invention. P prepared and filed the application together with a declaration wherein Jones appointed P to represent him and conduct all business before the PTO. While P was away on a vacation, Jones filed a preliminary amendment in the application amending the claims, and no Office action on the merits was issued by the PTO examiner. The amendment was signed by Jones, but not P. When P returned from vacation, Jones provided P with a copy of the amendment. Upon review of the amendment, P realized that the scope of the claims had been broadened, that the broadened claims are supported by the original disclosure, and that the claims now read upon prior art which Jones disclosed to P, but which was not disclosed in the specification. The prior art reference is not material to the patentability of the original claims in the application. Which of the following actions of P accords with proper PTO practice and procedure and is the most likely to place the application in condition for allowance?

- (A) File a supplemental amendment arguing that the Jones amendment should not be entered on the ground that 37 CFR § 1.33 provides that "Double correspondence with an applicant and his attorney or agent . . . will not be undertaken."
- (B) File a supplemental amendment canceling all amendatory changes effected by the Jones amendment.
- (C) File a supplemental amendment which (1) cancels all the claims in the patent application, (2) adds the original claims, and (3) argues that the newly added claims are supported by the disclosure.
- (D) File a supplemental amendment which (1) adds the original claims, (2) cites to the examiner the prior art reference disclosed by Jones to P with an explanation of how the newly added claims patentably distinguish over such prior art reference, and (3) argues that the added claims are supported by the disclosure.
- (E) File a supplemental amendment which (1) adds the original claims, (2) cites to the examiner the prior art reference disclosed by Jones to P with an explanation of how all the claims in the application patentably distinguish over such prior art reference, and (3) argues that all the claims in the application are supported by the disclosure.

14. Applicant filed a patent application claiming a widget which included a "sluiced cotter pin" as a means for holding a wheel to a shaft. The specification contained no details of the sluiced cotter pin and such a pin was not commonly known in the art. However, the specification noted details of such a pin could be found in an article published in a particular issue of a popular magazine. The examiner objected to the specification on the ground that it improperly incorporated the material of the publication by reference. Which of the following actions would accord with proper PTO practice and procedure in overcoming the objection?

- (A) File an amendment enclosing a copy of the magazine article.
- (B) File an affidavit attesting to the fact that you have personally read the article and that the details of the pin are clearly set forth therein.
- (C) Amend the specification to include the material incorporated by reference.



- (D) File a declaration executed by a registered practitioner stating that the amendatory material consists of the same material incorporated by reference.
- (E) Amend the specification to include the material incorporated by reference, and accompany it with an affidavit stating that the amendatory material consists of the same material incorporated by reference.

15. Inventor Jones invented Y in the United States on November 5, 1995, and hired practitioner P to prepare and file a provisional application. On February 9, 1996, P filed a provisional patent application in the PTO. P received a Notice to File Missing Parts dated March 6, 1996, because the appropriate filing fee was not filed. The Notice set a period for response which was one month from the date of the Notice or two months from the filing date, whichever was later. The filing fee and required surcharge were not filed in the PTO. The provisional application became abandoned. A Notice of Abandonment, dated September 9, 1996, was duly received by P's secretary in P's office, and P's secretary placed the notice in Jones' file. On February 3, 1997, Jones furnished P with a copy of a publication by Gezer, dated February 2, 1996, fully describing Y, and its method of manufacture. On February 4, 1997, P reviewed the Jones file and found the two notices. To properly protect Jones' patent rights, the most appropriate course of action for P to take is to

