

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

NOVEMBER 3, 1999

Morning Session (50 Points)

Time: 3 Hours

DIRECTIONS

This session of the examination is an open book examination. You may use books, notes, or other written materials that you believe will be of help to you *except* you may not use prior registration examination questions and/or answers. Books, notes or other written materials containing prior registration examination questions and/or answers *cannot* be brought into or used in the room where this examination is being administered. If you have such materials, you must give them to the test administrator before this session of the examination begins.

All questions must be answered in SECTION 1 of the Answer Sheet which is provided to you by the test administrator. You must use a No. 2 pencil (or softer) lead pencil to record your answers on the Answer Sheet. Darken *completely* the circle corresponding to your answer. You must keep your mark within the circle. Erase *completely* all marks except your answer. Stray marks may be counted as answers. No points will be awarded for incorrect answers or unanswered questions. Questions answered by darkening more than one circle will be considered as being incorrectly answered.

This session of the examination consists of fifty (50) multiple choice questions, each worth one (1) point. Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

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

DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO

1. Abigail has invented a novel watering mechanism for a flower pot. The flower pot also possesses a unique ornamental design. Abigail consults with patent practitioner P for advice on the differences between a design patent and a utility patent. Which of the following general statements regarding design and utility patents, if made by P, would be accurate?

- (A) A “utility patent” protects the way an article is used and works, while a “design patent” protects the way an article looks.
- (B) Unlike utility patent applications, a design patent application may not make a claim for priority of a provisional patent application.
- (C) Maintenance fees are required for utility patents, while no maintenance fees are required for design patents.
- (D) Both design and utility patents may be obtained on an article if the invention resides both in its utility and ornamental appearance.
- (E) All of the above.

2. A patent application filed in the PTO claims a nylon rope coated with element E for the purpose of preventing breakage of the rope. In the first Office action, the examiner rejects the claim as obvious over P in view of a trade journal publication, T. P teaches a nylon rope coated with resin for the purpose of making the rope waterproof. T teaches a nylon tent fabric coated with element E for the purpose of making the tent waterproof, and suggests the use of element E for making other nylon products waterproof. Following proper PTO practices and procedures, the combination of P and T:

- (A) cannot support a prima facie case of obviousness because T lacks a suggestion to combine with P for the purpose of preventing breakage in nylon rope.
- (B) cannot support a prima facie case of obviousness because P lacks a suggestion to combine with T for the purpose of preventing breakage in nylon rope.
- (C) cannot support a prima facie case of obviousness because T only contains a suggestion to combine with P for the purpose of waterproofing nylon rope.
- (D) can support a prima facie case of obviousness, even though T only contains a suggestion to combine with P for the purpose of waterproofing nylon rope.
- (E) can support a prima facie case of obviousness because the applicant is always under an obligation to submit evidence of non-obviousness regardless of whether the examiner fully establishes a prima facie case of obviousness.

3. What would **not** be permitted to be incorporated by reference in your client’s U.S. utility patent application?

- (A) Essential material from a U.S. patent.
- (B) Essential material from a foreign application.
- (C) Non-essential material from a prior filed, commonly owned U.S. application.
- (D) Essential material from a magazine article.
- (E) (B) and (D).

4. Beverly is a research chemist. While cleaning a clogged shower drain she recovers several ounces of goop from the drain. She analyzes the ingredients and properties, and finds that the goop makes a highly effective industrial lubricant. She comes to you for help in preparing and filing an application. She informs you that the goop is formed from equal parts of chemicals W, X, Y and Z. She knows that chemical W comes from the soap she uses and that chemicals Y and Z are components of the conditioner she uses on her hair. Her soap uses the tradename “Acme SmellNice”, and her shampoo and conditioner both use the tradename “A-1 Silky.” Chemicals W, Y and Z are all readily available on the commercial market. Chemical X is also a common, readily available chemical, but she cannot determine how it got in the shower drain. She suspects it is the result of a reaction between A-1 Silky shampoo and Acme SmellNice soap that occurs when the two are mixed in the presence of hot water. You prepare an application describing a prophetic example setting forth one way to make the goop from commercially available chemicals and a working example describing (as well as the inventor can) how the goop is formed in the bathroom drain. The working example describes mixing of A-1 Silky shampoo and Acme SmellNice soap in the presence of water having a temperature of at least 100°F to form chemical X. Because you know that the ingredients for at least Acme SmellNice soap have recently changed, but the nature of the change is unknown, you list every ingredient of A-1 Silky shampoo, and Acme SmellNice soap in positive language so there will be no confusion as to what is meant. The application includes the following claims:

- Claim 1. An industrial lubricant consisting essentially of equal parts of chemical W, chemical X, chemical Y and chemical Z.
- Claim 2. The industrial lubricant of Claim 1, wherein said chemical X is formed by mixing A-1 Silky shampoo and Acme SmellNice soap in the presence of water having a temperature of at least 100°F.

Which of the following statements is/are correct?

- (A) Claim 1 cannot be supported by an enabling specification because Beverly does not fully understand the processes that occurred in the drain, and a prophetic example alone is never sufficient to enable a claim.
- (B) Claim 2 is not patentable because it sets forth an incorrect theory of formation of chemical X.
- (C) Claim 1 is not patentable because Beverly merely found the goop in her drain and did not formulate it herself.
- (D) Claim 2 is not patentable because it is indefinite.
- (E) (B) and (D).

5. Jack, a registered patent agent, received a final rejection of all of the claims in an application directed to an article of manufacture. Jack is about to file a timely Notice of Appeal to the Board of Patent Appeals and Interferences. Before filing his notice of appeal, Jack would like to tie up some loose ends by amendment. Which of the following reply(replyes) may he file without triggering the requirements of 37 CFR § 1.116(b)?

- (A) A reply that presents his argument in a more defensible light and adds additional claims.
- (B) A reply amending the claims into process claims.
- (C) A reply amending all of the independent claims, accompanied by a declaration from the inventor.
- (D) A reply complying with a requirement of form expressly set forth in the previous Office action.
- (E) (A) and (D).

6. You are preparing a patent application for filing in the PTO. The application contains the following partial claim:

A walking device comprising:

- (i) a vertical member having opposing top and bottom portions;
- (ii) a handle connected to the top portion of the vertical member forming a 45E angle with the top portion of the vertical member;
- (iii)
- (iv) a set of non-skid covers for the set of legs, said set of legs being aluminum.

Following proper PTO practices and procedures, which of the following claim limitations best completes the claim by providing the missing limitation (iii)?

