

Patent Bar Exam Prep Workbook

Patent Education Series™

Copyright © 2003 - 2014

INTELLECTUAL PROPERTIES ENTERPRISES, INC

Patent Bar Exam Prep Workbook
Copyright © 2003-2014 by Intellectual Properties Enterprises, Inc

All rights reserved. No part of this work may be reproduced or transmitted in any form or by any means, electronic or mechanical, including photocopying, recording, or by any information storage or retrieval system, without the written permission of the copyright owner.

Every precaution has been taken to ensure that the information presented in this book is accurate. However, neither the author nor Intellectual Properties Enterprises, Inc shall have any liability to any person or entity with respect to any loss or damage caused or alleged to be caused directly or indirectly by the information contained within this work. The information is presented on an “as is” basis, there is no warranty.

Contact info: Intellectual Properties Enterprises, Inc
website: www.patenteducationseries.com

A few words about this book

The Patent Bar Exam Prep Workbook is a study aid for those preparing to take the patent bar examination. This exam covers topics found in the Manual of Patent Examination Procedure (MPEP) 9th Edition as of October 4th, 2014. The Workbook was designed to serve as a stepping stone between the material presented in the MPEP and the actual patent bar exams. You will gain the most by mastering the material covered in the MPEP first (or an additional study aid) and then attempting the Prep Workbook.

In addition to the Prep Workbook, Intellectual Properties Enterprises, Inc offers a complete line of products to help you prepare for the exam. You will find more information explaining the Patent Education Series™ and our current offerings at our website:

www.PatentEducationSeries.com

The best way to use the Patent Bar Exam Prep Workbook is to gain access to a copy of the online MPEP (you can visit the USPTO.gov website for this) and then use the MPEP to find the answer to each question.

Completing the Workbook activities will be beneficial to you in two ways. First, by answering the questions, you will learn the subject matter sure to be on the test. Second, you will become exceedingly familiar with the location of the topics within the MPEP, enabling you to look up your answers quickly on test day when you have access to the MPEP. Both skills are essential to achieving a passing score on the patent bar. The questions in the Workbook are painstakingly detail oriented, but that is just what you need to prepare for the patent bar exam.

Contact info for IP Enterprises:

Url:	www.patenteducationseries.com
-------------	---

Hello,

Thank-you for purchasing the Patent Bar Exam Prep Workbook. I hope you will 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™. You may contact us at www.patenteducationseries.com (current contact information will be presented there for you on the 'contact us' page).

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 of Intellectual Properties Enterprises, Inc
Founder of PatentEducationSeries.com

October, 2014

Table of Contents

General Information	7
MPEP Chapter Review	13
100 Secrecy, Access, National Security and Foreign Filing	15
200 Types, Cross-Noting and Status of Application	25
300 Ownership and Assignment	39
400 Representative of Applicant or Owner	47
500 Receipt and Handling of Mail and Papers	55
600 Parts, Form and Content of Application	67
700 Examination of Applications	87
800 Restriction in Applications Filed Under 35 USC 111; Double Patenting	105
900 Prior Art, Classification, Search	113
1000 Matters Decided by Various USPTO Officials	115
1100 Statutory Invention Registration (SIR) and Pre-Grant Publication (PGPub) and Preissuance	117
1200 Appeal	127
1300 Allowance and Issue	137
1400 Correction of Patents	143
1500 Design Patents	159
1600 Plant Patents	169
1700 Miscellaneous	173
1800 Patent Cooperation Treaty	175
1900 Protest	183
2000 Duty of Disclosure	187
2100 Patentability	191
2200 Citation of Prior Art and <i>Ex Parte</i> Reexamination of Patents	203
2300 Interference Proceedings	223
2400 Biotechnology	231
2500 Maintenance Fees	235
2600 Optional <i>Inter Partes</i> Reexamination	241
2700 Patent Terms and Extensions	261
2800 Supplemental Examination	269
Appendix I Prior Art Rejections	275
Appendix II 35 U.S.C. 102 Rejections	283
Appendix III 35 U.S.C. 103 Rejections	307
Appendix IV Disqualify Prior Art	321
Appendix V 35 U.S.C. 112 Specification Requirements	333
Feedback/Comments	344

General Information

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

Who can take the exam?

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

Check out the official PTO website at:

www.uspto.gov/web/offices/dcom/gcounsel/oed.htm - for further information regarding the specific requirements.

Tables of degrees for patent bar exam:

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

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

**must be from an accredited program*

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

If you don't have one of the specified science or engineering degrees, you will need to submit official transcripts listing every college level course you have taken (copies will not suffice, you need the originals). In addition, the PTO requires you send in a copy of the appropriate catalog cover along with the pages describing the particular courses you took.

