

United States Patent and Trademark Office
Registration Examination for Patent Attorneys and Agents
April 18, 2001

Morning Session Model Answers

1. ANSWER: (A) is the most correct answer because there is compliance with 37 C.F.R. § 1.195. MPEP § 1211.02. (E) and (C) are wrong because jurisdiction has not passed to the Board. MPEP § 1210. (B) and (D) are wrong because a remand is an action by the Board when it has jurisdiction of the case. MPEP § 1211. Under the present facts, jurisdiction has not passed to the Board. MPEP § 1210.

2. ANSWER. (C) is the most correct answer. Under 37 C.F.R. § 1.53(d), “(1) A continuation...application...of a prior nonprovisional application may be filed as a continued prosecution application provided that: (i) The prior nonprovisional application is either: a utility...application that was filed under 35 U.S.C. 111(a) before May 29, 2000, and is complete as defined by § 1.51(b);...and (ii) The application under this paragraph is filed before the earliest of payment of: (A) Payment of the issue fee on the prior application, unless a petition under 37 C.F.R. § 1.313(c) is granted in the prior application; (B) Abandonment of the prior application; or (C) Termination of proceedings on the prior application.” (A) is not the most correct answer. 37 C.F.R. § 1.53(d)(1) does not authorize filing a divisional application as a CPA of a prior provisional application. (B) is not the most correct answer. 37 C.F.R. § 1.53(d)(1) does not authorize filing of a continuation-in-part application as a CPA of a prior complete nonprovisional utility application. (D) is not the most correct answer. Pursuant to 37 C.F.R. § 1.53(d)(1)(i)(A), the prior application must be filed prior to May 29, 2000. Since the prior CPA was actually filed on June 1, 2000, a further CPA cannot be filed off that CPA. The filing date of the first application (November 28, 1999) is not relevant to 37 C.F.R. § 1.53(d)(1)(i)(A), and is only used for identification purposes in the first CPA. See, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50093, right column, second paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (E) is not the most correct answer. 37 C.F.R. § 1.53(d)(1)(i)(A) does not authorize the filing of a divisional or continuation application as a CPA of a prior complete nonprovisional utility application filed on or after May 29, 2000.

3. ANSWER: (B) is the most correct answer. Application number of each patent is not required to be listed by 37 CFR § 1.98(b)(1), which provides “(b)(1) Each U.S. patent listed in an information disclosure statement must be identified by inventor, patent number, and issue date.” As to (A), the elements of (A) are found in 37 CFR § 1.98 (a)(3)(ii), which provides “(ii) A copy of the translation if a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c).” As to (C), the elements of (C) are found in 37 CFR § 1.98 (b)(5), which provides “(5) Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.” As to (D), the elements of (D) are found in 37 CFR § 1.98(c), which provides “[w]hen the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications, provided that it is stated that these other patents or publications are cumulative.” As to (E), the elements of (E) are found in 37 CFR § 1.98(d), which provides “(d) A copy of any patent, publication, pending U.S. application or

other information, as specified in paragraph (a) of this section, listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application, unless: (1) The earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120; and (2) The information disclosure statement submitted in the earlier application complies with paragraphs (a) through (c) of this section.”

4. ANSWER: (C) is the most correct answer. 37 CFR § 1.366(c) (effective September 8, 2000), “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54649 (Sept. 8, 2000). Under 37 CFR § 1.366(a), any person or organization may pay maintenance fees and any necessary surcharges on behalf of a patentee. Authorization by the patentee is not required. 37 CFR § 1.366(c) states, “If the payment includes identification of only the patent number (i.e., does not identify the application number of the United States application for the patent on which the maintenance fee is being paid), the Office may apply the payment to the patent identified by patent number in the payment or may return the payment.” Only in (C) does the USPTO have the option of returning the maintenance fee. (A) and (B) are each incorrect. (D) is incorrect because (A) and (B) are incorrect. (E) is incorrect because (C) is correct.

5. ANSWER: (D) is the most correct answer. The Maintenance Fee Reminder is sent to the correspondence address used during prosecution unless a fee address has been designated. 37 C.F.R. § 1.363; MPEP § 2540.

6. ANSWER: (C) is the most correct answer. *See, e.g.*, 37 C.F.R. § 1.33(c); MPEP §§ 2222 and 403.

7. ANSWER: (E) is the correct answer. 37 CFR § 1.114 (effective August 16, 2000); “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 FR 50092, 50097 (August 16, 2000). (A) is a final action (§ 1.113). 65 FR 50097, column 1, states in pertinent part, “...an action that otherwise closes prosecution in the application (e.g., an Office action under *Ex Parte Quayle*, 1935 Comm’r Dec. 11 (1935)).” Thus (A), (B), (C) and (D) are individually correct, and (E), being the most inclusive, is the most correct answer.

8. ANSWER: (E) is the most correct answer. Third party requesters do not have the option of attending interviews. See 37 CFR § 1.560(a), which provides, in part, “[r]equests that reexamination requesters participate in interviews with examiners will not be granted.” As to (A) through (D), each item is founded on a portion of § 1.560(b), which states “(b) In every instance of an interview with an examiner in an *ex parte* reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111. Patent owner’s response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.”