- (A) a horizontal member, substantially round in shape, having opposing sides connected along one of the opposing sides to the bottom side of the vertical member and along the other of the opposing sides to a set of legs; and
- (B) a horizontal member, substantially round in shape, having first and second opposing sides connected along the first opposing side to the bottom side of the vertical member and along the second opposing side to a set of legs; and
- (C) a horizontal member, substantially round in shape, connected to the bottom portion of the vertical member; and
- (D) a horizontal member, substantially round in shape, having opposing top and bottom portions; the top portion of the horizontal member is connected to the bottom portion of the vertical member, and the bottom portion long the bottom portion of the vertical member is connected to a set of legs; and
- (E) a horizontal member, substantially round in shape, having a top side connected to the bottom side of the vertical member and a bottom side connected to the set of legs; and

7. Which of the following statements, regarding amendments filed after final rejection in a timely manner, is correct?

- (A) Amendments touching upon the merits of the application presented after final rejection shall be entered upon payment of the proper fee and a showing of good and sufficient reasons why they are necessary and were not earlier presented.
- (B) An amendment filed after final rejection is entitled to entry if it amends only the claims that were finally rejected.
- (C) Amendments after final rejection may be made canceling claims or complying with any requirement of form expressly set forth in the final Office action.
- (D) An amendment after final rejections is entitled to entry if it cancels claims and adds new claims that clearly set forth a previously unclaimed embodiment of the invention.
- (E) Applicant cannot make any further amendments after final rejection, but may submit remarks and a notice of appeal.

8. In which of the following situations, considered independently of each other, is the original, new, or amended claim supported in the application as filed?

- (A) An amendment to the specification changing the definition of “holder” from “is a hook” to “is a hook, clasp, crimp, or tong” and no amendment is made of the claim, which uses the term “holder.” The amendment is filed one month after the application was filed. There was no previous supporting disclosure in the specification of the holder being a clasp, crimp, or tong.
- (B) An amendment to the specification and claims changing the definition of “holder” from “is a hook” to “is a hook, clasp, crimp, or tong.” The amendment is filed one month after the application was filed. There was no previous supporting disclosure in the specification of the holder being a clasp, crimp, or tong.
- (C) Original claim 1 in the application refers to “a holder,” and original claim 2 depends from and refers to claim 1 stating, “said holder is a hook, clasp, crimp, or tong.” There is no disclosure in the specification preceding the claims in the application as filed for the holder to be a clasp, crimp, or tong.
- (D) An amendment is filed presenting a claim to an electrical insulating device, copied from a patent for the purpose of provoking an interference. The claim refers to “nonconductive plastic holder.” The application as filed contains a broad generic disclosure describing electrical insulating devices. The holder is described in the specification of the application as “conducting electricity.” There is no disclosure in the specification of the holder being “nonconductive.”
- (E) All of the above.

9. An application as originally filed contains the following Claim 1:

Claim 1. A doughnut making machine comprising:

- (i) an input conveyor that receives dough to be used in making said doughnuts;
- (ii) portioning means for portioning dough from said input conveyor into a plurality of dough balls, each of said plurality of balls containing dough sufficient to create a single doughnut;
- (iii) forming means for forming each of said dough balls into a ring of dough;
- (iv) a deep fat fryer which receives rings of dough from said forming means and cooks said rings of dough;
- (v) applying means for selectively applying a flavored coating on cooked rings of dough to produce doughnuts; and
- (vi) placing means for placing a plurality of said doughnuts on a flat sheet.

The specification adequately describes the claimed subject matter. Two different “means for selectively applying” are described in the specification: a sprayer and a brush. Which of the following original claims is an improper dependent claim?

- (A) 2. The doughnut making machine of Claim 1, wherein said placing means is a conveyor that extends from said applying means to said flat sheet.
- (B) 3. The doughnut making machine of Claim 1, wherein said forming means includes a cutter that removes a center portion of each of said dough balls to form a ring of dough.
- (C) 4. The doughnut making machine of Claim 1, wherein said applying means is omitted for making plain doughnuts.
- (D) 5. The doughnut making machine of Claim 1, wherein said applying means includes a sprayer which receives a sugar based flavored coating, wherein said sugar based flavored coating is sprayed on said cooked rings of dough.
- (E) 6. The doughnut making machine of Claim 1, wherein said applying means is a sprayer.

10. Which of the following dependent claims, each occurring in different patent applications, is in a proper claim format?

- (A) Claim 4. The process of claim 5, further characterized by...
- (B) Claim 2. The process of claim 1 or claim 5, further comprising...
- (C) Claim 6. The widget as in claims 1, 2 or 3, further including...
- (D) Claim 3. The widget as in the preceding claims, further containing...
- (E) Claim 5. The process as in claims 1-2 or 3, further comprising...

11. In August 1999, a recently registered patent agent, who is not an attorney, asked a registered patent attorney to help the agent establish a practice. Considering the additional facts in the following choices separately, which choice best comports with the professional responsibilities of both the agent and the attorney?

- (A) The agent advertises as a registered practitioner authorized to practice before the Office in patent and trademark cases. The attorney supervises all the trademark work done by the agent.
- (B) The agent advertises on television and radio as a registered patent agent and accepts patent cases on a reasonable contingent fee.
- (C) The attorney has the agent prosecute trademark applications before the Office and the attorney signs all the papers submitted to the Office without reading the papers.
- (D) The attorney and agent enter into a partnership agreement that has no health or retirement benefits, but specifies that after termination of the partnership, the agent and the attorney will not practice in each other's neighborhoods or accept each other's established clients.
- (E) Without receiving anything of value from the agent, the attorney refers patent application clients to the agent, the agent informs the clients that the agent is a registered patent attorney, and the agent competently represents the clients in patent cases.

12. On February 12, 1999, you filed a patent application containing two independent claims, Claims 1 and 2, directed to methods of forming an integrated circuit device. The applicant conceived the methods in Jacksonville, Florida on June 10, 1997. Commencing on June 10, 1997, the applicant exercised due diligence until she reduced the methods to practice on February 27, 1998. In an Office action dated August 18, 1999, the examiner rejected Claim 1 as being anticipated by Doppler under 35 U.S.C. § 102(b). Doppler is a French patent that was filed on July 18, 1996, and issued on January 13, 1998. The Doppler patent claims the method of the applicant's Claim 1 for forming integrated circuit devices. Claim 2 was rejected as being anticipated by Spot under 35 U.S.C. § 102(e). Spot is a U.S. patent that was filed on January 7, 1998, and discloses, but does not claim, the method of applicant's Claim 2 for forming an integrated circuit device. The Spot patent issued on May 5, 1999. Which of the following would be the most proper course of action to take to respond to the rejections?

- (A) File an antedating affidavit to overcome the rejection of Claim 1 and cancel Claim 2.
- (B) File an antedating affidavit to overcome both the rejections and request that an interference be declared with the Doppler patent.
- (C) File an antedating affidavit to overcome the rejection of Claim 2 and cancel Claim 1.
- (D) File a reply arguing that the rejections are improper because the Spot patent issued after the filing date of your client's application.
- (E) File an antedating affidavit to overcome both rejections.

