

their chosen answers are the most correct answers. Petitioner has failed to meet this burden.

The directions to the morning section state in part:

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.

Petitioner has presented various arguments attacking the validity of the model answers. All of Petitioner's arguments have been considered, but lack merit. For the following reasons, no points will be added to Petitioner's score for the morning section of the Examination.

Question 1 reads as follows:

1. As patent counsel for the National Pharmaceutical Company (NPC), you prepared and filed in the PTO a patent application for an improved medication for treating osteomyelitis, an infectious inflammatory bone disease. The application listed John Jones, an NPC research biochemist who is obligated by an employment contract to assign all inventions to NPC, as the sole inventor. The specification referenced a prior art medication containing an effective amount of an organic compound having a cyclopentadiene ring structure containing a metal ion held by coordination bonds used in the treatment of osteomyelitis, and noted that its use was often accompanied by nausea and muscle cramps. Comparative test data set forth in the specification revealed that the negative side effects of the use of the prior art medication could be essentially avoided by limiting the metal ion to a metal ion selected from the group consisting of osmium (atomic number 76), iridium (atomic number 77), platinum (atomic number 78), and gold (atomic number 79). Following several years of prosecution, the application issued as a patent on February 24, 1998, with the following single claim:

A medication for treating osteomyelitis containing an effective amount of an organic compound having a cyclopentadiene ring structure containing a metal ion held by coordination bonds, said metal ion being selected from the group consisting of osmium, iridium, platinum, and gold.

On February 10, 1998, Jones submitted an invention disclosure to you containing test data demonstrating that when iridium, platinum, or gold, as contrasted with osmium, is selected for the metal ion of the aforementioned organic compound, half as much organic compound is required to be effective in the medication for treating osteomyelitis. You then prepared and filed on February 23, 1998, a continuation-in-part application in the PTO on this discovery. In the first Office Action the primary examiner rejected the following claim on the ground of "statutory type" double patenting over the Jones patent based on 35 U.S.C. § 101:

A medication for treating osteomyelitis containing an effective amount of an organic compound having a cyclopentadiene ring structure containing a metal ion held by coordination bonds, said metal ion being selected from the group consisting of iridium, platinum, and gold.

Which of the following actions should overcome the examiner's rejection in accordance with proper PTO practice and procedure?

- (A) File a reply traversing the rejection and arguing that the same invention is not being claimed because the patent claim is broader than the rejected claim. Therefore, the patent claim can be infringed without infringing the rejected claim.
- (B) File an amendment rewriting the claim in accordance with 37 CFR § 1.121, and adding the corresponding atomic number immediately following the recitation of each metal ion.
- (C) File a terminal disclaimer under 37 CFR § 1.321.
- (D) File a declaration of prior invention under 37 CFR § 1.131.
- (E) File a reply traversing the rejection and arguing that 35 U.S.C. § 103(c), does not preclude patentability because "the subject matter and the claimed invention, were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

The correct answer is (A) and Petitioner selected answer (C). The question inquires which of five actions should overcome an examiner's rejection in accordance with proper PTO practice and procedure. Choice (A) is the most correct answer in view of 37 C.F.R. § 1.111(b) which reads "[t]he reply by the applicant . . . must . . . distinctly and specifically point[] out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action." In *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970), the Court stated: "By 'same invention' we mean identical subject matter. Thus the invention defined by a claim reciting 'halogen' is not the *same* as that defined by a claim reciting 'chlorine,' because the former is broader than the latter . . . [a] good test, and probably the only objective test, for 'same invention,' is whether one of the claims could be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same invention." 422 F.2d at 441, 164 USPQ at 621-22; see also MPEP § 804, Part II A. Thus, the rejection is improper which needs to be pointed out by the applicant, as choice (A) indicates.

Choice (C) is not a correct answer. See MPEP § 804.02 (“A terminal disclaimer is not effective in overcoming a statutory double patenting rejection”) (emphasis added). Petitioner argues that a terminal disclaimer may overcome a double patenting rejection. However, what Petitioner overlooks is that for a terminal disclaimer to overcome a double patenting rejection, the rejection must be of the obviousness type double patenting, and not of the statutory or same invention type. *See, e.g.,* Vogel, 422 F.2d at 441, 164 USPQ at 622. Accordingly, Petitioner’s argument is without merit and no error in grading has been shown.

Question 4 reads as follows:

4. As patent counsel for the Apex Biotechnology Corporation, you filed a patent application in the PTO on January 2, 1998, naming Smith as inventor, with claims directed to a method for recovering a purified eucaryotic growth hormone or an analog thereof from a bacterial cell. The growth hormone or analog thereof is produced in the bacterial cell via expression of a DNA sequence encoding the hormone or analog. A primary patent examiner initially rejected all the claims as obvious under 35 U.S.C. § 102(e)/103 in view of a commonly assigned application Serial No. 0X/XXX,XXX (the ‘XXX application), filed December 29, 1995 naming Jones as inventor. The rejection was “provisional” in the sense that the ‘XXX application had not yet issued as a patent. After consultations with Smith and Apex management, you filed a terminal disclaimer complying with 37 CFR § 1.321(c) disclaiming that part of the term of the Smith application which would extend beyond the expiration date of the commonly assigned, copending ‘XXX application. Upon the ‘XXX application becoming abandoned, in favor of a Continued Prosecution Application (CPA), filed June 4, 1998, the examiner withdrew the rejection and substituted the following two rejections in the Smith application:

- (1) A rejection of all the claims under 35 U.S.C. §§ 102(e)/103 as obvious over commonly-assigned U.S. Patent No. A,AAA,AAA to Able in view of U.S. Patent No. B,BBB,BBB to Baker; and
- (2) A “provisional” rejection of all the claims under 35 U.S.C. §§ 102(e)/103 as obvious over the CPA application in view U.S. Patent No. B,BBB,BBB to Baker.

The examiner correctly noted that both the Able patent and the CPA application disclose, but do not claim, the subject matter of the abandoned 'XXX application, and that the application which matured into the Able patent was assigned to Apex and was filed in the PTO on December 29, 1995. The invention claimed in the Smith application is patentably distinct from the inventions claimed in the Able patent and the CPA application.

Which of the following actions and/or arguments is most likely to overcome the examiner's rejections?