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- (A) on or before Friday, February 7, 1997, file in the PTO a nonprovisional application claiming Y, and file a copy of the Gezer publication, and an explanation of the relevance of the Gezer publication.
  - (B) on Monday, February 10, 1997, file in the PTO a nonprovisional application claiming Y, and file a copy of the Gezer publication, and an explanation of the relevance of the Gezer publication.
  - (C) on or before Friday, February 7, 1997, file a nonprovisional application claiming Y and claiming benefit of the filing date of the provisional application under 35 U.S.C. § 119(e), and file the filing fee and surcharge for the provisional application along with the appropriate petition and fee to revive the provisional application, a statement by P that the abandonment of the provisional application was unintentional, a copy of the Gezer publication, and an explanation of the relevance of the Gezer publication.
  - (D) on Monday, February 10, 1997, file a nonprovisional application claiming Y and claiming benefit of the filing date of the provisional application under 35 U.S.C. § 119(e), and file the filing fee and surcharge for the provisional application along with the appropriate petition and fee to revive the provisional application, a statement by P that the abandonment of the provisional application was unintentional, a copy of the Gezer publication, and an explanation of the relevance of the Gezer publication.
  - (E) on Friday, February 7, 1997, file a continuation provisional application claiming the benefit of the filing date of the February 9, 1996, provisional application. For the February 9, 1996, provisional application, file the filing fee and surcharge, the appropriate petition and fee to revive the provisional application, a statement by P that the abandonment of the provisional application was unintentional, a copy of the Gezer publication, and an explanation of the relevance of the Gezer publication.

16. A and B jointly invent a process for refining corn oil and they file a *pro se* patent application on the process on November 17, 1995. Shortly afterwards, A and B are hired by XYZ Corporation, a processor and distributor of vegetable oils. During the pendency of their patent application, on January 3, 1997, A and B jointly invent an improvement to their corn oil process, and pursuant to their employment agreement, they execute an assignment of the improved process invention to their employer. You are patent counsel for XYZ Corporation, and pursuant to instructions, you prepare a patent application on the improved process invention. On February 3, 1997, you file the patent application together with the executed assignment in the PTO. The first sentence of the improvement specification states that this application is a C-I-P of the copending *pro se* A and B patent application, which is adequately identified therein. On May 2, 1997, the *pro se* A and B patent application, becomes abandoned, and on June 2, 1997, all the claims in the improvement application, all of which are directed to the improved process, are rejected by the examiner as unpatentable under 35 U.S.C. § 103 over a U.S. patent that issued on March 4, 1997, on an application that was filed on December 11, 1995. Which of the following actions accords with proper PTO practice and procedure, and represents the most appropriate action for overcoming the examiner's rejection?

- (A) File a response which argues that the claims of the present application are nonobvious over the U.S. Patent issued on May 4, 1997.
- (B) File a response which argues that since A and B are the same inventors named in the previously filed *pro se* application and since the C-I-P application contains a specific reference to the earlier filed application, the present application is entitled to the benefit of the earlier filing date in accordance with 35 U.S.C. § 120 for purposes of the improvement process claims.
- (C) File a Rule 132 affidavit offering test data showing that the C-I-P process is significantly superior to the *pro se* process.
- (D) File a response which argues that the reference patent cannot be the basis of a rejection because its issue date postdates the filing date of the C-I-P application.
- (E) File a Rule 131 affidavit swearing back of the reference filing date.

17. Your client informs you that he has filed an international application in the United States and he wishes you to file the U.S. national stage prior to the 30 month deadline for filing the national stage in the U.S. which ends September 2, 1997, next Tuesday. Which of the following actions should you take on that date prior to midnight to obtain the benefit of the international filing date?

- (A) File a copy of the application in PTO with a cover letter indicating that this is a new application and requesting a filing date.
- (B) File a paper with the PTO identifying the international application and asking that the PTO send you a bill you for the US national filing fee.
- (C) File the oath or declaration only since that is all that is required for entry into the US national stage.

- (D) File a request to enter the national stage with the PTO identifying the international application and asking that the US national filing fee be deducted from your deposit account.
- (E) File a request that the International Bureau send all the necessary papers and the fee to the PTO.

18. C, a registered patent agent, has just received a final rejection of all of the claims in an application directed to an article of manufacture. C files a Notice of Appeal to the Board of Patent Appeals and Interferences. Nevertheless, he would like to tie up some loose ends by amendment before filing his appeal brief. Which of the following responses may he file without triggering the requirements of 37 CFR § 1.116(b)?

- (A) A response that presents his argument in a more defensible light and adds additional claims.
- (B) A response amending the claims into process claims.
- (C) A response complying with a formal requirement of the examiner.
- (D) A response amending all of the independent claims, accompanied by a declaration from the inventor.
- (E) (A) and (D).

