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

April 4, 1990

Morning Section (80 Points) 

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 proctor before this section of the examination begins.

All questions must be answered on the Answer Sheet which is provided to you by the proctor. 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. Stray marks may be counted as answers. Erase completely all marks except your answer.

This section of the examination consists of eighty (80) multiple choice questions, each worth one (1) point. Do not assume any additional facts not presented in the questions. You may write anywhere on this examination booklet. However, do not remove any pages from the test booklet. Only answers recorded on the Answer Sheet will be graded. You must score at least 56 points to pass this section of the examination.

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO CHECK THE CONTENTS OF THIS EXAMINATION BOOKLET OR TO BEGIN THE EXAMINATION.
INSTRUCTIONS: Each correct answer is worth one (1) point. There is only one most correct answer to each question. When several answers are correct and "All of the above", "(a) or (b) only", "(a), (b) and (c)", or the like is the most correct answer because it groups several correct answers, no other answer will be accepted. For those questions involving PTO policy and procedure, the most correct answer will be the policy and procedure which must, shall or should be followed in accordance with the Manual of Patent Examining Procedure unless modified by a subsequent court decision or a notice in the Official Gazette. No points are awarded for incorrect answers or unanswered questions. The questions must be answered in Section 1 on the Answer Sheet. Questions are answered by darkening the circle on the Answer Sheet containing the letter corresponding to the letter preceding the answer chosen. Questions answered by darkening more than one circle will be considered as being incorrectly answered.

1. A second application, claiming subject matter which was held non-elected as a result of a restriction requirement in a prior application by the same applicant, may be properly rejected on a patent granted on the prior application if:
   a) The second application is filed before the issuance of the patent.
   b) The restriction requirement was not traversed.
   c) The second application is filed the same day the patent is issued.
   d) The second application is filed more than one year after the patent is issued.
   e) None of the above.

2. Which of the following papers, if any, would be considered timely filed if sent by FEDERAL EXPRESS™ on the last date of the period for filing, properly addressed to the Commissioner of Patents and Trademarks, and including a signed certificate of express mailing stating the date of mailing?
   a) An amendment in response to an Office action.
   b) A certified check in payment of the issue fee for an allowed patent application.
   c) An agreement between parties to an interference under 35 U.S.C. 135(c).
   d) (a), (b) and (c).
   e) None of the above.

3. On April 2, 1989, you filed a patent application in the PTO for your client who is a resident and citizen of the United States. On April 3, 1990, you filed a PCT application in the United States Receiving Office with a Paris Convention priority based on the U.S. application, requesting that the search be performed by the European Patent Office (EPO). Which of the following statements is true?
   a) You lost your priority date by filing the PCT application too late.
   b) The PCT application is invalid.
   c) Filing the PCT application on April 3, 1990 disqualifies you from obtaining an EPO search.
   d) You cannot request the EPO search under any circumstances because you are an attorney and your client is a U.S. citizen and resident of the United States.
   e) None of the above statements is true.

4. In order for a later filed application to obtain the benefit of the filing date of an earlier filed U.S. patent application, which of the following must be true?
   a) All of the inventors named in the earlier filed application must be named in the later filed application.
   b) The later filed application must be filed before termination of the proceedings in the earlier filed application.
   c) The later filed application must contain or be amended to contain a specific reference to the earlier filed application.
   d) (a) and (b) only.
   e) (b) and (c) only.

5. Which of the following items is not required in order to obtain a filing date for a patent application?
   a) A specification containing an enabling disclosure and setting forth the best mode.
   b) A claim.
   c) An oath.
   d) A drawing necessary to understand the invention.
   e) None of the above.
6. Which of the following, if any, cannot be a basis for requesting reexamination of a U.S. patent to Adams that issued on July 11, 1989 based on an application filed on May 4, 1987?
   a) A U.S. patent to Baker which issued on May 5, 1987 based on an application filed on August 6, 1982 that describes, but does not claim the invention.
   b) Evidence that Adams sold the claimed invention in Bismarck, N.D. to another on January 5, 1986.
   c) A Canadian patent issued to Patrick which describes and claims the invention. The Canadian patent issued on November 6, 1985, based upon an application filed in Canada on January 29, 1984.
   d) The invention of Adams was described in a book authored by Jones. The book was published in France on January 2, 1986.
   e) None of the above.

7. In order for multiple inventors to be named as joint inventors in a patent application, which of the following must be true?
   a) Joint inventors must physically work together.
   b) Each inventor must make a contribution to the subject matter of every claim.
   c) Each inventor must make an approximately equivalent contribution to the claimed invention.
   d) Each of the inventors must be U.S. citizens.
   e) None of the above statements is true.

8. A final rejection is dated October 6, 1989. The examiner set a three month shortened statutory period for response. You prepare and mail an amendment with a proper certificate of mailing thereon having a mailing date of December 5, 1989. This amendment is received in the PTO on December 8, 1989. In response to this amendment, the primary examiner prepares an advisory action indicating that the amendment does not place the application in condition for allowance, but will be entered upon the filing of a Notice of Appeal. This Advisory Action is mailed on January 9, 1990. In order to obtain time, you send a request for a one-month extension of time with the appropriate fee on January 12, 1990. The extension of time is received by the PTO on January 22, 1990. On what date is the Notice of Appeal due to be filed without a further extension of time?
   a) February 6, 1990
   b) February 9, 1990
   c) February 22, 1990
   d) March 6, 1990
   e) March 9, 1990

9. As a patent agent, you file on behalf of your client a patent application containing a claim having a Markush group “consisting of elements A, B, and C”. The examiner properly rejects the claim under 35 U.S.C. 102 as being anticipated by a reference describing the claimed invention with only element A. The 102 rejection may be properly obviated by:
   a) Arguing that the reference is not relevant because it lacks elements B and C.
   b) Amending the claim to redefine the Markush group as “consisting of element A, B, C and D”.
   c) Amending “consisting of” to —consisting essentially of—.
   d) Cancelling elements B and C because prior art is concerned just with A.
   e) Cancelling element A from the Markush group.

10. Which of the following is a proper response to an Office action?
    a) The substitution of a complete specification without any indication of what changes have been made as compared with the original specification.
    b) An amendment cancelling all claims drawn to an elected invention, and presenting only claims to the non-elected invention.
    c) An amendment cancelling all of the claims and presenting no new claim or claims.
    d) Amending each rejected claim to add a limitation to a feature that was disclosed but not claimed in the application as filed.
    e) A request for suspension of an action without responding to the outstanding Office action.
11. Which of the following statements is true?
   a) The Commissioner will not entertain a petition which requests reconsideration of a rejection of a claim under 35 U.S.C. 112.
   b) A petition to vacate a final rejection, if filed within two months after the mailing date of the action, will stay the period for filing a substantive response to the final rejection.
   c) A petition which is filed 45 days after an adverse decision by the examiner on a request for reconsideration of a petitionable matter may be properly dismissed as untimely.
   d) An examiner’s objection to the dependency of a claim on a rejected claim, when the dependent claim is otherwise allowable, is not petitionable.
   e) None of the above statements is true.

12. Inventor A and associate B wrote an article which was published on Saturday, June 13, 1987. On Tuesday, June 14, 1988, A filed a patent application wherein the disclosure and claims are limited to the invention which is described in the article published on June 13, 1987. The first Office action contained a rejection of A’s claims as being anticipated by the June 13, 1987 publication. A argues that B only aided in research and contributed nothing to the claimed invention. A should:
   a) Consult B and have both A and B file declarations indicating that A is the sole inventor and that B did not contribute to the invention.
   b) Abandon the application.
   c) Amend the application to name both A and B as inventors.
   d) Abandon the application and refile with A and B as named joint inventors.
   e) File a declaration showing A is the sole inventor.

13. Which of the following is an improper reason for holding a patent application to be abandoned?
   a) Failure to respond to an adverse decision by the Board of Patent Appeals and Interferences affirming the examiner’s rejection of some of the claims and reversing the rejection of other claims.
   b) The agent of record files a letter of express abandonment.
   c) Failure to respond to an Office action within the six month statutory period.
   d) Failure to respond to every ground of rejection of an Office action where the examiner has pointed out the inadequacies of applicant’s response and given him or her time to correct the response.
   e) Failure to pay the issue fee within three months of the date of a notice of allowance wherein the sum of the issue fee is specified.

14. A statutory bar against the granting of a U.S. utility patent arises under certain circumstances regarding an inventor’s own foreign patent activity with respect to the same invention. Which of the following conditions must be present for such a statutory bar to arise?
   a) The foreign application must be filed more than twelve months before the U.S. filing.
   b) It must be filed by the applicant, his or her legal representatives or assigns.
   c) The foreign patent must be actually granted before the U.S. filing.
   d) (a) and (c) only.
   e) (a), (b) and (c).

