

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

Afternoon Session Model Answers

1. ANSWER: (B) is the most correct answer. 37 C.F.R. § 1.53(c)(3) requires the presence of a claim to convert a provisional application to a nonprovisional application. The Office will set a time period within which a claim must be submitted for the Office to grant the request if the provisional application does not have a claim and a claim is not filed with the request. See, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50099, middle column, (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (A) is not the most correct answer. 37 C.F.R. § 1.53(c)(3). There is only one application, and that application has a single filing date, the filing date of the provisional application. See, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50099, left column (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (C) is not the most correct answer. 35 U.S.C. § 111(b)(7); 37 C.F.R. § 1.53(c)(4). (D) is not the most correct answer. 37 C.F.R. § 1.53(c)(3) requires that any request to convert a provisional application to a nonprovisional application be filed prior to abandonment of the provisional application. See, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50098, left and middle columns (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (E) is not the most correct answer. The provisions of 35 U.S.C. § 119(e)(2) were amended to eliminate the requirement that a nonprovisional application claiming the benefit of a provisional application must have been filed during the pendency of the provisional. See, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50098, left and middle columns (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000).

2. ANSWER: (A) is the most correct answer, while (D) is not the most correct answer. See MPEP § 715.05, which, in pertinent part, states:

When the reference in question is a noncommonly owned U.S. patent claiming the same invention as applicant and its issue date is less than 1 year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, must be by way of 37 CFR 1.608 instead of 37 CFR 1.131... . The reference patent can then be overcome only by way of interference.

(B) and (C) are not the most correct answers. See MPEP § 715.05, which, in pertinent part, states:

If the patent is claiming the same invention as the application and its issue date is 1 year or more prior to the presentation of claims to that invention in the application, a rejection of the claims of the application under 35 U.S.C. 135(b) should be made. See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632, 1635 (Fed.Cir. 1997) (The court holding that application of 35 U.S.C. 135(b) is not limited to inter partes interference proceedings, but may be used as a basis for ex parte rejections.).

(E) is a wrong answer because an affidavit or declaration traversing a ground of rejection may be received only where the reference “substantially shows or describes but does not claim the same patentable invention.” 37 CFR § 1.132.

3. ANSWER: All answers accepted.

4. ANSWER: (D) is the most correct answer. 37 CFR § 1.105 (effective November 7, 2000), “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54633 (September 8, 2000), and 37 CFR § 1.56(c). A named inventor, and an attorney who prepares and prosecutes the application, are identified in 37 CFR § 1.56(c), and an assignee is specified in 37 CFR § 1.105(a)(1). Therefore (D) is correct. (E) is incorrect because (D) is correct.

5. ANSWER: (E) is the correct answer. 37 CFR § 1.115(b)(1) (effective November 7, 2000); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54636 (September 8, 2000). As stated in 65 FR at 54636, middle and right columns, “Factors that will be considered in disapproving a preliminary amendment include: the state of preparation of a first Office action as of the date of receipt (§ 1.6, which does not include § 1.8 certificate of mailing dates) of the preliminary amendment by the Office...” Thus, choices (C) and (D) are incorrect.

6. ANSWER: (E) is the most correct answer. The cancellation of Claim 3 overcomes the examiner’s objection. The addition of Claims 4 and 5 provide the client with patent protection in product by process format for the cable by both methods of manufacture. Thus, if Claim 4 is invalid, Claim 5 may remain valid. Answer (A) is incorrect because it is an improper multiple dependent claim. 35 U.S.C. § 112 ¶ 5; 37 C.F.R. § 1.75(c); MPEP § 608.01(n), part (I)(B)(1). Answer (B) alone is incorrect because, even though canceling the claim will overcome the rejection, it will also leave the application without a claim to the Ethernet cable made using the processes set forth in either Claim 1 or Claim 2. Answer (C) alone is not the most correct answer because even though canceling Claim 3 will overcome the rejection and provides protection for the Ethernet cable made by the process comprising the steps A, B and C, it will also leave the application without a claim to the Ethernet cable made using the processes comprising the steps of A, B, C, and D. Answer (D) alone is not the most correct answer because even though canceling Claim 3 will overcome the rejection and provides protection for the Ethernet cable made by the process comprising the steps A, B, C, and D, it will also leave the application without a claim to the Ethernet cable made using the processes comprising the steps of A, B, and C.

7. ANSWER: (D), not being in accord with proper USPTO practice and procedure, is the most correct answer. Photographs and ink drawings may not appear in the same application. See § 1.152 Design drawings. Moreover, the order is not that appearing in 37 CFR § 1.154. As to (A), (A) contains the elements set forth in 37 CFR § 1.154 (a), which provides “(a) The elements of the design application, if applicable, should appear in the following order: (1) Design application transmittal form. (2) Fee transmittal form. (3) Application data sheet (see § 1.76). (4) Specification. (5) Drawings or photographs. (6) Executed oath or declaration (see § 1.153(b)).” As to (B), (B) contains the elements set forth in 37 CFR § 1.154 (b), which provides: “(b) The specification should include the following sections in order: (1) Preamble, stating the name of

the applicant, title of the design, and a brief description of the nature and intended use of the article in which the design is embodied. (2) Cross-reference to related applications (unless included in the application data sheet). (3) Statement regarding federally sponsored research or development. (4) Description of the figure or figures of the drawing. (5) Feature description. (6) A single claim.” As to (C), (C) contains the elements set forth in 37 CFR § 1.154 (c), which provides “(c) The text of the specification sections defined in paragraph (b) of this section, if applicable, should be preceded by a section heading in uppercase letters without underlining or bold type.” Since (D) is incorrect, (E) is not the right answer.