13. Able files a patent application in 1999 disclosing a barstool having a rectangular molded plastic seat portion supported by four adjacent vertical tubular steel legs connected to the underside of the seat portion. A set of four horizontal tubular steel support members connects adjacent tubular steel legs to brace the legs. The barstool further includes a plastic back member connected to the topside of the plastic seat portion. The application states that wood could be used in place of tubular steel for the legs and horizontal support members. No alternative to plastic is mentioned in the application for use in the seat portion, but it is well known in the art that plastic and wood are interchangeable. As originally filed, Baker's application included the following Claim 1:

- Claim 1. A barstool comprising:
- (i) a rectangular seat portion having four vertical edges, an underside and a topside;
 - (ii) means for supporting said seat portion such that said underside is substantially horizontal; and
 - (ii) a back member connected to one of the vertical edges of said seat portion, said back member being substantially perpendicular to the topside of said seat portion.

The Examiner rejects the claim under 35 U.S.C. § 102 as being anticipated by a 1997 publication by Baker showing a three-legged wooden barstool with a rectangular seat, a back and arms. The Examiner cites, but does not apply against Claim 1, a 1996 patent to Charlie that discloses a four-legged wooden barstool with a round wooden seat. The Charlie patent states that in barstools the use of plastic and/or tubular steel is equivalent to the use of wood. Able responds to the rejection by amending his claim to require that the seat portion be formed of plastic, and by arguing that Baker does not disclose the recited "supporting means" because Baker utilizes only three legs, which is less stable than four legs. The examiner finds a 1980 Wilson patent that structurally equates three legged barstools to four-legged barstools. Which of the following is in accordance with proper PTO practices and procedures?

- (A) The anticipation rejection is withdrawn only because Baker does not disclose a plastic seat portion. An obviousness rejection is then made based on Baker in view of Charlie since Charlie suggests replacing a wood seat with a plastic seat. Able's argument concerning the recited "supporting means" of Claim 1 does not provide a basis for overcoming the anticipation rejection.
- (B) The anticipation rejection should be withdrawn because Baker does not disclose a plastic seat portion and because Baker does not disclose a four legged supporting means. An obviousness rejection is then made based on Baker in view of Charlie because Charlie suggests modifying Baker to utilize a plastic seat and four legs.
- (C) The anticipation rejection is maintained because one of ordinary skill in the art would understand that a plastic seat could readily replace a wood seat. Furthermore, Able's argument that the "supporting means" of Claim 1 is not disclosed because Baker utilizes only three legs is unsupported by any limitation in the Claim.
- (D) The anticipation rejection is withdrawn because Baker does not disclose a plastic seat. However, a rejection is made under 35 USC §112, paragraph 1 as being

based upon an inadequate disclosure because the specification does not specify that the use of a plastic seat is critical to the invention.

- (E) (B) and (D).

14. A patent application filed in the PTO contains the following original claim:

Claim 1. A talbecloth for protecting the finish of a table comprising:
a layer of cotton;
a layer of vinyl affixed to the layer of cotton; and
a backing of felt.

Which of the following amendment(s) is/are not in accord with proper PTO amendment practices and procedures?

- (A) In claim 1, line 3, add -with an epoxy resin-.
- (B) In claim 1, line 2, after "cotton" add -woven to have 250 threads per inch-.
- (C) In claim 1, line 3, before "layer" add -thin-.
- (D) In claim 1, line 1, correct the spelling of "talbecloth" please.
- (E) All of the above.

15. You draft a patent application disclosing and describing an electrical chronometer containing a resistor having a resistance of 20-90 ohms, preferably 40 ohms. You draft the following independent claim:

1. An electrical chronometer comprising a resistor with a resistance of 20-90 ohms.

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

- (A) 2. The electrical chronometer of Claim 1 wherein the resistor has a resistance of 40 ohms.
- (B) 2. An electrical chronometer as in Claim 1 wherein the resistor has a resistance of 40-90 ohms.
- (C) 2. An electrical chronometer as in Claim 1 wherein the resistor has a resistance of about 20 - 90 ohms.
- (D) 2. The electrical chronometer of Claim 1 wherein the resistor has a resistance of between 50 and 90 ohms.
- (E) (C) and (D).

16. When does jurisdiction over an application normally transfer from the examining group to the Board of Patent Appeals and Interferences?

- (A) After the examiner has notified the appellant by written communication that the reply brief has been entered and considered, and that the application will be forwarded to the Board.
- (B) After a supplemental examiner's answer, pursuant to a remand from the Board, has been mailed.
- (C) After 2 months from the examiner's answer, plus mail room time, if no reply brief has been timely filed.
- (D) (A), (B), or (C).
- (E) (A) or (C).

17. A request for reexamination of U.S. Patent X,XXX,XXX (the 'XXX patent) was filed by ABC Technology, Inc. (ABC) on the ground that a substantial new question of patentability exists. In the first Office Action during reexamination, all the claims, i.e., claims 1 through 4, were rejected as unpatentable under 35 U.S.C. § 103 over U.S. Patent Z,ZZZ,ZZZ (the 'ZZZ patent). Claims 1 through 4 are all independent and original claims, and are the only claims that were presented during prosecution of the application that matured into 'XXX patent. All the claims are directed to a hydrocyclone separator apparatus. The apparatus is used for separating material, including fibers suspended in a liquid suspension, into a light fraction containing the fibers, and a heavy fraction containing rejects. Assuming no issues under 35 U.S.C. §§ 102, 103, or 112 are raised, which of the following claims, if any, would be properly subject to rejection under 35 U.S.C. § 305?

- (A) Claim 5. A hydrocyclone separator apparatus according to claim 4, wherein said blades are configured in the form of generally plane surfaces curved in one plane only.
- (B) Claim 5. A hydrocyclone separator apparatus according to claim 4, wherein the outlet duct is in the form of two frustro-conical portions joined at their narrow ends.
- (C) Claim 5. A method of separating material including fibers suspended in a liquid suspension comprising the steps of separating the material into a light fraction containing the fibers and a heavy fraction containing rejects, and converting the light fraction into a pulp and paper stock suspension.
- (D) Claim 5. A hydrocyclone separator apparatus according to claim 4, wherein the separator chamber is conical in shape having at the narrow end an outlet for the heavy fraction and at its wide end an outlet for the light fraction.
- (E) None of the above.

18. A patent application filed in the PTO contains the following dependent claim:
2. The method of Claim 1, further consisting of the step of cooling the mixture to a temperature of 32° F.