15. An original U.S. patent application which is not subject to a secrecy order is open to the public in which of the following circumstances?
   a) Where the application has had a first action from the examiner.
   b) 18 months after the filing or priority date, whichever is earlier.
   c) After a final rejection.
   d) When an exact counterpart foreign application is published.
   e) When the application issues as a patent.

16. A reissue application was filed on January 5, 1990. The reissue application would not be appropriate in which of the following circumstances?
   a) Broadening claims of an original U.S. patent which issued on July 12, 1988.
   b) Narrowing claims of an original U.S. patent which issued on July 8, 1972.
   c) Correct failure to adequately claim priority in an earlier filed copending U.S. patent application.
d) Correcting a defective specification, the errors made without deceptive intent, which renders the original patent partially invalid.
e) Failure to claim foreign priority in the original U.S. patent application.

17. Which of the following is not required for a complete response to an Office action?
   a) An amendment of at least one rejected claim or of the specification.
   b) A request for further examination or reconsideration.
   c) A discussion of how any amendment presented avoids the objections and rejections in the Office action.
   d) Statement distinctly and specifically pointing out the supposed errors in the primary examiner’s action.
   e) A response to every ground of objection and rejection in an Office action.

18. The last day of the three month shortened statutory period of a non-final rejection occurs today, April 4, 1990. Your client is overseas and sends you a telex asking you to cancel all of the current claims in the application. She further advises you that a new set of claims would be sent to you in a few days which are to replace the current claims. Which of the following courses of action is most appropriate?
   a) File for an extension of time immediately.
   b) File an amendment today cancelling all claims in accordance with your client’s instructions.
   c) Await receipt of the new claims and then file the amendment and request for reconsideration with the appropriate fee for an extension of time, no more than 6 months from the date of the non-final rejection.
   d) File a request for reconsideration today and state that a supplemental amendment will be forthcoming.
   e) File a request for reconsideration today and argue the rejection.

19. Which of the following is a false statement with respect to patentability under 35 U.S.C. 103 of the claims in an application?
   a) One must consider the subject matter taken as a whole.
   b) One must establish the level of ordinary skill in the art.
   c) When the reference is a U.S. patent which matured from a continuation-in-part application, it may be necessary to check the file history of the reference to establish the effective date of the reference as to any feature relied upon in the reference.
   d) No subject matter developed by another person which qualifies as prior art under any provision of 35 U.S.C. 102 precludes patentability under 35 U.S.C. 103 where the subject matter and the claimed invention were, at the time the invention was made, subject to an obligation of assignment to the same person.
   e) When an applicant submits evidence to overcome an examiner’s prima facie holding of obviousness, the examiner must consider all of the evidence.

20. Which of the following would conform to the requirements for formal drawings in a patent application?
   a) A drawing on a sheet of 8 1/2" by 11" white three-ply bristol board.
   b) A drawing done with a No. 1 (soft) pencil.
   c) A drawing on a sheet of 8 1/2" by 14" white three-ply bristol board.
   d) A drawing including encircled reference numerals which correspond with reference numerals used in the specification to identify the designated components.
   e) A drawing having lines which are not clean, sharp, and solid.
21. Gard and Turner worked together at ABC Corporation. Gard invented a new article of manufacture. Turner and Gard jointly invented an apparatus in which Gard's article was a component. Adams, a registered practitioner, prepared a patent application describing and claiming the article and the apparatus. Gard and Turner executed the application and assigned their entire interest to ABC. Adams filed the application and recorded the assignment in the PTO. Adams received an Office action requiring restriction between the combination claims to the apparatus and the sub-combination claims to the article. Adams traversed the requirement and elected the claims to the article. The requirement was made final, and Adams cancelled the apparatus claims from the original application. Which of the following correctly sets forth what Adams must also file in connection with the amended application?

a) A amendment deleting Turner's name as an inventor.

b) A fee and a petition identifying Turner as a named inventor who is being deleted and acknowledging his invention was no longer being claimed.

c) Written consent of the assignee to amend the inventorship.

d) (a) and (b) only.

e) (a), (b) and (c).

22. In the Office action, the examiner rejected Arch's claims over a U.S. patent to Marble which discloses and claims Arch's stone polishing machine. The patent to Marble issued on November 7, 1989, and is based on an application filed on October 20, 1988. As agent for Arch, you should:

a) File an affidavit showing reduction to practice of Arch's stone polishing machine as of July 6, 1988 to remove the Marble patent as a reference.

b) File an affidavit showing conception of Arch's stone polishing machine as of November 17, 1987 to remove the Marble patent as a reference.

c) File an affidavit showing completion of Arch's stone polishing machine in the U.S. as of October 10, 1988 to remove the Marble patent as a reference.

d) Copy claims from the Marble patent and hope to win against Marble in an interference.

e) Abandon Arch's application as the Marble patent is a statutory bar.

23. In the Office action, the examiner rejected claims over a Canadian patent to Granite which discloses and claims Arch's stone polishing machine. The Canadian patent issued on December 12, 1988 and was based on an application filed in Canada on July 15, 1988. As an agent for Arch, you should:

a) File an affidavit showing reduction to practice of Arch's stone polishing machine as of July 6, 1988 to remove Granite as a reference.

b) File an affidavit showing conception of Arch's stone polishing machine as of November 17, 1987 to remove Granite as a reference.

c) File an affidavit showing completion of Arch's stone polishing machine in the U.S. as of October 10, 1988 to remove Granite as a reference.

d) Copy claims from the Granite patent and hope to win against Granite in an interference.

e) Abandon Arch's application as the Granite patent is a statutory bar.
24. An action was mailed from the PTO on July 26, 1989 with a three month shortened statutory period set for response. The response was filed with a proper one month extension of time and the appropriate fee. The very last day for filing the response with the one month extension would be:
   a) Sunday, November 26, 1989
   b) Friday, November 24, 1989
   c) Monday, November 27, 1989
   d) November 28, 1989, before 8:30 a.m., the opening of business at the PTO.
   e) None of the above.

25. A prior assignment of a first filed application is not applied by the PTO to which subsequently filed application?
   a) Continuation
   b) Continuation-in-part
   c) Divisional
   d) Reissue
   e) Reexamination

26. Which of the following is true?
   a) A claim for a “nickel alloy comprising nickel, chromium, iron and at least one member selected from the group consisting of copper, silver and tin” reads upon “an alloy consisting of nickel, silver, chromium, iron, copper, and cobalt” described in a publication.
   b) An independent claim 1 for an “article comprising a widget having a coating of from 0.05 to 1 mm thickness,” and a dependent claim 2 for “an article according to claim 1 wherein the coating is about 0.3 mm thick,” both read upon “a widget having a coating of 0.5 mm thickness” described in a publication.
   c) A claim for a “soap composition comprising a maximum of 0.2 parts by weight of X per part by weight of Y” reads upon a soap composition disclosed in a publication as having 5 parts by weight of X per part by weight of Y.
   d) A claim for “a laminate circuit material comprising a sheet of adhesive film, and a sheet of conductive material disposed on said sheet of adhesive film” does not read on an article consisting of an adhesive film disposed on one surface of a sheet of conductive material and a glass reinforced adhesive film disposed on the opposite surface of said sheet of conductive material.
   e) None of the above statements is true.

27. In a public use proceeding, which of the following can result in the decision that claims in a patent application, drawn to a process for manufacturing a product, are unpatentable?
   a) The applicant is shown to have only experimented with different embodiments of the invention.
   b) The applicant is shown to have secretly used the claimed process to manufacture the product, and the product was sold for several years before the application was filed, but the process could not be determined from reverse engineering of the product.
   c) The applicant used the process experimentally and subsequently abandoned the experiments.
   d) The applicant only filed the application and did not test the process.
   e) The applicant secretly used the process for several years to manufacture the product, but the product was never sold or in public use before the application was filed.

28. Which of the following statements is true?
   a) A specific working example of the best mode contemplated by the inventor for carrying out the invention must be set forth in the disclosure.
   b) A patent has never been held invalid due to the failure of the inventor to disclose the best mode.
   c) Whether the inventor has disclosed what the inventor considers to be the best mode is a separate question from whether or not the disclosure is enabling.
   d) The best mode requirement can be fulfilled by amendment if it was not disclosed, in the specification when the application was filed in the PTO.
   e) (a) and (b) only are true.
29. You file a patent application in the PTO on December 1, 1989, claiming priority benefit under 35 U.S.C. 119 of a foreign application filed on November 1, 1988. Which of the following statements is true?

a) Benefit of priority can be obtained in this instance provided a claim for priority is made and a certified copy of the foreign application is filed in the PTO.

b) You are entitled in this instance to the benefit of the filing date provided the foreign and United States applications are filed by the same applicant.

c) The priority benefit in this instance can only be obtained if the foreign application claims the same invention as is claimed in the application filed in the PTO.

d) Priority benefit can be obtained in this instance provided a claim to this effect is made in the oath and a certified copy of the foreign application is filed in the PTO.

e) You are not entitled to a right of priority in this instance.

