

# Patent Bar Exam Prep Workbook

Patent Education Series™

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**INTELLECTUAL PROPERTIES ENTERPRISES, INC**

Patent Bar Exam Prep Workbook  
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## **A few words about this book**

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The Patent Bar Exam Prep Workbook is a study aid for those preparing to take the patent bar examination. This exam covers topics found in the Manual of Patent Examination Procedure (MPEP) 8<sup>th</sup> Edition, Revision 4. The Workbook was designed to serve as a stepping stone between the material presented in the MPEP and the actual patent bar exams. You will gain the most by mastering the material covered in the MPEP first and then attempting the Prep Workbook.

In addition to the Prep Workbook, Intellectual Properties Enterprises, Inc offers a complete line of products to help you prepare for the exam. The Guidebook is considered the cornerstone of the Patent Education Series™. It is a consolidated version of the MPEP and is a beneficial resource to anyone desiring to pass the patent bar exam. You will find more information explaining the Patent Education Series™ at our website:

[www.PatentEducationSeries.com](http://www.PatentEducationSeries.com)

The Patent Bar Exam Prep Workbook will be beneficial to you in two ways. First, it will help you learn the subject matter sure to be on the test. Second, you will become exceedingly familiar with the location of the topics, enabling you to look up your answers quickly. Both skills are essential to achieving a passing score on the patent bar. The questions in the Prep Workbook are painstakingly detail oriented, but that is just what you need to prepare for the patent bar exam.

**Contact info for IP Enterprises:**

<b>Url:</b>	<b><a href="http://www.patenteducationseries.com">www.patenteducationseries.com</a></b>
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Hello,

Thank-you for purchasing the Patent Bar Exam Prep Workbook. I hope you will find it a useful tool.

I am committed to the success of individuals interested in patent law through the affordability and quality of my materials. Therefore, I am interested in any feedback or improvements you may have for the Patent Education Series™. Any suggestions for new study aids that would make preparation for the patent bar exam easier and more productive are appreciated. And welcome to this exciting career field!

Sincerely,

Lisa A. Parmley - President

August 2007

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## General Information

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- Patent Attorney:* An individual with a technical background in science or engineering who is classified as an attorney, has passed the patent bar exam and is licensed to practice law. A patent attorney may practice law before the USPTO, including all aspects of the patent prosecution process. In addition, they may aid in litigation proceedings such as infringement cases over patented inventions.
- Patent Agent:* An individual with a technical background as a scientist or an engineer who has passed the patent bar exam. Patent agents may practice law before the USPTO which includes all aspects of the patent prosecution process.
- Patent Practitioner:* An individual who has passed the patent bar exam and is registered to practice patent law before the USPTO. They may be either an agent or an attorney.

*Who can take the exam?*

You do not need to be a lawyer in order to qualify to sit for the patent bar exam. You do not even need to be a lawyer in order to begin a career in the field of Intellectual Property for that matter. In order to be considered eligible to sit for the patent bar exam, you should have at least a bachelor's degree in one of the required fields of science or engineering. An individual with a law degree, but without any education or training in science or engineering will not be eligible to take the patent bar exam.

Check out the official PTO website at:

[www.uspto.gov/web/offices/dcom/gcounsel/oed.htm](http://www.uspto.gov/web/offices/dcom/gcounsel/oed.htm) - for further information regarding the specific requirements.

**Tables of degrees for patent bar exam:**

<b>Engineering:</b>
• agricultural
• agricultural
• biomedical
• ceramic
• chemical
• civil
• computer
• electrical
• electrochemical
• engineering physics
• geological
• industrial
• mechanical
• metallurgical
• mining
• nuclear
• petroleum

<b>Science:</b>
• biology
• biochemistry
• botany
• general chemistry
• microbiology
• molecular biology
• chemistry
• pharmacology
• physics
<b>Computer Science*</b>
<b>Technology:</b>
• electronics
• food
• marine
• textile

*\*must be from an accredited program*

If you do not have one of the exact degrees found in the table, don't fret just yet. You may substitute coursework, training or experience in the appropriate field in lieu of the required degree. If you believe you meet the requirements to take the patent bar exam, apply by downloading the current PTO admissions bulletin. After you have located and signed all the required paperwork, you will have to pay the fee, and send everything in. It will take the PTO several weeks (possibly even months) to sort through your application.