19. In a drawing for a design patent application, broken lines may be properly used to show:

- (A) A less important aspect of the claimed design.
- (B) Hidden planes and surfaces which cannot be seen through opaque materials.
- (C) Indicia, lettering, or other ornamentation which is part of the claimed design embodied in the article of manufacture.
- (D) Structure that is not part of the claimed design, but is considered necessary to show the environment in which the article of manufacture is used.
- (E) (C) and (D) are correct.

20. Which of the following constitutes a proper method of service to an unrepresented applicant of papers in a protest of an application?

- (A) Transmission by first class mail to the applicant.
- (B) Personally delivering a copy to the applicant.
- (C) Leaving a copy at the usual place of business of the applicant with someone in the applicant's employment.
- (D) When there is no usual place of business by leaving a copy at the applicant's home with someone of suitable age and discretion who resides there.
- (E) All of the above.

21. Which of the following is a printed publication under 35 U.S.C. § 102(a) which may be used to defeat the patentability of an invention conceived and reduced to practice in Des Moines, Iowa, on December 14, 1996?

- (A) A doctoral thesis shelved at a California university library, indexed only by subject, and cataloged in the library card catalog on June 15, 1996.
- (B) A doctoral thesis shelved at a California university library and indexed only by graduating class prior to December 13, 1995.
- (C) A doctoral thesis orally presented to members of a California university graduate committee prior to December 13, 1995.
- (D) An oral presentation of research to members of the public in England on December 13, 1995.
- (E) None of the above.

22. In interference practice, which is/are necessary elements for a preliminary motion seeking to designate an application or patent claim to correspond to a count?

- (A) Identifying the claim and the count.
- (B) Showing that the claim defines the same patentable invention as the count.
- (C) The fee for the preliminary motion.
- (D) All of the above.
- (E) (A) and (B).

23. Your client, A, has assigned his original patent application covering a golf club with an elliptical shaft to his wholly-owned company, Golf, Inc. Since that time, A has filed a continuation-in-part application which claims priority under 35 U.S.C. § 120 from his original application. The subject matter of the continuation-in-part application includes a golf club with an elliptical shaft having dimples on the shaft. The dimples on the shaft decrease the wind resistance and enable golfers to generate more club-head speed and hit golf balls greater distances. A has recently discovered that a competitor, Sports, Inc., has begun selling golf clubs with an elliptical shaft having dimples on the shaft. A wants his company to bring suit against Sports, Inc. for patent infringement as soon as the patent issues on the continuation-in-part application. To insure that Golf, Inc. owns the rights in the patent that issues from the continuation-in-part application, you should:

- (A) Do nothing because the assignment recorded against the original application gives Golf, Inc. the rights to the subject matter in the continuation-in-part application.
- (B) Do nothing because Golf, Inc. is wholly-owned by A.
- (C) Do nothing because the assignment recorded against the original application gives Golf, Inc. the rights to the subject matter common to both the continuation-in-part and the original applications.

- (D) Prepare and file papers assigning the continuation-in-part application to Golf, Inc. because continuation-in-part applications require a new assignment if they are to be issued to an assignee.
- (E) List Golf, Inc. as assignee when the issue fee is paid.

24. Your client, D, from Sweden, has invented a new panacea for all geriatric diseases. He requests that you file a patent application for his new invention, and you immediately comply with his request. The application includes a signed declaration that D is the original and first inventor of his new panacea. Several months later, you receive the first Office Action on the application. The Office action indicates that the declaration signed by D is defective because it failed to set forth the country of which D is a citizen. The most appropriate response to the Office Action is:

- (A) Prepare and file a new declaration, complete with statements that D believes himself to be the original, first, and sole inventor of his new panacea, and that he is a citizen of Sweden.
- (B) Prepare and file an amendment to the declaration indicating that D is a citizen of Sweden.
- (C) Prepare and file a response to the Office action stating that D is a citizen of Sweden.
- (D) Petition the Commissioner under 37 CFR § 1.18 for a waiver of the requirement for a statement regarding citizenship, accompanied by the appropriate fee.
- (E) Either (A) or (B).