- (A) File a reply arguing (1) that the terminal disclaimer should be effective to overcome the 35 U.S.C. § 102(e)/103 rejection based on the public policy implicit in 35 U.S.C. § 103(c), which precludes citation as prior art of commonly-owned subject matter developed by another person, and (2) that Smith, Able, and Jones are "other persons."
- (B) File a declaration under 37 CFR § 1.132 by Smith unequivocally declaring that he conceived or invented the subject matter disclosed but not claimed in the references.
- (C) File a reply arguing that the terminal disclaimer should be effective to overcome the 35 U.S.C. §§ 102(e)/103 rejection based on the analogy of such rejection to a double patenting situation, citing *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985), wherein the court characterized an obviousness-type double patenting rejection as "analogous" to a 35 U.S.C. § 103 rejection.
- (D) File an affidavit under 37 CFR § 1.131 by Smith including facts that Smith conceived the claimed invention in a NAFTA member country in August 1993, that Smith moved to Hawaii in 1994 and began working on his conception in earnest during the period December 1994 until December 1, 1995, when he moved to a WTO member country other than a NAFTA country, where he successfully reduced his invention to practice on December 28, 1995. Accompany the affidavit with the argument that the affidavit effectively "swears back" of such references.
- (E) File a declaration under 37 CFR § 1.130 to disqualify the commonly owned references, accompanied by the argument that a prior art reference that renders claimed subject matter obvious under 35 U.S.C. § 103 necessarily creates an obviousness-type double patenting situation, which is obviated by the filing of the terminal disclaimer.

Answer (B) is the most correct choice and Petitioner selected answer (E).

Answer (B) is most correct because, as the fact pattern states, "both the Able patent and the CPA application disclose, but do not claim, the subject matter of [Smith's earlier]

application.” In such a situation:

“it is incumbent upon the inventors named in the application . . . to rebut a rejection under 35 U.S.C. 102(a) or (e), to provide a satisfactory showing by way of affidavit under 37 CFR 1.132 that the inventorship of the application is correct in that the reference discloses subject matter derived from the petitioner rather than invented by the . . . patentee notwithstanding . . . the inventorship of the patent.”

MPEP § 716.10. Accordingly, since Smith conceived of the same invention disclosed in the references but not claimed, he can submit an affidavit swearing to be the inventor of the subject matter claimed.

Answer (E) is not correct because a declaration made pursuant to 37 C.F.R. § 1.130(a) must state that the applicant’s claimed invention is not patentably distinct from the invention claimed in the reference. Such a statement, however, would be directly contrary to the above-stated fact: “[t]he invention claimed in the Smith application is patentably distinct from the inventions claimed in the Able patent and the CPA application.” Accordingly, the declaration identified in answer (E) could not be made.

Petitioner argues that the procedure set forth in answer (E) would cost the applicant less than the procedure set forth in answer (B) and is therefore preferable. However, as discussed above and in view of the facts, the procedure set forth in answer (E) is not an option, so Petitioner’s argument is without merit. In view of the above, no error in grading has been shown.

Question 7 reads as follows:

7. Which of the following statements regarding a Continued Prosecution Application (CPA) is not correct?

- (A) The request for a CPA can be filed by facsimile and processed entirely in the examining group.
- (B) The CPA will use the same file jacket as the prior application.
- (C) The application number of the CPA remains the same as the prior application.
- (D) No continuation-in-part CPA is permitted.
- (E) Priority to the parent application is granted only if there is reference to the parent application in the first paragraph of the specification of the CPA.

Answer (E) is the most correct choice and Petitioner selected answer (A).

Answer (E) is the correct answer because it states something that is incorrect, i.e., that a CPA must refer to the prior application in the first paragraph of its specification. Under 37 C.F.R. § 1.53(d)(2), a request for a CPA must identify the prior application. However, the CPA “will utilize the file jacket and contents of the prior application, including the specification” 37 C.F.R. § 1.53(d)(2)(iv). Thus, it is the request for a CPA paper that refers to the prior application and not its specification which is still in the prior application. Accordingly, answer (E) is the correct answer because there is no requirement that a CPA refer to the prior application in the first paragraph of its specification.

Answer (A) is not a correct answer choice to the question seeking a procedure that is incorrect for a CPA. The procedure set forth in answer (A) of filing a request for a CPA by facsimile which will be processed entirely in the examining group is correct. 37 C.F.R. §§ 1.6(d)(3) and 1.53(d)(9).

Petitioner argues that the fee required to be submitted with the CPA could not be submitted by facsimile and handled entirely within the examining group, and therefore the procedure in answer (A) is lacking. However, the fee need not accompany the facsimile request for a CPA. 35 U.S.C. § 111(a)(3). Authorization to charge the appropriate deposit account may be on the request or such authorization or payment may follow. In sum, the request may be submitted by facsimile and it is handled within the examining group, contrary to Petitioner's argument.

Petitioner also argues that answer (E) sets forth a correct procedure and is therefore an incorrect answer to the question concerning what is wrong with CPA practice. However, answer (E) directly conflicts with 37 C.F.R. 1.53(d)(7) which reads, in pertinent part, "[a] request for an application under this paragraph is the specific reference required by 35 U.S.C. 120 to every application assigned the application number identified in such request." Accordingly, Petitioner's assertion that the first paragraph of the specification of the CPA must refer to the parent application is unpersuasive. In view of the above, no error in grading has been shown.

Question 10 reads as follows:

10. Sam Smart, a cabinet maker employed by Star Furniture Company, designed a unique armoire blending the ascetic style of Shakerism with the flamboyant style of Victorianism. Star officials were so impressed that they asked Patent Counsel to take immediate steps to obtain patent protection on the armoire. Patent Counsel filed a provisional utility application in the PTO on September 16, 1997, naming Sam Smart as the sole inventor. On March 20, 1998, Patent Counsel filed nonprovisional utility and design applications in the PTO, each application claiming priority from the provisional utility application under 35 U.S.C. § 119(e)(1). In the first Office action in the design application, the examiner rejected the sole claim as unpatentable under 35 U.S.C. § 103 over a photograph of a gun cabinet appearing in a department store catalog published in October 1997. Which of the following actions accords with proper practice and procedure and is most likely to overcome the rejection?

- (A) Traverse the rejection on the ground that the photograph is not available as a reference because the inventors named in the provisional and nonprovisional applications are the same, the nonprovisional application was filed within 12 months of the provisional application, the nonprovisional application refers to the copending provisional application, and the provisional application antedates the publication date of the reference catalog.
- (B) Traverse the rejection on the ground that the photograph is not available as a reference because while the photograph depicts a gun cabinet of substantially the same appearance as the claimed design, the gun cabinet and the armoire are not from analogous arts.
- (C) Traverse the rejection on the ground that the design of the armoire is not obvious from the reference because an armoire functions essentially to hold clothes, whereas a gun cabinet functions essentially to hold rifles.
- (D) Traverse the rejection on the ground that the ornamentation of the armoire is not obvious from the reference since the ornamentation of the armoire is embossed on the armoire surface, whereas the ornamentation of the gun cabinet is impressed in the gun cabinet surface.
- (E) Traverse the rejection by submitting evidence of commercial success of the claimed design and arguing that the overall appearance and design, characteristics of the gun cabinet are basically different from the claims design.