9. ANSWER: (C), not being in accord with proper USPTO practice and procedure, is the most correct answer. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1107 (Jan. 5, 2001), middle column, “A general allegation of ‘unpredictability in the art’ is not a sufficient reason to support a rejection for lack of adequate written description.” (A), being in accord with proper USPTO practice and procedure, is not correct. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1107 (Jan. 5, 2001), left column, “A description as filed is presumed to be adequate... .” (B), being in accord with proper USPTO practice and procedure, is not correct. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1107 (Jan. 5, 2001), “A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption.⁶⁵ ...The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.⁶⁶” (footnotes not reproduced). (D), being in accord with proper USPTO practice and procedure, is not correct. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1107 (Jan. 5, 2001), left column, “[W]hen filing an amendment, applicant should show support in the original disclosure for new or amended claims.⁵⁹” Footnote 59 states, “See MPEP §§ 714.02 and 2163.06 (‘Applicant should... specifically point out the support for any amendments made to the disclosure.’).” (E), being in accord with proper USPTO practice and procedure, is not correct. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1106 (Jan. 5, 2001), right column, “[W]hen there is substantial variation within a genus, an applicant must describe a sufficient variety of species to reflect the variation within the genus.”

10. ANSWER: (A) or (D) are accepted as correct answers. MPEP § 2173.05(e). Claim 2 is indefinite because it is not clear which “said pipe” the claim is referring to since claim 1 recites a copper pipe and an aluminum pipe. Accordingly, claim 2 provides the basis for a proper rejection under 35 U.S.C. § 112, second paragraph. In (B), claim 3 can be construed as definite, inasmuch as “the outer surface,” e.g., the outer circumference, is an inherent part of the pipe and would not require antecedent recitation. Therefore, (B), would be incorrect. Alternatively, claim 3 in (B) could be properly construed as not being clear as to which outer surface is being referenced, i.e., “the outer surface” defined by the outer circumference of the pipe, or the external surface defined by the inner circumference of the pipe or the end(s) of the pipe inasmuch as the pipe is not defined as being closed and both the inner circumference and end(s) are external surfaces to the material of the pipe. However, recognizing claim 3 in (B) as being indefinite, but not claim 2, is incorrect because claim 2 is necessarily indefinite. Claim 2 must be recognized as being indefinite. Accordingly, selection of (D), which recognizes both (A) and (B) as providing the basis for a proper rejection under 35 U.S.C. § 112, second paragraph is also accepted. Selection of (B) alone is not accepted as a correct answer because it does not recognize claim 2 as being indefinite. Claim 4 is definite inasmuch as there is antecedent basis for “said plastic valve.” Therefore, (E) is incorrect.

11. ANSWER: (C) is the correct answer. 37 CFR § 1.105(a)(3) (effective November 7, 2000), “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54634 (September 8, 2000), and 37 CFR § 1.136(a)(1). (C) is correct pursuant to 37 CFR § 1.105(a)(3). (A) is incorrect because it is not responsive to the requirement for information. (B) is incorrect because “each attorney or agent who prepares or prosecutes the application,” is identified an individual under 37 CFR § 1.56(c). (D) is incorrect because information used to draft an application may be required under 37 CFR § 1.105(a)(1)(iv). (E) is incorrect because (C) is correct.

12. ANSWER: (E) is the most correct answer. Since the claim reads on a downward moving actuator and only a upward moving actuator was cited during the prosecution, the Shack restaurant device was material to the patentability of the invention. Moreover, Sam argued the significance of the downward motion feature. 37 C.F.R. § 1.56(b)(2)(i). Sam should have disclosed it under 37 C.F.R. § 1.56(c)(2). As to (A), the duty of disclosure extends to each practitioner who prepares or prosecutes the application. 37 C.F.R. § 1.56(c)(2). As to (B), even though Chris had completed the disclosure, the sighting of the Shack restaurant doorstep occurred prior to the filing date. Moreover, the restaurant (and doorstep) was in existence at least one year prior to Sam’s visit. MPEP § 2001.06. As to (C), information material to the invention is more than just patents and printed publications. 37 C.F.R. § 1.56; MPEP 2001.04, p.2000-3. As to (D), only patents and printed publication may be considered during a reexamination. 35 U.S.C. § 303(a); MPEP § 2209.

13. ANSWER: (A) is the most correct answer. The answer is inconsistent with 35 U.S.C. § 112 and MPEP § 608.01(n), subpart I.B.4. (B), (C), and (E) are wrong answers because they are consistent with 35 U.S.C. § 112 and MPEP § 608.01(n), subpart I.B.4. (D) is wrong because it is consistent with MPEP § 608.01(n), subpart I. C.

14. ANSWER: (D) is the most correct answer. MPEP § 608.01(n), part “IV. Claim Form and Arrangement.” A claim which depends from a dependent claim should not be separated therefrom by any claim which does not also depend from said “dependent claim.” (A), (B), and (C) are incorrect because they are practices encouraged by the MPEP §. MPEP § 608.01(n), subsection “IV. Claim Form and Arrangement.” (E) is incorrect because it represents a practice encouraged by MPEP § 608.01(m). See *Fressola v. Manbeck*, 36 USPQ2d 1211 (D.D.C. 1995).

15. ANSWER: (D) is the correct answer. 37 CFR § 1.105(a) (effective November 7, 2000); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54634 (September 8, 2000). (A) is specifically stated as an example in 37 CFR § 1.105(a)(1)(v). (B) and (C) are given as examples in 65 FR at 54634, left column, where the Office may require the submission of information. (E) is incorrect because (D) is correct.