8. ANSWER: (B) is the most correct answer. *See, e.g., Ex parte Lemieux*, 115 USPQ 148 (Bd. Pat. App. & Int. 1957); MPEP 715.01(c). (A) is incorrect because even if the promotional article constituted an offer to sell in the United States, it was made less than a year prior to Thomas' filing date. 35 USC § 102(b). With regard to statement (C), there is no requirement under 35 USC § 102 that a publication be made with an inventor's knowledge or permission before it constitutes prior art. Statement (D) is incorrect at least because the Birdoculars were “described in a printed publication in...a foreign country” (35 USC § 102(a)) before Thomas' filing date and is therefore presumptive prior art. There is no requirement that a publication describe something that has actually been reduced to practice before the publication can act as a prior art reference. Thus, statement (E) is not correct.

9. ANSWER: (E) is the most correct answer. Thomas may rely on activities in both Germany (a WTO member country) and Canada (a NAFTA country) in establishing a date of invention prior to publication of the Saskatoon Times article or in establishing priority. 35 U.S.C. § 104; see also MPEP 715.01(c).

10. ANSWER: All answers accepted.

11. ANSWER: (E) is the most correct answer. Invocation of the sixth paragraph of 35 U.S.C. § 112 does not exempt an applicant from compliance with the first and second paragraphs of 35 U.S.C. § 112. 35 U.S.C. § 112, paragraph 6; *See*, “Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, para. 6,” 65 F.R. 38510, 38514 (June 21, 2000), 1236 O.G. 98 (July 25, 2000) (middle column). (A), being in conformity with proper USPTO practice and procedure, is not correct. *See*, “Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, para. 6,” 65 F.R. 38510, 38514 (June 21, 2000), 1236 O.G. 98 (July 25, 2000) (middle column). (B), being in conformity with proper USPTO practice and procedure, is not correct. 35 U.S.C. § 112, ¶ 1; *In re Donaldson*, 16 F.3rd 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994); *B. Braun Medical, Inc. v. Abbott Lab.*, 124 F.3d 1419, 1425, 43 USP2d 1896, 1900 (Fed. Cir. 1997); *In re Dossel*, 115 F.3d 942, 946, 42 USPQ2d 1881, 18840185 (Fed. Cir. 1997); *See*, “Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, para. 6,” 65 F.R. 38510, 38514 (June 21, 2000), 1236 O.G. 98 (July 25, 2000) (middle column). (C) and (D), being in conformity with proper USPTO practice and procedure, are not correct. *See*, “Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, para. 6,” 65 F.R. 38510, 38514 (June 21, 2000), 1236 O.G. 98 (July 25, 2000) (right column).

[Note re Question 11, choice (D), second line: Examination proctors were instructed to direct examination candidates in choice (D), line 2, to change the word “clear” to –clearly–. 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.

12. ANSWER: (C) is the most correct answer. See “Changes to Implement Eighteen-Month Publication of Patent Applications; Final Rule,” 65 F.R. 57024, 57030, right column, which provides “Section 1.55(c) provides that any claim for priority under 35 U.S.C. 119(a) - (d) or 365(a) not presented within the time provided by §1.55(a) is considered to have been waived. Section 1.55(c) also provides that if a claim to priority under 35 U.S.C. 119(a)-(d) or 365(a) is presented after the time period provided by §1.55(a), the claim may be accepted if the claim identifying the prior foreign application by specifying its application number, country, and the day, month and year of its filing was unintentionally delayed.” As to (A), (A) is incorrect in that § 1.55(a) states that an applicant “may claim the benefit of the filing date of one or more prior foreign applications” and an applicant may want to claim priority to several applications and not just the earliest, since different priority applications may relate to different embodiments. As to (D), the claim for foreign priority must identify the foreign application for which priority is claimed, *as well as* any foreign application for the same subject matter and having an earlier filing date than the application for which priority is claimed. 37 C.F.R. § 1.55(a)(1)(i). As to (E), see 37 C.F.R. § 1.55(b) wherein it is stated: “[t]he affidavit or declaration must include a specific statement that, upon an investigation, he or she is satisfied that to the best of his or her knowledge, the applicant, when filing the application for the inventor’s certificate, had the option to file an application for either a patent or an inventor’s certificate as to the subject matter of the identified claim or claims forming the basis for the claim of priority.”