30. Dr. Kaper filed a patent application for a cholera vaccine. On November 30, 1989, the examiner required applicant to deposit samples of the vaccine to satisfy 35 U.S.C. 112, first paragraph. In a proper response filed on February 20, 1990, applicant traversed the examiner’s requirement, arguing that his specification was fully enabling and, therefore, no deposit should be required. On March 15, 1990, the examiner’s made the requirement final. Applicant filed a petition on April 2, 1990 requesting the Commissioner to invoke his supervisory authority to review the examiner’s requirement. The petition may be properly denied for which of the following reasons?

a) A petition to the Group Director should have been filed first before filing a petition to the Commissioner seeking supervisory review.

b) The petition was filed more than two months after the examiner’s original requirement and is, therefore, untimely.

c) No petition fee accompanied the petition.

d) The examiner’s requirement is not petitionable subject matter.

e) All of the above.

31. Which of the following statements is true?

a) The original oath or declaration filed under 37 CFR 1.63 may only be in English.

b) Where the oath or declaration includes a power of attorney to a registered agent or attorney, that agent or attorney may correct an obvious error in the residence address of the inventor after execution, but before filing the oath or declaration in the PTO.

c) If the date of execution of the original oath or declaration is more than three (3) months before the filing date of the application, the patent examiner should be expected to request an explanation of the lapse of time from the applicant or his agent or request a new oath or declaration.

d) The original oath of declaration must be filed before the application will be granted a serial number and filing date.

e) None of the above statements is true.

32. After requesting a statutory invention registration (SIR), you received a rejection under 35 U.S.C. 112 and you were notified that the application did not meet the requirements regarding the submission of a proper waiver of applicant’s rights to receive a patent. Your client decides that he does not want to obtain a SIR, but that he desires a patent. You should properly advise your client that:

a) The rules preclude withdrawal of a request for a SIR.

b) File a petition to the Commissioner accompanied with the appropriate fee to request review of the refusal to publish the SIR.


d) File a request to withdraw the request for publication of the SIR.

e) File only a petition to suspend the rules. No fee is required for this type of petition.
33. Affidavits or declarations under 37 CFR 1.131 containing a proper showing of reduction to practice of a claimed process may be used to overcome a rejection of claims to the process over prior art in which, if any, of the following circumstances?
   a) The reference is a foreign patent which claims the same invention as the rejected claims and has an effective date less than one year prior to the applicant’s effective filing date.
   b) The reference is a U.S. patent which claims the same invention as the rejected claims and has an effective date less than one year prior to the applicant’s effective filing date.
   c) The reference is a U.S. patent which discloses but does not claim the same invention as the rejected claims and has a patent date for the disclosed material more than one year prior to the applicant’s effective filing date.
   d) The reference is a foreign patent which claims the same invention as the rejected claims and has a publication date more than one year prior to the applicant’s effective filing date.
   e) None of the above.

34. In a reexamination proceeding, which of the following is true?
   a) Both the patent owner and the reexamination requester have the right to participate in interviews.
   b) Only ex parte interviews between the examiner and patent owner and/or his or her representative are permitted.
   c) Interviews pertaining to patentability issues may be held prior to the first office action following the order for reexamination.
   d) Following the order for reexamination, a reexamination requester who is not the patent owner is entitled to file one reply to the patent owner’s statement.
   e) Following the order for reexamination, and the patent owner’s statement respecting the order, a reexamination requester, who is not the patent owner, is entitled to at least one additional reply to the patent owner’s statement.

35. Practitioner Carter deposited a U.S. patent application with the U.S. Postal Service with a certificate of mailing under 37 CFR 1.8 dated March 7, 1989. The application was received in the PTO mail room on March 9, 1989. In a first Office action dated August 15, 1989, the examiner rejected all the claims in the application. The examiner set a three month shortened statutory period for response. On November 14, 1989, Carter deposited with the U.S. Postal Service, a continuation application of the prior application with a proper certificate of mailing under 37 C.F.R. 1.8 dated November 14, 1989. The continuing application was received in the PTO on November 17, 1989. The original application was allowed to go abandoned for failure to respond within the time period set for response. What is the effective filing date of the continuation?
   b) March 9, 1989.
   d) November 14, 1989.
   e) November 17, 1989.

36. Rogers invents a laser powered “Death Ray” mousetrap. Registered practitioner Smith prepares and files the patent application in the PTO. Rogers appoints Smith as attorney of record and requests that all correspondence be sent to Smith. Shortly thereafter, Rogers assigns his entire interest in the patent application to the Rat-Be-Gone Company. The assignment is recorded in the PTO. Which of the following is true?
   a) The PTO will automatically send all future correspondence to the Rat-Be-Gone Company.
   b) The assignment operates as a revocation of Smith’s power of attorney.
   c) The assignee may be represented by a registered practitioner of its own selection.
   d) The assignee’s revocation of the power of attorney to Smith requires approval by the Commissioner.
   e) None of the above statements is true.
37. Which of the following applications can never obtain the benefit of the filing date of a prior application?
   a) Substitute
   b) Continuation
   c) Divisional
   d) Continuation-in-part
   e) Reissue

38. A restriction requirement was made by the examiner between the product and method claims of an application since the method was broader than the product and different fields of search were involved. Which of the following actions, if any, by you as applicant’s representative is a complete response to the restriction requirement?
   a) Traverse the examiner’s requirement only.
   b) Make a provisional election only.
   c) Argue and request the examiner to make the requirement final.
   d) File a divisional application on the non-elected invention.
   e) None of the above.

39. With respect to reissue applications, which of the following statements is true?
   a) The material being added must be highlighted by enclosing it in brackets and the material being deleted must have a line drawn through it.
   b) When replacing a claim such as Claim 1 which will be cancelled, the replacement claim should be denoted as Claim 1a.
   c) The assignee alone may make the oath or declaration when the application enlarges the scope of the claim and it is filed within two years of the patent grant date.
   d) The applicant must acknowledge a duty to disclose information applicant is aware of, and which is material to the examination of the application.
   e) A proper reissue application may be filed more than two years after the date of issuance of the original patent with an amendment to an original patent claim, wherein the scope of the amended claim is narrowed in some respects and broadened in other respects.

40. An inventor residing in the United States who has a patent application pending in the PTO can utilize the Patent Cooperation Treaty (PCT) for which of the following purposes?
   a) To obtain a national filing in countries which are members of PCT.
   b) To avoid having to obtain a translation in a PCT member country, where a national filed application requires a translation.
   c) To obtain a search report on the invention.
   d) To take advantage of priority rights available under the Paris Convention.
   e) (a), (c) and (d) only.

41. Which of the following is true about claims in a patent application?
   a) Independent claims must be construed as only including the limitations described in the descriptive portion of the specification, even though such limitations are not recited in the claim.
   b) When Claims 1-10 are cancelled and ten new claims are added, the new claims should be numbered 1 through 10.
   c) Multiple dependent claims should refer to other claims in the conjunctive only.
   d) A dependent claim is construed as including only the limitations appearing in the dependent claim.
   e) Where there are several claims in an application, they must be numbered consecutively in Arabic numerals.

42. Which of the following statements is false?
   a) Microorganisms produced by genetic engineering are excluded from patent protection by 35 U.S.C. 101.
   b) The laws of nature, physical phenomena and abstract ideas are not patentable subject matter.
   c) A new mineral discovered in the earth is not patentable subject matter.
   d) A scientific truth, or the mathematical expression of it, is not a patentable invention.
   e) Mathematical algorithms per se are non-statutory.
43. Albright, a registered practitioner, prepared on behalf of a client a disclosure statement under 37 CFR 1.56. The disclosure statement is to be filed in the client's application which includes only claims to a process. Albright was given the following items of information by his client:

I. The product of the claimed process was sold in the U.S. eleven months prior to the filing date of the application.

II. An article authored by the client and disclosing the claimed process was sent to a Belgian publisher more than a year before the filing date of the application, but was published in a Belgian journal a week after the filing date of the application.

III. A U.S. patent to another disclosing, but not claiming the process, has now issued on a U.S. application which was filed three days before the filing date of the client's U.S. application.

Which of the foregoing items of information must Albright include in his disclosure statement?

a) I only.
b) II only.
c) III only.
d) I and II only.
e) II and III only.

44. Which of the following statements is false respecting a response to a final rejection or action?

a) An amendment may be made cancelling claims or complying with any requirement.
b) An amendment may be admitted upon a showing of good and sufficient reasons why it is necessary and was not earlier presented.
c) An amendment cannot be made as a matter of right in a properly appealed case.
d) An amendment presenting rejected claims in better form for consideration on appeal is not admissible.
e) An amendment cannot be made as a matter of right after a final rejection.

