

**Patent Practice and Procedure II
Final Exam – Spring 2006**

Instructions:

Put your Student ID number on this Exam Booklet and on the Scantron™ answer sheet. Turn in both.

This Exam is CLOSED BOOK. You may NOT use the MPEP, course materials, notes, outline, or anything else. You may not use a computer. You may use a hand-held English-Foreign-English dictionary, if such is not on your computer.

This exam is entirely multiple-choice. Fill in completely the bubble on your Scantron™ answer sheet that you believe corresponds to the BEST choice. On matters of law, pick the correct answer. On matters of judgment or strategy, pick the choice Professor Jepson would pick. Use only a No. 2 pencil to fill in the bubbles. Make no stray mark. Erase completely. Incomplete erasures and stray marks are counted as incorrect responses by a machine. We will not hand check. THIS IS YOUR RESPONSIBILITY. Your score will be the number correct. There is no penalty for guessing.

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- 1) Pursuant to 37 CFR 1.133(b), whose responsibility is it to make the substance of an interview of record in the application file when the interview was initiated by the applicant?
- a) Examiner.
 - b) Applicant.
 - c) Office.
 - d) Commissioner.
 - e) Director.
- 2) A complete and proper recordation of the substance of the interview, which is defined in MPEP § 713.04 does not include which of the following?
- a) A copy of the references discussed.
 - b) A brief description of the nature of any exhibit shown or any demonstration conducted;
 - c) Identification of the claims discussed;
 - d) Identification of specific prior art discussed;
 - e) Identification of the principal proposed amendments of a substantive nature discussed.
- 3) PTOL413A does not include?
- a) A list of participants.
 - b) A warning that the application may be delayed if applicant fails to submit a written record.
 - c) A list of references to be discussed.

- d) A list of claims to be discussed.
 - e) A brief description of any exhibit to be demonstrated.
- 4) Which of the following is inconsistent with current Office policy:
- a) There is a great emphasis on telephone interviews initiated by the examiner.
 - b) Examiners are not required to note or acknowledge requests for telephone calls
 - c) It is desirable for an attorney to call the examiner if the attorney feels the call will advance prosecution.
 - d) The presence of the applicant or his attorney is neither necessary nor requested.
 - e) It is necessary for an attorney to request a telephone interview.
- 5) What chapter of the MPEP covers Interference?
- a) 600
 - b) 800
 - c) 1200
 - d) 1500
 - e) 2300
- 6) What chapter of the MPEP covers Examination?
- a) 600
 - b) 700
 - c) 800
 - d) 1500
 - e) 2200
- 7) Building on an information disclosure and subsequent interview notes, you conceive of several enlargements on your Clients' initial ideas, you should:
- a) Keep them under your hat.
 - b) Tell your client about them and say you are giving them to her as a gift.
 - c) Claim them in your own name, in other words as a co-inventor.
 - d) File your own patent in your own name.
 - e) Claim them for your inventor and review the claims with
- 8) If you are on vacation skiing at Whistler, B.C. and staying at the Fairmount Chateau from Monday through Friday, but your amendment is due in Alexandria, Virginia on that same Friday, what can you do without leaving the slopes?
- a) There is nothing.
 - b) Ask for an extension.
 - c) Insist that the PTO must be wrong about the date.
 - d) Use a Certificate of Mailing.
 - e) Use Express Mail.

9) In the second complete sentence of your Brief Description of the Drawings, which describes your FIG. 1, the use of which of the following words is both optional and advisable?

- a) Perspective
- b) View
- c) Exploded
- d) Critical
- e) Embodiment

10) Which of the following is not required for compliance with Rule 321(d)?

- a) Comply with sections 321(b)(2) - (b)(4).
- b) Signed by rejected in accordance with 321.
- c) Signed by disqualified.
- d) Waives the right to separately enforce and license the rejected.
- e) Agree that such waiver shall not be binding upon the owner of rejected, its successors, or assigns, and the owner of the disqualified, its successors, or assigns.

11) Which of the following is not authorized to sign under Rule 321(b):

- a) Applicant
- b) Applicant and assignee of record of an undivided part interest
- c) Assignee of record of the entire interest
- d) Attorney or agent of record
- e) Co-inventor

12) What stands for this proposition: "acts in a foreign country are not to defeat the rights of applicants for patents, except as applicants may become involved in priority disputes."

- a) 35 USC § 102(e), the older version.
- b) 35 USC § 102(e), the current version.
- c) 35 USC § 351.
- d) Both "a" and "c".
- e) *In re Hilmer*, 359 F.2d 859 (C.C.P.A. 1966).

