

Patent Bar Exam Practice Questions Volume I

Patent Education Series™

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Patent Bar Exam Practice Questions

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A Few Words About This Book

The Patent Bar Exam Practice Questions manual is a study aid for those preparing to take the patent bar examination. This exam currently covers topics found in the Manual of Patent Examination Procedure (MPEP) 9th Edition. You will gain the most by mastering the material covered in the MPEP first and then attempting the Practice Questions manual.

In addition to the Practice Questions manual, 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

Hello,

Thank-you for purchasing the Patent Bar Exam Practice Questions manual. I hope you find it a useful tool for preparing for the Patent Bar Exam.

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

January 2, 2015

Using This Book

This practice exam book contains a mixture of old questions from the USPTO that were freely distributed, new questions we have created, and old questions that have been considerably updated.

If you can get some of these questions free, why should you pay for them? There were several old exams published and distributed freely online by the USPTO and many of these questions have circulated around the Internet. The problem is, out of the questions that were made available, more than half of them are outdated.

If you simply take the old exams (which you can still find online) and start studying from them using the currently tested MPEP, you'll be in for a very frustrating experience. Those questions were all created in the early 2000's, therefore they are over ten years old.

The MPEP has changed several times since then. New chapters have been created and old material has been phased out. You can't take those old exams and apply the questions to the currently tested version of the MPEP. Many of the questions will not make sense. So we have removed those questions from our question bank and from these books. Those that could be salvaged were adjusted. In addition, those that still apply offer do not have the correct MPEP cross-referencing so we have corrected that for you.

Although you may be tempted to take those old exams it's not a worthwhile experience. Hundreds of hours have gone into the creation of these books. They are not simply old exam questions copied and pasted. In addition, we have created many new questions that cover the America Invents Act (AIA), Patent Cooperation Treaty material as well as new changes to the MPEP. Entire topics of questions have been re-written to make this set of practice exam books as valuable as possible.

Table of Contents

35 USC 102	11
35 USC 112	41
ABANDONMENT	57
ACCESS	59
ALLOWANCE	61
AMENDMENTS	65
AMERICA INVENTS ACT (AIA)	71
APPEALS	91
APPLICATION PARTS	97
APPLICATION TYPES	101
ASSIGNMENTS	111
CERTIFICATE OF CORRECTION	115
CLAIM WRITING	117
CLAIMS	137
DESIGN PATENTS	151
DISCLAIMERS	155
DRAWINGS	157
DUTY TO DISCLOSE	159
ETHICS	161

EXTENSIONS	165
FEES	167
FOREIGN FILING	175
INFORMATION DISCLOSURE STATEMENT	177
INTERFERENCES	181
INTERVIEWS	185
INVENTORSHIP	187
MAILING	191
OATH	199
OBVIOUSNESS	201
OVERCOMING REJECTIONS	211
PATENT COOPERATION TREATY	227
PATENTABILITY	237
PETITION TO MAKE SPECIAL	243
PLANT PATENTS	247
POWER OF ATTORNEY	249
PRIOR ART	253
PRIORITY BENEFIT	261
PROTEST	265
PUBLICATION	267
REDUCTION TO PRACTICE	269
REEXAMINATION	271
REISSUE	275
REJECTIONS	289
REQUEST FOR CONTINUING EXAMINATION	297

REQUEST FOR INFORMATION	307
RESTRICTION	309
SMALL ENTITY	311
SPECIFICATION	319
SWEARING BACK	327

35 USC 102

1. In accordance with USPTO rules and procedures set forth in the MPEP, which of the following is not a "printed publication" under AIA 35 USC 102, with respect to a patent application filed June 1, 2014?

- A. A paper that was orally presented at a meeting held May 1, 2014, where the meeting was open to all interested persons and the paper was distributed in written form to six people without restriction.
- B. A doctoral thesis that was indexed, cataloged, and shelved May 1, 2014, in a single, university library.
- C. A research report distributed May 1, 2014, in numerous copies but only internally within an organization and intended to remain confidential.
- D. A reference available only in electronic form on the Internet, which states that it was publicly posted May 1, 2014.
- E. A technical manual that was shelved and cataloged in a public library as of May 1, 2014, where there is no evidence that anyone ever actually looked at the manual.