13. ANSWER: (D) is the most correct answer. The question is directed to the proper conduct by patent attorneys and agents. Practitioners, including registered patent agents, (37 C.F.R. § 10.1(r)), may advertise on television and radio. 37 C.F.R. § 10.32(a). Additionally, a registered patent agent may accept cases on a contingent fee basis. 37 C.F.R. § 10.36(b)(8) (permits contingent and fixed fees that are not clearly excessive or illegal). (A) and (B) are incorrect. The patent agent is not authorized to practice in trademark cases. 37 C.F.R. § 10.14(b). (C) is incorrect. Practitioners are proscribed from entering into partnership agreements restricting their right to practice before the USPTO. 37 C.F.R. § 10.38(a). The agreement in choice (C) provides “that after termination of the partnership, the agent and the attorney will not practice in each other’s neighborhoods or accept each other’s established clients,” which is contrary to 37 C.F.R. § 10.38(a). (E) is incorrect. A patent agent is proscribed from misrepresenting himself or herself as being a registered patent attorney. 37 C.F.R. §§ 10.23(b)(4) and 10.34(b).

14. ANSWER: (B) is the correct answer. 37 CFR § 1.176(b) (effective November 7, 2000); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54644 (September 8, 2000). As stated in 65 FR at 54644, left column, “Section 1.176(b) now allows the Office to make a restriction requirement in a reissue application between claims added in a reissue application and the original patent claims, where the added claims are directed to an invention which is separate and distinct from the invention(s) defined by the original patent

claims.” Thus (A) is incorrect. (C) is incorrect because the original patent claims “will be held to be constructively elected...” 37 CFR § 1.176(b). (D) is incorrect because (A) is incorrect. (E) is incorrect because (B) is correct.

15. ANSWER: (C) is the most correct answer. 37 C.F.R. § 3.56 recites, “Assignments which are made conditional...are regarded as absolute assignments for Office purposes... . The Office does not determine whether such conditions have been fulfilled.” MPEP § 317.03. (A), (B), (D), and (E) are incorrect because they are false statements. Regarding (B), MPEP § 317.03 recites, “Since the Office will not determine whether a condition has been fulfilled, the Office will treat the submission of such an assignment for recordation as signifying that the act or event has occurred.” Regarding (E), MPEP § 317.03 recites, “[T]he recording of a document is not a determination by the Office of the validity of the document or the effect that document has on the title to an application or patent.”

16. ANSWER: (B) is the most correct answer. When the article is preexisting, one may only secure patent protection of the method of using the article. Since claim 11 is defined in terms of circuitry and this circuitry was preexisting, claim 11 is not allowable. *Cf. Monsanto Co. v. Rohm & Haas Co.*, 312 F.Supp. 778, 164 USPQ 556 (ED Pa. 1970), *aff'd*, 456 F.2d 592, 172 USPQ 324 (CA 3), *cert. denied*, 407 U.S. 934, 172 USPQ 323 (1972) (new use of preexisting chemical as herbicide entitles applicant to method claims). (A) is incorrect because claim 12 is not barred by 35 U.S.C. § 102(b). As to (C), the remote control device was preexisting and claim 11 reads on the circuitry as it existed in 1995. (D) is incorrect. The manner of invention, whether it be by painstaking research or an inadvertent discovery of a new use is without significance. As to (E), claim 11 is not patentable based upon previous public use. The evidence of commercial success, which may be relevant for overcoming a rejection under 35 U.S.C. § 103, cannot overcome a rejection under 35 U.S.C. § 102.

17. ANSWER: (C) is the most correct answer. *See*, “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1105 (Jan. 5, 2001) left column, first paragraph. “The claimed invention as a whole may not be adequately described if the claims require an essential or critical feature that is not described in the specification and is not conventional in the art or known to one of ordinary skill in the art.” (A) is not the most correct answer. *See*, “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1104 (Jan. 5, 2001) right column, last paragraph. Describing an actual reduction to practice of the claimed invention is a means of showing possession of the invention. (B) is not the most correct answer. *See*, “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1104 (Jan. 5, 2001) right column, last paragraph. (D) is not the most correct answer. *See*, “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1105 (Jan. 5, 2001), left column, second paragraph, which states, “While there is no *in haec verba* requirement, newly added claim limitations must be supported by in the specification through express, implicit, or inherent disclosure.” (E) is not the most correct answer. *See*, “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1105 (Jan. 5, 2001), left column, second paragraph, which states, “An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not

only recognize the existence of the error in the specification, but also recognize the appropriate correction.”

18. ANSWER: (A) is the most correct answer. 35 U.S.C. § 102(d). The foreign application need not be published, but the patent rights granted must be enforceable. MPEP § 706.02(e). (B), (C), (D) and (E) are required by 35 U.S.C. § 102(d).

19. ANSWER: (D) is the correct answer. 37 CFR § 1.33(a)(1) (effective November 7, 2000) “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54617 (September 8, 2000). 37 CFR § 1.33(a)(1), in pertinent part provides, “Thus, the inventor(s), any registered practitioner named in the transmittal papers accompanying the original application, or a party that will be the assignee who filed the application, may change the correspondence address in that application under this paragraph.” As stated in 65 FR at 54617, middle column, “The parties who may so change the correspondence address would include only the one inventor filing the application, even if more than one inventor was identified on the application transmittal letter.” Since (A), (B), and (C) are provided for in 37 CFR § 1.33(a)(1), (D) is correct. (E) is incorrect because (D) is correct.