13) If an International Application has a filing date that is not a U.S. filing date for prior art purposes, then any earlier U.S. filing dates for which benefit is claimed by the International Application are:

- a) § 102(e) filing dates
- b) § 102(e) filing dates for the publication
- c) May be § 102(e) filing dates

- d) Not § 102(e) prior art dates
e) None of the above are always true



US 20040204800A1

(19) **United States**
(12) **Patent Application Publication** (10) **Pub. No.: US 2004/0204800 A1**
Honda (43) **Pub. Date: Oct. 14, 2004**

<p>(54) ELECTRONIC CONTROL UNIT FOR A VEHICLE</p> <p>(75) Inventor: Takayoshi Honda, Kariya-city (JP)</p> <p>Correspondence Address: NIXON & VANDERHYE, PC 1100 N GLEBE ROAD 8TH FLOOR ARLINGTON, VA 22201-4714 (US)</p> <p>(73) Assignee: DENSO CORPORATION, Aichi-pref (JP)</p> <p>(21) Appl. No.: 10/816,936</p> <p>(22) Filed: Apr. 5, 2004</p> <p>(30) Foreign Application Priority Data Apr. 11, 2003 (JP) 2003-108116</p>	<p>Publication Classification</p> <p>(51) Int. Cl.⁷ G06F 17/00 (52) U.S. Cl. 701/1</p> <p>(57) ABSTRACT</p> <p>In an electronic control unit for a vehicle, control data is stored in a volatile memory until a predetermined time passes after an ignition switch is turned off. This makes it possible to greatly reduce the frequency at which data is written into a nonvolatile memory. When the predetermined time has passed after the ignition switch is turned off, the control data stored in the volatile memory is written into the nonvolatile memory. Thereafter, the power supply from a power supply circuit to the volatile memory is stopped. Consequently, it is possible to store the control data reliably in either the volatile memory or the nonvolatile memory. It is also possible to reduce the dark current in the volatile memory.</p>
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14) Reproduced above is the cover sheet for US 2004/0204800. If a patent issues from this, when does it expire?

- a) October 14, 2024
b) April 5, 2024
c) April 5, 2023
d) April 11, 2023
e) April 11, 2024

15) Reproduced above is the cover sheet for US 2004/0204800. What is the 111(a) date?

- a) There is none.
b) April 5, 2004
c) April 5, 2003
d) April 11, 2003
e) April 11, 2004

16) Reproduced above is the cover sheet for US 2004/0204800. What is the 111(b) date?

- a) There is none.
b) April 5, 2004
c) April 5, 2003

- d) April 11, 2003
- e) April 11, 2004

17) Reproduced above is the cover sheet for US 2004/0204800. What is the 102(e) date?

- a) There is none.
- b) April 5, 2004
- c) April 5, 2003
- d) April 11, 2003
- e) April 11, 2004

18) *Snow v. Lake Shore & Mich. S. Ry. Co.*, 121 U.S. 617, 629-30 (1887) (We reject the argument "that this language is to be taken as a mere recommendation by the patentee of the manner in which he prefers to arrange these parts of his machine. There is nothing in the context to indicate that the patentee contemplated any alternative for the arrangement of the piston and piston-rod."). This is:

- a) The All Elements Rule.
- b) The Contemplated Alternatives Rule.
- c) The Nose of Wax Case
- d) Inconsistent with *Phillips v AWH*.
- e) Consistent with *Phillips v AWH*.

19) United States Patent 6,456,778 issued March 12, 2002 from PCT PCT/US98/14056, which had a 371 date of Jan. 14, 2000 and was published in English by the PCT on Jan. 28, 1999 based on a PCT filing of Jul. 8, 1998 from a provisional application filed Jul. 14, 1997. What is International filing date?

- a) July 14, 1997.
- b) July 8, 1998.
- c) Jan. 28, 1999.
- d) Jan. 14, 2000.
- e) March 12, 2002.

20) United States Patent 6,456,778 issued March 12, 2002 from PCT PCT/US98/14056, which had a 371 date of Jan. 14, 2000 and was published in English by the PCT on Jan. 28, 1999 based on a PCT filing of Jul. 8, 1998 from a provisional application filed Jul. 14, 1997. What is the 102(e) date?

- a) July 14, 1997.
- b) July 8, 1998.
- c) Jan. 28, 1999.
- d) Jan. 14, 2000.
- e) March 12, 2002.