ANSWER: (C) is the most correct answer. The internal report was intended to be confidential and therefore is not a "printed publication" under AIA 35 U.S.C. § 102. See MPEP § 2128.01. Answer (A) is incorrect. An orally presented paper can be a "printed publication" if copies are available without restriction. The paper is a "printed publication" under AIA 35 U.S.C. § 102. See MPEP § 2128.01. Answer (B) is incorrect. The thesis is a "printed publication" under AIA 35 U.S.C. § 102. See MPEP § 2128.01. Answer (D) is incorrect. An electronic publication disclosed on the Internet is considered to be publicly available as of the date the item was posted. The reference is a "printed publication" under AIA 35 U.S.C. § 102. See MPEP § 2128. Answer (E) is incorrect. There is no need to prove that anyone actually looked at a document. The manual is a "printed publication" under AIA 35 U.S.C. § 102. See MPEP § 2128.

2. According to the first-to-invent provisions prior to March 16, 2013, which of the following is not a policy underlying the public use bar of pre-AIA 35 USC 102(b)?

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

ANSWER: (D) is the most correct answer. Extending patent term is not a policy underlying any section of 35 U.S.C. § 102. Answers (A), (B), (C) and (E) do state policies underlying the public use bar.

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

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

ANSWER: (A) is the most correct answer. MPEP § 715.07, under the heading "Facts and Documentary Evidence" states that "The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. ... The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country (MPEP § 715.07(c)) at least the conception being at a date prior to the effective date of the reference. ... In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose." Here, the co-inventors admit, and the documentary exhibits relied upon demonstrate that they failed to reduce the claimed invention to practice prior to the publication date of the Bell and Watson reference. It is also apparent that due to the lack of an antenna in the cell phone described in Smith's and Jones's declarations and journal article, that the cell phone which was reduced to practice prior to the publication date of the Bell and Watson article would not have worked for its intended purpose. Accordingly, the examiner should maintain the rejection and make it final. (B) and (C) are incorrect choices since the evidence of record shows that Smith and Jones are unable to overcome the prior art. (D) is wrong because an original copy of the published figure which shows that Smith and Jones were not in possession of the claimed invention prior to Bell and Watson publication cannot help their case. (E) is incorrect because prior art under pre-AIA 102(a) is not a statutory bar.

4. According to the first-to-invent provisions prior to March 16, 2013, Rolland files a U.S. patent application fourteen months after he perfects an invention in Europe. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following would establish a statutory bar against the granting of a U.S. patent to Rolland?

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

ANSWER: (A) is the correct answer. See pre-AIA 35 U.S.C. § 102 (d), and MPEP § 706.02(e). (A) is correct because the foreign patent establishes a bar under 35 U.S.C. §102(d). (B) is incorrect because the invention is not described in a printed publication more than one year prior to the date of the U.S. application. Pre-AIA 35 U.S.C. § 102(b). (C) is incorrect because the invention is not in public use more than one year prior to the date of the U.S. application. MPEP § 2133. (D) is incorrect because the sale is not in the United States. (E) is incorrect because (A) is correct.

5. In accordance with the first-to-invent provisions prior to March 16, 2013, which of the following practices or procedures may be properly employed in accordance with the USPTO rules and the procedures set forth in the MPEP to overcome a rejection properly based on pre-AIA 35 USC 102(a)?

- A. Perfecting a claim to priority under 35 USC 119(a)-(d) based on a foreign application having a foreign priority filing date that antedates the reference.
- B. Filing a declaration under 37 CFR 1.131 showing that the cited prior art antedates the invention.
- C. Filing a declaration under 37 CFR 1.132 showing that the reference invention is by "others."
- D. Perfecting priority under 35 USC 119(e) or 120 by, in part, amending the declaration of the application to contain a specific reference to a prior application having a filing date prior to the reference.
- E. (A), (B) (C), and (D).