16. ANSWER: (B) is the most correct answer. Admissions by applicant constitute prior art. 37 C.F.R. § 1.104(a)(3). As explained in *Tyler Refrigeration v. Kysor Industrial Corp.*, 777 F.2d 687, 227 USPQ 845 (Fed. Cir. 1985), the Fed. Circuit found that

the district court decided on two separate and independent grounds that the Aokage patent was such prior art. One basis was Tyler’s admission of the

Aokage reference as prior art before the PTO during the prosecution of the '922 Subera patent. The court found that, in a wrap-up amendment, the Tyler attorney admitted in his discussion as to "all the claims" of the three Subera applications, that "the most pertinent available prior art known to the Applicants and their representatives is the Aokage U.S. Patent 4,026,121 cited by the Examiner" (emphasis added). In view of this explicit admission, the district court's decision was proper and was sufficiently based on clear and convincing evidence. The controlling case law in this court recognizes this principle. See *Aktiebolaget Karlstads Mekaniska Werkstad v. ITC*, 705 F.2d 1565, 1574, 217 U.S.P.Q. (BNA) 865, 871 (Fed. Cir. 1983); *In re Fout*, 675 F.2d 297, 300, 213 U.S.P.Q. (BNA) 532, 536 (CCPA 1982), and *In re Nomiya*, 509 F.2d 566, 571, 184 U.S.P.Q. (BNA) 607, 612 (CCPA 1975). Thus, we must affirm the court's decision that the Aokage patent was prior art and as such binding on Tyler. (Here again, we do not pass on the other grounds on which the court concluded that the Aokage was prior art within the meaning of 35 U.S.C. § 102.)

Since (B) is true, (D) is not true. Answers (A), (C) and (D) also are not true since the Acme patent can not be sworn behind or otherwise removed as a result of the admission. (E) is not true because (A) and (D) are not true.

[Note re Question 16, choice (B), line 1: Examination proctors were instructed to direct examination candidates after the word "by," to insert the word --the--. Also in Question 16, choice (D), line 3, examination proctors were instructed to direct examination candidates after the word "by" to insert the words --the registered practitioner--. The question has been carefully reviewed to see if there is any alternative reasonable meaning to the question if any or all of the changes were not made. No such meaning was found. The Director of Enrollment and Discipline concluded that omission of the changes should have no material affect on the question, and should not inhibit an individual's ability to correctly answer the question.

17. ANSWER: (C) is the correct answer. 37 CFR § 1.104(e) (effective November 7, 2000); "Changes To Implement the Patent Business Goals; Final Rule," 65 FR 54604, 54633 (September 8, 2000). As stated in 65 FR at 54633, middle column, "In view of the recent case law dealing with prosecution history, the failure of an applicant to comment on damaging reasons for allowance would give rise to a presumption of acquiescence to those reasons..." Thus, (A) is incorrect. 65 FR at 54633, middle column, also provides, "That the examiner does not respond to a statement by the applicant commenting on reasons for allowance does not mean that the examiner agrees with or acquiesces in the reasoning of such statement." Thus (B) is incorrect. (D) is incorrect because (A) is incorrect. (E) is incorrect because (C) is correct.

18. ANSWER: (E) is the correct answer. 37 CFR § 1.114(e), effective date August 16, 2000; see, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 FR 50092, 50097 (Aug. 16, 2000). (E) is correct since the provisions of 37 CFR § 1.114 do not apply to design patent applications. Therefore, choices (A) through (D) are incorrect.

19. ANSWER: (A) is the most correct answer. In *Evans Cooling Systems, Inc. v. General Motors Corp.*, 125 F.3d 1448, 44 USPQ 2d 1037 (Fed. Cir. 1997) the Federal Circuit held that even though an invention is misappropriated by a third party, the public sale bar applies (35 U.S.C. § 102(b)). Accordingly, (A) is true and (B) is not. (C) is incorrect since the people at MC were not the true inventors, and therefore, the misappropriation is within the jurisdiction of the USPTO. 35 U.S.C. § 102(f). (D) is incorrect inasmuch as (C) is incorrect. (E) is incorrect inasmuch as (A) is correct.

20. ANSWER: (D) is the most correct answer. “It is not necessary in order to establish a prima facie case of obviousness...that there be a suggestion or expectation from the prior art that the claimed [invention] will have the same or a similar utility as one newly discovered by the applicant.” *In re Dillon*, 919 F.2d 688, 692, 16 USPQ2d 1897, 1900 (Fed. Cir. 1990) (emphasis in original). Thus, “[i]t is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant.” MPEP § 2144 (“Rationale Different from Applicant’s is Permissible”). Here, T suggests the combination with P to achieve a different advantage or result, i.e., waterproofing, from that discovered by applicant, i.e., reducing breakage. Answers (A) - (C) are incorrect because the suggestion to combine does not need to be for the same purpose as applicant discloses in the application. *Dillon*, 919 F.2d at 692, 16 USPQ2d at 1900; MPEP § 2144 (“Rationale Different from Applicant’s is Permissible”). Answer (E) is incorrect because an applicant is under no obligation to submit evidence of non-obviousness unless the examiner meets his or her initial burden to fully establish a prima facie case of obviousness. MPEP § 2142.

21. ANSWER: (D) is the most correct answer. 35 U.S.C. § 132(a); 37 C.F.R. § 1.114. “In those instances in which an applicant seeks to add new matter to the disclosure of an application, the procedure set forth in § 1.114 is not available, and the applicant must file a continuation-in-part application under § 1.53(b) containing such new matter.” See, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50095, right column (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (A) is not the most correct answer. At a minimum, corrected drawings suitable for reproduction are required. 37 C.F.R. § 1.85(b). (B) is not the most correct answer. As stated in 37 C.F.R. § 1.85(c), “If...a drawing does not comply with § 1.84 at the time an application is allowed, the Office may notify the applicant and set a three month period of time from the mail date of the notice of allowability within which the applicant must file a...formal drawing in compliance with § 1.84 to avoid abandonment. This time period is not extendable under § 1.136(a) or § 1.136(b).” See also 37 C.F.R. § 1.136(b). (C) is not the most correct answer. 35 U.S.C. § 119(e)(2) has been amended to eliminate the copendency requirement. (E) is not the most correct answer. 37 C.F.R. § 1.78(a)(4). For a nonprovisional application to properly claim the benefit of the filing date of a provisional application the provisional application must be entitled to a filing date and the basic filing fee set forth in 37 C.F.R. § 1.16(k) must be paid within the time period set forth in 37 C.F.R. § 1.53(g). See also, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50094, left column (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000).

