

United States Patent and Trademark Office
Registration Examination for Patent Attorneys and Agents
October 18, 2000

Morning Session Model Answers

1. ANSWER: (B). 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. (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. (D) is incorrect. 37 C.F.R. § 1.75(a). The specification must conclude with one or more claims. (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.

2. ANSWER: (C). 35 U.S.C. § 135(b) requires that the claim be made in the ABC patent within one year of the issuance of the XYZ patent. MPEP § 1211.01 states that there is no obligation resting on the Board to consider new or amended claims submitted while the case is on appeal. MPEP § 1210 states that when an application is refiled, the Board should be promptly notified. Failure to notify the Board may result in the Board’s refusing an otherwise proper request to vacate its decision. See also MPEP § 2307.03. (E) is incorrect as 35 U.S.C. § 135(b) requires the claim to be made within one year. (D) is incorrect because the Board may refuse the amendment and because the claims have not yet been determined to be allowable. Note that the XYZ patent was filed before the ABC application and is therefore prior art under 35 U.S.C. § 102(e). See MPEP § 2306 and 2307.02. (A) is incorrect because the claims are not in the application, no interference could be declared and such a “transfer” is not feasible. (B) is incorrect because the Board is not required to enter the amendment and Sam may forfeit his opportunity to present the claims within one year if he does not act promptly (as in answer (C)).

3. ANSWER: (E) is the correct answer. MPEP § 708.02. I is sufficient to result in the petition being granted. MPEP § 708.02, subpart (VIII). II is sufficient. MPEP § 708.02, subpart (IV). III is sufficient. MPEP § 708.02, subpart (III). Therefore, (A) through (D) are incorrect.

4. ANSWER: (E). Amendment in said manner is limited to deletions or additions of no more than five words. 37 C.F.R. § 1.121(a)(2)(i)(B). Thus, the answer is not true. (A) is true, and therefore an incorrect answer. MPEP § 714.01(d). (B) is true, and therefore an incorrect answer. MPEP § 714.22. (C) is true, and therefore an incorrect answer. 37 C.F.R. § 1.121(a); MPEP § 714.22. (D) is true, and therefore an incorrect answer. 37 C.F.R. § 1.121(b)(3)(i).

5. ANSWER: (E) is the correct answer. MPEP § 706.02 points out the distinction between rejections based on 35 U.S.C. §§ 102 and 103. For anticipation under 35 U.S.C. § 102 the reference must teach every aspect of the claimed invention either explicitly or impliedly. (A), (B), (C), and (D) are each incorrect because each reply does not address the lack of anticipation

by Bud. (A) is further incorrect. It is proper to take official notice without citing a reference until the practitioner challenges the examiner to provide support. Until seasonably challenged, the examiner would not have to provide support for the official notice. MPEP § 2144.03. (B) is further incorrect because a § 102(e) reference can properly have a patent date after the filing date of an application. (C) is further incorrect because no amendment is necessary. (D) is further incorrect because a prima facie case of obviousness is not necessary in a rejection under 35 U.S.C. § 102.

6. ANSWER: (A). In accordance with MPEP § 2172, part II, evidence that shows a claim does not correspond in scope with that which applicant regards as applicant's invention may be found, for example, in contentions or admissions contained in briefs or remarks filed by applicant. *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969). (B) is incorrect. MPEP § 2172, part II, states, "As noted in *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA 1979) agreement, or lack thereof, between the claims and the specification is properly considered only with respect to 35 U.S.C. 112, first paragraph; it is irrelevant to compliance with the second paragraph of that section." (C) is incorrect. MPEP § 2172, part III indicates that the second paragraph of 35 U.S.C. 112 does not prohibit applicants from changing what they regard as their invention during the pendency of the application. *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971) (Applicant was permitted to claim and submit comparative evidence with respect to claimed subject matter which originally was only the preferred embodiment within much broader claims (directed to a method). (D) is incorrect. MPEP § 2172, part III indicates that the fact that claims in a continuation application were directed to originally disclosed subject matter which applicants had not regarded as part of their invention when the parent application was filed was held not to prevent the continuation application from receiving benefits of the filing date of the parent application under 35 U.S.C. 120. *In re Brower*, 433 F.2d 813, 167 USPQ 684 (CCPA 1970). (E) is incorrect because (B), (C), and (D) are incorrect.

7. ANSWER: (B). 37 C.F.R. § 1.84(a)(2), MPEP § 608.02, "Color Drawings or Color Photographs." (A) is wrong because a petition under 37 C.F.R. § 1.84 is required to avoid an objection to the color photographs. Also, since small entity status was properly established at the time of filing, the inventor is entitled to maintain small entity status until any issue fee is due. 37 C.F.R. § 1.28(b). (C) – (E) are also wrong because they do not provide for the required petition under § 1.84. In (D), the change in small entity status after the application was filed does not require the inventor to retroactively pay a large entity filing fee. Additionally, (E) is wrong because the inventor would be required to file a large entity filing fee and a continuation application therefore does not achieve the stated goal of avoiding unnecessary government fees.

8. ANSWER: (C) is correct. See MPEP § 1411.01. As to (A) see MPEP § 1402. A reissue patent is not granted. As to (B), new matter may not be entered in a reissue. As to (D) see MPEP § 1412.03, p.1400-13. Since (A), and (B) are incorrect, (E) is incorrect.