25. Alice invented a new pharmaceutical compound. You have prepared, filed, and prosecuted a patent application containing Claims 1 through 15 directed to the compound. All of the claims were finally rejected under 35 U.S.C. § 102(b) in view of the Leary patent. You appealed the final rejection and have received a decision from the Board of Patent Appeals and Interferences affirming the rejection of Claims 1 to 10 in view of Leary and reversing the rejection of Claims 11-15. However, the Board has entered a new ground of rejection of Claims 11 through 15 under 35 U.S.C. § 103 in view of the Garcia patent. Which of the following is/are correct response(s) to the Board's new ground of rejection?

- (A) File a request for reconsideration by the Board within one month of the date of the Board decision.
- (B) File a Notice of Appeal regarding the Board's decision respecting claims 1-5 with the U.S. Court of Appeals for the Federal Circuit within 60 days of the date of the decision.
- (C) Submit an amendment to the Examiner that amends Claims 11-15 to avoid the Garcia reference, along with an affidavit providing evidence of the non-obviousness of the claimed compound compared to the compound disclosed by Garcia, within the appropriate time period set in the Board Decision.
- (D) Submit an amendment to the examiner amending claim 1 to define over Leary and amending Claims 11-15 to define over the Garcia patent.
- (E) Both (A) and (C) are correct.

26. V has invented a new composition for stabilizing and preserving blood products. On October 30, 1992, V filed a patent application in the PTO for his composition. The specification discloses that the composition includes: 10 to 40 percent active component, preferably 20 to 35 percent active component; 5 to 20 percent preservative, preferably 10 to 15 percent preservative; and 40 to 85 percent water, preferably 50 to 70 percent water. The patent issued on April 5, 1994, with the following single claim:

1. A blood preservative composition comprising 20 to 30 percent active component; 5 to 20 percent preservative; and 40 to 85 percent water.

On the evening of March 31, 1996, you receive a telephone call from V. In reviewing his patent, he has discovered an error in the patent that occurred without deceptive intent. He wants you to prepare a reissue application and make the following amendment to Claim 1 and add two claims.

- I. 1. A blood preservative composition comprising [20] 10 to [30] 40 percent active component; 5 to 20 percent preservative; and 40 to 85 percent water.
- II. 2. The blood preservative composition of Claim 1, wherein the composition comprises 10 to 15 percent preservative.
- III. 3. A blood preservative composition comprising 20 to 35 percent active component; 10 to 15 percent preservative; and 50 to 70 percent water

You prepare and file the reissue application on April 1, 1996. Which of the above claims is/are proper in the reissue application?

- (A) I.
- (B) II.
- (C) I and II.
- (D) II and III.
- (E) I, II, and III.

27. Which of the following elements are necessary to obtain an international filing date for an application filed under the Patent Cooperation Treaty?

- I. An oath or declaration of the inventor.
  - II. The correct filing fee.
  - III. A part which appears on its face to be a description.
  - IV. A part which appears on its face to be a claim.
  - V. The designation of at least one PCT Contracting State.
- (A) I, II, and III.
  - (B) II and III.
  - (C) II, III, and V.
  - (D) III, IV, and V.
  - (E) III and IV.

28. Inventor Jones received a patent that, through error and without deceptive intent, failed to disclose an embodiment of the invention. Eighteen months later, Jones asks whether a reissue application may be filed. Jones also tells you that the original patent with the blue ribbon seal has been lost. Your advice to Jones should include:

- (A) under 35 U.S.C. § 251, new matter cannot be added to a reissue application.
- (B) any added claims to the new embodiment would not satisfy 35 U.S.C. § 112.
- (C) under 35 U.S.C. § 251, it is too late to enlarge the scope of the issued claims in a reissue application.
- (D) under 35 U.S.C. § 251, Jones cannot get a reissue of a patent that has been lost.
- (E) (A) and (B).

29. You have filed a complete plant patent application claiming 1) a distinct and new plant variety and 2) a method for obtaining the plant variety. Which of the following statements is/are false?

- I. You may not amend the application to add additional description of the plant variety inadvertently omitted from the original application.
  - II. You may be required to deposit an adequate sample of the plant variety with an acceptable depository and the claims may be rejected under 35 U.S.C. § 112 without the deposit.
  - III. You may be required to restrict the claims between plant variety and plant method inventions you want examined for ultimate issuance as the single claim in the plant patent application to which you are entitled.
- (A) III.
  - (B) II and III.
  - (C) I and II.
  - (D) I and III.
  - (E) I, II, and III.