45. Jones and Smith are both employees of Ajax Corporation located in Dallas, Texas, and both Jones and Smith have an obligation to assign to Ajax any and all rights to any inventions developed either singly or jointly during their respective employment with Ajax. Prior to working for Ajax, Jones was an independent consultant. While an independent consultant, Jones invented a new drug, called Miracle 1. Jones caused an application to be filed in the PTO claiming Miracle 1. Jones retained all rights in the Miracle 1 application. He was not under any obligation to assign his rights in Miracle 1 to anyone. After becoming employed by Ajax, Jones assigned to Ajax his entire interest in the Miracle 1 application. After the assignment of rights to Miracle 1, Jones and Smith jointly invented an improvement on Miracle 1, the improvement being called Miracle 2. Ajax Corporation filed a patent application on Miracle 2 in the name of Jones and Smith. During the pendency of the Miracle 2 application, the Miracle 1 application issued as a patent. Miracle 2 is an obvious variation of Miracle 1. Jones maintained her Miracle 1 invention secret prior to issuance of the Miracle 1 patent, except for the confidential disclosure to Smith associated with the development of Miracle 2 and the prosecution of the Miracle 1 application by attorneys for Ajax. The Miracle 1 patent is prior art under 35 U.S.C. 103 under which of the following, if any, statutory provisions?

a) 35 U.S.C. 102(a)
b) 35 U.S.C. 102(e)
c) 35 U.S.C. 102(f)
d) 35 U.S.C. 102(g)
e) None of the above.

46. After unsuccessfully responding to the final rejection, the six month period of the rejection expired March 9, 1990. Applicant deposited a Notice of Appeal with the appropriate fee in the U.S. Postal Service on March 9, 1990 pursuant to 37 C.F.R. 1.8. The paper is not received in the PTO until March 16, 1990. The very last day for filing the Appeal Brief without an extension of time is:

a) April 9, 1990
b) April 16, 1990
c) May 9, 1990
d) May 16, 1990
e) June 9, 1990
47. Practitioner Adams received a first Office action from the examiner rejecting the client’s claims to a three step process under 35 U.S.C. 103 as being obvious over Reference A in view of Reference B. After reviewing the applied references and discussing the rejection with his client, Adams determined that the rejected claims are *prima facie* obvious over the references. Which of the following most correctly describes what showing can be properly employed to rebut the *prima facie* case?

a) The claimed process produces an unexpected result which is not taught by the references.

b) Two steps of the process cooperate to give a synergistic result, which is not taught by the references.

c) The prior art is not enabling.

d) (a) and (b) only.

e) (a), (b) and (c).

48. On April 4, 1989, foreign applicant A filed, in a foreign country, a foreign patent application containing a single claim. Today, April 4, 1990, you received a copy of the foreign application in a foreign language without an English translation. The application must be filed today so that the applicant does not lose the benefit of his foreign priority date. Which of the following courses of action would be appropriate to obtain the benefit of the priority date?

a) File the foreign language application today in the PTO.

b) Advise applicant A that although the application can be filed today and the PTO will accept the foreign language application, he cannot obtain a filing date of April 4, 1990 because the application does not include a certified copy of the corresponding foreign application to obtain priority.

c) Advise Applicant A that it is too late to obtain priority because a translated version could not be filed by close of business today.

d) Advise applicant A that although the application can be filed today and the PTO will accept the foreign language application, he cannot obtain a filing date of April 4, 1990 because the application does not include an oath or declaration.

e) Advise applicant A that the application cannot be filed in the PTO because PTO rules require the application papers to be in the English language.

49. Which of the following statements respecting an appeal to the Board of Patent Appeals and Interferences is *true*?

a) An applicant may properly appeal only if he or she has been given a final rejection.

b) An applicant may properly appeal if an examiner allows a claim based on an erroneously narrow interpretation of the claim.

c) An applicant may properly appeal if an examiner twice refuses to allow the applicant to correct the inventors named in the application and, based on that refusal, rejects the claims for improper inventorship under 35 U.S.C. 102(f).

d) An applicant may properly appeal a Commissioner’s decision refusing to waive a rule.

e) None of the above statements is true.

50. In each of the following situations, a parent application was subject to a proper restriction requirement. As a result of the requirement, a divisional application was filed. During the pendency of the divisional application, the parent issued as patent P. In which of the following situations, if any, would the divisional application properly be subject to a holding of double patenting?

a) The claims of patent P cover a combination, while the claims of the divisional application cover a subcombination thereof.

b) The claims of patent P cover a process, while the claims of the divisional application cover an apparatus for practicing the claimed process.

c) The claims of patent P and the divisional application are not consonant with the requirement made by the examiner, due to the fact that the claims of the divisional application have been changed in material respects from the claims at the time the requirement was made.

d) The claims of patent P cover a process, while the claims of the divisional application cover a product made by such process.

e) None of the above.
51. Which of the following statements is true?
   a) Advertising by registered patent attorneys and agents is strictly prohibited.
   b) During the course of representation of a client, under no circumstances, should a registered practitioner communicate on the subject of the representation with a party known to be represented by another practitioner.
   c) With a client's consent after full disclosure, a registered practitioner may divide a fee for legal services with another practitioner who is not a partner in or associate of the practitioner's law firm or law office.
   d) Under no circumstances may a registered practitioner acquire any proprietary interest, by way of lien or otherwise, in the subject matter of a proceeding before the PTO which the practitioner is conducting for a client.
   e) None of the above statements is true.

52. Which of the following statements best defines the maximum time period within which a person can properly file a request for a reexamination proceeding?
   a) Anytime prior to termination or expiration of the patent.
   b) Anytime during the enforceability of the patent plus six years.
   c) Only during the pendency of a timely instituted infringement action.
   d) Only during the pendency of an infringement action subsequent to the expiration of the patent plus six years.
   e) Anytime prior to the payment of the third maintenance fee.

53. Which of the following statements is true?
   a) A design patent must be granted for any new, original and useful design for an article of manufacture.
   b) A design patent may be issued for 3 1/2, 7 or 14 years, depending on the fee paid by the applicant.
   c) A utility patent cannot be entitled to the benefit of the filing date of an earlier filed and copending design patent, even if the provisions of 35 U.S.C. 120 are otherwise satisfied.
   d) A design patent may be entitled to the benefit of a filing date of an earlier filed foreign design patent under the provisions of 35 U.S.C. 119 if filed within one year of the filing date of such foreign design patent.
   e) Double patenting may exist between a design patent application and a utility application and/or utility patent.

54. Which of the following may not be required for a public use proceeding to be instituted in connection with a pending patent application?
   a) A petition with supporting affidavits or declarations making a prima facie showing that the invention claimed in the application has been in public use or on sale more than one year before the application filing date.
   b) Filing of a duplicate of the petition and supporting affidavits or declarations, or service of such duplicate on the applicant or his attorney or agent of record.
   c) A fee.
   d) Identification of the serial number of the application.
   e) A hearing before the Commissioner or his designee.

55. Gray is the owner of a U.S. patent which issued on July 11, 1989. Red, Gray's competitor, is the owner of a U.S. patent which issued August 15, 1989. On September 1, 1989, Gray learned of Red's patent and determined that Red's issued claims, which are broader than Gray's issued claims, read on the unclaimed disclosure of Gray's patent. Gray, therefore, decides that he wants to file a reissue application copying verbatim Red's claims and asking the PTO to declare an interference. He will allege in his reissue oath that his patent is invalid or inoperative due to claiming less than he had a right to claim. The latest date that Gray can properly file his reissue application to copy Red's claims is:
   a) July 11, 1990
   b) August 15, 1990
   c) July 11, 1991
   d) August 15, 1991
   e) September 1, 1991
56. Jones, your client learns that his competitor, Smith, on January 3, 1990, filed an original patent application concerning technology vital to Jones’ business. You file a protest in the PTO for Jones claiming that Smith stole the invention from Jones. On behalf of your client, you request an interview with the examiner at which time you and Jones will present evidence clearly supporting Jones’ position. You and Jones attach a self-addressed postcard to the protest and request the PTO to mail the postcard as an acknowledgment that the protest has been received. Upon evaluation of the protest, the PTO will take which of the following courses of action?

a) Mail the self-addressed postcard acknowledging receipt of Jones’ protest.
b) Deny entry of Jones’ protest because the derivation issue raised by Jones is not an issue which the PTO will consider when raised by a protestor.
c) Enter Jones’ protest, and grant Jones an interview at which time Jones will have the opportunity to present his evidence.
d) Grant entry of Jones’ protest because Jones provided an explanation of the basis for his allegation that Smith stole Jones’ invention.
e) The PTO will take no action.

57. Which of the following best describes what can be properly filed in the PTO using the 37 CFR 1.8 certificate of mailing procedure and be considered as having been filed in the PTO on the date the paper is shown to have been deposited as the U.S. Postal Service?

b) An agreement under 35 U.S.C. 135(c) between parties to an interference.
c) Respondent’s answer in a disciplinary proceeding.
d) An amendment in response to an Office action wherein several claims were rejected.
e) All of the above.