ANSWER: (A) is the most correct answer. See MPEP § 706.02(b), under the heading "Overcoming a 35 U.S.C. § 102 Rejection Based on a Printed Publication or Patent." (B), and (C) are incorrect because they present showings that support the rejection. See MPEP § 706.02(b), supra. (D) are not correct because to perfect priority under 35 U.S.C. §§ 119(e) or 120 it is, inter alia, necessary to amend the specification of the application to contain a specific reference to a prior application having a filing date prior to the reference. See MPEP § 706.02(b), supra. Furthermore, the declaration is not to be amended. (E) is incorrect because (B), (C) and (D) are incorrect.

6. Which of the following practices or procedures may be employed in accordance with the USPTO rules and the procedures set forth in the MPEP prior to March 16, 2013, to overcome a rejection properly based on pre-AIA 35 USC 102(e)?

- A. Persuasively arguing that the claims are patentably distinguishable from the prior art.
- B. Filing an affidavit or declaration under 37 CFR 1.132 showing that the reference invention is not by "another."
- C. Filing an affidavit or declaration under 37 CFR 1.131 showing prior invention, if the reference is not a U.S. patent that either claims the same invention or claims an obvious variation of the subject matter in the rejected claim(s).
- D. (A) and (C).
- E. (A), (B) and (C).

ANSWER: (E) is the most correct answer. See MPEP § 706.02(b), under the heading "Overcoming A 35 U.S.C. § 102 Rejection Based On A Printed Publication Or Patent." (A), (B), and (C) alone, as well as (D) are not correct because they are not the most inclusive.

7. Adams filed Application X on March 1, 2001. Beth filed application Y on May 1, 2001. Neither application has been published. Applications X and Y are copending and commonly assigned. Earlier filed application X claims the same invention as claimed in application Y using identical language. In accordance with the MPEP, which of the following actions should the examiner or assignee follow?

- A. The claims to the same invention in application Y should be rejected under pre-AIA 35 USC 102(a) as being anticipated by application X.
- B. The claims to the same invention in application Y should be rejected under pre-AIA 35 USC 102(b) as being anticipated by application X.
- C. The claims to the same invention in application Y should be rejected under pre-AIA 35 USC 102(e) as being provisionally anticipated by application X.
- D. The common assignee should file a terminal disclaimer in application Y to avoid any question of double patenting.
- E. The claims to the same invention in application Y should be rejected under pre-AIA 35 USC 102(e) as being anticipated by application X.

ANSWER: (C) is correct pre-AIA 35 U.S.C. § 102(e). (C) is correct because section I. of MPEP § 706.02(f) states, "If (1)...the applications are commonly assigned and (2) the effective filing dates are different, then a provisional rejection of the later filed application should be made." (A) is wrong because the facts do not indicate prior knowledge or use by others, or that the application Y is patented or published. (B) is wrong because the facts do not indicate that the application Y is patented or published, or the existence of "public use" or "on sale" bars. (D) is wrong. This is a statutory double patenting situation that cannot be avoided by filing a terminal disclaimer. See *In re Bartfeld*, 17 USPQ2d 1885 (Fed. Cir. 1991). MPEP § 706.02(f), section I. (E) is wrong. It is improper to make a nonprovisional rejection under pre-AIA § 102(e) in the circumstances described in the question. Choice (E) provides for an improper nonprovisional rejection under § 102(e).

8. According to the first-to-invent provisions prior to March 16, 2013, which of the following practices or procedures may be properly employed to overcome a rejection properly based on pre-AIA 35 USC 102(e)?

- A. Persuasively arguing that the claims are patentably distinguishable from the prior art.
- B. Filing an affidavit or declaration under 37 CFR 1.132 showing that the reference invention is not by "another."
- C. Filing an affidavit or declaration under 37 CFR 1.131 showing prior invention, if the reference is not a U.S. patent that either claims the same invention or claims an obvious variation of the subject matter in the rejected claim(s).
- D. (A) and (C).
- E. (A), (B) and (C).

ANSWER: (E). See MPEP § 706.02(b), under the heading "Overcoming a 35 U.S.C. § 102 Rejection Based on a Printed Publication or Patent." (A), (B), and (C) alone, as well as (D) are not correct because they are not the most inclusive.