20. ANSWER: All answers accepted.

21. ANSWER: (A) is the most correct answer. The USPTO does not require or recommend a minimum or maximum number of dependent claims. 37 C.F.R. § 1.75(c). (B) is a USPTO recommendation. See MPEP 608.01(m) (“Claims should preferably be arranged in order of scope so that the first claim presented is the least restrictive.”). (C) is a USPTO recommendation. See MPEP 608.01(m) (“Similarly, product and process claims should be separately grouped.”). (D) is a PTO recommendation. See MPEP 608.01(n), part IV. (E) is a USPTO requirement. See MPEP 608.01(m) (“Each claim begins with a capital letter and ends with a period.”).

22. ANSWER: (A) is the most correct answer because 37 C.F.R. § 1.131(a)(1) requires that the reference not claim the same patentable invention as the rejected invention. (B), (C), (D), and (E) are wrong because MPEP § 706.02(b) identifies these answers as actions that can be taken to overcome a 35 U.S.C. § 102(a) rejection.

23. (A) is the correct answer. 37 C.F.R. § 1.8(a)(1)(i)(A). MPEP § 512 states, “The Certificate of Mailing procedure does not apply to papers mailed in a foreign country.” Since the Henry application was mailed in Mexico, the stamped date of receipt in the USPTO is controlling. (B) and (E) are wrong because the Henry application is abandoned. (C) and (D) are wrong because the Alice application was transmitted to the USPTO by facsimile. 37 C.F.R. §§ 1.6(d) and 1.8(a)(1)(i)(B). In such case, a Certificate of Transmission serves to avoid abandonment even though the transmission is from a foreign country. In this regard, MPEP § 512 states:

Under 37 CFR 1.8, a person may state on certain papers directed to the Office... the date on which the paper will be...transmitted by facsimile. If the date stated is within the period of reply, the reply in most instances will be considered timely. This is true even if the paper does not actually reach the Office until after the end of the period for reply.

The Certificate of Transmission procedure, however, also applies to papers transmitted to the Office from a foreign country... .

24. ANSWER: (D) is the most correct answer. 37 CFR § 1.114 (effective August 16, 2000), *see*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 FR 50092, 50096 (Aug. 16, 2000); and 37 CFR § 1.8. As stated in 65 FR 50096, column 3, “(4) a request for continued examination under § 1.114 is entitled to the benefit of a certificate of mailing under § 1.8 (*cf.* 1.8(a)(2)(i)(A))...” (A) is correct. The filing of a reply under 37 CFR § 1.111 in a national patent application is not a case enumerated in 37 CFR § 1.8(a)(2). (C) is included in 37 CFR § 1.8(a)(1), and thus (D) is correct. (B) is incorrect. 37 CFR § 1.8(a)(2)(i)(A). (E) is incorrect because (B) is incorrect.

25. ANSWER: (C) is the most correct answer. 37 C.F.R. § 1.114 and 1.53(d). “An applicant in a utility application filed on or after June 8, 1995, and before May 29, 2000, may obtain further examination either by timely filing a request for continued examination under § 1.114, or by timely filing a continued prosecution application under § 1.53(d).” *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50096, middle column, first complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (A) is not the most correct answer. 37 C.F.R. § 1.114(a) and (c). The filing of a request for continued examination and payment of the fee for the request is not sufficient to toll the running of any time period set in the final rejection for reply to avoid abandonment of the application. If a reply to an Office action is due, a submission meeting the requirements of 37 C.F.R. § 1.111 must be timely received to continue examination of an application. *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). (B) is not the most correct answer. 37 C.F.R. § 1.114(a)(2). “Under the request for continued examination procedure..., a submission will be considered if the submission and the requisite fee is filed prior to the abandonment of the application.” *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50096, left column, second complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (D) is not the most correct answer. 35 U.S.C. § 154, Pub. Law 106-113, § 4405. The application is not entitled to patent term adjustment. “If...an applicant in a utility...application filed before May 29, 2000 (but on or after June 8, 1995) files a request for continued examination under § 1.114, the application being prosecuted is not an application filed on or after May 29, 2000, and is not entitled to the patent term adjustment provisions of Pub. L. 106-113.” *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50096, middle column, first complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (E) is not the most correct answer. 35 U.S.C. § 154, Pub. Law 106-113, § 4405. The CPA application is entitled to patent term adjustment. “If...an applicant in a utility...application filed before May 29, 2000, files a CPA under § 1.53(d) after May 29, 2000, the application being prosecuted (now a CPA) is an application filed on or after May 29, 2000, and is entitled to the patent term adjustment provisions of Pub. L. 106-113.” *See*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50096, middle column, first complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000).

26. ANSWER: (A) is the most correct answer. 37 C.F.R. § 1.114(d), last sentence. (B), (C), (D), and (E) are not the most correct answers. Each is recognized as being a “submission” within the scope of 37 C.F.R. § 1.114(c).

27. ANSWER: (A) is the most correct answer. MPEP § 2133.03(e)(1) and 35 U.S.C. § 102(b). II does not create a statutory bar because it is permitted experimental testing. MPEP § 2133.03(e)(3) and 2133.03(e). Therefore (B) is incorrect. III does not create a statutory bar because the sale did not occur in the United States. MPEP § 2133.03(d). Therefore, (C) and (D) are incorrect. (E) is incorrect because (A) is correct.