30. Banana, Inc. wishes to cite a prior art reference, consisting of a patent, to the PTO to be entered into the file of an issued patent owned by Orange, Inc. Which of the following is necessary to ensure that the prior art reference is entered into the patent file?

- (A) Banana's citation of the reference must be accompanied by an explanation of the pertinency and manner of applying the reference to at least one of the claims of the patent.
- (B) The term of the patent must not have expired.
- (C) The reference must present a substantial new question of patentability.
- (D) Banana's citation of the reference must be accompanied by the appropriate fee.
- (E) Both (B) and (C).

31. Which one of the following statements about multiple dependent claims is correct?

- (A) The total number of claims in a U.S. patent with one multiple dependent claim is two or more claims and one of the claims must be an independent claim.
- (B) Multiple dependent claims cannot serve as a basis for another multiple dependent claim.
- (C) A multiple dependent claim cannot be objected to if at least one of the claims from which it depends is allowable.
- (D) If a utility patent application is filed without multiple dependent claims, it cannot thereafter be amended, consistent with 37 CFR § 1.75, to include any multiple dependent claims.
- (E) The total filing fees paid for a patent application, filed with one or more multiple dependent claims is identical to the total filing fees paid for a patent application filed with the same claims written so that they are not in multiple dependent form.

32. On April 7, 1994, applicant filed an international patent application under the Patent Cooperation Treaty (PCT) in the European Patent Office (EPO). The international application was in the French language and the United States was designated in accordance with Article 4 (1)(ii) in the application. The application claimed priority of an earlier French national application filed on April 14, 1993. The International Search Report was issued by the EPO on September 29, 1994. A copy of the international application was communicated to the PTO under Article 20 of the PCT on October 27, 1994, the same day the International Application was published by the World Intellectual Property Organization. A Demand for international preliminary examination, in which the United States was elected, was properly filed on November 2, 1994. The EPO issued the International Preliminary Examination Report, which was accompanied by an Annex, on July 10, 1995. The applicant filed in the PTO, the basic national fee to enter the national phase in the United States on September 6, 1995, and a translation of the international application on September 18, 1995. On January 16, 1996, the PTO sent the applicant a notice which required the oath or declaration of the inventor to be furnished within a one month period. The applicant filed in the PTO a proper declaration of the inventor on January 29, 1996, and an English translation of the Annex to the International Preliminary Examination Report on February 2, 1996. The declaration and translation of the Annex were both accompanied by the necessary fees. The United States national phase application issued as a patent on July 16, 1996. The USPTO examiner has cited the issued patent as a prior art reference under 35 U.S.C. § 102(e). What is the effective date of the Patent as a reference under 35 U.S.C. § 102(e)?

- (A) October 27, 1994.
- (B) September 6, 1995.
- (C) September 18, 1995.
- (D) January 29, 1996.
- (E) February 2, 1996.



33. P files a patent application claiming a process for lubrication at a high temperature using a mixture of compounds X and Y. The process may be used in high speed aircraft. Included in the specification are test data supporting the high temperature lubricating utility of the mixture. In the first Office action, the examiner rejects all the claims as being anticipated by a prior art publication from 1900 which discloses a mixture of compounds X and Y and reveals test data at ambient temperature which supports the position that the mixture of compounds X and Y has poor lubricating properties. Which of the following arguments accords with proper PTO practice and procedure and represents the best chance for overcoming the rejection?

- (A) Argue that the claims required lubricating at high temperature and the prior art does not teach the use of compounds X and Y as a lubricant at high temperature and therefore the rejection was improper.
- (B) Argue that the lubricant is intended for use with high speed aircraft, and that the reference publication issued long before high speed aircraft came into existence.
- (C) Argue that the fact that your test data demonstrates good lubrication properties for a mixture of compounds X and Y and the fact that the reference's test data demonstrates poor lubrication properties for a mixture of compounds X and Y is clear and convincing evidence that your claims are patentable thereover.
- (D) Argue that the reference publication is more than 75 years old, and that technological processes for preparing the mixture of compounds X and Y were archaic at the time, and that in all probability the test data in the reference publication was obtained with a contaminated specimen.
- (E) Argue that although not expressly disclosed in your application, your invention and the reference publication relate to different forms of compound X.