22. All answers accepted.

23. ANSWER: (E) is the most correct answer because the advice is consistent with PCT Rule 4/15(b) and 37 C.F.R. § 1.425. (A), (B), (C), and (D) are wrong because the advice provided is not consistent with 37 C.F.R. § 1.425. MPEP § 1820, p.1800-16.

24. ANSWER: (E) is the correct answer. 37 CFR § 1.48(b) (effective November 7, 2000); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54619 (September 8, 2000). As stated in 65 FR at 54619, middle column, “Sections 1.48(b) and (d) are revised to indicate that a request to correct the inventorship thereunder must be signed by a party as set forth in § 1.33(b)...” (A), (B), and (C) are provided for in 37 CFR § 1.33(b). Thus (E), the most inclusive answer, is correct.

25. ANSWER. (B) is the most correct answer. As stated in “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092 (Aug. 16, 2000), 1238 O.G.13 (Sept. 5, 2000), “Section 4801 of the American Inventors Protection Act of 1999 contains no provision for according the resulting nonprovisional application a filing date other than the original filing date of the provisional application. Thus, under the patent term provisions of 35 U.S.C. 154, the term of a nonprovisional application resulting from the conversion of a provisional application pursuant to 35 U.S.C. § 111(b)(5) will be measured from the original filing date of the provisional application (which is the filing date accorded the nonprovisional application resulting from the conversion under § 4801 of the American Inventors Protection Act of 1999).” However, the pendency is counted against the patent term. (A), being in accord with USPTO practice and procedure, is not the most correct answer. 37 C.F.R. § 1.53(c)(3), third sentence. See also, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50093 (Aug. 16, 2000), 1238 O.G.13 (Sept. 5, 2000). (C), being in accord with USPTO practice and procedure, is not the most correct answer. 37 C.F.R. § 1.53(c)(3), fourth sentence. (D), being in accord with USPTO practice and procedure, is not the most correct answer. 37 C.F.R. § 1.53(c)(3). (E) is a correct statement, and therefore is not a correct answer. 35 U.S.C. § 119(e)(3).

26. ANSWER: (B) is the most correct answer. Under 37 C.F.R. § 1.26(b), “Any request for refund must be filed within two years from the date the fee was paid.” See, “Changes to Implement the Patent Business Goals, Final Rule,” 65 F.R. 54604, 54608, middle column (September 8, 2000), 1238 O.G. 77 (Sept. 19, 2000). (A) is not the most correct answer. 37 C.F.R. § 1.26(a). See, “Changes to Implement the Patent Business Goals, Final Rule,” 65 F.R. 54604, 54608, right column (September 8, 2000), 1238 O.G. 77 (Sept. 19, 2000). (C) is not the most correct answer. 37 C.F.R. § 1.52(b)(6) provides that other than in a reissue application, the paragraphs of the specification of an application may be numbered at the time the application is filed. See, “Changes to Implement the Patent Business Goals, Final Rule,” 65 F.R. 54604, 54620 (left column), 54621 (Comments 22, 23, 24, and 25, and responses) (September 8, 2000), 1238 O.G. 77 (Sept. 19, 2000). (D) is not the most correct answer. 37 C.F.R. § 1.52(d)(2) provides for that an English language translation of the non-English language provisional application will not be required in the provisional application. (E) is not the most correct answer. 37 C.F.R. § 1.52(e)(5). See, “Changes to Implement the Patent Business Goals, Final Rule,” 65 F.R. 54604, 54621, left column (September 8, 2000), 1238 O.G. 77 (Sept. 19, 2000).

27. ANSWER: (D) is the most correct answer. MPEP § 608.01, subsection “Illustrations In the Specification.” 37 C.F.R. § 1.58(a) permits tables and chemical formulas in the specification in lieu of formal drawings. (A) is incorrect. MPEP § 608.01, subsection “Illustrations In the Specification.” Graphical illustrations, diagrammatic views, flowcharts, and diagrams in the descriptive portion of the specification do not come within the purview of 37 C.F.R. § 1.58(a). The examiner should object to such descriptive illustrations in the specification and request formal drawings in accordance with 37 C.F.R. § 1.81 when an application contains graphs in the specification. (B) is incorrect. 37 C.F.R. § 1.75(a). The specification must conclude with one or more claims. (C) is incorrect. MPEP § 608.01, subsection “Hyperlinks And Other Forms Of Browser-Executable Code In The Specification.” USPTO policy does not permit the USPTO to link to any commercial sites since the USPTO exercises no control over the organization, views, or accuracy of the information contained on these outside sites. (E) is incorrect. 37 C.F.R. § 1.79. A reservation for a future application of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application.

28. ANSWER: (D) is the most correct answer. Under 37 C.F.R. § 1.85(a), correcting the drawings to comply with 37 C.F.R. § 1.84(a)(1) and (k), and making them suitable for reproduction is a *bona fide* response. (A), (B), and (C) are not the most correct answer. In each, Smith seeks to hold the requirement in abeyance. As stated in 37 C.F.R. § 1.85(a) (effective November 29, 2000), “Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a *bona fide* attempt to advance the application to final action.” See also, “Changes to Implement Eighteen-Month Publication of Patent Applications; Final Rule,” 65 F.R. 57024, 57032, “Section 1.85.” (E) is not the most correct answer inasmuch as (A), (B), and (C) are not the most correct answers.