28. ANSWER: (A) is the most correct answer. 35 U.S.C. § 102(g) applies only when another inventor has not abandoned, suppressed or concealed the invention. In this case, Molly concealed the invention for 12 years. It was not until she saw the popularity of Troy’s device that she filed a patent application. (A) is not true because Molly concealed the invention. (B) is not true since the invention of Molly was concealed for 12 years and effectively abandoned. (C) is not true since §102(a) applies only when the invention is publicly known by others. Since (A) is true, (E) is not.

29. ANSWER: (B) is the most correct answer. See 37 C.F.R. § 1.196(b); MPEP § 1214.01. As to (A) see MPEP §1206, p.1200-8, “(6) Issues.” As to (C), the recapture doctrine prevents claims from being recaptured. See MPEP § 1412.02. As to (D) see 37 C.F.R. § 1.196(d) and MPEP § 1212 where it states that failure to respond in time will result in dismissal of the appeal. As to (E), third party may not appeal 37 C.F.R. §§1.310 and 1.303(a). *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 11 USPQ2d 1866, 1869 (Fed. Cir. 1989) (a reexamination under 35 U.S.C. § 302 is conducted *ex parte* after it is instituted); *In re Opprecht*, 10 USPQ2d 1718 (Fed. Cir. 1989) (third parties do not participate in *ex parte* reexamination before the USPTO).

30. ANSWER: (B) is the most correct answer. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947) (holding that the “lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon” is not relevant to an affidavit or declaration under 37 C.F.R. 1.131(b)); MPEP § 715.07(a). (A) is incorrect. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm’r Pat. 1889); MPEP § 715.07(a). Applicant must show evidence of facts establishing diligence. (C) is incorrect. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958) (after conception has been clearly established, diligence must be considered prior to the effective date is clearly established, since diligence then comes into question); MPEP § 715.07(a). (D) is incorrect. MPEP § 715.07(c). 37 C.F.R. 1.131(a) provides for the establishment of a date of completion of the invention in a NAFTA or WTO member country, as well as in the United States, an applicant can establish a date of completion in a NAFTA member country on or after December 8, 1993, the effective date of section 331 of Public Law 103 - 182, the North American Free Trade Agreement Act, and can establish a date of completion in a WTO member country other than a NAFTA member country on or after January 1, 1996, the effective date of section 531 of Public Law 103 - 465, the Uruguay Round Agreements Act. Not all countries are members of NAFTA or WTO, and prior invention in a foreign country cannot be shown without regard for when the reduction to practice occurred. (E) is incorrect. MPEP § 715.07. Actual reduction to practice generally, but not always, requires a showing that the apparatus actually

existed and worked, “There are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice. *In re Asahi/America Inc.*, 68 F.3d 442, 37 USPQ2d 1204 (Fed. Cir. 1995) (citing *Newkirk v. Lulegian*, 825 F.2d 1581, 3USPQ2d 1793 (Fed. Cir. 1987) and *Sachs v. Wadsworth*, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931). The claimed restraint coupling held to be so simple a device that mere construction of it was sufficient to constitute reduction to practice. Photographs, coupled with articles and a technical report describing the coupling in detail were sufficient to show reduction to practice.).

31. ANSWER: (E) is the most correct answer because 35 U.S.C. § 112 authorizes multiple dependent claims as long as they are in the alternative form. MPEP § 608.01(n), subsection I A.

32. ANSWER: (B) is the most correct answer because patentability of a product claimed by a product-by-process claim is based on the product itself, and the claimed subject matter in claim 2 is not naturally occurring. MPEP § 2105. (A) is incorrect because claim 1 recites both a product and a process in the same claim and is therefore not within one of the statutory classes set forth by 35 U.S.C. 101. MPEP § 2173.05(p), subpart (II). (C) and (D) are incorrect because claim 3 is drawn to a naturally occurring composition. MPEP § 2105. (E) is incorrect because (B) is correct.

33. ANSWER: (A) is the most correct answer. MPEP § 2144.03. I is incorrect because an applicant must seasonably traverse the well-known statement or the object of the well-known statement is taken to be admitted prior art. *In re Chevenard*, 60 USPQ 239 (CCPA 1943). Therefore (B) and (D) are incorrect. III is incorrect because the action can potentially be made final. Therefore (C) is incorrect. (E) is incorrect because (A) is correct.

34. ANSWER: All answers accepted.

35. ANSWER: (B) is the correct answer. The phrase “consisting of” excludes any step not specified in the claim. MPEP § 2111.03. Thus, a claim that depends from a claim which “consists of” the recited steps cannot add a step. *Id.* Here, the dependent claim adds the step of cooling. Answer (A) is incorrect because the transitional term “comprising” is inclusive or open-ended and does not exclude additional, unrecited steps. MPEP § 2111.03. Answers (C) and (D) are incorrect because the terms “including” and “characterized by” are synonymous with the term “comprising.” MPEP § 2111.03. Answer (E) is incorrect because Answer (C) and Answer (D) are incorrect.