If you don't have one of the specified science or engineering degrees, you will need to submit official transcripts listing every college level course you have ever taken (copies will



not suffice, you need the originals). In addition, the PTO requires that you send in a copy of the appropriate catalog cover along with the pages describing the particular courses you took. If you are substituting training, certifications or work experience in lieu of education, you will need to send in official forms and/or work contracts. Of course, the PTO will take their time scrutinizing all of this. Be prepared that it may take them a little longer to sort through your application if you fit under this category.

In addition to the technical requirements, the PTO expects you to establish "good moral character and repute". You must sign an oath agreeing to abide by this character requirement.

*What is the process for becoming a patent practitioner?*

First of all, don't expect this to happen overnight. Becoming a patent practitioner is far from an instantaneous process. As indicated by the timeline below, the process is actually a little painful and lengthy. The patent bar exam itself is the painful part. The fact is, it is a difficult test.

**The following is a brief timeline describing the events that must transpire and the approximate length of time it takes to become a registered patent practitioner:**

• <b>Study time</b>	• <i>Variable (3-6+ months)</i>
• <b>Apply for the test when ready</b>	• <i>About 2-8 weeks for acceptance</i>
<p><i>90-day window period will begin upon acceptance</i></p> <p><b>---Take the exam---</b>  <i>(must be accomplished within 90-day window period)</i></p>	
• <b>Receive your test results</b>	• <i>Should be immediately with computer exams</i>
• <b>Official registration ☺</b> <i>(must send in a form with a registration fee \$100)</i>	• <i>About 3 months</i>

*When are the tests offered?*

Now that the patent bar exam is administered via computer, you will be able to schedule your own test date. That means you can study for the exam, and then apply to take it. We suggest that you do not wait until you are accepted to begin studying. Remember, you will

have to take the exam within the 90-day window period and that period will begin as soon as you are accepted. If you wait to prepare until you have been accepted, you may find yourself not quite ready for the exam even at the end of the 90-days. We suggest that you first learn the fundamentals of Patent Law with our online course and then begin learning the details with the Guidebook to Patent Law and this Prep Workbook. Once you've completed reading and working through the exercises in these two manuals, then apply for the exam. That way you will have plenty of time left to work through previous exam questions. It may even be possible for you to set-up the exam (depending on the availability of the exam at your location), take it and pass it all within days of receiving your official acceptance notice if you prepare yourself well before applying.

### *Where do I take the exam?*

Once you've been accepted to sit for the exam, the PTO will send you a letter explaining exactly what you need to do to schedule your exam date and where you will need to go to take it. They have outsourced Prometric to oversee the administration of the exam. Prometric is a reputable testing agency that administers computerized exams across the nation.

### *How do I prepare for the exam?*

The patent bar exam is fairly difficult, but it is far from impossible. Fortunately, the test is actually very predictable. It covers the same basic points from the Manual of Patent Examination Procedure (MPEP) each time. However, without knowing which points will be tested, the exam may become virtually unmanageable as the Patent and Trademark Office (PTO) always tests over incredibly minute details found within the thousands of pages of the MPEP.

The test consists of one-hundred multiple choice questions and spans an entire day. You can expect two-three hour sessions consisting of 50 questions each and you will need to answer a total of at least 70 questions correctly in order to pass. You will be able to access the USPTO's online MPEP, rules and laws, but nothing may be brought into the exam facility on the day of the exam.

The patent bar exam recycles many old questions, sometimes even word for word. Therefore, reviewing old exams is one of the best ways to prepare yourself. Our PTO Exam Simulator software includes 600 previously tested PTO exam questions. The software has many indispensable features to help get you ready for exam day.

One note; make sure you give yourself plenty of time to take old exams before going in to take the real test. The questions are tricky enough that **just learning the material usually won't get you a passing score**; you have to be familiar with the question style.