Following proper PTO practices and procedures, from which of the following claims does the dependent claim not properly depend?

- (A) 1. A method of making liquid compound A consisting of the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
 - (B) 1. A method of making liquid compound A comprising the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
 - (C) 1. A method of making liquid compound A including the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
 - (D) 1. A method of making liquid compound A characterized by the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
 - (E) (C) and (D).
19. If a claim has been properly rejected under 35 U.S.C. § 103 as being rendered obvious over a combination of prior art references, then in accordance with proper PTO practice and procedure:

- (A) it is not necessary that the prior art suggests the combination to achieve the same advantage or result discovered by the applicant, if the combination provides motivation to make the claimed invention.
- (B) the rationale to modify or combine the prior art must be found expressly set forth in the prior art.
- (C) in considering the disclosure of prior art it is proper to take into account the specific teachings of the reference. It is not proper to take into account the inferences that one skilled in the art could reasonably draw from the specific teachings.
- (D) it is improper for a patent examiner to take official notice of facts outside the record which are capable of instant and unquestionable demonstration as being “well known.”
- (E) it is proper to rely on equivalence in support of the rejection, the equivalence may be recognized in the prior art or in the applicant’s disclosure.

20. An application is directed to novel and unobvious scissors for cutting hair having a pair of cutter blades and a pointer loop. The application includes the following partial independent Claim 1 and dependent Claims 2-5.

- Claim 1. An apparatus for cutting hair, said apparatus comprising:
- (i) a first cutting member having a first cutting edge at one end and the other end of said first cutting member terminating in a thumb loop;
 - (ii) a second cutting member having a second cutting edge at one end and the other end terminating in a finger loop having an arcuate finger brace extending therefrom;
 - (iii) _____
 - (iv) said second cutting member additionally including a pointer loop between said finger loop and said mid-point, said finger loop having a finger loop center such that a plane through said finger loop center and said pointer loop center is generally parallel to said second cutting edge in order for the apparatus for cutting hair to be generally balanced when held by a user.
- Claim 2. The apparatus of claim 1, wherein said first cutting member includes a threaded aperture extending entirely therethrough between said thumb loop and said mid-point, and an adjusting screw that extends through said threaded aperture to engage a bearing surface below the pointer loop on said second cutting member.
- Claim 3. The apparatus of claim 2, wherein said connector is a rivet.

Without regard to prior art, and in view of partial Claim 1, which of the following best completes missing paragraph (iii) of Claim 1 while maintaining the broadest scope of protection and complying with proper PTO practice and procedure?

- (A) “said first cutting member having a mid-point between its ends and said second cutting member having a mid-point between its ends, and said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points by a connector; and”
- (B) “wherein said first cutting member and said second cutting member are formed entirely of metal and are pivotally secured to each other at respective mid-points; and”
- (C) “said first cutting member including a reservoir for dispensing disinfectant solution and having a mid-point between its ends; and”
- (D) “and said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points; and”
- (E) “said first cutting member and said second cutting member being pivotally secured to each other by a connector; and”

21. Which of the following would be a proper rejection in a reexamination proceeding?

- (A) A rejection under 35 U.S.C. § 102(a) based on an affidavit that the invention was known or used by others before the invention thereof by the applicant for patent.
- (B) A rejection under 35 U.S.C. § 102(b) based on an affidavit that the invention was in the public use in this country more than one year prior to the date of the application for a patent in the United States.
- (C) A rejection under 35 U.S.C. § 102(e) that the invention was described in a patent by another filed in the United States before the invention thereof by the patent applicant.
- (D) A rejection under 35 U.S.C. § 102(f) that the applicant did not himself invent the subject matter sought to be patented.
- (E) A rejection under 35 U.S.C. § 102(b) that the invention was on sale in this country, more than one year prior to the date of the application for patent in the United States.

22. Patentee P wishes to amend Claim 1 in the patent granted to P, and obtain the following amended Claim 1 either through reexamination or reissue:

- 1. A ball valve comprising:
 - i) a housing;
 - ii) a valve [member] ball rotatably joined in the housing;
 - iii) a [flanged] seal engagable with surfaces of the [member] ball; and
 - iv) a linear spring [means] interposed between the housing and the seal and biasing the seal into engagement with the [member] ball.

The amended claim is supported by the original disclosure in the application, which matured into P's patent. In the absence of questions of recapture, novelty, obviousness, and utility which of the following statements is/are true?

- (A) A claim so amended is properly presented in a reissue application filed on October 14, 1999, and a reissue patent is grantable where reissuance is sought of a patent granted on September 9, 1997.
- (B) A claim so amended is properly presented in a reissue application filed on September 9, 1999, and a reissue patent is grantable where reissuance is sought of a patent granted on October 7, 1997.
- (C) A claim so amended is properly presented in a request for reexamination filed on October 14, 1999, and a certificate of reexamination is grantable where reexamination is sought of a patent granted on September 9, 1997.
- (D) A claim so amended is properly presented in a request for reexamination filed on September 9, 1999, and a certificate of reexamination is grantable where reexamination is sought of a patent granted on October 7, 1997.
- (E) (B) and (D).

23 and 24. Answer Questions 23 and 24 based on the following facts.

Your client, Homer, invented a new system for laying underground pipes for in-ground sprinkler systems utilizing a tunneling tool he calls “the Mole.” The Mole is placed in a small hole is dug in the ground at a starting location. A target is placed in the ground at the desired ending location. The Mole automatically tunnels through the ground to the target. The Mole has a clamp to pull flexible pipe behind it as it tunnels. A high-pressure air source is connected to the Mole to remove dirt as the Mole progresses toward the target. Homer informs you that he has continuously used this original system for three years in his commercial landscaping business, displayed the system to his numerous customers, and handsomely profited from his original system. In the original system, the Mole sensed and moved toward the target emitting electromagnetic signals. Recently, the Mole sometimes gets confused due to interference from ferromagnetic underground pipes and overhead power lines. Two months ago Homer modified the system to utilize ultrasonic signals emitted from the target. The ultrasonic signals are encoded with location information derived by the target from a Global Positioning System (GPS) satellite. The modified system decodes the location information and tunnels toward the specified location. The use of ultrasonic signals in the modified system is new and unobvious. Homer has reduced the modified system to actual practice, and kept it confidential. Homer prepared a draft patent application fully describing both the original system and the modified system. He wants you to review the draft application, make sure it meets all requirements, and revise it as necessary prior to filing. The draft application prepared by Homer includes the following draft claims:

- Claim 1. A system for laying underground flexible pipe in the ground, said system comprising:
 - (i) a target placed in the ground at a target location and including a transmitter which emits target signals;
 - (ii) a tunneling device including a clamp operable to connect one end of said flexible pipe to said tunneling device, said tunneling device further including a sensor which detects said target signals and steers said tunneling device to move toward said target; and
 - (iii) a source of high pressure air connected with said tunneling device for removing dirt as said tunneling device moves toward said target.
- Claim 2. The system of claim 1, wherein said transmitter emits electromagnetic signals.
- Claim 3. The system of claim 1, wherein said transmitter emits ultrasonic signals.
- Claim 4. The system of claim 3, wherein said ultrasonic signals include encoded position information that is decoded by the decoder portion of said tunneling device sensor.
- Claim 5. The system of claim 1, wherein said transmitter emits signals having encoded position information.