34. The following claims are included in a newly filed patent application:

Claim No.

- 1. Independent
- 2. Dependent on claim 1
- 3. Dependent on claim 1
- 4. Dependent on claim 2 and 3
- 5. Independent
- 6. Dependent on claim 1,2, or 5
- 7. Dependent on claim 6

Which of the following represents the proper number of total claims for fee calculation purposes?

- (A) 10
- (B) 9
- (C) 11
- (D) 7
- (E) 8

35. An application for an improved gizmo was filed by attorney X in the PTO on March 3, 1997. The declaration and power of attorney was signed by joint inventors A and B. A and B work for company Z. No assignment has been filed in the application. C, who also works for company Z became aware of the application filed in the PTO on March 3, 1997, and wants to inspect the application since C believes that she should also be named as a joint inventor in the application. You are a registered patent agent with an office in Washington, D.C. On June 2, 1997, C visits your office and hires you as her agent. Your client, C, informs you that she wants to inspect the application filed in the PTO on March 3, 1997. C also informs you that the application was filed in the names of A and B and that the invention is for an improved gizmo. Which of the following would be the most appropriate advice to give to your client?

- (A) That C may inspect the application if she can get written permission from company Z.
- (B) That C may inspect the application immediately since she knows the filing date of the application and needs only the permission of the primary examiner in charge of the application.
- (C) That only you, acting as her agent, would be permitted to inspect the application.
- (D) That C may inspect the application if she can get written permission from attorney X.
- (E) (A) and (D) only.

36. You, a patent practitioner, receive a final rejection from the examiner allowing claims 2, 3, and 5 and rejecting claims 1 and 4. Which of the proposed responses below would be entered by the examiner as the applicant's matter of right?

- (A) An amendment canceling claims 1 and 2 and adding a new claim 6.
- (B) An amendment canceling claim 4 only.
- (C) An amendment canceling claims 1 and 4 and adding new claims 6 and 7.
- (D) An amendment amending claim 4 and canceling claim 1.
- (E) An amendment canceling claims 1 and 4 and amending claims 2 and 3.

38. You are a sole practitioner prosecuting a patent application for your client. You received a final rejection dated June 2, 1997. You believe that the examiner's final rejection is unsound. On July 1, 1997, you advised your client to appeal to the Board of Patent Appeals and Interferences. On July 15, 1997, your client informs you that she plans to obtain a new representative and you are to take no further action on the application. Thereafter, you mail to the PTO by "Express Mail" a request for withdrawal, a certificate of mailing by "Express Mail", and a postage-paid self-addressed card of receipt itemizing these two items. Actual withdrawal occurs:

- (A) On the day that you "express mail" the request for withdrawal, certificate of mailing by "Express Mail" and receipt card.
- (B) On the day that the Office received your application for withdrawal as identified on the receipt card that was returned to you.
- (C) On the day your client informed you she was obtaining a new representative.
- (D) On the day that the Office approves your request for withdrawal.
- (E) On the day that you receive the receipt card sent back to you by the Office.

39. An application received a first Office action from the examiner, dated March 18, 1996. A shortened statutory period for response was set at three months. Applicant filed a response on June 22, 1996. No fee or petition for extension of time accompanied the response. On June 28, 1996, applicant received a letter from the examiner indicating that the response of June 22, 1996 was not acceptable since no fee and petition for extension of time was submitted. If applicant submits a petition and fee to the PTO on July 22, 1996, how many month(s) must be covered by the fee?

- (A) Five months.
- (B) Two months.
- (C) Four months.
- (D) Three months
- (E) One month.

40. Kent, an inventor, filed a patent application in the PTO and received a filing date of June 14, 1995, on a supersonic krypton diffuser. On October 17, 1995, Mr. Kent filed an Information Disclosure Statement (IDS). On October 28, 1995, Mr. Kent received an Office action from the examiner dated October 19, 1995, allowing Claims 1-5, the only claims in the application. What action must Mr. Kent take to have the IDS considered by the examiner?