The test is considered open book since you will have access to an online MPEP, but this is a little misleading. You will not have time to look up very many of the answers. The PTO can ask any question within the realm of the MPEP. This encompasses thousands of pages worth of materials. In addition, a single question on the patent bar exam may cover several separate topics. A test taker without a good understanding of these topics might have to madly skim through several rules and laws to check that he or she put down the right response. When the PTO has a question relating to only a single topic, the question itself will take up nearly the entire page, requiring you to spend several minutes just reading through the Hemmingway-like story they have crafted in order to confuse you. The PTO is notorious for putting in material that is irrelevant to the answer just to hold up the unsuspecting test taker.

The best advice...go in as prepared as possible! The MPEP you will have access to the day of the exam will be very cumbersome for looking up answers. You just won't have the time to check many answers out at all. Therefore, learn as much of the material as you can and expect to rely on the MPEP for a maximum of about 20% of the total number of questions.

*What do I do if I fail the test?*

Whatever you do, don't give up. There is no disgrace in this. The pass rates alone are evidence that usually less than half of all those who take the patent bar exam actually pass it for any given test session. Many well-established and well-respected patent attorneys and agents alike have repeated the exam. One important fact to keep in mind is that no one (except the truly tactless) will ever even ask you how many times you sat for the exam. Another fact is that it really would be a shame to give up altogether. Everyone is allowed as many attempts as they want and there is no penalty for repeating the exam (well, other than having to re-pay and re-sit for it).



## MPEP Chapter Review

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The MPEP is the source for patent practitioners and patent examiners (the people who decide whether or not an invention qualifies for a patent). Each Chapter on the following pages of the Prep Workbook corresponds with a chapter of the 8<sup>th</sup> Edition, Revision 4 MPEP. Every Chapter of the Prep Workbook contains a brief introduction followed by an outline of the important sections that are tested. Following this outline is a list of objectives for you to focus on, including important laws and rules from 35 U.S.C. and 37 C.F.R. in addition to key terms. You should review all the outlined topics and suggested objectives for each chapter in an MPEP or the Guidebook to Patent Law before you begin with the Prep Workbook questions.

Once you feel comfortable with the topics outlined in the Prep Workbook, begin answering the questions. You may use your MPEP or Guidebook to Patent Law. Remember, this is only a learning exercise for now.

Once you've attempted all the questions, review the answer key at the end of each chapter. This will only help cement the correct answer in your mind before moving on. After you've mastered the Prep Workbook, we suggest that you spend time with actual test questions from previous Patent and Trademark Office (PTO) exams. You may want to invest in the Patent Education Series™ PTO Exam Simulator software™, where all the questions and answers are organized by topic. This software will allow you to also take randomized, timed exams just like the one you will have the day of the exam.



## **Chapter 100**

### **Secrecy, Access, National Security and Foreign Filing**

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The public can freely access patents. However, patent applications and other patent related documents are usually kept confidential. This chapter covers who may or may not look at a particular patent related document. After all, inventors usually invest a great deal of time and hard work into their inventions; it wouldn't be fair to give someone the opportunity to steal it.

Patent applications containing information sensitive to national security are placed under a secrecy order by the PTO. Absolutely no member of the public may view these documents even after the patent has issued.

If an inventor files for a U.S. patent, they may not immediately apply for another patent on the same subject matter in a foreign country. The applicant must either allow six months to pass or apply for a foreign filing license.

## Secrecy, Access, National Security and Foreign Filing

### *Chapter Outline:*

- Confidentiality of Patent Applications
  - 101 General
  - 102 Information as to the status of an application
  - 103 Right of public to inspect patent files and some application files
- Issues Regarding National Security
  - 120 Secrecy orders
- Foreign Filing
  - 140 Foreign filing licenses
  - 150 Statements to DOE and NASA

### *Objectives:*

- ***Know which patent files are open to the public.***
- ***Become familiar with foreign filing licenses.***
- ***Know the following laws and rules:***

37 C.F.R. 1.14	Files open to the public.
35 U.S.C. 122	Confidential status of applications; publication of patent applications.