36. ANSWER: (C) is the correct answer. 37 CFR § 1.105 (effective November 7, 2000); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54634 (September 8, 2000). The example at 65 FR 54634, column 2, states, “The examiner cannot require that the reply be more specific or hold the reply to be incomplete based on such information. The examiner can, however, in the next Office action seek confirmation that this is the most specific date that was obtained or can be obtained based on a reasonable inquiry being made if that is not already clear from the reply.” Thus (A) and (B) are incorrect and (C) is correct. (D) is incorrect because (A) is incorrect. (E) is incorrect because (C) is correct.

37. ANSWER: (A) is the most correct answer. The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed before the patent is granted, not before the examiner allows the claims, as is required by 37 CFR § 1.55 (Claim for foreign priority), subparagraph (a)(2), which states “(2) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed before the patent is granted...” As to (B), (B) contains the elements of 37 CFR § 1.55 (a)(2), which states “...If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by the processing fee set forth in § 1.17(i), but the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323.” As to (C), (C) contains the elements of 37 CFR § 1.55 (a)(1)(ii), which provides “(ii) In an application that entered the national stage from an international application after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT.” As to (D), (D) contains the elements of 37 CFR § 1.14(c)(1)(i), which states “[i]f a U.S. patent application publication or patent incorporates by reference, or includes a specific reference under 35 U.S.C. 119(e) or 120 to, a pending or abandoned application, a copy of that application-as-filed may be provided to any person upon written request including the fee set forth in § 1.19(b)(1).” As to (E), (E) contains all of the elements of 37 CFR § 1.14(c)(1)(ii), which states “If an international application, which designates the U.S. and which has been published in accordance with PCT Article 21(2), incorporates by reference or claims priority under PCT Article 8 to a pending or abandoned U.S. application, a copy of that application-as-filed may be provided to any person upon written request including a showing that the publication of the application in accordance with PCT Article 21(2) has occurred and that the U.S. was designated, and upon payment of the appropriate fee set forth in § 1.19(b)(1).”

38. ANSWER: (A) is the correct answer. 37 CFR § 1.115(b)(2) and (c) (effective November 7, 2000); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54636 (September 8, 2000). (A) is correct because a continuation-in-part application is filed under 37 CFR § 1.53(b) and will not be disapproved according to 37 CFR § 1.115(b)(2)(i). (B), (C) and (D) are incorrect because a preliminary amendment will be disapproved if it is not filed on the filing date of the CPA. See, 37 CFR § 1.115(b)(2)(ii). (E) is incorrect because (A) is correct.

39. ANSWER: (B) is the correct answer. 37 CFR § 1.133 (effective November 7, 2000); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54640-54641 (September 8, 2000). As stated in 65 FR at 54641, left column, “Comment 65: One comment urged that interviews be allowed in a CPA prior to a first action. Response: The comment has been adopted in a broader manner to apply to all continuations and substitute applications that conform to practice set forth in the MPEP.” Thus, (B) is correct. (A) is incorrect because interview will not be permitted off Office premises without the authority of the Commissioner. 37 CFR § 1.133(a)(1). (C) is incorrect because an interview for the discussion of the patentability of a pending application will not occur before the first Office action, unless the application is a continuing or substitute application. 37 CFR § 1.133(a)(2). (D) is incorrect because (B) is correct. (E) is incorrect because (A) and (C) are incorrect.

40. ANSWER: (B) is the most correct answer. 35 U.S.C. § 102(b); MPEP § 2173.05(h). Deletion of the anticipated element from the claim leaves an invention that is no longer anticipated by the reference. (A), (D), and (E) are incorrect despite the amendments because the claim remains anticipated since the claim is still directed to the invention described in the reference wherein X is element A. For example, in (D) and (E), element A would still be a member of the group and the claim would still be anticipated by the prior art. (C) is incorrect because the argument does not change the fact that the claim remains anticipated by the same invention described in the reference wherein X is element A. (E) is incorrect because “comprising” cannot be used in a proper Markush group.

41. ANSWER: (C) or (D) are accepted as correct answers. 37 CFR § 1.76(d) (effective November 7, 2000); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54624-25 (Sept. 8, 2000); and 37 CFR § 1.63 (effective November 7, 2000). Under 37 CFR § 1.63(c)(1), Applicant’s mailing address need not be identified in the declaration if it is included in the application data sheet. Thus, (A) is incorrect. The foreign priority information must be included in the declaration because it was not included in the application data sheet. 37 CFR § 1.63(c)(2). Thus, (C) is correct. Applicant’s citizenship in (B) must be included in the declaration under 37 CFR § 1.63(a)(3), if “applicant” in (B) is construed as a person or party, e.g., 37 CFR § 1.42, other than the inventor, and no exception is made for citizenship under 37 CFR § 1.63(c). In the latter instance, where both (B) and (C) are correct, and (D) is the most correct answer because it is inclusive of (B) and (C). (B) alone is not accepted because the foreign priority document must be included in the declaration. (E) is incorrect because (A) is incorrect.

42. ANSWER: (A) is the most correct answer. A petition to make special may be made simply by filing a petition including any evidence showing that the applicant is 65 years of age or more, such as a birth certificate or a statement from the applicant. No fee is required. MPEP § 708.02. Although a petition to make special as indicated in statement (B) is likely available, it would require a petition fee. *Id.* A petition to make special as indicated in statement (B) is likely not available because such a petition may not be based on prospective infringement. *Id.* Also, even if a petition as indicated in statement (C) were available, it would require a petition fee. Thus, neither of these options would be the most inexpensive. (B) also requires a statement explaining the relationship of the invention to safety of research in the field of recombinant DNA research.