If you are substituting training, certifications or work experience in lieu of education, you will need to send in official forms and/or work contracts. Of course, the PTO will take their time scrutinizing all of

this. Be prepared that it may take them a little longer to sort through your application if you do not have one of the specified science or engineering degrees.

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

What is the process for becoming a patent practitioner?

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

Instead of thinking of this hurdle as simply passing a test, it will serve you well to consider it more as taking a college course. Learning what you need to know of patent law in order to pass the Patent Bar exam is at minimum what you would expect to study in a college course for a full semester. You can't just spend a couple of weeks studying and expect to pass, it's a much more involved process than that.

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

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

Even with this requirement however, passing the Patent Bar and gaining your registration as a Patent Practitioner is well worth the effort. An entire new career door is opened for you by passing this test.

When are the tests offered?

The patent bar exam is administered via computer, so you will be able to schedule your own test date. That means you can study for the exam, and then apply to take it. We suggest that you do not wait until you are accepted to begin studying. Remember, you will have to take the exam within the 90-day window period and that period will begin as soon as you are accepted. If you wait to prepare until you have been accepted, you may find yourself not quite ready for the exam even at the end of the 90-days. We suggest that you first learn the fundamentals of Patent Law and begin learning the details with our course and this

Prep Workbook. Once you've completed reading and working through the exercises only then should you consider applying for the exam. That way you will have plenty of time left to work through previous exam questions. If you go into this prepared, it may be possible for you to schedule the exam, take it, and pass it all within days of receiving your official acceptance notice.

Where do I take the exam?

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

How do I prepare for the exam?

The patent bar exam is fairly difficult, but it is far from impossible. Fortunately, the test is predictable. It covers the same basic points from the Manual of Patent Examination Procedure (MPEP) each time.

However, without knowing which points will be tested, the exam may become virtually unmanageable as the Patent and Trademark Office (PTO) always tests over incredibly minute details found within the thousands of pages of the MPEP.

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

The patent bar exam recycles some old questions, sometimes even word for word. Therefore, reviewing old exams is one of the best ways to prepare yourself. We've created other study aids for you that include hundreds of previously tested PTO exam questions along with many we have created covering new material.

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

The test is considered open book since you will have access to an online MPEP, but this is a little misleading. Since the test is timed, you may not have time to look up very many of the answers. The PTO can ask any question within the realm of the MPEP. This encompasses thousands of pages worth of materials.

In addition, a single question on the patent bar exam may cover several separate topics. A test taker without a good understanding of these topics might have to madly skim through several rules and laws to check that he or she put down the right response. When the PTO has a question relating to only a single topic, the question itself will take up nearly the entire page, requiring you to spend several minutes just reading through the Hemmingway-like story they have crafted in order to confuse you. The PTO is notorious for putting in material that is irrelevant to the answer just to hold up the unsuspecting test taker.

The best advice...go in as prepared as possible. The MPEP is a very cumbersome tool for looking up answers. You just won't have the time to check many answers out at all. Therefore, learn as much of the material as you can and expect to rely on the MPEP for the rest.

What do I do if I fail the test?

Whatever you do, don't give up. There is no disgrace in this. The pass rates alone are evidence that usually less than half of all those who take the patent bar exam actually pass it for any given test session. Many well-established and well-respected patent attorneys and agents alike have repeated the exam.

One important fact to keep in mind is that no one (except the truly tactless) will ever even ask you how many times you sat for the exam. Another fact is that it really would be a shame to give up altogether. Everyone is allowed as many attempts as they want and there is no penalty for repeating the exam (other than having to re-pay and re-sit for it).

MPEP Chapter Review

The MPEP is the source for patent practitioners and patent examiners (the people who decide whether or not an invention qualifies for a patent). Each Chapter on the following pages of the Prep Workbook corresponds with a chapter of the 9th Edition MPEP. Every Chapter of the Prep Workbook contains a brief introduction followed by an outline of the important sections that are tested. Following this outline is a list of objectives for you to focus on, including important laws and rules from 35 U.S.C. and 37 C.F.R. in addition to key terms. You should review all the outlined topics and suggested objectives for each chapter in an MPEP or additional study aid before you begin with the Prep Workbook questions.

Once you feel comfortable with the topics outlined in the Prep Workbook, begin answering the questions. You may use your MPEP or one of our other study aids (we offer our very popular Guidebook to Patent Law within our full program that is highly recommended). Remember, this is only a learning exercise for now so it's OK to use the MPEP or other study aid to help you answer the questions.

Once you've attempted all the questions within a chapter, review the answer key at the end of each chapter. This will only help cement the correct answer in your mind before moving on. After you've mastered the Prep Workbook, we suggest that you spend time with actual test questions from previous Patent and Trademark Office (PTO) exams. You may want to invest in the Patent Education Series™ Patent Bar Review course for more study tools.