Answer (E) is the most correct answer and Petitioner selected answer (A).

Choice (E) is most correct because, as MPEP § 1504.03, Part I.D., recites,

“[s]econdary considerations, such as commercial success . . . are relevant to the evaluation of obviousness of a design claim just as in a utility claim.” *See also In re Rosen*, 673 F.2d 388, 390, 213 USPQ 347, 349 (CCPA 1982) (“In determining the patentability of a design [e.g., under 35 U.S.C. § 103], it is the overall appearance, the visual effect as a whole of the design, which must be taken into consideration”).

Answer (A) is not correct because “[t]he right of priority provided for by section 119(e) of [Title 35] shall not apply to designs.” 35 U.S.C. § 172; see also 37 C.F.R. § 1.53(c)(3) (“No claim for priority under [37 C.F.R.] § 1.78(a)(3) may be made in a design application based on a provisional application”); 37 C.F.R. § 1.78(a)(3). Accordingly, since the only standing rejection concerns the design application and answer (A) includes the response that the provisional application antedates the reference, answer (A) improperly claims priority for a design application to an earlier provisional application. This choice, and Petitioner’s argument in support thereof, directly conflict with 35 U.S.C. § 172 and 37 C.F.R. §§ 1.53(c)(3), 1.78(a)(3). Thus, no error in grading has been shown.

Question 18 reads as follows:

18. Which of the following statements regarding design patent applications is not correct?

- (A) The specification may contain a brief description denoting the nature and environmental use of the claimed design.
- (B) The drawings may be color drawings or color photographs if accompanied by a grantable petition.
- (C) The design application may have only a single claim.
- (D) Different embodiments or modifications may be set forth in the specification, but do not need to be shown in the drawings.
- (E) The inventive novelty or unobviousness of a design resides in the shape or configuration, and/or surface ornamentation of the subject matter which is claimed.

Answer (D) is correct and Petitioner selected answer (B). Choice (D) is the most correct answer because “it is permissible to illustrate more than one embodiment of a design invention in a single application.” MPEP § 1504.05(II)(A); *see also In re Rubinfeld*, 270 F.2d 391, 393, 123 USPQ 210, 212 (CCPA 1959) (“we see no reason why . . . 35 U.S.C. § 171 should, per se, preclude the showing of two or more embodiments of a design invention”). Additionally, “[t]he design must be represented by a drawing that complies with the requirements of § 1.84, and must contain a sufficient number of views to constitute a complete disclosure of the appearance of the design.” 37 C.F.R. § 1.152(a). Accordingly, when there are different embodiments of a design, compliance with the rule’s provision that there be a sufficient number of views to constitute a “complete” disclosure of the design requires that each embodiment be set forth in the drawings. Therefore, different embodiments or modifications of a design need to be shown in the drawings.

Answer (B) correctly states that the drawings may be color or color photographs if accompanied by a grantable petition. 37 C.F.R. § 1.152(a)(2). Answer (B) is therefore

an incorrect answer choice to the question reading “[w]hich of the following statements regarding design patent applications is not correct” (emphasis in original).

Petitioner argues that MPEP § 1503.02 contradicts 37 C.F.R. § 1.152(a)(2) and in practice, the rule is not true because the petition will be denied. However, contrary to Petitioner’s argument, the current version of the MPEP, which was in effect at the time of the examination, directly follows the above rule. *See* MPEP § 1503.02(V) (entitled “Photographs and Color Drawings”). Accordingly, as the rule sets forth, filing a “grantable” petition with the color photographs and drawings will result in the granting of the petition.

Finally, Petitioner argues that answer (C) is also a correct answer choice to the question reading “[w]hich of the following statements regarding design patent applications is not correct” (emphasis in original). However, since Petitioner did not select answer (C), this argument fails to point out any error with respect to Petitioner’s answer choice, as required by 37 C.F.R. § 10.7(C). In view of the above, no error in grading has been shown.

Question 23 reads as follows:

23. Claimed subject matter had been properly rejected under 35 U.S.C. § 103 over a combination of prior art references which render the claimed subject matter *prima facie* obvious. Which of the following actions by a practitioner in accordance with proper PTO procedure is most likely to be sufficient to overcome the *prima facie* case of obviousness?

- (A) Filing a declaration under 37 CFR § 1.132 containing evidence that the claimed subject matter possesses unexpected results, disclosed in the application, which are not described in the prior art, and arguing that the evidence rebuts the *prima facie* case.
- (B) Filing a reply arguing and giving your opinion that the claimed apparatus provides unexpectedly superior productivity.

- (C) Filing a declaration under 37 CFR § 1.132 presenting evidence of superior properties for iron-containing compositions disclosed in the application where the broad rejected claim is drawn to a “metal-containing” composition. The prior art reference discloses and describes an aluminum composition which satisfies the broad claim, and the practitioner argues that the evidence rebuts the *prima facie* case of obviousness.
- (D) Filing a declaration under 37 CFR § 1.132 which demonstrates that a “metallic” apparatus of Claim 1 has superior properties to a plastic apparatus having all the structural limitations recited in the claim, and arguing that the evidence, which relies on properties disclosed in the application, rebuts the *prima facie* case of obviousness, where Claim 1 was rejected under 35 U.S.C. § 103 over references disclosing metallic apparatuses, and the references made out a *prima facie* case of obviousness.
- (E) Filing a declaration under 37 CFR § 1.132 demonstrating commercial success of a telephone apparatus having all the structural limitations recited in the rejected claim except that the commercially successful apparatus is plastic and is disclosed in the application, whereas the rejected claim is limited to a “metallic” telephone apparatus, and arguing that the evidence rebuts the *prima facie* case of obviousness, where the claim was rejected under 35 U.S.C. § 103 over references disclosing metallic telephone apparatuses, and the references made out a *prima facie* case of obviousness.

Answer (A) is the most correct choice and Petitioner selected answer (D).

Answer (A) is most correct because a showing of unexpected results can rebut the *prima facie* case of obviousness. *E.g.*, *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966); MPEP § 2145. An affidavit or declaration may be filed traversing the obviousness rejection based on the prior art. 37 C.F.R. § 1.132.