21) United States Patent 6,456,778 issued March 12, 2002 from PCT PCT/US98/14056, which had a 371 date of Jan. 14, 2000 and was published in English by the PCT on Jan. 28, 1999 based on a PCT filing of Jul. 8, 1998 from a provisional application filed Jul. 14, 1997. What is the 111(b) date?

- a) July 14, 1997.
- b) July 8, 1998.
- c) Jan. 28, 1999.
- d) Jan. 14, 2000.
- e) There is none.

22) United States Patent 6,456,778 issued March 12, 2002 from PCT PCT/US98/14056, which had a 371 date of Jan. 14, 2000 and was published in English by the PCT on Jan. 28, 1999 based on a PCT filing of Jul. 8, 1998 from a provisional application filed Jul. 14, 1997. What is the 111(a) date?

- a) July 14, 1997.
- b) July 8, 1998.
- c) Jan. 28, 1999.
- d) Jan. 14, 2000.
- e) There is none.

23) United States Patent 6,456,778 issued March 12, 2002 from PCT PCT/US98/14056, which had a 371 date of Jan. 14, 2000 and was published in English by the PCT on Jan. 28, 1999 based on a PCT filing of Jul. 8, 1998 from a provisional application filed Jul. 14, 1997. What is best prior art date?

- a) July 14, 1997.
- b) July 8, 1998.
- c) Jan. 28, 1999.
- d) Jan. 14, 2000.
- e) There is none.

24) The Board reverses all of the Examiner's rejections, but adds a new rejection of all of your claims. You submit an amendment. Examiner submits a Supplemental Examiner's Answer. What do you do?

- a) File, within one month, an appropriate Reply Brief.
- b) Appeal the new rejection by the Board to the Board.
- c) Petition the Commissioner requesting that the claims be either allowed or rejected by Examiner.
- d) Request reconsideration of the Board's decision.
- e) Request that the Board again assume jurisdiction of the application so that the basis of the new rejection may again be reviewed in view of the amendment and the Examiner's reasons for not allowing the claims as amended.

- 25) Is there a rule that business with the Office has to be transacted in writing?
- a) No, you can telephone.
 - b) No, you can telephone or email.
 - c) Yes, Rule 2.
 - d) Yes, 35 USC § 21.
 - e) Yes, MPEP § 202.
- 26) Where a regulation does not set forth the time period in which a petition must be filed, the time period is
- a) 30 days.
 - b) One month.
 - c) Two months.
 - d) Three months
 - e) At the discretion of the Examiner.
- 27) A signature on a paper submitted to the Office:
- a) Means nothing.
 - b) Constitutes an acknowledgment that willful false statements are punishable under 18 U.S.C. 1001, and may jeopardize the validity of the application or any patent issuing thereon.
 - c) Identifies the Registered Attorney or Agent, but does not vouch for any statement of facts.
 - d) Identifies the Registered Attorney or Agent, but does not vouch for any representations of law.
 - e) Means that the facts are verified.
- 28) You want to expunge certain trade secret information from an application file. You submitted as an exhibit that now you realize you did not need. Which of the following would you NOT include in your Rule 59 Petition?
- a) Clear identification of the information to be expunged.
 - b) Statement that the materials constitute a trade secret.
 - c) An averment that the information to be expunged has not otherwise been made public.
 - d) A fee.
 - e) An acknowledgement that you made a mistake.
- 29) What decision stands for the proposition that when an applicant describes in the specification a particular embodiment of an invention as the "claimed invention," and not just one of many embodiments, the result in litigation may be that none of the claims may be entitled to a scope broader than that described embodiment?

- a) *In Re Costello*, 717 F.2d 1346 (Fed. Cir. 1983)
- b) *In re Asahi/America, Inc.*, 68 F.3d 442 (Fed. Cir. 1995)
- c) *Networld LLC v. Centraal Corp.*, 242 F.3d 1347 (Fed. Cir. 2001)
- d) *In re Rozmus*, 928 F.2d 412 (Fed. Cir. 1991)
- e) *Tyler Refrigeration v. Kysor Industrial Corp.*, 777 F.2d 687 (Fed. Cir. 1985)

30) In an Amendment made during Reexamination, which of the following sentences is best?

- a) However, as claimed, the illuminated toothbrush directs bactericidal light and starts to kill bacteria after a few seconds.
- b) As claimed, however, the illuminated toothbrush directs bactericidal light and starts to kill bacteria after a few seconds.
- c) However, as claimed, the illuminated toothbrush directs bactericidal light and kills all harmful bacteria after two seconds.
- d) As claimed, however, the illuminated toothbrush directs bactericidal light and kills all harmful bacteria after two seconds.
- e) However, as we are claiming, the illuminated toothbrush directs bactericidal light and kills all harmful bacteria after two seconds.