29. ANSWER: (C) is the most correct answer. See MPEP § 2128 under the subheading “Date of Availability,” of the heading “Electronic Publications As Prior Art.” (A) is wrong. See MPEP § 2129 under the heading “A Jepson Claim Results In An Implied Admission That Preamble Is Prior Art.” (B) is wrong. See MPEP § 2128.02. A journal article or other publication becomes available as prior art on date it is received by at least one member of the public. (D) is wrong. See MPEP § 2128.01 under the heading “A Thesis Placed In A University Library May Be Prior Art If Sufficiently Accessible To The Public.” (E) is wrong. See *In re Nomiya*, 184 USPQ 607, 610 (CCPA 1975); MPEP § 2129 under the heading “Admissions By Applicant Constitute Prior Art.”

30. ANSWER: (D) is the most correct answer. 37 C.F.R. § 1.103(c). See, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50100, right column, Comment 11 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (A) is not the most correct answer. 37 C.F.R. § 1.114. “An applicant may not obtain examination of a different or non-elected invention (e.g., a divisional) in a request for continued examination under § 1.114.” See, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50102, left column, Comment 21 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (B) is not the most correct answer. 37 C.F.R. § 1.312. Amendments are not entered as a matter of right. Section 1.312 is not intended to be used for continued examination of applications. See MPEP 714.16.

Any amendments considered necessary by the applicant should be completed before the notice of allowance is issued.” See, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50102, middle column, Comment 24 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (C) is not the most correct answer. 37 C.F.R. §§ 1.85(c) and 1.136(c)(2). The three-month period set in the notice of allowability for submission of any outstanding corrected or formal drawing is not extendable under 37 C.F.R. § 1.136(a) or (b). See, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50102, middle column, Comment 23 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (E) is not the most correct answer. 37 C.F.R. § 1.103(a). The Office will not suspend action if a reply by the applicant is due. See, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50101, left column, Comment 12 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000).

31. ANSWER: (D) is the most correct answer. 35 U.S.C. § 102(a); MPEP § 715, subsection styled “SITUATIONS WHERE 37 C.F.R. 1.131 AFFIDAVITS OR DECLARATIONS CAN BE USED.” (A) is incorrect. 35 U.S.C. 102(b), MPEP § 715. (B) is incorrect. The question involved is one of “double patenting.” 37 C.F.R. § 1.131, MPEP § 715. (C) is incorrect. 35 U.S.C. § 102(g); 37 C.F.R. § 1.131. As explained in MPEP § 715, subsection styled “SITUATIONS WHERE 37 C.F.R. 1.131 AFFIDAVITS OR DECLARATIONS ARE INAPPROPRIATE,” “i. ... 37 C.F.R. 1.131 is designed to permit an applicant to overcome rejections under 35 U.S.C. 102(a) and (e) based on patents and publications which are not statutory bars, but which have publication dates, or in the case of U.S. patents, effective filing dates, prior to the effective filing date of the application but subsequent to the applicant’s actual date of invention. However, when the subject matter relied on is also available under 35 U.S.C. 102(g), a 37 C.F.R. 1.131 affidavit or declaration cannot be used to overcome it. *In re Bass*, 474 F.2d 1276, 177 USPQ 178 (CCPA 1973). This is because subject matter which is available under 35 U.S.C. 102(g) by definition must have been made before the applicant made his invention. References under 35 U.S.C. 102(a) and (e), by contrast, merely establish a presumption that their subject matter was made before applicant’s invention date. It is this presumption which may be rebutted by evidence submitted under 37 C.F.R. 1.131.” (E) is incorrect. An affidavit or declaration under 37 C.F.R. 1.131 is unnecessary because the reference is not prior art and should not be used. MPEP § 715.

32. ANSWER: (E) is the most correct answer. 37 C.F.R. §§ 1.114 and 1.116(b) and (c). See, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50097, middle column, second complete paragraph, 50101, Comment 19 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (A) is not the most correct answer. 37 C.F.R. § 1.313(a), third sentence. A petition under § 1.313 is not required if a request for continued examination is filed prior to payment of the issue fee. (B) is not the most correct answer. 37 C.F.R. § 1.312, in pertinent part, provides, “Any amendment filed pursuant to this section must be filed before or with the payment of the issue fee.” See, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50097, middle column, fourth complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (C) is not correct. See, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50097, right column,

second complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). *See also* 37 CFR § 1.313(d). (D) is not the most correct answer. “The Office will not suspend action in an application when a reply by the applicant is outstanding. 35 U.S.C. 133 requires the applicant to ‘prosecute the application’ within six months of an Office action (or a shorter period as set in the Office action) to avoid abandonment of the application. If an applicant files a request for continued examination but does not also provide any submission (in reply to the prior Office action) within the period for reply to the prior Office action, the application is abandoned by operation of law. (35 U.S.C. 133).” *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50102, left column, Comment 20 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000).

33. ANSWER: (C). MPEP 2163.03, item I. Original claims constitute their own description. *In re Koller*, 613 F.2d 819, 204 USPQ 702 (CCPA 1980). (A) and (B) are incorrect. As stated in MPEP 2163.03, item I, “An amendment to the specification (e.g., a change in the definition of a term used both in the specification and claim) may indirectly affect a claim even though no actual amendment is made to the claim.” There is no supporting disclosure in the original description of the invention for the holder to a clasp, crimp, or tong. (D) is incorrect. MPEP 2163.03, item IV. A broad generic disclosure is not necessarily a sufficient written description of a specific embodiment, especially where the broad generic disclosure conflicts with the remainder of the disclosure. *Fields v. Conover*, 443 F.2d 1386, 170 USPQ 276 (CCPA 1970). (E) is not correct because (C) is correct.