58. Benson, Kline and Whitney filed a first patent application on January 5, 1983, containing a single claim to a generic invention. On June 7, 1984, while that application was pending, Benson and Kline filed a second patent application, the claims of which were directed solely to a species of the invention disclosed in the first application, Benson and Kline made the species independent of Whitney. The second application made a specific reference to the first application. The first application was abandoned on August 15, 1984. Thereafter, on September 14, 1987, Benson and Kline appealed a rejection of all of the claims of the second application to the Federal Circuit. The court affirmed the rejection on October 2, 1988. The court’s mandate was sent to the PTO on October 23, 1988. The mandate was received by the PTO on October 25, 1988. On October 27, 1988, Benson and Kline filed a third, continuation application, which was identical and made specific reference to the second application. On November 4, 1988, Benson and Kline filed a notice of express abandonment of the second application in the PTO. Which of the following statements is true?

a) The lack of identity of inventorship precludes the third application from obtaining the benefit of the filing date of the first application under 35 U.S.C. 120.
b) The receipt of the mandate by the PTO marked the termination of proceedings, and the filing of the third application in the PTO thereafter resulted in lack of copendency of the second and third applications.
c) The filing of the third application prior to express abandonment of the second application established copendency between the third and second applications as required by 35 U.S.C. 120.
d) The lack of identity between the claims of the first application and the second and third applications precluded the second and third applications from obtaining the benefit of the filing date of the first application.
e) The specific reference in each application only to the preceding application satisfies the requirement of 35 U.S.C. 120 that an application must contain a specific reference to the earlier filed application.
59. Which of the following statements is true respecting an information disclosure statement (IDS)?

a) The IDS must include an argument as to why the claimed invention is patentable over the prior art cited in the IDS.
b) The inclusion of arguments in the IDS that a limitation in a claim is critical and not taught by the cited prior art cannot result in file wrapper estoppel.
c) Gross negligence can be inferred in all circumstances where applicant failed to cite material prior art on an IDS.
d) Citation of numerous prior art references and publications is more helpful to the examiner than citation of a specific passage of reference which is considered pertinent.
e) The relevance of a cited reference can be pointed out by a brief statement quoting or paraphrasing a specific passage in the reference.

60. Which of the following statements is true?

a) Registered patent practitioners have a duty to disclose to the Director of Enrollment and Discipline disreputable or gross misconduct of other practitioners.
b) A reissue application with broadened claims cannot be filed within two years of the patent grant date because enlarging the scope of the claims would necessarily be prohibited new matter.
c) If a mathematical algorithm is included in a claim, then that claim is always unpatentable.
d) There can be no late payment of a patent maintenance fee without payment of an extension of time fee.
e) None of the above statements is true.

61. An inventor asks you, a registered practitioner, to prepare a patent application on an invention that the inventor reduced to practice twenty years ago. The inventor stated that the invention is only known to the inventor and no other person. The inventor also stated that the invention was really ahead of its time and as a result is only now commercially feasible. The most proper advice or course of action for you to take is to:

a) Orally advise the inventor that the invention has been abandoned and that patent protection is no longer available.
b) Prepare a patent application for filing at the PTO, and advise the inventor that the information regarding the last twenty years has no effect on the patentability of the invention at issue.
c) Prepare a patent application for filing, and do not disclose the 20 year lapse to the examiner.
d) Prepare an written opinion advising the inventor whether the invention has in fact been abandoned under the case law interpretation of 35 U.S.C. 102(c).
e) Advise the inventor that unless the disclosure of the invention was made public, the twenty year lapse between reduction to practice and applying for a patent really cannot make a difference.
63. Which of the following errors is not correctable by reissue?
   a) Failure to make reference to a prior copending application.
   b) The registered practitioner did not appreciate the full scope of the invention.
   c) Failure to timely file a divisional application.
   d) Failure to file a certified copy of the original foreign patent application to obtain the benefit of foreign priority under 35 U.S.C. 119 before the patent was granted.
   e) Reintroducing a claim needlessly cancelled during the pendency of the patent application.

64. Which of the following is not acceptable evidence of non-obviousness for a claimed invention?
   a) Commercial success of the claimed invention outside the United States.
   b) Satisfaction of a long felt need by the claimed invention.
   c) Copying of the claimed invention by others.
   d) The combination of elements of the invention produce unexpected results.
   e) Promotional advertising.

65. Your client’s application contains Claims 1 to 4. You filed a Notice of Appeal of the primary examiner’s final rejection of independent claim 1 and dependent claims 2 and 3. You took no action with respect to dependent claim 4, which the examiner has allowed. The Board affirmed the rejection of independent claim 1 and reversed the rejections of dependent claims 2 and 3. By an Office action dated March 20, 1990, the examiner set a one month time period to rewrite the dependent claims in independent form. Your client will be out of the country until May 1, 1990 and cannot be contacted. What action should you take to prevent abandonment of the application?
   a) File a response on or before April 20, 1990, rewriting the dependent claims in independent form.
   b) Do nothing as an allowed claim is present in the application and the examiner has the authority to cancel the rejected claim and rewrite the other claims.
   c) Wait until your client returns and file a response with a one month extension of time.
   d) On or before April 20, 1990, file a request for a one month extension of time and the appropriate fee, and upon your client’s return, file a response on or before May 20, 1990.
   e) File a response on or before April 20, 1990, granting the examiner authority to rewrite the dependent claims in independent form by Examiner’s Amendment.

66. A practitioner can petition to have an application given “special” status with no fee in which of the following circumstances?
   a) The invention is deemed of peculiar importance to the Department of Education of the U.S. Government.
   b) A prospective manufacturer with sufficient presently available capital and facilities is ready to manufacture the invention upon allowance of the patent application.
   c) The invention relates to recombinant DNA.
   d) The applicant is over 65 years of age.
   e) There is an infringing device actually on the market.

67. Which of the following concerning a continuation application is true?
   a) A continuation application may be based on a prior application which may have subsequently issued as a patent.
   b) The same inventors named in the prior application, upon which the continuation application is based, must be named in the continuation.
   c) An invention sought to be patented in the continuation application need not have been described in the prior application on which the continuation application is based.
   d) (a) and (c) only.
   e) (b) and (c) only.

68. In a patent application you prepared and filed, the primary examiner required an election of spe
cies. The application issued as a patent with no generic claim, only claims to the elected species. You filed a divisional application claiming the nonelected species. One dependent claim in the divisional was amended to contain the exact same limitations as an allowed claim in the parent application. The primary examiner rejected the claim under 35 U.S.C. 101 on the ground of same-type double patenting. Which of the following would be an appropriate response to the Office action to protect the applicant’s interests?

a) File a terminal disclaimer to overcome the double patenting rejection.
   b) Abandon the divisional application.
   c) Request reconsideration because the election was required by the Office in the parent application and, therefore, the parent cannot be used as a reference against the divisional application.
   d) Petition for review of the examiner’s requirement for election of species.
   e) Cancel the rejected dependent claim.

69. Practitioner Jones received a Notice of Allowance dated August 4, 1989 with a three month statutory period to pay the issue fee. Due to a heart attack, Jones did not attend to the application until February 7, 1990. The most appropriate action for Jones to take would be to:

a) File a petition to accept delayed payment of the issue fee based on failure to pay the issue fee due to unintentional delay, together with the issue fee and petition fee.
   b) File a petition to accept delayed payment of the issue fee based on failure to pay the issue fee due to unintentional delay.
   c) File a petition for a two month extension of time, together with the issue fee and petition fee.
   d) File a petition for a three month extension of time, together with the issue fee and petition fee.
   e) File a petition for a four month extension of time, together with the issue fee and petition fee.

70. When is a suspension of action in your client’s application appropriate?

a) When requested by you during an outstanding Office action, because you expect relevant evidence of your client’s efforts to sell the invention to become available shortly.
   b) When your client is not available to enable you to file a timely response to an outstanding Office action.
   c) When requested by you for good and sufficient cause after responding to the first Office action.
   d) When your client, after paying the issue fee, wishes to evaluate his claim coverage in the allowed application so that a decision can be made whether a new application should be filed seeking broader patent protection.
   e) When your client fails to pay legal fees owed to you.