Answer (D) is not correct because, as set forth in the answer choice, “[c]laim 1 was rejected under 35 U.S.C. § 103 over references disclosing metallic apparatuses,” but the declaration only “demonstrates that a ‘metallic’ apparatus of Claim 1 has superior properties to a plastic apparatus having all the structural limitations recited in the claim.” Since the rejection is based on metallic apparatuses in the prior art, not a plastic apparatus,

comparing the claimed invention in a declaration to a plastic apparatus is of no moment. Rebuttal evidence must compare the claimed invention with the specific prior art that was the subject of the rejection. *See., e.g., In re Beattie*, 974 F.2d 1309, 1313, 24 USPQ2d 1040, 1042-43 (Fed. Cir. 1992).

Petitioner argues that in answer (A), it was inaccurate to describe the claimed subject matter as “possessing” unexpected results, rather than as “producing” unexpected results, and that answer (A) does not sufficiently overcome the *prima facie* case of obviousness. However, of all the answer choices, answer (A) is most correct in terms of responding to an obviousness rejection by submitting proper evidence of unexpected results pursuant to the governing case law. Petitioner has simply failed to show how answer (E), with the above-discussed deficiencies, is a more correct choice than answer (A). In view of the above, no error in grading has been shown.

Question 28 reads as follows:

28. Inventor Smith prepared and filed on February 11, 1997, a provisional application regarding a machine Smith invented in the United States on November 5, 1996. A Notice to File Missing Parts dated March 6, 1997, informed Smith that the filing fee was omitted, and that the filing fee along with the surcharge are required. The Notice set a period for reply which was two months from the filing date. Smith failed to pay the filing fee and the required surcharge. The provisional application became abandoned. A Notice of Abandonment, dated May 11, 1997, was sent to Smith. Smith engaged practitioner P to prepare and file a patent application, and informed P that Smith had filed a provisional application on February 11, 1997. On February 11, 1998, P filed a complete nonprovisional patent application for Smith, claiming benefits under 35 U.S.C. 119(e) of the filing date of the provisional application. On March 4, 1998, Smith furnished P with a copy of a publication by Allon, dated February 2, 1997, fully describing the machine and a manner of making and using the machine. Also on March 4, 1998, Smith gave P copies of the two notices. P, upon asking Smith why no reply had been filed to either notice, learned that Smith had been hospitalized for a heart attack and ensuing complications from March 5 through May 4, 1997, and Smith’s significant

other put the notices away without opening or showing them to Smith so as not to disturb Smith, and then forgot about the notices. Smith first learned of the notices on March 3, 1998, while sorting through papers to prepare Smith's 1997 income tax return. To properly protect Smith's patent rights, the most appropriate course of action for P to take is

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- (A) to do nothing inasmuch as the regulations no longer provide for revival of an abandoned provisional application after a nonprovisional application has been filed.
 - (B) to promptly file a request to withdraw the holding of abandonment explaining that abandonment was improper inasmuch as Smith's significant other had withheld the notices from Smith, and Smith had not received the notices. Also, with the request file the filing fee, a copy of the Allon publication, and an explanation of the relevance of the Allon publication.
 - (C) to promptly file a petition requesting the Commissioner to exercise his supervisory authority to withdraw the holding of abandonment as improvident inasmuch as Smith's significant other had withheld the notices from Smith, and Smith had not received the notices.
 - (D) promptly file a petition and fee to revive the provisional application as being unintentionally abandoned, the appropriate surcharge, the filing fee, and a statement that the entire delay was unintentional. Also file in the nonprovisional application an IDS listing the Allon publication along with a copy of the Allon publication, and an explanation of the relevance of the Allon publication to the claims in the patent application.
 - (E) promptly file a petition and fee for a two month extension of time, a petition and fee to revive the provisional application as being unintentionally abandoned, the filing fee, and a statement that the entire delay was unintentional.

The correct answer is (D) and Petitioner selected answer (E). The question asks which of five courses of action should P take to properly protect Smith's patent rights. Choice (D) is the most correct answer. The petition to revive the provisional application and required fees should promptly be filed after Smith learned of the abandonment of the application. See 37 C.F.R. § 1.137(b). The facts present a case of unintentional abandonment. If the petition to revive the provisional application is granted, Smith's application may claim the benefit of the filing date of the provisional application since the

application is filed within twelve months from the filing date of the provisional application. See 37 C.F.R. § 1.78(a)(3); MPEP § 201.11. If the petition is granted, the Allon publication is prior art under 35 U.S.C. § 102(a) with respect to the claims of the application because the publication was published less than one year before the earliest effective filing date of Smith's application, and Smith can antedate the publication with an antedating affidavit under 37 C.F.R. § 1.131. The duty of disclosure regarding the Allon publication is met. See 37 C.F.R. § 1.56.

Answer (E) is not correct because filing a petition and two month extension of time are unnecessary. The application went abandoned. There is nothing upon which to receive a two month extension of time. Additionally, the petition to revive in answer (E) is not accompanied by the appropriate surcharge or a proper response, such as the supplemental IDS, as part of the petition, which is required by 37 C.F. R. § 1.137(b)(1).

Petitioner argues that the model answer is flawed because it does not hurt the client to file the petition for an extension of time, the petition to revive fee is present in answer (E), and the duty of disclosure is not required during the timing of the petition to revive. However, filing an unnecessary petition is not to the client's benefit; the petition to revive lacks the separate surcharge fee; and without filing an IDS, no appropriate response accompanies the petition to revive, as required by 37 C.F. R. § 1.137(b)(1).

Petitioner also argues that, as set forth in the facts, the notice of abandonment was issued too early and the question is therefore defective. Petitioner's argument is unpersuasive. The question merely states that the notice of abandonment was mailed on May 11, 1997, which should prompt the practitioner with respect to preparing and filing an adequate petition to revive. Moreover, the facts of the question were the same for all

the examinees and this argument fails to point out any error with respect to Petitioner's answer choice, as required by 37 C.F.R. § 10.7(C). In view of the above, no error in grading has been shown.