23. Which of the following would not be reasonable advice to Homer?
- (A) Claim 5 is not indefinite even though it is not limited to ultrasonic target signals and the only disclosed embodiment that utilizes encoded position information utilizes ultrasonic target signals.
 - (B) Claim 1, as presently written, is statutorily barred, and the claimed invention should be limited to the modified system.
 - (C) Because the original system had a drawback in that it sometimes got confused by ferromagnetic underground pipes or power lines, and because Homer continued to develop the system to overcome these drawbacks, the original system was experimental and does not constitute prior art against the modified system.
 - (D) Claim 4 is indefinite.
 - (E) The language in Claim 1 reciting the “target” should be reworded to clarify that the ground is not part of the claimed combination, *e.g.*, by adding the words “adapted to be” before “placed”.
24. Claims 1 and 2 are unpatentable under which of the following statutory provisions?
- (A) 35 U.S.C. § 102(b).
 - (B) 35 U.S.C. § 102(c).
 - (C) 35 U.S.C. § 102(d).
 - (D) 35 U.S.C. § 102(e).
 - (E) None of the above.
25. Which of the following is not a PTO recommendation or requirement?
- (A) Claims should be arranged in order of scope so that the first claim presented is the least restrictive.
 - (B) Product and process claims should be separately grouped.
 - (C) Every application should contain no more than three dependent claims.
 - (D) A claim which depends from a dependent claim should not be separated from that dependent claim by any claim which does not also depend from the dependent claim.
 - (E) Each claim should start with a capital letter and end with a period.

26. A patent was granted to inventor Munch on August 3, 1999, on a patent application filed in the PTO on March 5, 1997. In which of the following circumstances in a reexamination proceeding of the Munch patent, considered independently of each other, will the cited prior art reference(s) properly support a determination that there is substantial new question of patentability?

- (A) In a reexamination proceeding, claims 7-15 in the Munch patent are rejected as being anticipated under 35 U.S.C. § 102(a) by the disclosure in the Leal patent. The Leal patent was granted on January 21, 1997. It is the only rejection in the reexamination proceeding. During the original prosecution of the Munch application, the Leal patent was used by the examiner as prior art to reject original claims 1-5 as being anticipated under 35 U.S.C. § 102(a).
- (B) In a reexamination proceeding, newly added claims 16-20 in the Munch patent are rejected as being anticipated under 35 U.S.C. § 102(b) by the disclosure in the Zellot patent. The Zellot patent was granted in 1987. It is the only rejection in the reexamination proceeding. During the original prosecution of the Munch application the examiner cited the Zellot patent against claims 1-7 in the patent application Munch filed on March 5, 1997.
- (C) In a reexamination proceeding, claims 1-15 in the Munch patent are rejected as being obvious under 35 U.S.C. § 103 over the Wills patent in view of the Note patent. The Wills patent was granted on December 3, 1996, and the Note patent was granted in 1994. It is the only rejection in the reexamination proceeding. During the original prosecution of the Munch application the examiner used the Wills patent as prior art to reject original claims 1 and 2 in the Munch application. The Note patent was never before the examiner during the original prosecution of the Munch application, is not cumulative with the prior art cited during the original prosecution, and is material to the question of obviousness.
- (D) In a reexamination proceeding, claims 1-15 in the Munch patent are rejected as being anticipated under 35 U.S.C. § 102(a) by the disclosure in the Richards patent. The Richards patent was granted on January 14, 1997. It is the only rejection in the reexamination proceeding. During the original prosecution of the Munch application, the examiner used the Richards patent in combination with a patent to Smith, granted in 1923, to reject original claims 1-5 in the application as being obvious under 35 U.S.C. § 103.
- (E) All of the above.

27. Which of the following statements explains why Claim 1 below does recite subject matter eligible for protection under the Patent Statute?

Claim 1. A top soil for retaining water comprising:
about 10% of material X;
about 60% of material Y; and
balance of material Z.

- (A) The subject matter is eligible if the top soil occurs in nature, and M was the first to find the topsoil on a remote tropical island.
- (B) The subject matter is eligible if M developed the top soil through extensive research and experimentation with various materials, including materials X, Y, and Z.
- (C) The subject matter is eligible because all inanimate objects are subject matter eligible for protection under the patent statute.
- (D) The subject matter is eligible because the claim is sufficiently broadly written as not to exclude the inclusion of a living organism.
- (E) (A) and (B).

28. A patent application filed in the PTO contains the following three claims, including product by process Claim 3:

Claim 1. A method for making an Ethernet cable comprising the steps of A, B and C.
Claim 2. The method of claim 1, further characterized by the step of D.
Claim 3. The Ethernet cable as in any one of the preceding claims.

In the first Office action, the examiner objects to Claim 3 as being an improper dependent claim and requires cancellation of the claim. Following proper PTO practices and procedures, which of the following replies best overcomes the examiner's objection and provides the client with the broadest patent protection?

- (A) Amend Claim 3 to read: "The Ethernet cable as made by the process set forth in claims 1-2."
- (B) Cancel Claim 3.
- (C) Add Claim 4, which reads: "An Ethernet cable made by a process comprising the steps of A, B and C."
- (D) Add Claim 5, which reads: "An Ethernet cable made by a process comprising the steps of A, B, C and D."
- (E) (B), (C), and (D).

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

- (A) Unlike questions of public use, there is no requirement that “on sale” activity be “public.”
- (B) Sales to toy stores throughout the United States of a claimed rocking horse by an independent third party more than one year before the filing date of applicant’s patent application without the applicant’s consent will not bar applicant from obtaining a patent for the rocking horse.
- (C) An offer for sale of a claimed invention, where the offer originates in the United States and is communicated to a potential buyer in Europe, more than one year before the filing date of applicant’s patent application, cannot be sufficient activity to bar applicant from obtaining a patent for the invention.
- (D) Delay alone in filing a patent application is sufficient to infer any required intent by the inventor to abandon the invention.
- (E) “Patented” in 35 U.S.C. § 102(e) includes the publication of German applications as printed documents called Offenlegungsschrift.