Chapter 100

Secrecy, Access, National Security and Foreign Filing

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

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

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

Secrecy, Access, National Security and Foreign Filing

Chapter Outline:

- 101 General
- 102 Information as to Status of an Application
- 103 Right of Public To Inspect Patent Files and Some Application Files
- 104 Power to Inspect Application
- 105 Suspended or Excluded Practitioner Cannot Inspect
- 106 Control of Inspection by Assignee 106.01-Rights of Assignee of Part Interest
- 110 Confidential Nature of International Applications
- 115 Review of Applications for National Security and Property Rights Issues
- 120 Secrecy Orders
- 121 Handling of Applications under Secrecy Order and/or Bearing National Security Markings
- 130 Examination of Secrecy Order Cases
- 140 Foreign Filing Licenses
- 150 Statements to DOE and NASA
- 151 Content of the Statements

Objectives:

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

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

• ***Key terms:***

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

Short answers

1. What are the 3 major types of patent status?
2. A reexamination file is normally NOT open to inspection by the general public until what happens?
3. Name two individuals who through written authority may grant access to a provisional application.
4. Who has the authority to grant access to a pending or abandoned application filed on or after September 16, 2012 that is in confidence?
5. When the publication or issue date is later than the current date (i.e., the date of the request), who will that information be given to?
6. What are the two ways in which permission to file a patent application abroad may be obtained?
7. Name two times when an applicant may want to consider an explicit petition for foreign filing licenses.
8. List two types of information that are considered status information.
9. Name 3 individuals who are entitled to status information in an application that has not been published, but is pending or abandoned.
10. Name 2 individuals who may grant written authority to status information in a non-published, pending or abandoned application?
11. Name two types of abandoned applications available from the File Information Unit (FIU).

Fill in the blank

1. Approved patents are freely open to the public (unless they are under a _____).
2. Permission to file a patent application abroad may be obtained by waiting _____ after filing a patent application in the USPTO.
3. In _____, access or certified copies may only be requested by parties with written authority from a named inventor, the applicant, the assignee of record, or the attorney or agent of record.
4. The applicant or assignee of record of _____ interest in an application may file an application or intervene in the prosecution of the application, appointing an attorney or agent of his or her own choice.
5. Secrecy Orders remain in effect for a period of _____ from its date of issuance.
6. No information concerning pending or abandoned patent applications (except applications which have been _____, reissue applications and reexamination proceedings) may be given to the public without appropriate written authorization.
7. If a non-published, pending or abandoned application contains written authority granting access to the requester signed by a patent practitioner of record, then the requester is entitled to _____.
8. For an application filed on or after _____, an applicant other than an inventor may provide written authority to parties requesting access to a provisional application.
9. If an applicant filed a U.S. patent application, then immediately or within 6 months filed an application for the same disclosure in a foreign country, the applicant will need to petition for a _____.
10. A member of the public, without a petition for access, may obtain a copy of a pending application as originally filed, when the application is _____ in a U.S. patent application publication or a U.S. patent, upon the filing of an appropriate request and the payment of the required fee.
11. Any interested party may file a _____, accompanied by the proper fee, to the Director for access to an application.

True/False

1. Reexamination files are always open to inspection by the general public.
2. Patents for atomic energy will be issued without any special statements.
3. The applicant in an application that has not been published, but is pending or abandoned may give written authority granting access to status information to a requester.
4. A registered attorney or agent named in the papers accompanying the application papers is entitled to status information in an application that has not been published, but is pending or abandoned.
5. An assignee of an undivided part interest is not entitled to status information in an application that has not been published, but is pending or abandoned.
6. For applications filed prior to September 16, 2012, if an executed oath or declaration has been filed, no person but the applicant will be permitted to have access to the file of any pending application kept in confidence.
7. If a patent application has been published, then a copy of the specification, drawings, and all papers relating to the file of that published application (whether abandoned or pending) may be provided to any person upon written request and payment of the appropriate fee.
8. If a redacted copy of the application was used for the patent application publication, the copy of the application will be limited to the redacted copy of the application and the redacted materials.
9. If a published patent application maintained in the IFW system is abandoned, the entire application is available to the public for inspection and obtaining copies.
10. A Secrecy Order may not be renewed.
11. A petition for a retroactive filing license may be filed if an unlicensed foreign filing has occurred through error.
12. An abandoned application referred to in a U.S. patent application publication is not available from the FIU.
13. Status information of an application can include whether the application is pending, abandoned, or patented.
14. Status information of an application does not include whether another application claims the benefit of the application.
15. Whenever a patent relies on the filing date of an earlier but still pending application, the Office allows an applicant to obtain a copy of the prior application upon without written request.
16. Reissue applications are not open to inspection by the public.
17. Only the relevant portions of a defensive publication is available to the public for inspection.