Question 29 reads as follows:

29. On September 10, 1997, Smith invented a process for implanting processing chips in human heads. The chips permit the human to control replies when angered. Smith filed a *pro se* patent application in the PTO on the process on November 17, 1997. Shortly afterwards, Smith was hired by EZ Corporation, a processor and distributor of chips. During the pendency of the Smith patent application, on January 3, 1998, Smith invented an improvement to the process, and pursuant to Smith's employment agreement, Smith executed an assignment of the improved process invention to EZ Corporation. You are patent counsel for EZ Corporation. Pursuant to instructions, you prepared a patent application on the improved process invention. On February 3, 1998, you filed a complete patent application together with the executed assignment in the PTO. The application filed on February 3, 1998, in addition to disclosing the process disclosed in the *pro se* application, also disclosed and claimed only the improved process. The first sentence of the specification in the application filed on February 3, 1998, stated that the application was a CIP of the copending *pro se* Smith patent application, which was adequately identified therein. On May 11, 1998, the *pro se* Smith patent application became abandoned. On June 4, 1998, all the claims to the improved process in the application filed on February 3, 1998, were rejected by the primary examiner as unpatentable under 35 U.S.C. § 103 over a U.S. patent that issued on March 3, 1998, on an application that was filed on December 11, 1995. Which of the following actions accords with proper PTO practice and procedure, and represents the most appropriate action for overcoming the examiner's rejection?

- (A) File a reply which argues that the claims of the present application are nonobvious over the U.S. Patent issued on March 3, 1998.
- (B) File a reply which argues that since Smith is the same inventor named in the previously filed *pro se* application, and since the CIP application contains a specific reference to the earlier filed application, the CIP application is entitled to the benefit of the earlier date in accordance with 35 U.S.C. § 120 for purposes of the improvement process claims.
- (C) File an affidavit under 37 CFR § 1.132 presenting test data showing that the process in the CIP application is significantly superior to the process in the *pro se* application.

- (D) File a reply which argues that the reference patent cannot be the basis of a rejection because its issue date postdates the filing date of the CIP application.
- (E) File an affidavit under 37 CFR § 1.131 swearing back of the reference filing date.

Answer (A) is the correct choice and Petitioner selected choice (D). Answer (A) is the most correct answer because the practitioner argues that the claims are patentable over a patent used in the rejection, shows errors in the examiner's action, and replies to the ground of rejection by addressing the relied upon reference. In doing so, the practitioner has met the requirements for replying to an Office action. See 37 C.F.R. § 1.111(b):

“The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and . . . present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”

Answer (D) is not correct because the facts are that Smith invented the improved process on January 3, 1998, the reference has a patent application filing date of December 11, 1995, and issued as a patent on March 3, 1998. Accordingly, the reference is prior art for both 35 U.S.C. §§ 102 and 103 purposes. See 35 U.S.C. § 102(e) (patent applications which issue as patents are prior art if filed before the date of invention by the applicant); 35 U.S.C. § 103 (referring to prior art and only limits the use of § 102(f) and § 102(g) prior art).

Petitioner argues that because there was no rejection under 35 U.S.C. § 102 for lack of novelty, answer (D) is correct. However, as discussed above, § 102(e) prior art can be used for § 103 purposes and, accordingly, this argument is without merit. No error in grading has been shown.

Question 30 reads as follows:

30. Inventor X, a citizen of Germany, invented a tape dispenser in Germany on May 5, 1996. On January 22, 1997, X filed a patent application for the tape dispenser in the German Patent Office. On January 22, 1998, you filed a complete U.S. patent application in the PTO claiming a tape dispenser on behalf of X. The U.S. application was filed with a declaration under 37 CFR § 1.63 signed by X claiming foreign priority of the German patent application. In an Office action dated June 17, 1998, and setting a three month shortened statutory period for reply, a primary patent examiner properly rejected all the claims in the U.S. patent application as being anticipated under 35 U.S.C. § 102(a) by the disclosure in magazine articles describing how to make and use an identical tape dispenser. The articles were published in the United States in February 1997, and in Great Britain in March 1997. Which of the following actions accords with proper PTO practice and procedure, and represents the most appropriate action for overcoming the rejection?

- (A) On or before September 17, 1998, file a certified copy of the German application, and an English translation of the German application.
- (B) On or before September 17, 1998, file a certified copy of the German application, an English translation of the German application, and point out that the reference is no longer available as prior art.
- (C) File a reply on or before September 17, 1998, which argues that the reference cannot be used because the application inventor X filed in the German Patent Office antedates the article.
- (D) File an affidavit under 37 CFR § 1.132 signed by you stating that the reference cannot be used because the application which inventor X filed in the German Patent Office antedates the articles.
- (E) File a petition to have the Commissioner exercise his supervisory authority and withdraw the rejection stating that the reference cannot be properly used inasmuch as the declaration under 37 CFR § 1.63 makes clear that the application inventor X filed in the German Patent Office antedates the articles.

The correct answer is (B) and Petitioner chose answer (C). Answer (B) complies with proper PTO practice and procedure. To perfect a claim of foreign priority, the claim for benefit of foreign priority must be filed, along with a certified copy of the foreign application, 35 U.S.C. § 119(b), and an English translation of the foreign application, 37 C.F.R. § 1.55. Additionally, the practitioner must reply to the rejection by pointing out that the reference is no longer available as prior art. 37 C.F.R. § 1.111(b).

Answer (C) is not the most correct answer because it does not include the necessary step of filing a certified copy of the foreign application and English translation thereof. Petitioner argues the following: “The only choice which specifically includes a reply to the Office Action is choice (C). Therefore, choice (C) is factually true and is a correct answer.” However, the use of the word “reply” does not overcome the failure to file a certified copy of the foreign application and English translation thereof and, as discussed above, answer (B) complies with PTO practice and procedure, thereby making it the most correct answer. In view of the above, no grading error has been shown.

Question 34 reads as follows:

34. On November 6, 1997, the practitioner filed a complete patent application, filing fee, and declaration under 37 CFR § 1.63 identifying inventors A and B by their full names, and providing their residence, post office addresses, and citizenship. Inventors A and B did not assign, and were under no obligation to assign their rights in the invention to any other party. A primary examiner required restriction between the invention of Claims 1-5, and the invention of Claims 6-10. The practitioner elected the invention of Claims 1-5. The examiner withdrew Claims 6-10 from consideration. On July 15, 1998, the practitioner filed a reply to a first Office action dated May 8, 1998, which did not set a period for reply. In the reply, Claims 6-10 were canceled, and Claims 1 and 3 were amended by adding limitations supported by information disclosed, but unclaimed in the application. The limitations were substantially embraced by the statement of invention in the

application. Claim 1 is an independent claim, and Claims 2-5 depend directly or indirectly from Claim 1. On August 1, 1998, inventors A and B then provided the practitioner with information clearly showing that Claims 1-5, as amended, were not the joint invention of A and B, and that such error arose without deceptive intent. Which of the following actions fulfills proper PTO practice and procedure for correcting inventorship?