31) When responding to a Rejection in an Office Action, you should

- a) Address your argument to all the claims
- b) Address your argument to all the claims having the words at issue
- c) Address your argument to the invention
- d) Address your argument to the claim at issue.
- e) Address your argument to the preferred embodiments.

32) When responding to an Objection in an Office Action, you should

- a) Address your argument to all the claims
- b) Address your argument to all the claims having the words at issue
- c) Address your argument to the invention
- d) Address your argument to the claim at issue.
- e) Address your argument to the preferred embodiments.

33) What a reference teaches is a question of:

- a) Law
- b) Fact
- c) Mixed law and fact
- d) Law based on underlying questions of fact
- e) Fact before the PTO, law on appeal

34) Prima facie obviousness is a question of:

- a) Law

- b) Fact
- c) Mixed law and fact
- d) Law based on underlying questions of fact
- e) Fact before the PTO, law on appeal

35) To establish that a reference is nonanalogous, Professor Jepson would most likely use a:

- a) Rule 181 Petition.
- b) Rule 132 Declaration.
- c) Rule 182 Petition.
- d) Rule 131 Affidavit.
- e) Rule 130 Declaration.

36) There can be no motivation or suggestion to combine the prior art when:

- a) The inventor was not aware of that art.
- b) There is no express suggestion in the art to combine.
- c) The one piece of art disparages another piece and the two are needed to make the proposed combination.
- d) The inventor did not rely upon the art.
- e) One of the pieces teaches away from any combination.

37) In the *Iron Grip Bar Bell* case, the district court used the “overall picture” and “common sense” test. That test is:

- a) Susceptible to hindsight trap.
- b) Equivalent to the Deere three part test.
- c) Equivalent to the Deer four part test.
- d) Equivalent to the suggestion, motivation, teaching test.
- e) None of the above.

38) An Examiner may rely upon common knowledge for a rejection based on obviousness:

- a) Never
- b) Where facts outside of the record are capable of instant and unquestionable demonstration as being “well-known” in the art.
- c) If the Examiner can state the data specifically.
- d) Only in areas of esoteric technology.
- e) Anytime.

39) If you protest to the Commissioner what you perceive as unfair treatment at the hand of the Examiner, you do so by way of.

- a) Petition.

- b) Appeal.
- c) Motion.
- d) Hearing.
- e) Writ.

40) If your Examiner twice rejects your Claim 1, which you have never amended, you may take the patentability of Claim 1 by ____ to the Federal Circuit.

- a) Petition.
- b) Appeal.
- c) Motion.
- d) Hearing.
- e) Writ.

41) At the USPTO, "Expectancy" means:

- a) The number of hours per balanced disposal.
- b) The time it takes to get the First office Action..
- c) The actual examiner time to Allowance (does not include time Application takes to respond to Office actions).
- d) The actual time to Allowance (does include time Application takes to respond to Office actions).
- e) How many counts an Examiner is expected to get per pay period based on her GS status.

42) The first paragraph of a Rule 132 Affidavit typically would contain:

- a) A description of the subject matter of the Application.
- b) A description of the invention.
- c) A description of the claimed invention at issue in the underlying Rejection.
- d) A description of Affiant.
- e) An Oath.

43) The first day a Preliminary Amendment may be sent is:

- a) The filing date.
- b) The received date.
- c) The day after the filing date.
- d) The day before the First office Action is mailed.
- e) The day the First Office Action is mailed.

44) A preliminary amendment in compliance with ____ will be entered unless disapproved by the Director:

- a) 37 CFR §1.56
- b) 37 CFR §1.130

- c) 37 CFR §1.121
- d) 35 USC §134
- e) *Ex parte Quayle*.

45) A preliminary amendment seeking cancellation of all the claims without presenting any new or substitute claims will be:

- a) Disapproved.
- b) Approved.
- c) Entered.
- d) Objected to.
- e) Held in Abeyance.

46) For purposes of an Appeal within the PTO, the term "Affidavit" means:

- a) Affidavit
- b) Declaration under 37 CFR §1.68
- c) Declaration under 28 U.S.C. §1746
- d) A transcript of an ex parte deposition
- e) All the above

47) For purposes of an Appeal within the PTO, the term "Party" means:

- a) A petitioner.
- b) An appellant.
- c) Counsel for any of the above.
- d) A participant in a contested case.
- e) Any and all the above.