71. In an Office action dated January 13, 1989, the examiner rejected all of the claims in your client’s application. The examiner set a three month shortened statutory period for response. The action was never received in your law office. On April 4, 1990, the U.S. Postal Service delivered a bundle of mail addressed to you at your office which had somehow gotten lost within the U.S. Postal system. The bundle included a note from the Postal Service apologizing for the delay in mail service. The bundle included the Office action, and surprisingly, the Notice of Abandonment for the application dated July 26, 1989. Can the application be revived?

a) Yes, by filing a response to the Office action, a request for a three month extension of time along with a proper petition to revive the application based on failure to prosecute due to unintentional delay, and the appropriate petition and extension of time fees.
   b) Yes, by filing a petition to withdraw the holding of abandonment.
   c) Yes, by filing a response to the Office action, a proper petition to revive the application based on failure to prosecute due to unavoidable delay, a proper terminal disclaimer, and the appropriate petition and terminal disclaimer fees.
   d) Yes, by filing a response to the Office action, a proper petition to revive the application based on failure to prosecute due to unavoidable delay, and the appropriate petition fee.
   e) Yes, by either (b) or (c) above.
72. You received a Notice of Allowance and Issue Fee Due letter setting a three month response period to pay the issue fee. At the same time you also receive a Notice of Allowability with a drawing change requirement to make minor corrections to the drawings. The Notice of Allowability sets a three month response period. The Notice of Allowance and Notice of Allowability have the same mailing date. You pay the issue fee on the last day of the three month period. However, you forgot to file a letter to the Draftsman to correct the drawings. Which of the following statements is true?

a) The application will not become abandoned since you have paid the issue fee and the PTO will advise you to correct the drawings with a new shortened statutory period of response.

b) The application will not become abandoned since you have paid the issue fee.

c) The application will not become abandoned if within the fourth, fifth or sixth month after the date of the Notice of Allowability you file in the PTO a letter to the Draftsman to correct the drawings.

d) The application will not become abandoned unless within the fourth, fifth or sixth month after the date of the Notice of Allowability you file in the PTO (i) a letter to the Draftsman to correct the drawing, (ii) a petition for an extension of time, and (iii) the proper extension of time fee.

e) None of the above statements is true.

73. Which of the following statements is true?

a) If an application contains disclosure of unclaimed subject matter and the unclaimed subject matter was discovered by an inventor who is not named in the application as filed, claims to this subject matter may not be properly added to the application.

b) A party who requests reexamination of a patent and who is not the owner of the patent has no right to judicial review of a PTO final reexamination decision.

c) An extension of time may be obtained under the provisions of 37 CFR 1.136 in a reexamination proceeding.

d) Two or more patent applications having claims drawn to patently indistinct inventions can avoid an obviousness-type double patenting rejection provided that each application has the same inventive entity and a common issue date.

e) None of the above statements is true.

74. Practitioner Smith filed a patent application in the PTO with 10 claims on March 15, 1989. In an Office action dated November 7, 1989, the examiner properly rejected all 10 claims under 35 U.S.C. 112 for lack of an enabling disclosure. She also rejected all 10 claims under 35 U.S.C. 103 as being obvious over prior art. The Office action set a three month shortened statutory period for response. The inventor informed Smith that he had invented an improvement that would overcome rejection over the cited prior art. On January 10, 1990, practitioner Smith filed a continuation-in-part (CIP) application of the prior application wherein disclosure was added overcoming the enabling disclosure deficiencies of the prior application. What is the effective filing date of the CIP application?

a) March 15, 1989 for the subject matter disclosed in the parent application, and January 10, 1990 for the subject matter not common with the parent application.

b) January 10, 1990 for all subject matter disclosed in the CIP application.

c) November 7, 1989 for the subject matter disclosed in the parent application, and January 10, 1990 for the subject matter not common with the parent application.

d) November 7, 1989 for all the subject matter disclosed in the CIP application.

e) March 15, 1990 for all subject matter disclosed in the CIP application.
75. If an amendment signed by the applicant is received in the PTO for an application in which there is a duly appointed registered practitioner, and no assignment executed by the applicant has been recorded, the amendment:
   a) Should be entered and acted upon only if the applicant previously filed a revocation of the practitioner's authority to act in the application.
   b) Should not be entered or acted upon because it has not been cosigned by the practitioner.
   c) Should be entered and acted upon.
   d) Should be entered and acted upon only if it is signed by the practitioner.
   e) None of the above.

76. When more than one inventor is named in a patent application, an examiner may require the inventors to identify:
   a) The inventive entity of the subject matter of each claim.
   b) The invention date of the subject matter of each claim.
   c) The ownership of the subject matter of each claim on the date of invention.
   d) All applications filed by the named inventors in which claimed subject matter is substantially identical to that claimed in the patent application being examined.
   e) All of the above.

77. The claims of an application are properly subject to a double patenting rejection. The named inventor has assigned all of her patent rights to Company X and the assignment has been recorded in the PTO. A terminal disclaimer, which can overcome the rejection, may be properly signed by which of the following?
   a) The named inventor.
   b) The attorney or agent of record.
   c) The secretary of the X Company.
   d) (a) or (c).
   e) (a), (b) or (c).

78. Practitioner Smith has filed an Appeal Brief. In the Examiner's Answer, the primary examiner maintained her position respecting the final rejection, and added a new ground of rejection. Which of the following courses of action should Smith take after receiving the Examiner's Answer in view of the new ground of rejection?
   a) Do not file a Reply Brief, but request an oral hearing two months after the date of the Examiner's Answer to enable proper presentation of any additional arguments.
   b) File a petition to strike the Examiner's Answer.
   c) File a Reply Brief arguing that the new ground of rejection is improper at this stage of prosecution.
   d) File a Reply Brief directed to the new ground of rejection raised in the Examiner's Answer.
   e) File a Reply Brief three months after the date of the Examiner's Answer.

79. After all claims in an application have been indicated as allowable by the examiner, the examiner has a duty to consider a citation of prior art after prosecution has ended if the citation is accompanied by which of the following?
   a) A timely affidavit under 37 CFR 1.132 with respect to the cited prior art.
   b) A statement by the applicant or his attorney or agent that, in the judgment of the person making the statement, the information cited is material to the examiner of the application as defined in 37 CFR 1.56(a) and is filed with an explanation as to why the information disclosure statement was not earlier presented.
   c) A proposed amendment cancelling allowed claims which does not affect the scope of the claimed invention.
   d) (a) or (b).
   e) (a), (b) or (c).
80. How should a trademark be referenced in a patent application?
    a) When the mark is capitalized and placed between quotation marks.
    b) When the mark is coupled with the word "type" and placed between quotation marks.
    c) When the owner of the mark is identified in the specification.
    d) Only when the owner of the mark gives permission to use it.
    e) None of the above.

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

April 4, 1990

Afternoon Section (100 Points) Time: 4 Hours

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 proctor before this section of the examination begins.

This section of the examination consists of three (3) essay questions. The point value for each question is indicated at the beginning of each question. All answers must be written in the Answer Book provided to you by the proctor.

Points will be deducted for any claims written which are indefinite, add new matter, or are not within the scope of the invention as shown in any drawings or as described or which would be open to any other objection/rejection that would normally result in the course of patent examination. Points will also be deducted for employing irrelevant or incorrect reasoning, applying inappropriate procedures, failing to follow instructions, using poor English grammar, and failing to answer the question posed. Points will further be deducted for failure to properly follow and employ all controlling statutory provisions and regulations as well as Patent and Trademark Office policy and procedure. Citation of actual cases is not required, however, wrong citations will be basis for deducting points. Do not assume additional facts not found in the questions. You must obtain a score of at least 70 points to pass this section of the examination.

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO CHECK THE CONTENTS OF THIS EXAMINATION BOOKLET OR TO BEGIN THE EXAMINATION.
INSTRUCTIONS: This question is directed to claim drafting and consists of three options. You must select one of the options and draft a claim. If you select more than one option, only the first claim appearing in your Answer Book will be graded. Points will be deducted for claiming subject matter not within the scope of the invention as described or not as shown in the figures, using language which is indefinite or does not have antecedent basis, or for failing to interrelate the elements or components of your claim in Options A and B, or for failing to present the claims limited to the compositions set forth in Option C.

Option A: The invention illustrated in Figures 1 and 2 below and described on page 2 is directed to a three ring loose-leaf album. Figure 1 is an end view with the album in the closed position. Figure 2 is a view of the exterior surface of the album in the open position.
The album includes top 12 and bottom 28 covers; spine 44; exterior surfaces 14, 30 and 46; interior surfaces 18, 34 and 50; a ring assembly 60 including base 62 and three rings 64 equally spaced along the base; feet 32; four hinges 68; recessed exterior surface portion 16; and indicia 26.

One feature of the invention is a recessed portion 16 in the exterior surface 14 of the top cover 12 wherein personalized indicia 26 are positioned. An important feature of the invention is the presence of a hardened polymer resin which has been poured into the recess to bond the indicia in place. The hardened polymer resin is clear to permit the indicia to be visible. Another feature is the four projecting feet 32 on the back cover. Although not specifically illustrated, the feet may be decorative, e.g., ball and claw, as in the instance when the top and bottom covers and the spine are made of wood. Whether or not the feet are decorative, they permit the album to be displayed in a fashion similar to furniture.

Another important feature is the arrangement of hinges 68 so that there is minimal external exposure of the hinges and so as not to detract from the decorative aspects of the album when covers 12 and 28 are in a closed position as shown in Figure 1. When opened, the top cover exposes a three ring loose-leaf assembly of a base 62 and three rings 64, equally spaced along the base.