- (A) Where the information shows that A is the sole inventor of Claims 1-5, as amended, the practitioner should file an amendment to name only A as the sole inventor of the invention set forth in Claims 1-5, together with a statement by the practitioner to correct the inventorship. The foregoing should be filed promptly, and preferably before the next Office action.
- (B) Where the information shows that A and C are joint inventors of Claims 1-5, as amended, the practitioner should file an amendment deleting B as an inventor, and adding C as a joint inventor. The amendment should be accompanied by a petition including a statement by B and C that the error in inventorship occurred without deceptive intent on their part, a statement identifying B as the named inventor who is being deleted and acknowledging that B's invention is no longer being claimed, and a statement by C that the amendment is necessitated by the amendment of the claims. An oath or declaration under 37 CFR § 1.63 by A and C should also accompany the amendment. The foregoing should be filed promptly, and preferably before the next Office action.
- (C) Where the information shows that A is the sole inventor of Claims 1-5, as amended, the practitioner should file a properly completed request on a separate paper for a continuation application as a continued prosecution application. The request names as inventor only A, and is accompanied by the proper filing fee, and a statement by the practitioner requesting the deletion of B as inventor inasmuch as B is not an inventor of the invention being claimed in the new application. The foregoing should be filed before an issue fee is paid in the prior application, or before the prior application is abandoned.

- (D) Where the information shows that A and C are joint inventors of Claims 1-5, as amended, the practitioner should file a properly completed request on a separate paper for a continuation application as a continued prosecution application. The request names as inventors A and C, and is accompanied by the proper filing fee, and a statement by the practitioner requesting the deletion of B as inventor inasmuch as B is not an inventor of the invention being claimed in the new application, and addition of C as an inventor. The request is accompanied by a new declaration under 37 CFR § 1.63 naming A and C as the inventors. The foregoing should be filed before an issue fee is paid in the prior application, or before the prior application is abandoned.
- (E) All of the above.

The correct answer is (C) and Petitioner selected answer (B). The question inquires which of four actions fulfills proper PTO practice and procedure for correcting inventorship. Choice (C) is the most correct answer because the procedure in (C) follows the practice set forth in 37 C.F.R. § 1.53(d), including subsection (d)(4). A newly executed oath or declaration is not needed inasmuch as none is required when a continuation application is filed under the continuing prosecution application procedure in § 1.53(d).

The procedure in answer (B) is incomplete because the petition fee has not been paid and the requirements of 37 C.F.R. §§ 1.48(a)(3) and 1.17(i) have therefore not been met. Petitioner argues that the fee omitted in answer (B) can be paid by way of a deposit account and the question does not specifically state that the practitioner did not have a deposit account or that general authorization to charge all fees to the deposit account was not filed with the application. However, the question seeks the best answer and, without reading facts into the answer choices, answer (C) is the most correct answer. Petitioner's argument is contrary to the express examination direction to "not assume any additional facts not presented in the questions." No error in grading has been shown.

Question 36 reads as follows:

36. Which of the following statements regarding a CPA application is correct?

- (A) A proper CPA division application is filed on August 17, 1998, where, on February 20, 1998, a final Office action setting a three month shortened statutory period for reply was mailed in a prior application; and on August 17, 1998, a request is filed by facsimile for a CPA division application of the prior application; the request, signed by the practitioner, includes an authorization to charge small entity fees under 37 CFR § 1.16 to a deposit account, identifies the correct application number of the prior application; and refers to and is accompanied by a preliminary amendment causing the CPA application to have two independent claims, and 12 dependent claims.
- (B) A CPA continuation application stands abandoned where, before the abandonment of a prior application wherein there was a final rejection, a request was filed in the PTO on December 8, 1997, for a CPA continuation application of the prior application; the request was filed without a filing fee; the PTO sent to the practitioner a Notice To File Missing Parts of Application dated December 17, 1997, requiring payment of the \$790.00 filing fee, and \$130.00 surcharge on or before February 17, 1998; and on July 17, 1998, the practitioner files a petition and check covering the fees for a five month extension of time, the filing fee, and surcharge.
- (C) An improper, as opposed to a proper CPA division application, has been filed where a Notice of Allowance and Issue Fee Due setting a three month statutory period for reply was mailed in a prior application on February 4, 1998; the issue fee was never paid; a completed request for a CPA division application was filed in the PTO on May 6, 1998, with a certificate of mailing by first class mail under 37 CFR § 1.8; the certificate is dated May 4, 1998; and the request correctly identifies the application number of the prior application and is signed by the practitioner.
- (D) A proper CPA continuation application has been filed where a provisional application was filed in the PTO on August 12, 1997; a completed request for a CPA continuation application was filed by hand delivery in the PTO on August 11, 1998; and the request correctly identifies the application number of the prior provisional application and is signed by the practitioner.

- (E) A design application may be properly filed as CPA divisional application of a prior utility application by filing, during the pendency of the prior utility application, a completed request, signed by the practitioner, which correctly identifies the application number of the prior application, together with a preliminary amendment canceling the original specification and substituting a design specification.

The correct answer is (C) and Petitioner selected answer (A). The question inquires which of five statements regarding a CPA application is correct. Choice (C) is the most correct answer because, as provided in 37 C.F.R. §§ 1.8 and 1.53, there is no continuity between the prior application and the CPA application. A certificate of mailing may not be used for filing a request for a continued prosecution application. 37 C.F.R. § 1.8(a)(2)(i)(A). The prior application became abandoned on May 5, 1998, for failure to pay the issue fee. 37 C.F.R. § 1.135(a); MPEP § 1306; 37 C.F.R. § 1.316; 35 U.S.C. § 151. The request was filed on May 6, 1998, after the prior application became abandoned. Thus, the request does not satisfy the requirement of 37 C.F.R. § 1.53(d) that the request be filed before the abandonment of the prior application. If continuity with the prior application cannot be established upon petition to revive, the application may be accorded a filing date upon petition under 37 C.F.R. § 1.53(e) to convert the application to a 37 C.F.R. § 1.53(b) application.

Answer (A) is not correct because in that choice, the CPA division application is improper, and should not be assigned a filing date. A CPA application must be filed before the abandonment of the prior application. 37 C.F.R. § 1.53 (d)(1)(ii)(B). The request for the CPA was filed in the sixth month after the Office action setting a three month shortened statutory period for reply. The authorization to charge small entity fees under 37 C.F.R. § 1.16 does not authorize payment of extension of time fees, which are

set in 37 C.F.R. § 1.17. The prior application became abandoned on May 21, 1998, for lack of a timely reply with an extension of time.