30. On September 14, 1999, you filed a patent application in the PTO on behalf of a large corporation together with an authorization to charge the filing fee to your deposit account. However, due to unforeseen circumstances, measures were not taken to cover the \$760.00 filing fee against the amount in your deposit account, which has a \$10.00 balance. Consequently, you received a notice from the PTO dated September 28, 1999, that your deposit account has insufficient funds. Which of the following steps avoids abandonment of the recently filed application?

- (A) On September 29, 1999, replenish the deposit account with \$800.00 in cash to encompass the filing fee, and the \$10 fee required by 37 CFR § 1.21(b)(1).
- (B) On September 29, 1999, open a new deposit account with \$800.00 in cash, and file in the PTO correspondence authorizing the fee for filing the application be charged against your new deposit account.
- (C) On September 29, 1999, file in the PTO a check for \$760.00 for the filing fee, and file in the PTO correspondence authorizing the balance of the filing fee be paid from your deposit account.
- (D) On September 29, 1999, replenish the deposit account with \$890.00 in cash to cover the filing fee, and a surcharge fee for late payment of the filing fee, and file in the PTO correspondence authorizing the fees for the application be charged to your deposit account.
- (E) (B) or (C).

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

Claim No.

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

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

- (A) 10
- (B) 13
- (C) 11
- (D) 12
- (E) 8

32. On August 23, 1999, you file a patent application in the PTO. Along with the application, you file an unexecuted declaration that refers to the application and a preliminary amendment that describes the best mode of carrying out the claimed invention. Subsequently, you file a signed declaration in reply to a Notice to File Missing Parts. The best mode is described only in the preliminary amendment. In the first Office action, the examiner objects to the preliminary amendment as adding new matter to the specification and requires cancellation of the new matter. Considering the following responses and the additional facts separately, the best way to respond to and overcome the objection, and obtain a patent is to:

- (A) file a reply pointing out that the objection is improper because the declaration filed in reply to the Notice to File Missing Parts is a properly executed declaration that refers only to the amendment.
- (B) file a reply pointing out that the objection is improper because the declaration filed in reply to the Notice to File Missing Parts is a properly executed declaration that refers only to the application and amendment.
- (C) file a reply pointing out that the objection is improper because the declaration filed in reply to the Notice to File Missing Parts is a properly executed supplemental declaration that refers only to the amendment.
- (D) file an appeal to the Board of Patent Appeals and Interference requesting review of the examiner's objection to the amendment as adding new matter.
- (E) file a reply to the Office action canceling the new matter.

33. During a reexamination proceeding, you submit the following amendment less than two years from the date that a patent was granted with the claim:

1. (once amended) An application specific integrated circuit for calculating a correlation coefficient, comprising: a multiplication unit [having a plurality of sixty-four bit shift registers]; an integration unit coupled to said multiplication unit; and a digital filter unit coupled to said integration unit and to said multiplication unit.

The original disclosure in the patent application stated that a plurality of thirty-two bit shift registers could be used to form the multiplication unit. In accordance with PTO rules and procedure, which, if any, of the following statements, including any reasons given in support thereof, concerning the amendment is true?

- (A) The form of the amendment is improper, since underlining and brackets are not proper in proceedings where only issues concerning substantial new questions of patentability may be raised.
- (B) The claim as amended should be allowed if it overcomes the art of record in the application since the amendment was made less than two years from the date that a patent was granted.
- (C) The claim as amended should be allowed if it overcomes the art of record in the application since the amendment, although broader in some respects than the claim of the patent, is narrower in other respects.
- (D) The claim as amended should not be allowed since it broadens the scope of the claim of the patent.
- (E) None of the above.

34. If a claim has been properly rejected under 35 U.S.C. § 103 as being rendered *prima facie* obvious over a combination of prior art references, then the rejection can be rebutted in accordance with proper PTO practice and procedure by:

- (A) showing the criticality of the claimed range where the range in the claim overlaps the range disclosed in one or both prior art references.
- (B) arguing that the client has recognized latent properties in the prior art which were not recognized by the prior art references.
- (C) arguing that a combination would not be made by a businessman for economic reasons.
- (D) contending that each of the prior art references, taken individually, does not teach or render obvious the claimed invention.
- (E) (A), (B), and (C).

35. Morris, a registered practitioner with a solo practice he operates out of his house, obtained a plant patent for a client on a commercial catnip hybrid. One morning, over four years later, as he was sorting through his cat's toys, he came across a letter from his client indicating the client's belief that a maintenance fee was due four years after issuance. By the time Morris found the letter, it was eight months after the four year anniversary of the plant patent's issuance. Morris should immediately:

- (A) Tender the maintenance fee and submit a petition (with the required fee) for acceptance of payment where the delay was unintentional.
- (B) Pay the maintenance fee plus the surcharge for filing a maintenance fee during the grace period.
- (C) Write the client that no maintenance fee is in fact owed, and apologize for the delay in responding to the client.
- (D) Do nothing because the patent is irrevocably lost due to failure to pay the maintenance fee within the grace period.
- (E) Tender the maintenance fee and submit a petition (with an affidavit blaming the cat and with the required fee) for acceptance of payment where the delay was unavoidable.

36. Following proper PTO practices and procedures, which of the following reference(s) anticipates Claim 1:

- 1. A composition consisting of:
 - 60-80% cellulose;
 - 16-18% nylon;
 - up to 0.5% fiber; and
 - at least 6% cotton;said composition being capable of absorbing water in the amount of not more than 45% by weight of the composition.
- (A) A reference disclosing a sponge having 69% cellulose, 16% nylon, 0.4% fiber, 7% cotton, and 7.6% silk.
- (B) A reference disclosing a sponge having 78% cellulose, 17% nylon, 0.2% fiber, 4.8% cotton, and a water content of 30% by weight.
- (C) A reference disclosing a sponge having 76% cellulose, 16% nylon, 8% cotton and containing no water.
- (D) A reference disclosing a sponge having 61% cellulose, 18% nylon, 0.6% fiber, 20.4% cotton, and a water content of 45% by weight.
- (E) (B) and (D).

37. A patent application includes the following partial Claim 1:

- Claim 1. A shaving implement comprising
- (i) _____
 - (ii) a shaving head including a razor, said shaving head being connected to said handle at said first end;
 - (iii) a collapsible tube of shaving cream positioned in and substantially filling said chamber, said tube including a neck having a dispensing opening;
 - (iv) a tube squeezing slide positioned within said channel and said chamber, said slide including opposed slots thereon, said slots being in sliding engagement with said longitudinal sides of said channel; and
 - (v) a tube closure connected to said neck of said collapsible tube.

Which of the following, if included as paragraph (i) of Claim 1, best completes the claim while giving the client the broadest protection?