Draft a single claim to a three ring loose-leaf album as described above and shown in Figures 1 and 2. Your claim must include and interrelate at least the following elements: the hardened polymer resin; top and bottom covers 12 and 28; spine 44; hinges 68; interior surfaces 18, 34 and 50; base 62 and rings 64; feet 32; exterior surfaces 14, 30 and 46; recess 16; and indicia 26.

The object of this question is to demonstrate your ability to draft a claim which clearly defines how the claim elements interrelate to each other as opposed to being able to merely draft a broad claim. For purposes of this examination, you may not be your own lexicographer to name the elements identified above. You must use the terminology set forth in the above description. Your claim must define the three ring loose-leaf album that is operative in the manner described and shown above. You may not describe any of the above-mentioned required elements in terms of means plus function. A claim drafted to a design or to any method of manufacture or method of use will receive no credit.
Option B: This invention is a variable-gain, speech amplifier that is activated when the attenuation of the incoming signal is less than a predetermined level, the function of which is to reduce distortion in battery-powdered radio receivers. The figure below is a diagram of the circuit blocks required to make the apparatus function according to the preferred embodiment, as described on page 4. The diagram below does not illustrate the power source because the use of battery powered energy sources for radio receivers is well known in the art.
The Figure illustrates circuit blocks for a radio receiver having a demodulator means 404 for receiving a radio frequency signal from an antenna 402 and demodulating the audio from the signal. The demodulated audio frequency signal is fed to the step attenuator 406 for selectively reducing the signal level according to a control signal from the microcomputer 418. The signal output from the step attenuator 406 is fed to the high pass filter 408. The activation of the high pass filter is also controlled by a control signal from the microcomputer 418. When not activated, the high pass filter 408 is simply bypassed by the audio frequency signal which, whether filtered or not, is fed to speech amplifier 410 the output of which is connected directly to speaker 412. The microcomputer 418 is manually controlled by volume control 414 via an analog to digital converter 416 converting the analog signal output from the volume control to a digital signal for outputting to the microcomputer 418.

When the volume control 414 is set at a low level, the microcomputer 418 sets the step attenuator 406 at a correspondingly high attenuation level and the high pass filter is bypassed (deactivated). As the volume control 414 is advanced to higher settings, the attenuation level of the step attenuator 406 is stepwise reduced. When a low enough level of attenuation is reached such that the speech amplifier 410 would have a clipped output at lower speech frequencies, beyond a tolerable level of distortion, the microcomputer 418 will activate the high pass filter 408 to prevent the excessive low frequency clipping by limiting the magnitude of only the lower frequency signals.

Draft a claim to a radio receiver having a speech amplifier circuit as illustrated and described above. Your claim must include and interrelate at least all of the following components: demodulator means 404, step attenuator 406, high pass filter 408, speech amplifier 410, volume control 414, analog to digital converter 416 and microcomputer 418. You must use means plus function language to describe operation of the components.

The object of this question is to demonstrate your ability to draft a claim which clearly defines how the claim elements interrelate to each other as opposed to being able to merely draft a broad claim. For purposes of this examination, you may not be your own lexicographer to name the elements identified above. You must use the terminology set forth in the above description. Your claim must define a radio receiver speech amplifier circuit that is operative in the manner described and shown above. You must describe the required elements in terms of means plus function. A claim drafted to any method of manufacture or method of use will receive no credit.

GO TO PAGE 5 FOR OPTION C
Option C: The invention is directed to intermediate compounds used in the preparation of pyrazole compounds used for the quantitative analysis of iron. In particular, the intermediates are derivatives of a 4-amino-2-pyrone heterocyclic ring having the following position numbers:

\[
\begin{align*}
\text{Option C: } & \quad \text{The invention is directed to intermediate compounds used in the preparation of pyrazole compounds used for the quantitative analysis of iron. In particular, the intermediates are derivatives of a 4-amino-2-pyrone heterocyclic ring having the following position numbers:} \\
& \quad \text{The compounds of the invention are represented by the formulas on this page below and on page 6:}
\end{align*}
\]
The inventor has discovered that substituted 4-amino-2-pyrones, wherein the intermediate compounds are substituted at the amino terminus and result in an iron reagent having greater time and light stability.

You are preparing a patent application for the inventor. The inventor has provided you with prior art references showing the following compounds:

Draft one generic claim which describes the intermediates used in the preparation of pyrazole compounds. Your claim must not read directly on the prior art.

The claim must include only one generic formula, the substituents being defined in terms of different R groups. You may use Markush groups to define substituents only. This is not an exercise for drafting a broad claim, but requires you to present a claim directed only to the compounds specifically set forth on pages 5 and 6 which are within the scope of the invention. If more than one claim is presented, only the first claim will be considered and graded. No credit will be given for any claim presenting a process of making of using the compound, or a Markush grouping of formulas. In order to assist you in nomenclature regarding certain heterocyclic rings, please find below the names of heterocyclic rings which appear in some of the compounds above:

Piperidine  Morpholine  Pyrrolidine
Gary Frost is a prolific inventor who has dabbled in virtually all areas of technology, from toy racing cars to computer-assisted inventions. When Frost conceives of an idea, he files a patent application on that idea, and then waits to license the idea to someone in the particular industry. Over the recent New Year's holidays, he took a well deserved respite from his tinkering in his garage workshop.

On Saturday night, December 30, 1989, a terrible storm hit from the west and a leak developed in the wall of Frost's garage. The next morning, Frost discovered that the wood laminate siding on the exterior of his garage had weathered and deteriorated. Eventually, the deterioration in the laminate caused the the leak he observed in the interior of his garage workshop. Frost spent the rest of the day doing his best to patch the damage to the interior wall and exterior siding.

On New Year's Eve, Frost went to a party. He returned home around 4:00 a.m. on New Year's Day, January 1, 1990. As he was getting ready for bed, a thought suddenly struck him. He said to himself out loud, "Eureka! If only the exterior siding had had a coating of trihematol, the leak would not have occurred."

Trihematol had recently come on the market as a diluent for certain lubricating systems. This use had nothing to do with wood laminates. However, through his work in various technologies, Frost had the brilliant idea of applying a thin coating of trihematol on the wood laminate to protect the laminate from penetration of water. This would have prevented the water damage he observed to his garage wall and to the exterior siding.

Trihematol is commercially available in any hardware store. Trihematol is well known as representing a particular chemical composition. The description of trihematol is fully described by its inventor, Stickwell, in his article in *The American Lubricator*, Vol. 342, pp. 238-95 (1984). Stickwell's article has a fully enabling disclosure of how to make trihematol.

As Frost had a lot of things on his mind, and a lot of other business matters pending in other technologies that had precedence, Frost never obtained a supply of trihematol and, thus, never reduced the invention to practice. Frost chalked the project up as a good idea, but one that he would hold off with unless there was a commercial interest demonstrated by a third party's interest.

To preserve his rights, however, Frost drafted a patent application. Frost, is an amateur patent practitioner and has been drafting his own patent applications for some time. He has written several hundred cases. On January 1, 1990, Frost drafted the following patent application:
Trihematol Coated Laminate

For many years, wood laminates have been coated with a variety of coatings to render them weather resistant, i.e. against moisture and water. However, even the best commercial coatings for such laminates provide a relatively short period of protection.

In accordance with my invention, a wood laminate that is used as an external siding for houses and other structures is coated with an effective amount of trihematol to prevent penetration of water and moisture. The thickness of the thin coating may preferably be from 0.2 to 0.6 mm. In the most preferred embodiment the thickness of the trihematol coating is 0.3 mm. Trihematol is described by Stickwell, *The American Lubricator*, Vol. 342, pp. 238-95 (1984).

Example

A wood laminate having three separate sections of wood particulate matter bonded by a conventional resin and a total thickness for the three layers of 1.5 cm. is spray coated with trihematol to a thickness of 0.3 mm. The product is permitted to dry for two hours, after which it is ready for usual application as an exterior surface for buildings such as houses, garages and the like.

I claim:

1. In a wood laminate having a coating to protect the wood laminate from the effects of weather, the improvement which comprises said wood laminate having a coating of trihematol, the thickness of said coating being from 0.2 to 0.6 mm.

The application was filed in the U.S. Patent and Trademark Office (PTO) on February 9, 1990. All formalities were met including paying the proper filing fee, filing the inventor's declaration under 35 U.S.C. 115, and filing a small entity declaration. An Official Filing Receipt was issued by the PTO on March 5, 1990.

On March 8, 1990, Frost received in his mailbox both the Official Filing Receipt and also a copy of *The Stickwell Letter*. Stickwell, the inventor of the trihematol composition, publishes *The Stickwell Letter*, a bimonthly newsletter reporting on his latest activities and thoughts of the past two weeks or so. The issue of *The Stickwell Letter* Frost received on March 8, 1990, reported on Stickwell's thoughts for the period from February 15 through March 1, 1990. A short news item on *The Stickwell Letter* appeared as follows:
Trihematol New Uses

When I first invented trihematol a few years ago, I had no idea that it would be as useful as it has turned out to be in so many divergent fields. Just last week, I spilled some trihematol on my wooden laboratory bench. It hardened right away with a translucent appearance. I tried to wash it off. I used every solvent I could think of, but the trihematol was just very resistant to everything. If you apply a very thin coating of trihematol on wood, say, 0.4 mm, it will protect that wood surface forever! This will come as good news to our friends in Alaska, who may wish to try this on their wood laminate exterior surfaces. Surely, a very thin 0.4 mm coating of trihematol will do wonders to preserve any wood material exposed to moisture and water.