18. If an abandoned application is referred to in an international application that is published, access to the abandoned application is available.
19. Access will be given on oral request to any applicant, inventor, patentee, assignee, or attorney or agent of record in an application or patent only upon proof of identity or upon recognition based on personal acquaintance.
20. An associate or representative of the named person in a power to inspect is entitled to access to the application on behalf of the authorized person.
21. After publication of an international application designating the U.S., the USPTO will allow access to, those international application files which are kept in the USPTO.
22. All applications are screened upon receipt in the USPTO for subject matter that, if disclosed, might impact national security.
23. A petition for a retroactive filing license filed on or after September 16, 2012 must specify that the error occurred without deceptive intent.

Answer Key

Short answers

1. The 3 major types of patent status include: pending applications, abandoned applications, and issued patents.
2. A reexamination file is normally NOT open to inspection by the general public until the file has been scanned into the IFW system.
3. In provisional applications, access will only be given to parties with written authority from the following:
 - a named inventor
 - the assignee of record
 - the attorney or agent of record
 - or, for an application filed on or after September 16, 2012, an applicant other than an inventor.
4. For applications filed on or after September 16, 2012, the following individuals may provide a written authority for access to a pending or abandoned application kept in confidence:
 - the applicant
 - a patent practitioner of record
 - the assignee or an assignee of an undivided part interest
 - or an inventor
5. When the publication or issue date is later than the current date (i.e., the date of the request), such information may be given only to the applicant, an inventor, the assignee of record, or the attorney or agent of record.
6. The two ways in which permission to file a patent application abroad may be obtained include:
 1. either a petition for a foreign filing license may be granted, or
 2. an applicant may wait 6 months after filing a patent application in the USPTO at which time a license on that subject matter is no longer required as long as no Secrecy Order has been imposed.
7. Explicit petitions for foreign filing licenses may be considered by applicants when:
 - the filing receipt license is not granted;
 - the filing receipt has not yet been issued;
 - there is no corresponding U.S. application;
 - there is subject matter additional to that already licensed is sought to be licensed; or
 - expedited handling is requested.

Answer Key

8. Status information of an application means only the following information:
- whether the application is pending, abandoned, or patented;
 - whether the application has been published;
 - the application number or the serial number plus any one of the filing date of the national application, the international filing date or the date of entry into the national stage; and
 - whether another application claims the benefit of the application
9. The following individuals are entitled to status information in an application that has not been published, but is pending or abandoned:
- the applicant;
 - a patent practitioner of record;
 - the assignee or an assignee of an undivided part interest;
 - the inventor or a joint inventor; or
 - a registered attorney or agent named in the papers accompanying the application papers
10. A non-published, pending or abandoned application containing written authority granting access to the requester signed by any of the individuals listed below, allows the requester access to status information.
- the applicant;
 - a patent practitioner of record;
 - the assignee or an assignee of an undivided part interest;
 - the inventor or a joint inventor; or
 - a registered attorney or agent named in the papers accompanying the application papers
11. The following abandoned applications are available from the FIU:
- An abandoned application referred to in a U.S. patent application publication or U.S. patent; and
 - A pending File Wrapper Continuation application (FWC) of an abandoned application.

Fill in the blank

1. secrecy order
2. 6 months
3. provisional applications
4. the entire interest
5. 1 year
6. published
7. status information
8. September 16, 2012
9. retroactive filing license
10. incorporated by reference
11. petition

Answer Key

True/False

1. False, a reexamination file is normally NOT open to inspection by the general public until the file has been scanned into the IFW system
2. False, no patents for nuclear material or atomic energy will be issued except under special circumstances along with a statement filed with the application or sent in within 30 days after requested by the Director of the USPTO.
3. True
4. True
5. False, the assignee or an assignee of an undivided part interest is entitled to status information in an application that has not been published, but is pending or abandoned.
6. False, any one of joint applicants, an attorney or agent of record, or an assignee may also have access.
7. True
8. True
9. True
10. False, a Secrecy Order may be renewed for additional periods of not more than 1 year upon notice by a government agency that the national interest so requires.
11. True
12. False, an abandoned application referred to in a U.S. patent application publication or U.S. patent is available from the FIU.
13. True
14. False, status information of an application includes whether another application claims the benefit of the application.
15. False. whenever a patent relies on the filing date of an earlier but still pending application, the Office permits an applicant to obtain a copy of the prior application upon written request and payment of the appropriate fee.
16. False, reissue applications are open to inspection by the general public.
17. False, the entire application file of a defensive publication is available to the public for inspection and obtaining copies.
18. True
19. True
20. False, an associate or representative of the named person is not entitled to access to the application on behalf of the authorized person.
21. True
22. True
23. False, only those filed prior to September 16, 2012 must specify that the error occurred without deceptive intent.