

Scope of October 17, 2001 Examination.

The registration examination scheduled for October 17, 2001, is directed at patent laws, rules, policies, practices and procedures to be followed when prosecuting patent applications in the United States Patent and Trademark Office. The U.S. patent statutes, the USPTO rules of practice, the Manual of Patent Examining Procedure, and the Patent Cooperation Treaty, as modified by any later court decisions or Official Gazette notices, determine the correct answers. The examination will include questions that address statutory changes enacted by the American Inventors Protection Act of 1999 (the Act), Public Law 106-113, 113 Stat. 1501 (1999), as well as changes to the rules and procedures that were published in the Federal Register and Official Gazette on or before January 5, 2001. The examination will also include questions addressing laws, rules procedures and policies not affected by the Act or related rule changes. No determination has been made regarding how many questions will cover the respective areas.

The rule and procedural changes addressed in the examination are found in the following final rules, comments accompanying the rule changes, and guidelines published on or before January 5, 2001. These rule changes were published after the last revision of the MPEP dated February 2000. The final rules, comments, and guidelines are identified below by cites to the *Federal Register* and the *Official Gazette*, where applicable. Links to the identified rules are provided below. The final rules, commentary to the final rules, and the guidelines will determine the correct answer to the extent that there is any conflict or difference with the MPEP dated February 2000.

The current Seventh Edition of Manual of Patent Examining Procedure (MPEP), revision 1, dated February 2000 does not reflect the Act-related changes. At the time the examination was drafted a revised MPEP reflecting Act-related changes had not been published. A printed publication of a revised edition may not be available before the examination. Furthermore, the revision of the MPEP dated February 2000, which is available at www.uspto.gov/web/offices/pac/mpep/mpep.htm, contains statutes and rules in Appendices L and R. However, the statutes and rules in Appendices L and R also do not reflect the Act-related changes. Accordingly, it is not recommended that candidates rely on the statute and rules in Appendices L and R.

The final rules reflecting all Act-related amendments to the rules through December 2000, have been consolidated into Title 37 – Code of Federal Regulations in a document dated December 18, 2000, and made available on the United States Patent and Trademark Office Web site: <http://www.uspto.gov/web/offices/pac/mpep/patrules1218.pdf>

The Patent Statute, as amended to reflect the Act-related and other statutory changes, is available at the following Office Web site:
<http://www.uspto.gov/web/offices/pac/mpep/patlaws1214.pdf>

Further, final rules, as well as the guidelines are available on the Office Web site under the "All Federal Register Notices" link on the homepage.

The *Federal Register* Notices are the authoritative source for the rules and comments.

1. Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule. 65 FR 50092 (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). Effective date: Aug. 16, 2000. Effective date: May 29, 2000
<http://www.uspto.gov/web/offices/com/sol/notices/reqcontexmpr.pdf>
2. Changes to Permit Payment of Patent and Trademark Fees by Credit Card; Final Rule. 65 FR 33452 (May 24, 2000), 1235 O.G. 38 (June 13, 2000). Effective dates: June 5, 2000 (§ 1.23); July 24, 2000 (§ 1.21).
<http://www.uspto.gov/web/offices/com/sol/notices/cc-fr.pdf>
3. Revision of Patent Fees for Fiscal Year 2001; Final Rule. 65 FR 49193 (Aug. 11, 2000), 1237 O.G. 131 (Aug. 29, 2000). Effective date: Oct. 1, 2000.
<http://www.uspto.gov/web/offices/com/sol/notices/revpatfee.pdf>
4. Changes To Implement the Patent Business Goals; Final Rules. 65 FR 54604 (Sept. 8, 2000), 1238 O.G. 77 (Sept. 19, 2000). Effective dates: See 65 FR 54604 and 65 FR 78958. Some sections Sept. 8, 2000 and some sections Nov. 7, 2000.
<http://www.uspto.gov/web/offices/com/sol/notices/patbusgoals.pdf>
5. Changes to Implement the Patent Business Goals; Final Rule and corrections to final rules. 65 FR 78958 (Dec. 18, 2000). Effective date: Dec. 18, 2000.
<http://www.uspto.gov/web/offices/com/sol/notices/pbgfrcorr.pdf>
6. Changes to Implement Patent Business Goals; Final Rule, Correction. 65 Fed. Reg. 80755 (Dec. 22, 2000). Effective date: Dec. 18, 2000.
<http://www.uspto.gov/web/offices/com/sol/notices/corrbusgols.pdf>
7. Changes To Implement Patent Term Adjustment Under Twenty-Year Patent Term; Final Rules. 65 FR 56366, (Sept. 18, 2000), 1239 O.G. 14 (Oct. 3, 2000). Effective dates: Oct. 18, 2000 (§§ 1.701-1.705), Nov. 17, 2000 (§ 1.18).
<http://www.uspto.gov/web/offices/com/sol/notices/pattermadj.pdf>
8. Changes to Implement Eighteen-Month Publication of Patent Applications; Final Rule. 65 FR 57024 (Sept. 20, 2000), 1239 O.G. 63 (Oct. 10, 2000). Effective date: Sept. 20, 2000. <http://www.uspto.gov/web/offices/com/sol/notices/chpatapp.pdf>
9. Changes To Implement Eighteen-Month Publication of Patent Applications; Correction. Final Rule; correction. 65 FR 66502 (Nov. 6, 2000), 1240 O.G. 98 (Nov. 28, 2000). Effective date: Nov. 29, 2000.
<http://www.uspto.gov/web/offices/com/sol/notices/65fr66502.html>
10. Treatment of Unlocatable Patent Application and Patent Files; Final Rule. 65 FR 69446 (Nov. 17, 2000), 1241 O.G. 36 (Dec. 12, 2000). Effective date: Nov. 17, 2000.
<http://www.uspto.gov/web/offices/com/sol/notices/trtunlopat.pdf>
11. Simplification of Certain Requirements in Patent Interference Practice; Final Rule. 65 FR 70489 (Nov. 24, 2000). Effective date. Dec. 26, 2000.
<http://www.uspto.gov/web/offices/com/sol/notices/simreqpatint.pdf>
12. Rules to Implement Optional Inter Partes Reexamination Proceedings; Final Rule. 65 FR 76756 (Dec. 7, 2000). Effective date: Feb. 5, 2001.
<http://www.uspto.gov/web/offices/com/sol/notices/intparexprcdng.pdf>

In addition, the following materials can also be covered by questions on the examination.

13. Reestablishment of the Patent and Trademark Office as the United States Patent and Trademark Office, 65 Fed. Reg. 17858 (April 5, 2000).
<http://www.uspto.gov/web/offices/com/sol/notices/reestadop.pdf>
14. Guidelines Concerning the Implementation of Changes to 35 U.S.C. 102(g) and 103(c) and the Interpretation of the Term "Original Application" in the American Inventors Protection Act of 1999, 1233 O.G. 54-56 (April 11, 2000).
<http://www.uspto.gov/web/offices/com/sol/og/2000/week15/patamin.htm>
15. Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, para. 6, 65 Fed. Reg. 38510-38516 (June 21, 2000); 1236 O.G. 98-104 (July 25, 2000). <http://www.uspto.gov/web/offices/com/sol/og/2000/week30/patguid.htm>.
16. Guidelines Setting Forth a Modified Policy Concerning the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 U.S.C. 103(c), 1241 O.G. 96-97 (December 26, 2000).
<http://www.uspto.gov/web/offices/com/sol/og/2000/week52/patcommn.htm>
17. Assignment of Confirmation Number and Time Period for Filing a Copy of an Application by EFS for Eighteen-Month Publication Purposes, 1241 O.G. 97-98 (December 26, 2000). <http://www.uspto.gov/web/offices/com/sol/og/2000/week52/pat18mo.htm>
18. Utility Examination Guidelines, 66 F.R. 1092-1099 (January 5, 2001).
<http://www.uspto.gov/web/offices/com/sol/notices/utilexmguide.pdf>
19. Guidelines for Examination of Patent Applications Under the 35 U.S.C. Sec. 112, para. 1 "Written Description" Requirement 66 F.R. 1099-1111 (January 5, 2001).
<http://www.uspto.gov/web/offices/com/sol/notices/writdesguide.pdf>

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