43. ANSWER: (C) is the most correct answer. MPEP § 608.01(n). (A) is incorrect because a dependent claim must further limit the subject matter of a previous claim. 37 C.F.R. § 1.75(c). The claim in (B) is actually inconsistent with claim 1. (B) is incorrect because there is no antecedent basis for the wheels. MPEP § 2173.05(e). (D) is incorrect because it does not refer back in the alternative only. MPEP § 608.01(n). (E) is incorrect because (C) is correct.

44. ANSWER: (E) is the most correct answer. As stated in MPEP § 2172.01, “a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968).” (A) is incorrect. As stated in MPEP § 2172.01, “A claim which omits matter disclosed to be essential to the invention as

described in the specification or in other statements of record may be rejected under 35 U.S.C. 112, first paragraph, as not enabling. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976)”; MPEP § 2164.08(c). (B) is incorrect. As stated in MPEP § 2165, “Failure to disclose the best mode need not rise to the level of active concealment or grossly inequitable conduct in order to support a rejection or invalidate a patent. Where an inventor knows of a specific material that will make possible the successful reproduction of the effects claimed by the patent, but does not disclose it, speaking instead in terms of broad categories, the best mode requirement has not been satisfied. *Union Carbide Corp. v. Borg - Warner*, 550 F.2d 555, 193 USPQ 1 (6th Cir. 1977).” (C) is incorrect. As stated in MPEP § 2165.02, “The best mode requirement is a separate and distinct requirement from the enablement requirement of the first paragraph of 35 U.S.C. 112. *In re Newton*, 414 F.2d 1400, 163 USPQ 34 (CCPA 1969). (D) is incorrect. MPEP § 2165.01, part V indicates that if there is no disclosure of the best mode contemplated by the inventor at the time the application is filed, such a defect cannot be cured by submitting an amendment seeking to put into the specification something required to be there when the patent application was originally filed. *In re Hay*, 534 F.2d 917, 189 USPQ 790 (CCPA 1976). Any proposed amendment of this type should be treated as new matter. MPEP § 2165.01.

45. ANSWER: (B) is the most correct answer. 37 CFR § 1.114(c) (effective August 16, 2000), “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 FR 50092, 50097 (Aug. 16, 2000), and 37 CFR § 1.111(b). As stated in 65 FR 50097, column 1, “Section 1.114(c) also provides that if reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111.” (B) is correct because the reply complies with 37 CFR § 1.111(b). (A) is incorrect because a reply under 37 CFR § 1.111(b) must be reduced to writing. 37 CFR § 1.2. (C) is incorrect because a reply under 37 CFR § 1.111(b) must present arguments pointing out the specific distinctions believed to render the claims patentable over the applied references. (D) is incorrect because (A) and (C) are incorrect. (E) is incorrect because (B) is correct.

46. ANSWER. (A) is the most correct answer. 37 C.F.R. §§ 1.16(a) and 1.17(e). The fee to request continued examination of an application is currently \$355.00 for a small entity, and \$710.00 for other than a small entity. The fee for filing each application for an original patent, except provisional, design, or plant applications is currently \$355.00 for a small entity, and \$710.00 for other than a small entity. See “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). (B) is not the most correct answer. 37 C.F.R. § 1.8(a)(2) provides, in pertinent part, “The procedure described in paragraph (a)(1) of this section does not apply to, and no benefit will be given to a Certificate of Mailing or Transmission on the following: (i) Relative to Patents and Patent Applications – (A) The filing of a national patent application specification and drawing or other correspondence for the purpose of obtaining an application filing date, including a request for a continued prosecution application under § 1.53(d).” (C) is not the most correct answer. 37 C.F.R. § 1.21(m). See “Changes to Permit Payment of Patent and Trademark Fees by Credit Card,” 65 F.R. 33452-33455 (May 24, 2000), 1235 O.G. 38 (June 13, 2000). (D) is not the most correct answer. 37 C.F.R. § 1.53(c)(3) requires the petition to convert be filed prior to the earliest of the abandonment of the provisional application or the expiration of twelve months after the filing date of the provisional application. (E) is not the most correct answer. Under 37 C.F.R. § 1.53, a nonprovisional application based on conversion

of a provisional application must include the filing fee for a nonprovisional application. The conversion request must be accompanied by the fee set forth in 37 C.F.R. § 1.17(i). In addition, the surcharge required by 37 C.F.R. § 1.16(e) if either the basic filing fee for a nonprovisional application, or the oath or declaration was not present on the filing date accorded the resulting nonprovisional application. A properly paid basic filing fee for a provisional application is not applied to the filing or other fees due for a nonprovisional application resulting from conversion of a provisional application. 37 C.F.R. § 1.53(c)(3), second sentence.