- (A) Submit a certification under 37 CFR § 1.97 and a fee.
- (B) Submit a certification under 37 CFR § 1.97 only.
- (C) Submit a certification under 37 CFR § 1.97, petition, and petition fee.
- (D) Submit a petition and petition fee.
- (E) None of the above.

41. Applicant files an application with the PTO on January 4, 1997, which is granted special status. The application is taken up out of turn, and a Notice of Allowance is mailed on April 15, 1997. Applicant files an Information Disclosure Statement on April 21, 1997, citing prior art that he has become aware of since the application was filed. The disclosure document will:

- (A) Be considered because the application was granted special status.
- (B) Be considered because it was received by the PTO within three months of filing.
- (C) Be considered because it was filed within a 3 month shortened statutory period of the Notice of Allowance.
- (D) Be considered because the applicant has not received the Notice of Allowance mailed on April 15th, when the IDS was issued.
- (E) Be considered if accompanied by a certification, petition and the appropriate fee.

42. Applicant filed a patent application in the PTO on January 30, 1997. The application was based on an application for an inventors' certificate filed in country X on January 31, 1996. The laws of country X permit applicants to apply, at their discretion, either for a patent or for an inventors' certificate, and country X is a signatory of the Stockholm Revision of the Paris Convention. In the first Office action, the examiner rejected applicant's claims as anticipated by a reference with an effective date of November 6, 1996. To overcome the rejection applicant is required to:

- (A) File a copy of the foreign application for inventor's certificate together with an English translation of the papers.
- (B) File a copy of the foreign application for inventor's certificate showing the date of the application.
- (C) File a claim for a right of priority based upon the foreign application for inventor's certificate together with an English translation of the papers.
- (D) File a claim for a right of priority based upon the foreign application for inventor's certificate along with a certified copy of the foreign application, and an English translation of the papers.
- (E) The rejection cannot be overcome because the right of priority must be based upon an application for patent in a foreign country, rather than an application for an inventors' certificate.

43. On May 8, 1996, John Doe filed a first patent application containing claims to invention X and invention Y. In the first Office action, the examiner required restriction to one of the inventions. Doe elected to prosecute invention X. In the second Office action, the examiner rejected the claims to invention X as unpatentable over prior art. Following an interview with the examiner, Doe successfully persuaded the examiner that his claims distinguished over the prior art. The application issued as a patent on May 6, 1997. On May 7, 1997, Doe filed a second application claiming only invention Y. Which of the following is true?

- (A) The patent issuing on the first application may not be used as a reference against the second application because the latter resulted from a restriction requirement.
- (B) The patent issuing on the first application may be used as a reference against the second application because the latter was filed after the patent issued.
- (C) The patent issuing on the first application may not be used as a reference against the second application because the latter was filed within 1 year of the filing date of the first application.
- (D) The patent issuing on the first application may not be used as a reference against the second application because inventions X and Y are independent and distinct inventions as evidenced by the requirement for restriction and were originally claimed in the same application.
- (E) The second application is entitled to the benefit of the earlier filing date of the first application.

44. Which of the following files are not open to the public?

- (A) Interference files involving an issued patent where the interference has been terminated.
- (B) Papers relating to a reexamination proceeding which have been entered of record in a reexamination file.
- (C) Assignment records relating only to pending patent applications.
- (D) Assignment records relating to issued patents.
- (E) An assignment record relating to a pending patent application and an issued patent.

45. Which of the following statements is true?

- (A) Where all of the members of a law firm are of record in a patent application, withdrawal can only be accomplished by filing a request for withdrawal signed by all the members of the law firm.
- (B) A registered practitioner not of record in a patent application is afforded the privilege of filing papers in the application provided such papers bear the signature and registration number of the practitioner.
- (C) If an attorney is suspended from practice before the Office as a result of a disciplinary proceeding involving a patent matter, he or she can still represent trademark applicants before the Office.
- (D) On January 3, 1993, the Commissioner excluded X and suspended Y for 1 year from practice before the PTO. On January 6, 1997, both X and Y filed petitions for reinstatement. The Commissioner will consider both petitions.
- (E) (B) and (D).