Petitioner argues that, when reciting the items included in answer (A), “not using the term ‘consists’ reasonably leads a reader to believe that an Extension of Time and request to charge the deposit account may have been included in the facsimile request.” This argument by Petitioner is directly contrary to the examination direction to “not assume any additional facts not presented in the questions,” and is therefore without merit. Petitioner also argues that after performing the acts set forth in answer (A), the practitioner would still have three days to file the missing items. However, the fact that subsequent facts can cure the deficiencies in answer (A) does not make answer (A) with its existing deficiencies a correct answer choice. Accordingly, answer (A) stands incorrect and this argument is similarly without merit. No error in grading has been shown.

Question 43 reads as follows:

43. Five different situations are presented below wherein the attorney of record calls an error to the attention of the examiner. Which request (or lack of request) by the attorney, and reply by the examiner is not in accord with proper PTO practice and procedure?

(A) An Office action dated February 11, 1998, and setting a three month shortened statutory period for reply was accompanied by a citation of references wherein a prior art patent was identified with an incorrect patent number. The attorney of record, on April 6, 1998, called the error to the attention of the examiner and requested that the examiner restart the reply period. The attorney should receive from the examiner a new citation of references correcting the error, a copy of the Office action redated, and a communication restarting the three month shortened statutory period for reply to run from the date the error is corrected.

- (B) A page of rejections is omitted from an Office action dated April 21, 1998, which set a three month shortened statutory period for reply. The attorney of record, on May 25, 1998, called the error to the attention of the examiner and requested that the examiner set a new reply period. The attorney should receive from the examiner a complete, redated Office action setting a three month shortened statutory period for reply to run from the date the error is corrected.
- (C) A copy of a patent reference is omitted from an Office action dated April 21, 1998, which set a three month shortened statutory period for reply. The attorney of record, on May 25, 1998, called the error to the attention of the examiner and requested that the reply period be reset. The attorney should receive from the examiner a copy of the omitted patent reference, and a communication resetting the reply period to be a two month shortened statutory period running from the date the error is corrected.
- (D) A copy of a patent reference was omitted from an Office action dated April 16, 1998, which set a three month shortened statutory period for reply. The attorney of record, on May 19, 1998, called the error to the attention of the examiner, but did not request that the examiner set a new reply period. The attorney should receive from the examiner a copy of the omitted patent reference with a letter noting that the time period set for reply remains as set forth in the Office action dated April 16, 1998.
- (E) A copy of a patent reference was omitted from an Office action dated March 9, 1998, which set a three month shortened statutory period for reply. The attorney of record, on July 14, 1998, called the error to the attention of the examiner and requested that the reply period be reset. The attorney should receive from the examiner a copy of the omitted patent reference with a letter noting that the time period set for reply remains as set forth in the Office action dated March 9, 1998.

The correct answers are (A) and (B) and Petitioner chose answer (C). The question presents five different situations wherein the attorney of record calls an error to the attention of the examiner and asks for the one that is not in accord with proper PTO practice and procedure. Answers (A) and (B) are the most correct answers. MPEP § 710.06 provides that “[i]f the error is brought to the attention of the Office within the period for reply set in the Office action but more than 1 month after the date of the Office

action, the Office will set a new period for reply, if requested to do so by the applicant, to substantially equal the time remaining in the reply period.” Since the errors in both (A) and (B) were called to the examiner’s attention more than one month after the date of the Office action, the Office would set a new period for reply “to substantially equal the time remaining in the reply period.” Under this practice, the time remaining in the response periods for both (A) and (B) should be set at two months. As such, reference in both (A) and (B) to a “three month shortened statutory period” is not in accord with proper PTO practice and procedure. MPEP § 710.06 also provides that the Office will set a new period for reply only if requested by the attorney. The new period must be a minimum of one month, and it runs from the date the error was corrected. MPEP § 710.06.

Answer (C) is in accordance with proper PTO practice as described in the first paragraph of MPEP § 710.06 which reads:

“ . . . For example, if the error is brought to the attention of the Office 5 weeks after mailing the action, then the Office would set a new 2 - month period for reply”

Accordingly, answer (C) is not a correct choice to the question reading “[w]hich request . . . is not in accord with proper PTO practice and procedure” (emphasis in original).

Petitioner argues that all answer choices should be given credit because the question has two correct answer choices. However, the question is not rendered ambiguous by the fact that there are two correct answers. The fact that two correct answers were provided gave Petitioner two opportunities to correctly answer the question. Petitioner does not urge that answers (A) and (B) comply with PTO practice and procedure.

Finally, Petitioner argues that answer (D) is also a correct answer choice to the question reading “[w]hich request . . . is not in accord with proper PTO practice and procedure” (emphasis in original). However, since Petitioner did not select answer (D), this argument fails to point out any error with respect to Petitioner’s answer choice, as required by 37 C.F.R. § 10.7(C). In view of the above, no error in grading has been shown.

Question 45 reads as follows:

45. The practitioner filed a patent application for inventor Jones on February 7, 1996. An Office action dated September 10, 1997, was a second action, final rejection of all the claims in the Jones application, and set a three month shortened statutory period for reply. On March 4, 1998, the practitioner filed a reply, containing an amendment and arguments which the practitioner and Jones believed would place the application in condition for allowance, a request for a three month extension of time, and the appropriate extension of time fee. In the ensuing different factual scenarios presented below, which course of action by the practitioner is in accord with proper PTO practice and procedure?

(A) The practitioner did not file a notice of appeal and appeal fee on or before March 10, 1998. An Advisory action dated March 24, 1998, informed the practitioner that the amendment was not entered, and a Notice of Abandonment dated April 11, 1998, informed the practitioner that the application was abandoned. Thereafter, the practitioner should file, on or before Monday, July 13, 1998, a petition to revive the application as unintentionally abandoned, together with the appropriate petition fee, a notice of appeal and appeal fee, and a statement that the entire delay in filing the notice of appeal and fee from the due date for the reply until the filing of a grantable petition was unintentional.