- ***Key terms:***

- access
- foreign filing license
- patent status
- secrecy orders
- servicing the applicant



**Short answer**

1. List the three major types of patent status.
  
2. Are reissue applications available for public inspection?
  
3. When are interferences open to inspection by the public?
  
4. Name three types of files that are open to the public.
  
5. What must a petition for a retroactive license include?
  
6. What two components referencing the application does an individual need to include in the request to learn the status of an application?
  
7. Can secrecy orders be renewed for additional periods?
  
8. How can an inventor get a foreign filing license?
  
9. When is servicing not required?
  
10. Name three individuals who may view pending or abandoned patents.

**Fill in the blank**

1. The status of a parent application is disclosed only when the status of any pending \_\_\_\_\_, \_\_\_\_\_ or \_\_\_\_\_ application derived from it is also disclosed.
2. Confidentiality only applies to \_\_\_\_\_. \_\_\_\_\_ are open to the public (unless they are under secrecy order).
3. Exceptions to the confidential status of abandoned applications include when the abandoned application is \_\_\_\_\_.
4. A person requesting status information may be provided the filing date if the \_\_\_\_\_ numerical identifier is not available, but the last \_\_\_\_\_ of the numerical identifier is available.
5. Access to international applications is denied to all members of the public until it becomes published internationally unless \_\_\_\_\_ is granted by the applicant.

**True/False**

1. A provisional application will not be published.
2. Secrecy order terms will remain in effect for 6 months from the date of issuance.
3. Papers relating to reexamination proceedings are not open to the public.
4. Filing in a foreign country is allowed 1 year after filing in the U.S.
5. If an inventor sends off a foreign application 3 months after filing in the U.S., he or she may petition for a retroactive license.
6. Pending or abandoned patents may not be viewed by any member of the public, as these patents have confidential status.
7. An individual may find out the status of an international application if he or she gains access from the applicant(s).
8. The Commissioner may not make exceptions to the confidential status of applications.
9. An exception to the confidential status of an application may occur when the material within the application is incorporated by reference in a U.S. patent.

<b>Answer Key</b>
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**Short answer**

1. The three major types of patent status are:
  - pending
  - abandoned
  - issued
2. Yes, all reissue applications and related papers in the application file are open to inspection by the public. Copies may be furnished upon paying a fee.
3. Once the interference has terminated or an award of priority or judgment has been entered as to all parties and all counts.
4. The following files are open to the public:
  - issued patents or published statutory invention registrations
  - all reissue applications
  - all requests for reexamination (which will be announced in the Official Gazette provided the fee has been paid)
  - published, abandoned applications (except if a redacted copy of the application is used for the patent application publication)
  - papers relating to reexamination proceedings
  - files of any interference involving a patent, provided:
    - the interference has terminated
    - an award of priority or judgment has been entered
5. A petition for a retroactive license must include:
  - a list of all the foreign countries the application was filed in
  - the dates the application was filed in each country
  - an oath indicating:
    - that the subject matter is not under secrecy order
    - evidence that the license has been diligently sought
    - evidence that the illegal foreign filing occurred by mistake and without deceptive intent
6. In order to learn the status of an application, an individual must send in a request identifying the application by serial number and indicating the filing date of the application.
7. Secrecy orders may be renewed for additional periods of not more than 1 year upon notice by a government agency that national interest so requires it.
8. An individual may receive a foreign filing license by applying for one, waiting 6 months after filing the U.S. application, or by filing a petition for a retroactive license.

<b>Answer Key</b>
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9. Servicing is not required when the application is incorporated in whole or in part into an issued U.S. patent or the application is preserved in secrecy.
10. The following individuals may view pending or abandoned patents:
  - any of the inventors except in cases where the assignee has requested otherwise
  - any inventor who was named even if they did not sign the paperwork
  - any assignee (of entire or partial interest)
  - a licensee of entire interest (not of partial interest)
  - an attorney or agent of record, or anyone given written authorization from an inventor

***Fill in the blank***

1. (continuation) (CIP) (divisional)
2. (applications) (Patents)
3. (published)
4. (8 digit ) (6 digits)
5. (authorization)

***True/False***

1. True
2. False, they remain in effect for 1 year from issuance.
3. False
4. True
5. True
6. True
7. True
8. False, the Commissioner can if necessary.
9. True