Frost was dumbfounded at this news. Once again, he had found a real winner! Recognizing the commercial importance of his discovery, he has consulted you as his patent counsel. As a result of your study, and as a result of experiments by Frost conducted after March 8, 1990, you have ascertained the following indisputable facts:

1. Frost's activities during the New Year's holidays were all prior to Stickwell's accidental discovery as reported in The Stickwell Letter.

2. Frost's pending patent application is a fully enabling disclosure and a constructive reduction to practice of the invention.

3. The earliest date of publication for The Stickwell Letter describing the invention is March 7, 1990.

4. There is no public disclosure of Frost's invention in any way prior to The Stickwell Letter.

5. The Stickwell Letter is a "printed publication" under 35 U.S.C. 102(a).

6. Frost's experiments after March 8, 1990 have shown that the thickness of the trihematol must always be at least 0.2 mm, but satisfactory results are achieved with coating thicknesses up to 0.9 mm. The laminate prepared with any thickness up to 0.9 mm, in fact, performs the identical function in the identical way to yield the same result as disclosed and claimed in Frost's original patent application.

7. A wood laminate coated with trihematol of any thickness is clearly patentable over the prior art as of the filing date of the original Frost patent application.
Frost tells you that a continuation-in-part (CIP) application should be promptly filed which will vary the disclosed thickness range to include thickness from 0.2 to 0.9 mm. Frost also also tells you to substitute the following claim as the only the only claim in the CIP application:

In a wood laminate having a coating to protect the wood laminate from the effects of weather, the improvement which comprises said wood laminate having a coating of trihematol, the thickness of said coating being from 0.2 to 0.9 mm.

Will a continuation-in-part application with Frost's proposed CIP claim provide valid patent protection for Frost's invention? Yes or No.

If YES, explain fully why the proposed CIP claim provides valid patent protection and would provide better protection than the original claim. Explain fully why the original claim is inadequate.

If NO, explain fully why Frost's proposed CIP claim does not provide valid patent protection for the invention. Present your patent strategy that would provide Frost with valid patent protection in an infringement suit against a party who would use a trihematol coating of 0.7 mm thickness. If your patent strategy involves amending original claim 1, you must draft and present your amended claim in accordance 37 CFR 1.121. If you amend the claim, you may not present any new claim or claims. If, however, your patent strategy involves cancelling or retaining the original claim and adding a new claim, you must draft and present only one new claim. No credit will be given for merely explaining the scope of any proposed new claim or for merely explaining how the original claim should be or would be amended. Explain fully how your amended or new claim and strategy would provide valid patent protection of Frost's invention.

Your answer, including explanations, must demonstrate that you would comply with all controlling statutory and rule provisions as well as PTO policy and procedure, i.e., you must relate the facts presented to the question and show how you would meet the requirements of any statute or rule, or meet the requirements of a policy of procedure set forth in the Manual of Patent Examining Procedure. Do not include unnecessary rhetoric in your answer. The mere citation of a statute, rule or other authority, or a statement to the effect that a statute, rule or other authority would or would not be complied with is not an acceptable answer and will receive no credit.
QUESTION 3 (40 Points)

You are a patent agent, Registration No. 55,555. On December 5, 1989, you filed patent application Serial No. 07/999,999 on behalf of your client, Alden Akers, for an invention titled "FIRE HOSE NOZZLE". The application is being examined by Examiner Wendell Young in Group Art Unit 313.

Akers' invention is a rotating, piercing nozzle for fire hoses. The main features of the nozzle are shown in Figure 1.
Akers conceived the rotating, piercing nozzle and reduced it to practice in Jefferson-town, Iowa on July 1, 1989 after he witnessed firemen experiencing difficulty in putting out a fire in an attic space between a roof and a ceiling. The following is an excerpt from Akers' patent application describing his invention and his three claims:

The nozzle 50 has a tubular shaft 52, a piercing member 60, and an impact cap 54. A sledge hammer is used to strike the impact cap 54 in order to drive the nozzle through the roof 74 of a burning building and into the attic space 70, like a giant nail.

A second feature of the nozzle is that a rotating sleeve 10 driven by the pressure of the water 30 that enters through the hose 58 breaks up the water into a mist. The portion of the nozzle denoted by numeral 10 rotates and discharges water droplets in the form of mist 76 as shown.

I claim:

1. An improved means for combatting a fire located in the attic space of a building.

2. An improved fire-fighting tool comprising, in combination:

   a water discharge nozzle having a rotating sleeve member for discharging waters radially outward; and

   a piercing means connected to said nozzle for piercing a building structure.

3. An improved fire-fighting tool comprising, in combination:

   a tubular shaft;

   a water discharge nozzle portion attached to one end of said shaft;

   a piercing means connected to said nozzle; and

   an impact cap mounted on the opposite end of said shaft for transmitting a driving impact force from a sledge hammer or the like for causing said piercing means to penetrate a building structure.
In an Office action dated February 20, 1990, setting a three month shortened statutory period for response, Examiner Young rejected the claims of the Akers application as follows:

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as failing to particularly point out and distinctly claim the invention. Claim 1 recites only a single 'means' and thus encompasses all means for performing the desired function.

Claim 1 is also rejected under 35 U.S.C. 102(a) as anticipated by Figure 1 of the October 1, 1967 article article by J.J. James in the Fire Fighter's Journal. Figure 1 shows a piercing nozzle.

Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as anticipated by British Patent No. 1,111,111, filed in the British Patent Office on June 1, 1988, and issued as a British patent on January 15, 1990. Figure 1 of the British patent shows a piercing nozzle with a rotating sleeve for discharging the water radially outward.

Claim 3 is rejected under 35 U.S.C. 103 as being obvious to one of ordinary skill in the art in view of the disclosure in Figure 1 of the October 1, 1967 article by J.J. James in the Fire Fighter's Journal. The Figure shows a long, rigid tubular shaft, and a piercing nozzle with a non-rotating sleeve for discharging the water radially outward, the rigid tubular shaft being sealed at the end of the shaft opposite the nozzle. Applicant has described his nozzle as being "like a giant nail." It is common knowledge that a nail must have a head or similar means to receive the impact of a hammer to drive the nail into a body. Thus, it would have been obvious and within the skill of the art to provide the sealed end of the shaft with an impact cap to receive a blow from a sledge hammer.

Fig. 1 in Fire Fighter's Journal.  
Fig. 1 of the British patent.

After receiving this Office action from Examiner Young, you are of the opinion that the examiner has made a prima facie case of obviousness with respect to claim 3. You consult with Akers, who reveals that until he added the impact cap to his invention, to enable the use of a sledge hammer to force the piercing member through a roof, his sales were negligible. After adding the impact cap on July 1, 1989, his nozzle instantly became a phenomenal commercial success, with sales of over $1 million
in 6 months. Akers also says he knows there has been a long felt need in the industry for an improved means for penetrating attic spaces, and that several inventors have tried unsuccessfully to make such an improvement. He provides you with a copy of an article by B. Williams in *Fire Fighter's Journal*, published in June 1988, substantiating this statement.

Assume that Young's descriptions of the prior art are complete and accurate, and that the information provided you by inventor Akers is complete and accurate.

**Draft all of the documents needed to properly respond to the Examiner Young's action.** In preparing the documents, YOU MUST INCLUDE ALL INFORMATION WHICH SHOULD APPEAR IN FORMAL HEADINGS AND SIGNATURE BLOCKS FOR EACH DOCUMENT. You must prepare a response which will properly overcome all of the rejections made by Examiner Young, but also retain at least two of the original three claims. You may cancel any claim. However, YOU MAY NOT REWRITE ANY ORIGINAL CLAIM OR PRESENT ANY NEW CLAIM. No credit will be given to any answer merely explaining what course of action should be taken to prosecute the application. No credit will be given for any rewritten or added claim, or for arguments made for any rewritten or added claim, or for arguments made in support of any rewritten or added claim.

Your documents should be no longer than is needed to explain your position, and should not include unnecessary rhetoric. Your answer must demonstrate that you would comply with all controlling statutory and rule provisions as well as PTO policy and procedure, i.e., you must relate, where necessary, the facts presented in the question to the statute, rule, policy or procedure to show how you would meet the requirements of the statute, rule, policy or procedure. No credit will be given for merely citing a statute, rule, or other authority, or for a statement to the effect that a statute, rule or other authority will or will not be met or satisfied.