48) The fees for filing a Notice of Appeal, an Appeal brief, and a Request for Oral Argument will cost Intel:

- a) \$10,000.00.
- b) \$2,000.00.
- c) \$1,000.00.
- d) \$500.00.
- e) \$250.00

49) You filed for Appellant a Notice of Appeal on July 1, 2006 from a final Office action mailed June 1, 2006 and that set a 3-month shortened statutory period for reply. You then filed an Appeal Brief compliant with the Rule 41.37 on September 15, 2006. You:

- a) Are good to go.
- b) Need a one month extension.
- c) Need a two month extension.
- d) Need a three month extension.

e) Need an RCE.

50) Applicant receives final Office action March 1, 2001, rejecting all remaining claims. Examiner gives six months to respond. On May 1, Applicant files Notice of Appeal. When is Appeal Brief due?

- a) Two months from Final.
- b) Two months from Notice of Appeal.
- c) Five months from Final.
- d) Six months from Final.
- e) Sixty days from Notice of Appeal.

51) Five claims are before the Board. Two were allowed by Examiner. The Board hands down a new ground of rejection of the three claims on appeal. Which is not an appropriate response?

- a) Submit a showing of facts and have the matter reconsidered by the examiner.
- b) Request reconsideration by the Board.
- c) Accept the decision of the Board and file an amendment canceling the rejected claims.
- d) Petition the Commissioner to have the rejection withdrawn as being improper because prosecution of the application is closed.
- e) Amend only the claims rejected on the new grounds.

52) You tell your client that the Board rejected all claims. Client tells you that the latest sales figures show that his invention is highly successful. To have these figures considered, you should?

- a) Timely appeal to U.S. District Court for the District of Columbia.
- b) File a reissue application.
- c) Timely appeal to the Federal Circuit.
- d) File a Substitute Application.
- e) Request Reexamination.

53) Issue fee has been paid. The application will issue on May 3, 2004. April 13, 2004, you learn of a reference that would anticipate just claim 1. What, if anything, do you do?

- a) Wait for Issue, then file a Request for Reissue.
- b) Petition requesting withdrawal from issue so reference can be considered in a continuation application.
- c) File IDS disclosing reference.
- d) Petition requesting withdrawal stating that reference raises a serious question of patentability and explain why reference was not earlier presented.
- e) Petition requesting Examiner to consider the patentability of claim 1 over the reference.

54) Which is true regarding Reissues?

- a) New matter may be added only to correct an error.
- b) A reissue patent may be granted enlarging the scope of the original patent claims if applied for three years from the date of the grant of the original patent.
- c) Only one reissue patent is permitted to be issued for distinct and separate parts of the thing patented.
- d) A reissue patent application and all amendments thereto should be prepared using cut-up soft copies of the original patent, with only a single column of the printed patent mounted on a separate sheet of paper.
- e) You must claim priority in the reissue patent application even if a claim was made in the application on which the original patent was granted

55) The “ethics” rules that govern your behavior prosecuting patents as a registered patent attorney are:

- a) 35 USC 10 et seq.
- b) 37 CFR 10.00 et seq.
- c) 28 USC 1000 et seq.
- d) ABA Rules of Professional Responsibility
- e) The Model Rules

56) Patent has issued, what can you change by a certificate of correction?

- a) Add another example to illustrate the best mode.
- b) Correct a typographical error.
- c) Add claims of a narrower scope.
- d) Correct test data in the specification for experiment that was finally done correctly after issuance.
- e) Add a drawing of another embodiment of the disclosed invention.

57) An Appeal from the Board in an Interference goes to:

- a) Federal Circuit
- b) USDC District of Columbia
- c) Any USDC
- d) Federal Circuit, or, USDC District of Columbia
- e) Federal Circuit, or, any USDC

58) A Section 291 Action is for:

- a) Interfering application claims
- b) Interference between claims in an application and claims in a patent.
- c) Interfering patents.
- d) Dropping prior art into an application file anonymously.
- e) Dropping prior art into a patent file anonymously.

59) To get into an interference, each party must have:

- a) A pending application
- b) One allowable claim
- c) Identical disclosures
- d) Both "a" and "b"
- e) All the above

60) An abandoned United States patent application:

- a) Is never available as evidence of prior art.
- b) May become prior art only if it is properly incorporated by reference in the disclosure of a United States patent.
- c) May become prior art as of its filing date, but only if it is properly incorporated by reference in the disclosure of a United States patent.
- d) May become evidence of prior art as of its filing date, but only if it is properly incorporated by reference in the disclosure of a United States patent or United States application publication.
- e) May become prior art when it is properly incorporated by reference in the disclosure of a United States application publication.

End of Examination.