46. Inventors X and Y jointly conceive and reduce to practice an invention. Subsequently, in the course of determining how best to commercially exploit the invention, they have a “falling out” and decide to go their own ways. Inventor X decides to obtain patent protection for the invention, but inventor Y refuses to join in any application. Which of the following actions accords with proper PTO practice and procedure?

- (A) Inventor X should file an application for patent as sole inventor accompanied by X’s affidavit as to the pertinent facts.
- (B) An application for patent should be filed in the names of inventor X and inventor Y as joint inventors, but the filing fee should be allocated between them, with the rights of the inventors under any issuing patent being contingent on payment of the allocated fee.
- (C) Inventor X should file an application for patent on behalf of himself and inventor Y and provide proof of the pertinent facts relating to inventor Y’s refusal to join in the application.
- (D) Inventor X should file an application for patent as sole inventor documenting inventor Y’s refusal to join in the application, and requesting that inventor Y be barred thereafter from joining in the application.
- (E) Inventor X should file an application for patent as sole inventor documenting inventor Y’s refusal to join in the application, and requesting that inventor Y be barred from those patent rights which he would have had if he had been joined.

47. You file a patent application on behalf your client, a small company, claiming a cleaning solution wherein uric acid is the primary ingredient. You received an Office action dated August 19, 1997, wherein all the claims were rejected under 35 U.S.C. § 112. You provided your client with a copy of the Office action. Today, August 27, 1997, the President of the client called and informed you that the company wants to keep the composition of the uric acid-containing cleaning solution a trade secret. The President informed you that the company has developed another cleaning solution composition wherein sulfuric acid is the primary ingredient, and uric acid is not present. The President also informed you that the sulfuric acid-containing cleaning solution is better able to clean than the uric acid-containing cleaning solution. The use of sulfuric acid was not disclosed in the pending application. Which of the following is in accord with PTO practice and procedure to obtain patent protection for the sulfuric acid-containing cleaning solution and maintain the confidentiality of the uric acid-containing cleaning solution?

- (A) Abandon the pending application, and file a new patent application disclosing and claiming only the sulfuric acid-containing cleaning solution wherein sulfuric acid is the primary ingredient. The new application should not refer back to the previous, pending application.
- (B) File a continuation-in-part application disclosing and claiming the sulfuric acid-containing cleaning solution wherein sulfuric acid is the primary ingredient. The first sentence of the specification of the continuation-in-part application should refer to the previously filed, copending application.

- (C) File an amendment in the pending application adding claims to the sulfuric acid-containing cleaning solution wherein sulfuric acid is the primary ingredient.
- (D) File a reissue application on the pending application and broaden the claims in the reissue application to be inclusive of the sulfuric acid-containing cleaning solution wherein sulfuric acid is the primary ingredient.
- (E) File an amendment in the pending application directing that the word "uric" be replaced with the word "sulfuric" wherever "uric" occurs in the specification and claims.

48. What would be permitted to be incorporated by reference in your client's U.S. utility patent application?

- (A) Essential material from a commonly assigned, previously filed patent application, pending in a foreign country on the filing date of your client's domestic utility patent application.
- (B) Essential material from a pending U.S. application.
- (C) Non-essential material from an unpublished foreign patent.
- (D) Essential material from a non-patent publication, published in the U.S., which was published prior to the filing date of your client's domestic utility patent application.
- (E) An oath filed in another commonly assigned patent where the patent had the same inventor and the same assignee.

49. In response to a final rejection dated February 4, 1997, with a three month shortened statutory period for response, you call the examiner in charge of the patent application to schedule a first interview on July 3, 1997, to discuss further narrowing the scope of claim limitations. Your request for an interview should be \_\_\_\_\_

- (A) denied because your request is after the expiration of the shortened statutory period for response.
- (B) granted only if applicant pays the extension fee for the expired time.
- (C) granted.
- (D) denied because interviews are not permitted after the final Office action.
- (E) granted only if you have a proposed amendment and pay the extension fee.

50. Which, if any, of the following claim language is definite with respect to the scope of a claim?

- (A) . . . R is a strong reactant, for example, chlorine.
- (B) . . . material like wool or acrylic.
- (C) . . . lighter hydrocarbon, for instance, the vapors or gases produced.
- (D) . . . normal process conditions, such as ambient temperature.
- (E) None of the above.