- (B) The practitioner did not file a notice of appeal and appeal fee on or before March 10, 1998. An Advisory action dated March 24, 1998, informed the practitioner that the amendment was not entered. A Notice of Abandonment dated April 11, 1998, informed the practitioner that the application was abandoned. Thereafter, the practitioner should file, on or before Monday, July 13, 1998, a petition to revive the application as unavoidably abandoned, together with the appropriate petition fee, a notice of appeal and appeal fee, and a statement that the entire delay in filing the notice of appeal and fee from the due date for the reply until the filing of a grantable petition was unavoidable since it was believed that the reply placed the case in condition for allowance, and notice to the contrary was not given until after expiration of the reply period and any available extension thereof.
- (C) The practitioner did not receive a Notice of Allowance and Issue Fee Due dated March 24, 1998, mailed to him. However, the practitioner did receive a Notice of Abandonment dated July 11, 1998, informing him of the application's abandonment for nonpayment of the issue fee. Thereafter, the practitioner should file, on or before October 11, 1998, a petition to revive the application as unavoidably abandoned, together with the appropriate petition fee, a continuing application, and a statement that the entire delay in filing the continuing application from the due date for filing an issue fee until the filing of a grantable petition was unavoidable.
- (D) The practitioner, after receiving a Notice of Allowance and Issue Fee Due dated March 24, 1998, was informed by Jones not to pay the issue fee until the industry or a competitor showed interest in the invention. The practitioner received a Notice of Abandonment dated July 11, 1998, advising of the application's abandonment for nonpayment of the issue fee. Jones advised the practitioner on August 24, 1998, that such interest was expressed to Jones on the preceding day. Thereafter, the practitioner should file, on or before Monday, November 9, 1998, a petition to revive the application as unavoidably abandoned, together with the appropriate petition fee, and issue fee, and a statement that the entire delay in filing the issue fee from the due date for the fee until the filing of a grantable petition was unavoidable.
- (E) All of the above.

Answer (A) is the most correct choice and Petitioner selected answer (D).

Answer (A) is most correct because after the final rejection issued, the applicant failed to file a reply in the form of a notice of appeal. Accordingly, the practitioner had to then

seek revival of the application by filing a petition to revive, the petition fee, a notice of appeal, the appeal fee, and a statement of unintentional delay, pursuant to 37 C.F.R. § 1.137(b).

Answer (D) is not correct because the facts show that the delay was avoidable since they were waiting “until the industry or a competitor showed interest in the invention.” Accordingly, filing a petition to revive for “unavoidable” delay would be inappropriate. See 37 C.F.R. § 1.137(a)(3) (requiring “[a] showing to the satisfaction of the Commissioner that the entire delay . . . was unavoidable”). The practitioner could not, with credibility, state that the particular delay recited in answer (D) was unavoidable.

Petitioner argues that the question and answer (A) are misleading because the inventor and practitioner believed the application to be in condition for allowance, but the facts do not show that the abandonment was unintentional. However, the practitioner was not avoiding prosecution, as in answer (D), but chose the option of filing an amendment hoping to persuade the examiner. It is clear from the question and answer (A) that the practitioner and the inventor did not intend abandonment in view of the fact that they were pursuing prosecution. Accordingly, this argument by Petitioner is without merit and no error in grading has been shown.

Question 48 reads as follows:

48. Jack loved to tinker with electrical gadgets in his youth, but adulthood and the responsibilities of a job and a family forced him to spend his time with other pursuits. Retirement, however, opened the door to renew his passion for tinkering, and soon he began to spend so much time at his pastime that he developed a reputation as an eccentric among his friends and neighbors. One day, while Jack was tinkering in his homemade shop and his wife, Jill, was entertaining relatives, Bruce, a visiting relative and a registered patent attorney, wandered into Jack's shop, and soon became entranced with one of the gadgets that Jack had invented. Bruce informed Jack that his invention appeared to be patentable and that he, Bruce, would be delighted to obtain patent protection for Jack for no more than the expenses involved, and that he, Bruce, could probably arrange to market the invention for little more than the effort involved in making a few phone calls. After very little persuasion, Jack retained Bruce to patent the invention, insisting, however, that he be permitted to review the final draft of the application, that he be consulted at every step of the prosecution, and that no prosecution decision be made without his concurrence. Bruce agreed, and thereupon prepared and filed a patent application naming Jack as sole inventor. Subsequently, Bruce succeeded in negotiating the sale of Jack's entire interest in the invention to the Star Financial Group, which in turn conveyed an exclusive license in the invention to the Omega Electrical Corporation. Both the assignment to Star and the license to Omega were properly executed and recorded in the PTO. According to proper PTO practice and procedure, which of the following statements is true?

- (A) Omega may intervene in the prosecution of Jack's patent application and appoint a patent attorney other than Bruce without Jack's consent.
- (B) Omega may intervene in the prosecution of Jack's patent application and appoint a patent attorney other than Bruce, and specifically request that Jack be excluded from access to his patent application file.
- (C) Star may intervene in the prosecution of Jack's patent application and appoint a patent attorney other than Bruce, and specifically request that Jack be excluded from access to his patent application file.
- (D) Omega may intervene in the prosecution of Jack's patent application and appoint a patent attorney other than Bruce, and specifically request that Jack be excluded from access to his patent application file, but Jack may be permitted to inspect the file on sufficient showing why the inspection is necessary to conserve his rights.

- (E) Star may intervene in the prosecution of Jack's patent application and appoint a patent attorney other than Bruce, and specifically request that Omega be excluded from access to his patent application file.

Answer (C) is the most correct choice and Petitioner selected answer (E).

Answer (C) is true because Star is the assignee of record of the entire interest in Jack's patent application and may therefore "conduct the prosecution of the patent application to the exclusion of the named inventor or previous assignee." 37 C.F.R. § 3.71.

See also MPEP § 106:

"The assignee of record of the entire interest in an application may intervene in the prosecution of the case, appointing an attorney of his or her own choice. (See 37 CFR 3.71.) Such intervention, however, does not exclude the applicant from access to the application to see that it is being prosecuted properly, unless the assignee makes specific request to that effect."

Answer (E) is not correct because Omega is an exclusive licensee and may not be excluded from access to Jack's patent application file. See MPEP § 106.01:

"While it is only the assignee of record of the entire interest who can intervene in the prosecution of an application or interference to the exclusion of the applicant, an assignee of a part interest or a licensee of exclusive right is entitled to inspect the application."

(Emphasis added).

Petitioner argues that Star may "request" that Omega be excluded from access to his patent application file notwithstanding the fact that, pursuant to MPEP § 106.01, the request would be futile since Omega is entitled to inspect the application. This argument is without merit since making a futile request does not make answer (E) a more correct choice than answer (C). In fact, Petitioner does not even dispute the fact that answer (C)

complies with proper PTO practice and procedure. Accordingly, no error in grading has been shown.

ORDER

For the reasons given above, no points have been added to Petitioner's score in the Morning Section of the Examination. Therefore, Petitioner's score remains at 56. This score is insufficient to pass the Morning Section of the Examination.

Upon consideration of the petition to the Commissioner for a regrade, it is ORDERED that the petition be denied.

This is a final agency action.

AUG 19 1999



Q. Todd Dickinson
Acting Assistant Secretary of Commerce and
Acting Commissioner of Patents and Trademarks