47. ANSWER: (E) is the correct answer. 37 CFR § 1.111(a)(2) (effective November 7, 2000F); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54635 (September 8, 2000). (C) and (B) are factors that are specified in 37 CFR § 1.111(a)(2)(i) and (ii). (A) is incorrect because although the request set forth in (A) may be included in a reply under 37 CFR § 1.111(b), it is not set forth as a factor in disapproving a third reply under 37 CFR § 1.111(a)(2). (D) is incorrect because (A) is incorrect.

48. ANSWER: (A) is the most correct answer. 37 C.F.R. § 1.173(a)(1). (C) and (D) are not most correct answers. 37 C.F.R. § 1.173(a)(1). 65 FR 54604 (Sept. 8, 2000) (effective Nov. 7, 2000). (C) is not the most correct answer because it would furnish a copy of the patent in single column format, instead of the required double column format. (D) is not the most correct answer because it would furnish a copy of the patent on both sides of a single sheet of paper, as opposed to the required single side of a sheet of paper. (B) is wrong because it represents a format for submitting a reissue application which was formerly set out as an option in MPEP § 1411, but which was changed by the new rule. *Id.* (E) is wrong because it mimics (B), with the exception that the columns of the cut-up soft copies of the printed patent are mounted on both sides, rather than one side, of each page. (B) and (E) are also incorrect because they indicate that the copies of the patent must be “cut-up soft copies,” whereas the rules no longer require the same.

49. ANSWER: (E) is the most correct answer. Since a redacted copy of the application was used for publication purposes, 37 C.F.R. § 1.14 (c)(2) provides that “(2) If a redacted copy of the application was used for the patent application publication, the copy of the specification, drawings, and papers may be limited to a redacted copy.” As to (A), (A) contains the elements of 37 C.F.R. § 1.14(b)(2), which reads “When status information may be supplied. Status information of an application may be supplied by the Office to the public if any of the following apply: ... (2) The application is referred to by its numerical identifier in a published patent document (*e.g.*, a U.S. patent, a U.S. patent application publication, or an international application publication), or in a U.S. application open to public inspection (§ 1.11(b), or paragraph (e)(2)(i) or (e)(2)(ii) of this section).” As to (B), (B) is within the purview of 37 C.F.R. § 1.14(a)(1)(iii) which states: “(a)(1) Status information is: ... (iii) The application “numerical identifier” which may be: (A) The eight-digit application number (the two-digit series code plus the six-digit serial number); or (B) The six-digit serial number plus any one of the filing date of the national application, the international filing date, or date of entry into the national stage.” As to (C), (C) contains the elements of 37 C.F.R. § 1.14(c)(1)(i), which states “(c) *When copies may be supplied.* A copy of an application-as-filed or a file wrapper and contents may be supplied by the Office to the public, subject to paragraph (i) of this section (which addresses international applications), if any of the following apply: (1) *Application-as-filed.* (i) If a U.S. patent application publication or patent incorporates by reference, or includes

a specific reference under 35 U.S.C. 119(e) or 120 to, a pending or abandoned application, a copy of that application-as-filed may be provided to any person upon written request including the fee set forth in § 1.19(b)(1).” As to (D), a coinventor is entitled to access to the application independent of whether or not he or she signed the declaration. Note that as stated in 37 C.F.R. § 1.41(a)(2), if a declaration or oath is not filed, the inventorship is that inventorship set forth in the application papers.

50. ANSWER: (B) is the correct answer because the application is properly deposited with the USPS as “Express Mail Post Office to Addressee” and the “date-in” is properly entered by the USPS. MPEP § 502, subpart styled “‘Express Mail’ Service” states, “The only type of service which can be used for ‘Express Mail’ directed to the Patent and Trademark Office is the ‘Post Office to Addressee’ service of the U.S. Postal Service. 37 C.F.R. 1.10.” MPEP § 513 under the heading “Date-In, Direct Deposit, ‘Express Mail’ Box Receptacles & Log Books” recites, “The ‘date-in’ on the ‘Express Mail’ mailing label must be completed by the USPS, not the applicant.” MPEP § 513 under the heading “‘Express Mail’ Mailing Label Number” recites, “Effective December 2, 1996, 37 C.F.R. 1.10(b) no longer requires...that the ‘Express Mail’ mailing label number be placed on the correspondence prior to mailing.” MPEP § 513, subpart styled “Effective Date, Weekends & Holidays” states, “Effective December 2, 1996, 37 C.F.R. 1.6(a)(2) provides that correspondence deposited as ‘Express Mail’ in accordance with 37 C.F.R. 1.10 will be stamped, and, therefore, considered as filed on the date of its deposit, regardless of whether that date is a Saturday, Sunday or Federal holiday within the District of Columbia.” Therefore, (B) provides a filing date of March 10, 2001. (A) is wrong because the receipt date of March 12, 2001, is the filing date, since the “Express Mail Post Office to Post Office” procedure is ruled out by 37 C.F.R. § 1.10 and MPEP § 502. (C) is wrong because the receipt date of March 14, 2001, is the filing date, since the “date-in” was not entered by the USPS as required by MPEP § 513. (D) is wrong because the effective receipt date is March 26, 2001, since the “date-in” was not entered by the USPS as required by MPEP § 513. (E) is wrong because the receipt date is March 26, 2001, since the “Express Mail Post Office to Post Office” procedure is ruled out by 37 C.F.R. § 1.10 and MPEP § 502.