- (A) a substantially rigid handle including a chamber and a channel formed in said handle, said channel being defined by longitudinal sides within said handle;
- (B) a substantially rigid handle having a first end, said handle including a chamber and a channel formed in said handle, said channel being defined by longitudinal sides within said handle;
- (C) a substantially rigid handle having a first end, said handle including a chamber and an elongated channel formed in said handle;
- (D) a substantially rigid handle having a first end, said handle including a chamber and a channel formed in said handle;
- (E) a substantially rigid handle having a first end, said handle including a channel formed in said handle, said channel being defined by longitudinal sides within said handle;

38. Which of the following must be included in a petition for a retroactive license to file a patent application in a foreign country?

- (A) A verified statement containing an averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order.
- (B) A verified explanation of why the material was filed abroad through error and without deceptive intent without the required license first having been obtained.
- (C) A listing of each of the foreign countries in which the unlicensed patent application was filed.
- (D) (A) and (B).
- (E) (A), (B) and (C).

39. Applicant filed a patent application claiming a polyol. The application discloses that the claimed polyol is used to form rigid polyurethane foam having a structural formula. The examiner properly rejected the claimed polyol as unpatentable over prior art disclosing the claimed polyol and its use to form rigid polyurethane foam having the same structural formula. Given the fact that applicant's specification discloses that the polyol may be produced by a process comprising steps A, B, C, and D, and the process is novel and unobvious, which of the following claims, if introduced by amendment, would overcome the rejection?

- (A) A polyol having the property of forming rigid polyurethane foam having structural formula Z, the polyol being produced by the process comprising the steps A, B, C, and D.
- (B) A polyol produced by the process comprising the steps A, B, C, and D, said polyol having the property of forming rigid polyurethane foam having structural formula Z.
- (C) A polyol produced by the process comprising the steps A, B, C, and D.
- (D) A polyol comprising the resultant product of steps A, B, C, and D.
- (E) A polyol-producing process comprising steps A, B, C, and D, said process resulting in a polyol capable of forming rigid polyurethane foam having structural formula Z.

40. In the course of prosecuting a patent application before the PTO, you receive a non-final Office action allowing Claim 1, and rejecting Claims 2 through 6, the remaining claims in the case. Claim 1 reads as follows:

- 1. A ship propeller exhibiting excellent corrosion resistance, said ship propeller consisting essentially of a copper base alloy consisting of 2 to 10 percent tin, 0.1 to 0.9 percent zinc, and copper.

The specification of the application teaches that the copper base alloy made with the addition of 2 to 10 percent aluminum increases the alloy's wear resistance without detracting from its corrosion resistance. However, adding aluminum to the surface of the propeller does not increase wear resistance. Which of the following claims, if any, if added by amendment would accord with proper PTO practice and procedure?

- (A) 7. A copper base alloy according to Claim 1 wherein said alloy includes 2 to 10 percent aluminum.
- (B) 7. A ship propeller according to Claim 1 including the step of adding 2 to 10 percent aluminum to the copper base alloy.
- (C) 7. A ship propeller according to Claim 1 including 2 to 10 percent aluminum.
- (D) 7. A ship propeller according to Claim 1 wherein said alloy includes 2 to 10 percent aluminum.
- (E) None of the above.

41. A claim limitation reads “a pH range between 7 and 12, preferably between 9 and 10.” Which of the following is correct?

- (A) Since the limitation properly sets forth outer limits, it is definite.
- (B) As long as the limitation is supported in the written description, it is proper.
- (C) The limitation is indefinite.
- (D) Since the limitation sets forth a preferred range, it is definite.
- (E) An applicant is precluded from expanding the claim coverage beyond a pH range of 7-12 under the doctrine of equivalents.

42. Patent practitioner Wally is hired to prepare a patent application directed to a method of making a particular composition. After consulting with his client, Wally believes that schematic drawings would be helpful, and that color drawings would be most helpful in disclosing the method. Wally diligently contacts a draftsman to prepare the color drawings and proceeds to complete his draft patent application. The application contains only method claims. Upon completing the application, Wally forwards the draft application to his client for review. The application contains method claims, and does not include any reference to drawing figures. Before the color drawings are complete, Wally receives an urgent call from his client directing Wally to file the application by the close of business that day due to an unforeseen statutory bar date. Drawings are not required to understand the claimed method. A patent would be barred if the application is filed the following day. Which of the following combination of acts presents the **minimum** course of action to be taken by Wally in order to obtain a filing date that avoids the statutory bar?

- (A) File the application, oath and filing fee by the close of business without the drawings.
- (B) File the application by the close of business without the oath, filing fee or drawings.
- (C) File the application and filing fee without the drawings and later file a petition for accepting the color drawings along with the petition fee; three (3) sets of color drawings; and a proposed amendment to insert the following in the specification: “The file of this patent contains at least one drawing executed in color. Copies of this patent with color drawing(s) will be provided by the Patent and Trademark Office upon request and payment of the necessary fee.”
- (D) File the application without the drawings by the close of business; file a preliminary amendment the next day that amends the specification to refer to drawing figures and which includes a set of black and white drawings.
- (E) None of the above.

43. You received an Office action dated March 17, 1999, rejecting the claims of a pending patent application filed April 22, 1998. You prepared a timely reply that would overcome the examiner's rejections and place the application in condition for allowance. You put the reply in a correctly addressed envelope, with a metered mail stamp having a date of June 4, 1999. Your procedure is to give all outgoing mail to your staff assistant who keeps it locked in his desk drawer until he can mail it at the end of his work day. The reply fell inside the desk, behind the drawer, and was never mailed. Today, November 3, 1999, you receive a Notice of Abandonment of the patent application for which the reply was prepared. You searched and found the unopened and unmailed envelope. You know that the applicant, your mother, sold five items covered by all the claims of the now abandoned application over a year ago (but not before the original application was filed) and that her commercial survival depends on obtaining the claims in the abandoned application. A valid patent, including the claims in the abandoned application, can be obtained for your mother, if:

- (A) you submit a new reply to the patent examiner arguing the commercial success of the item as shown by the sales of the five items sold over a year ago with affidavits under 37 CFR § 1.132 traversing the holding of abandonment.
- (B) you mail the reply today in its original, sealed envelope which takes precedence over the Notice of Abandonment since the date stamped on the envelope is both before the due date for reply and before the Notice of Abandonment.
- (C) the applicant files a petition to revive an unintentionally abandoned application stating that the entire delay in filing the required reply was unintentional, files the reply that was prepared by you in June 1999, and submits the appropriate petition fee.
- (D) you provide the unopened envelope as evidence of the staff assistant's negligence and petition the Group Director to reopen prosecution of the application on the merits.
- (E) you file a petition to revive an unavoidably abandoned application stating that the entire delay in filing the reply was unavoidable, submitting the required reply prepared by you in June 1999, the proper petition fee, and a terminal disclaimer and fee dedicating to the public a terminal part of the term of any patent granted equivalent to the period of abandonment of the application.