34. ANSWER: (D) is the most correct answer. *See*, 37 CFR §§ 1.702(e) and 1.703(e). Answer (A) is incorrect at least because the Patent Term Guarantee Act of 1999 applies to Joseph’s application, which was filed after May 29, 2000. Answer (B) is incorrect because a failure to engage in reasonable efforts to conclude prosecution may reduce patent term extension, but is not a complete forfeiture of any extension. Answer (C) is incorrect because the three year period set forth in 37 CFR § 1.702(b) does not include time consumed by review by the Board of Appeals and Patent Interferences or any delay in processing of the application that was requested by the applicant. Answer (E) is incorrect because any reduction is based on an expected reply within three months of the Office action, regardless of the deadline set by the USPTO. *See*, 37 CFR § 1.704(b) and “37 CFR Part 1 Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term; Final Rule,” Federal Register Vol. 65, No. 181 at 56371.

35. ANSWER: (E) is the most correct answer. Nonpublication of the application does not affect the patent term extension provisions of the Patent Term Guarantee Act of 1999. Thus, statement (B) is true. The patent term extension provisions of 37 CFR §§ 1.702 *et seq.* are separate and independent of the eighteen-month publication provisions. There is no support for statement (A). An applicant may rescind a nonpublication request at any time. *See* “37 CFR Parts 1 and 5 -- Changes To Implement Eighteen-Month Publication of Patent Applications; Final Rule,” Federal Register Vol. 65, No. 183 (9/20/2000) at 57024, middle column. Thus, statement (C) is also true. Accordingly, the best answer is (E).

36. ANSWER: (D) is the most correct answer. In this case, an appeal brief was due two months after the filing of the Notice of Appeal. 37 CFR § 1.192. Joseph’s Notice of Appeal was filed September 19, 2002 and the Appeal Brief was initially due November 19, 2002. This non-

statutory time period could be extended under 37 CFR § 1.136(a). Since Joseph filed the Appeal Brief on March 18, 2003, a four-month extension of time was required. Answer (A) is incorrect because the two-month period for filing the appeal brief is measured from the time that Joseph filed the Notice of Appeal and the six month statutory time period does not apply. Answer (B) is incorrect at least because the premise that the Appeal Brief was filed more than six months after the Notice of Appeal was filed is incorrect.

37. ANSWER: (A) is the most correct answer. 37 C.F.R. § 1.114(a) and (d). The filing of a request for continued examination, including a submission, after the filing of a Notice of Appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal is considered a request to withdraw the appeal and reopen prosecution of the application before the examiner. The submission may be an amendment to the written description. 37 C.F.R. § 1.114(c). See, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50095, left column, third complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (B) is not the most correct answer. 37 C.F.R. § 1.114(a)(3). The procedure of § 1.114 is not available in an application after the filing of a Notice of Appeal to the Federal Circuit unless the appeal is terminated and the application is still pending. See, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50095, middle column, first complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (C) is not the most correct answer. The filing of an RCE (with a submission and fee) in an allowed application after the issue fee has been paid without a petition under 37 C.F.R. § 1.313 to withdraw the application from issue “will not operate to avoid issuance of the application as a patent.” See, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50095, middle column, second complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (D) is not the most correct answer. The procedure of § 1.114 is not available in an application after the filing of a Notice of Appeal to the Federal Circuit unless the appeal is terminated and the application is still pending. See, MPEP 1216.01; and “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50095, middle column, first complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (E) is not the most correct answer. 37 C.F.R. § 1.114(e)(1). “The continued examination provisions of 35 U.S.C. 132(b) and §1.114...will not be available for: (1) A provisional application (which is not examined under 35 U.S.C. chapter 12).” See, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50095, left column, second complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000).

38. ANSWER: (D) is the most correct answer. 37 C.F.R. § 1.28(a) and (b) provides that a request for a refund based on the excess amount paid on establishment of small entity status must be filed within three (3) months of the date of the timely payment of the full fee. The date of the timely payment of the full fee in this case is Monday, October 9, 2000. Hence, the three month period ends on Tuesday, January 9, 2001. The filing of a request for a one month extension of time on Monday, December 11, 2000, does not extend the three-month time period from the date of the timely payment of the full fee because 37 C.F.R. § 1.28(a) states, “The three-month time period is not extendable under § 1.136.”

39. ANSWER: (C) is the correct answer. 37 CFR § 1.510(b) (effective November 7, 2000); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54649 (September 8, 2000). As stated in 65 FR at 54649, middle column, “Section 1.510(b)(4) now sets forth the requirement that a copy of the patent for which reexamination is requested must be submitted in double column format, on single-sided sheets only.” Thus (C) is correct. (A) is incorrect because 37 CFR § 1.510(b)(1) requires that each substantial new question of patentability be based on prior patents and publications. (B) is incorrect because the statement in (B) is required by 37 CFR § 1.293(b), not by 37 CFR § 1.510(b). (D) is incorrect because under 37 CFR § 1.510(b)(5), the name and address of the party served must be indicated if the request is by a person other than the patent owner.

40. ANSWER: (A) is the most correct answer. Answer (A) is not true since Jack did not invent the knife, therefore he is not entitled to a patent. Jack derived the invention from another, and the picture of Jack with the Vietnamese knife is evidence of derivation. 35 U.S.C. § 102(f); MPEP § 2137. Answer (B) is correct in that Jack should have disclosed “all information material to patentability,” including the existence of the Vietnamese knife, during the original patent prosecution. (C) is correct in that to qualify as prior under 35 U.S.C. § 102(b), the use must be in this country. (D) is correct in that a request for reexamination must be based upon patents and printed publications. (E) is correct in that public use derived from the inventor’s own work cannot be used against the inventor under 35 U.S.C. § 102(a). MPEP § 2132.