44. A practitioner should consider whether information presented during prosecution of an application may be used by the examiner as evidence against the applicant. What evidence may an examiner not use to demonstrate that a claim fails to correspond in scope with that which an applicant regards as his or her invention?

- (A) Arguments, containing admissions, advanced in a reply filed by the practitioner representing the applicant.
- (B) Admissions contained in a brief.
- (C) The lack of agreement between the claims and the specification.
- (D) Affidavits, containing admissions, filed under 37 CFR § 1.132.
- (E) All of the above.

45. Which of the following statements regarding a reissue patent application is *true*?

- (A) Only one reissue patent application is permitted to be issued for distinct and separate parts of the thing patented.
- (B) New matter may be properly added in a reissue application to correct an error made during the prosecution of the original patent application.
- (C) A reissue will not be granted to “recapture” claimed subject matter deliberately canceled in an application to obtain a patent.
- (D) To retain the benefit of priority under 35 U.S.C. § 119, it is not necessary to make a new claim for priority in the reissue patent application if a claim for priority was perfected in the application on which the original patent was made.
- (E) (C) and (D).

46. You filed a patent application for Sam, who invented an apparatus for labeling and identifying baseballs. In the application, the apparatus is described as including means for marking baseballs; an ultraviolet light source; and a computer coupled to both the means for marking baseballs and the ultraviolet light source. The only means for marking baseballs set forth in the application was a commercially available invisible ink stamper, also known as a marker. The specification described the invention as being useful for identifying home run baseballs. The application was filed with one claim, which stated:

Claim 1. An apparatus, comprising: an invisible ink stamper; an ultraviolet light source; and a computer coupled to said invisible ink stamper and to said ultraviolet light source.

Claim 1 was properly rejected under 35 U.S.C. §102(b) as being anticipated by a patent issued to McGoo, which disclosed an apparatus having only an invisible ink stamper, an ultraviolet light source, and a computer coupled to the invisible ink stamper and to the ultraviolet light source. The McGoo patent did not mention identifying baseballs, but described the invention as useful for labeling and identifying baseball bats. Which of the following amendments, if any, avoids anticipation of Claim 1 by the McGoo patent?

- (A) 1. (amended once) An apparatus intended to be used to identify home run baseballs, comprising: an invisible ink stamper; an ultraviolet light source; and a computer coupled to said invisible ink stamper and to said ultraviolet light source.
- (B) 1. (amended once) An apparatus, [comprising] consisting of: an invisible ink stamper, an ultraviolet light source, and a computer coupled to said invisible ink stamper and to said ultraviolet light source.
- (C) 1. (amended once) An apparatus, comprising: [an invisible ink stamper] a marker; an ultraviolet light source, and a computer coupled to said means for marking baseballs and to said ultraviolet light source.
- (D) (B) and (C).
- (E) None of the above.

47. A patent application includes the following Claim 1:

- Claim 1. A method of making an electrical device comprising the steps of:
- (i) heating a base made of carbon to a first temperature in the range of 1800°C to 2000°C;
 - (ii) passing a first gas over said heated base, said first gas comprising a mixture of hydrogen, SiCl₄, phosphorus, and methane, whereby said first gas decomposes over said heated base and thereby forms a first deposited layer of silicon, phosphorus and carbon on said heated base;
 - (iii) heating said base having said deposited layer to a second temperature of approximately 1620°C; and
 - (iv) passing a second gas over said base heated to said second temperature, said second gas consisting of a mixture of hydrogen, SiCl₄, AlCl₃, and methane, whereby said second gas decomposes over said heated base to form a second deposit layer adjacent said first layer, said second layer comprising silicon, aluminum and carbon.

Assuming proper support in the specification, which of the following claims, if presented in the same application, is a proper claim?

- (A) Claim 2. The method of claim 1, wherein said first temperature is in the range of 1875°C to 1925°C, and preferably between 1895°C and 1905°C.
- (B) Claim 3. The electrical device of claim 1, wherein said first gas further comprises an inert gas such as Argon.
- (C) Claim 4. The method of claim 1, wherein said second gas further consists of Argon.
- (D) Claim 5. The method of claim 1, wherein said first gas further comprises an inert gas such as Argon.
- (E) Claim 6. The electrical device of claim 1, wherein said heated base has a first layer comprising silicon, phosphorus, and carbon.

48. An original claim in a patent application to a mechanical arts invention recites the limitation of “a clip,” which is shown in an original application drawing as being one of several elements of the invention. The “clip” is well known in the mechanical arts. However, “a clip” does not appear in the original written description part of the application. Which of the following is correct?

- (A) The written description may not be properly amended to include “a clip”
- (B) The claim is indefinite with respect to “a clip.”
- (C) The application lacks an enabling disclosure as to “a clip.”
- (D) The claim is definite with respect to “a clip.”
- (E) The application fails to set forth the best mode for “a clip.”

49. A nonprovisional patent application has been filed for inventor Alton disclosing and claiming an alumino-silicate catalyst for oxidizing organic compounds. Which of the following statements, considered separately, about the best mode contemplated by Alton for the alumino-silicate catalyst is not true?

- (A) The best mode must be designated as the best mode in the application if the application contains several embodiments, one of which is the best mode.
- (B) The presence of one specific example in the specification is evidence that the best mode has been disclosed.
- (C) The best mode need not be updated if, between the time of filing the non-provisional patent application and a continuation application, Alton discovered a better catalyst than the best mode disclosed in the non-provisional application.
- (D) A failure to disclose the best mode in the application as filed cannot be cured by first introducing into the application by amendment a specific mode of practicing the invention.
- (E) There is no statutory requirement for the best mode being disclosed in the specification as a specific example.

50. You are drafting a patent application disclosing and describing a door assembly wherein a door, a door frame, and a pair of hinges are separate elements which must be included in a claim to the assembled combination of a door secured to a door frame by a pair of hinges. The application discloses that it is essential to the invention that the door is secured to the doorframe in the described manner to permit the door to be readily opened and closed. The application further discloses that it is also essential to the invention for the assembly, in a closed relationship, to keep out exterior elements, while providing privacy and permitting quick egress in an emergency. Which of the following claims properly sets forth the combination?

- (A) An assembly having a door capable of being hingedly connected to a doorframe.
- (B) An assembly having a door and means for securing the door.
- (C) An assembly having a door and a pair of hinges for securing the door.
- (D) An assembly having a door, and a doorframe, said door being secured to said doorframe with a pair of hinges.
- (E) An assembly having a door adapted to be secured to a doorframe with a pair of hinges.

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