41. ANSWER: (D) is the most correct answer. There is no such refund permitted since 35 U.S.C. 42(d) only permits a refund of any fee “paid by mistake or any amount paid in excess of that required.” According to the statute, any refund of an “amount paid in excess” must be based upon an overpayment of a fee that was, in fact, required when the fee was paid. See “Changes to Implement the Patent Business Goals; Final Rule,” 65 F.R. 54604, 54642 (center column) (September 8, 2000), 1238 Official Gazette 77 (September 19, 2000). As to (A) and (B), see “Changes to Implement the Patent Business Goals; Final Rule,” 65 F.R. 54604, 54642 (center column) (September 8, 2000), 1238 Official Gazette 77 (September 19, 2000), which states: “[t]his procedure further expedites design application processing by decreasing clerical processing time as well as the time spent routing the application between processing steps... . Further, the ‘Petition to Make Special’ procedure will continue to be made available without any anticipated increase in the required petition fee.” As to (C), it contains all of the elements of 37 CFR § 1.155(a), which provides “(a) The applicant may request that the Office expedite the examination of a design application. To qualify for expedited examination: (1) The application must include drawings in compliance with § 1.84; (2) The applicant must have conducted a preexamination search; and (3) The applicant must file a request for expedited examination including: (i) The fee set forth in § 1.17(k); and (ii) A statement that a preexamination search was conducted. The statement must also indicate the field of search and include an information disclosure statement in compliance with § 1.98.” As to (E), it contains all of the elements of 37 CFR § 1.155(b), which provides “(b) The Office will not examine an application that is not in condition for examination (e.g., missing basic filing fee) even if the applicant files a request for expedited examination under this section.”

42. ANSWER: (A) is the most correct answer. 37 CFR § 1.97(b)(4) and (c), effective date November 7, 2000; see, “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR

54604, 54630 (September 8, 2000); and 37 CFR § 1.114, effective date August 16, 2000, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 FR 50092 (Aug. 16, 2000). (A) is correct since November 15, 2000, is “before the mailing of a first Office action after the filing of a request for continued examination under § 1.114” (37 CFR § 1.97(b)(4)). As stated in 65 FR 54630, column 2, “As the filing of a RCE under § 1.114 is not the filing of an application, but merely continuation of the prosecution in the current application, § 1.97(b)(4) does not provide a three-month window for submitting an IDS after the filing of a request for continued examination. Thus, choices (B) and (C) are each incorrect as they are subject to the requirements of 37 CFR § 1.97(c). (E) is incorrect since (A) is correct. (D) is incorrect because (B) is incorrect.

43. ANSWER: (C) is the correct answer. MPEP § 608.04(c) includes the following recitation:

Where the new matter is confined to amendments to the specification, review of the examiner’s requirement for cancellation is by way of petition. But where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one.

See, also, MPEP § 706.03(o), which includes the following recitation:

In amended cases, subject matter not disclosed in the original application is sometimes added and a claim directed thereto. Such a claim is rejected on the ground that it recites elements without support in the original disclosure under 35 U.S.C. 112, first paragraph.

[Note re Question 43, third line of factual background: Examination proctors were instructed to direct examination candidates to delete from the third line of the factual background the word --in--. The question has been carefully reviewed to see if there is any alternative reasonable meaning to the question if the change was not made. No such meaning was found. The Director of Enrollment and Discipline concluded that omission of the change should have no material affect on the question, and should not inhibit an individual’s ability to correctly answer the question.

44. ANSWER: (A) is the most correct answer. 37 C.F.R. § 1.192(a); MPEP § 1206, “Time For Filing Appeal Brief.” (B) is incorrect. 37 C.F.R. § 1.192(a); MPEP § 1206, “Time For Filing Appeal Brief.” (C) is incorrect. MPEP § 1206, 1215.04. Although failure to file the brief within the permissible time will result in dismissal of the appeal, if any claims stand allowed, the application does not become abandoned by the dismissal, but is returned to the examiner for action on the allowed claims. (D) is incorrect. 37 C.F.R. § 1.137(a) or (b), MPEP § 1206, “Time For Filing Appeal Brief.” A proper brief must be filed before the petition to revive the application and reinstate the appeal will be considered on its merits. Alternatively, a continuing application or an RCE may be filed. 37 C.F.R. § 1.137(c). (E) is incorrect. MPEP § 1206, “Time For Filing Appeal Brief.” The time extended is added to the calendar day of the original period, as opposed to being added to the day it would have been due when said last day is a Saturday, Sunday, or Federal holiday.

45. ANSWER: (B) is the most correct answer. 37 C.F.R. § 1.84(e), (f) and(g). *See*, Changes to Implement Eighteen-Month Publication of Patent Applications, Final Rule, 65 F.R. 57024, 57031-57032 (September 20, 2000), 1239 O.G. 125 (Oct. 17, 2000). (A) is not the most correct answer. 37 CFR § 1.84(j) provides that views in a drawing must not be connected by projection lines, and views must not contain center lines. (C) is not the most correct answer. 37 C.F.R. § 1.84(a)(2) provides that “[c]olor drawings are not permitted in...an application, or copy thereof, submitted under the Office electronic filing system. The Office will accept color drawings in utility or design patent applications...only after granting a petition filed under this paragraph explaining why the color drawings are necessary.” Any such petition must include a fee and meet the certain requirements set forth in the last sentence of § 1.84(a)(2). *See*, Changes to Implement Eighteen-Month Publication of Patent Applications, Final Rule, 65 F.R. 57024, 57031 (September 20, 2000), 1239 O.G. 125 (Oct. 17, 2000). (D) is not the most correct answer. 37 C.F.R. § 1.84(b)(1) was “amended to eliminate the requirement for three copies of black and white photographs and a petition to accept such photographs.” *See*, Changes to Implement The Patent Business Goals, Final Rule, 65 F.R. 54604, 54628, middle column (September 8, 2000), 1238 O.G. 77 (Sept. 19, 2000). (E) is not the most correct answer. 37 C.F.R. § 1.84(k) provides that “Indications such as ‘actual size’ or ‘scale ½’ on the drawings are not permitted since these lose their meaning with reproduction in a different format.” *See*, Changes to Implement The Patent Business Goals, Final Rule, 65 F.R. 54604, 54628, right column (September 8, 2000), 1238 O.G. 77 (Sept. 19, 2000).

[Note re Question 45, choice (E), first line: Examination proctors were instructed to direct examination candidates to insert after “must,” the word --be--. The question has been carefully reviewed to see if there is any alternative reasonable meaning to the question if any or all of the change was not made. No such meaning was found. The Director of Enrollment and Discipline concluded that omission of the change should have no material affect on the question, and should not inhibit an individual’s ability to correctly answer the question.

46. ANSWER: (E) is the most correct answer. 37 C.F.R. § 1.33(c). (A) is incorrect. MPEP § 403, p.400-9. Powers of attorney to firms filed in executed applications filed after July 2, 1971, are not recognized by the Patent and Trademark Office. However, the firm’s address will be considered to be the correspondence address. (B) is incorrect. MPEP § 402.02, and 406. The associate attorney may not appoint another attorney. (C) is incorrect. 37 C.F.R. § 1.36. An assignment will not itself operate as a revocation of a power or authorization previously given. (D) is incorrect. MPEP § 402.05. Revocation of the power of the principal attorney or agent revokes powers granted by him or her to other attorneys or agents

47. ANSWER: (E) is the most correct answer. For (A) *see*, “Utility Examination Guidelines,” 66 F.R. 1092, 1099, left column (Jan. 5, 2001). “The applicant can do this by... providing reasoning or arguments... .” For (B), *see*, “Utility Examination Guidelines,” 66 F.R. 1092, 1099, left column (Jan. 5, 2001). “The applicant can do this by amending the claims... .” For (C) *see*, “Utility Examination Guidelines,” 66 F.R. 1092, 1099, left column (Jan. 5, 2001). “The applicant can do this by...providing evidence in the form of a declaration under 37 C.F.R. § 1.132...rebutting the basis or logic of the prima facie showing.” For (D), *see*, “Utility Examination Guidelines,” 66 F.R. 1092, 1099, left column (Jan. 5, 2001). “The applicant can do this by...providing evidence in the form of a...printed publication...rebutting the basis or logic

of the *prima facie* showing.” (A), (B), (C), and (D) alone are not the most correct answer inasmuch (E), referencing all of the above, is the most correct answer.

48. ANSWER: (D) is the most correct answer. With regard to Statement (A), public use in Canada is not a statutory bar under 35 U.S.C. § 102(b) regardless of whether Canada is a NAFTA country. MPEP § 706.02(c). Thus, although UpNorth cannot claim priority to the Canadian application under 35 U.S.C. § 119(a), their commercial activity is not a bar. Statement (B) is incorrect because UpNorth cannot rely on the Canadian application for priority. 35 U.S.C. § 119(a). Under the given facts, the Canadian application would not be prior art against a U.S. application regardless of whether the Canadian application was abandoned. Thus, (C) is not reasonable advice. Under 35 U.S.C. § 104, UpNorth can rely on Canadian activities to establish a date of invention prior to the competitor’s commercial use in the United States. Statement (E) is therefore not reasonable advice.

49. ANSWER: (C) is the most correct answer. See, “Utility Examination Guidelines,” 66 F.R. 1092, 1098, left column (Jan. 5, 2001), “A claimed invention must have a specific and substantial utility. This requirement excludes ‘throw-away,’ ‘insubstantial,’ or ‘nonspecific’ utilities, such as the use of a complex invention as landfill, as a way of satisfying the utility requirement of 35 U.S.C. 101.” (A) is not the most correct answer. See, “Utility Examination Guidelines,” 66 F.R. 1092, 1097, middle column (Jan. 5, 2001), “An applicant need only provide one credible assertion of specific utility for each claimed invention to satisfy the utility requirement.” (B) is not the most correct answer. See, “Utility Examination Guidelines,” 66 F.R. 1092, 1098, middle column (Jan. 5, 2001), “Any rejection based on lack of utility should include a detailed explanation why the claimed invention has no specific and substantial credible utility. Whenever possible, the examiner should provide documentary evidence regardless of publication date (*e.g.*, scientific or technical journals, excerpts from treatises or books, or U.S. or foreign patents) to support a factual basis for the *prima facie* showing of no specific and substantial credible utility.” (D) is not the most correct answer. See, “Utility Examination Guidelines,” 66 F.R. 1092, 1098, left column (Jan. 5, 2001), wherein it states, “An invention has a well-established utility (1) if a person of ordinary skill in the art would immediately appreciate why the invention is useful based on the characteristics of the invention (*e.g.*, properties or applications of a produce or process), and (2) the utility is specific, substantial, and credible.” (E) is not the most correct answer. See, “Utility Examination Guidelines,” 66 F.R. 1092, 1098 right column (Jan. 5, 2001), which states what is recited in (E).

50. ANSWER: (D) is the most correct choice. MPEP § 2173.05(h), and *Ex Parte Cordova*, 10 USPQ2d 1949 (Bd. Pat. App. & Inter. 1989) and 35 U.S.C. § 102(b). (A) is incorrect since the article does not disclose a metallic shoelace, whereas Claim 1 requires a telecommunications device having a metallic shoelace. Since the “optional” element does not have to be disclosed in a reference for the claim to be anticipated, claims 2 and 3, which provide for inclusion of optional elements, are each anticipated by the article. Thus, (B), and (C), are incorrect. Inasmuch as (C) is correct, (E) is incorrect.