9. All Answers accepted.

10. ANSWER: (A) is the correct answer. MPEP § 2173.05(e). Claim 2 is indefinite because "said pipe" lacks antecedent basis. Claim 3 is definite, as "the outer surface" is an inherent part of the pipe and would not require antecedent recitation. Therefore, (B), (D), and (E) are

incorrect. Claim 4 is definite as there is antecedent basis for “said plastic valve.” Therefore, (C) is incorrect.

11. ANSWER: (C). 37 C.F.R. § 1.136; MPEP § 710.02(e), p. 700-77. (A) and (B) are not true because the amendment is treated as timely. There is no authority for (D). (E) is untrue because (C) is true.

12. ANSWER: (A). 37 C.F.R. § 1.33(c). (B) 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. (C) is incorrect. MPEP § 402.02, and 406. The associate attorney may not appoint another attorney. (D) is incorrect. 37 C.F.R. § 1.36. An assignment will not itself operate as a revocation of a power or authorization previously given. (E) 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.

13. ANSWER: (C). An effort to convert a narrowing reissue application to a broadening reissue application more than two years after issuance of the original patent is ineffective. Furthermore, a claim that is broader than the original claims in any aspect is a broadened claim for the purposes of reissue. Thus, claims 10-15 are improper (regardless of whether there is any prosecution history estoppel), and statements (B) and (D) are incorrect. Statement (A) is incorrect because claims 16-19 are narrower than the original patent claims and are fully supported by the original reissue oath. For that same reason, (C) is correct. (E) is incorrect because (C) is correct.

14. ANSWER: (D). 37 C.F.R. § 1.116; MPEP § 714.13, Entry Not Matter of Right [p. 700-118]. The reply in (D) is directed to a reply permitted to be made under 37 C.F.R. § 1.116(a). (A), (B), and (C) are directed to the merits of the application, and are not in accord with 37 C.F.R. § 1.116(a).

15. ANSWER: (E). Both (B) and (D) cannot be incorporated into a U.S. utility application. MPEP § 608.01(p).

16. ANSWER: (D). 35 U.S.C. § 102(a). As explained in MPEP § 901.01, the “matter canceled from the application file wrapper of a U.S. patent may be used as prior art as of the patent date in that it then constitutes prior public knowledge under 35 U.S.C. 102(a), *In re Lund*, 376 F.2d 982, 153 USPQ 625 (CCPA 1967). See also MPEP § § 2127 and § 2136.02.” (A) is incorrect. 35 U.S.C. § 102(e). As stated in MPEP § 901.01, “Canceled matter in the application file of a U.S. patent is not a proper reference as of the filing date under 35 U.S.C. 102(e), see *Ex parte Stalego*, 154 USPQ 52, 53 (Bd. App. 1966).” (B) is incorrect. As stated in MPEP § 901.02, “*In re Heritage*, 182 F.2d 639, 86 USPQ 160 (CCPA 1950), holds that where a patent refers to and relies on the disclosure of a copending abandoned application, such disclosure is available as a reference. See also *In re Lund*, 376 F.2d 982, 153 USPQ 625 (CCPA 1967).” (C) is incorrect. As MPEP § 901.02 indicates, where the reference patent claims the benefit of a copending but abandoned application which discloses subject matter in common with the patent, and the abandoned application has an enabling disclosure of the common subject matter and claimed

matter in the reference patent, the effective date of the reference as to the common subject matter is the filing date of the abandoned application. *In re Switzer*, 77 USPQ 1, 612 O.G. 11 (CCPA 1948); *Ex parte Peterson*, 63 USPQ 99 (Bd. App. 1944); and *Ex parte Clifford*, 49 USPQ 152 (Bd. App. 1940)." (E) is incorrect. As stated in MPEP § 901.05, "In general, a foreign patent, the contents of its application, or segments of its content should not be cited as a reference until its date of patenting or publication can be confirmed by an examiner's review of a copy of the document."

17. ANSWER: (C). Rene is barred by the recapture rule. MPEP § 1412.02. As to (A), see MPEP § 1412.02. Rene responded to a rejection by amending her claims, similar to Example B in MPEP § 1412.02, p.1400-10. As to (B), again recapture is the determinative factor. As to (D), the issue of financial concerns is of no import. As to (E) independent claims may not be broadened during a reexamination.

18. ANSWER: The best answer is (D). (A), (B) and (E) are each wrong at least because action cannot be suspended in an application that contains an outstanding Office action or requirement awaiting reply by the applicant. 37 C.F.R. § 1.103; MPEP § 709. These recommendations, if followed, would likely lead to abandonment of the application. (C) is wrong at least because inventorship in an issued patent is properly corrected through 37 C.F.R. § 1.324, not § 1.48. Also, (C) is contrary to ManCo's instructions that the matter is to be straightened out before the application is allowed to issue as a patent, and may raise questions concerning compliance with the duty of candor before the USPTO.

19. ANSWER: (C). Correction of inventorship may be made under the provisions of 37 C.F.R. § 1.48 or by filing a continuation application. MPEP § 201.03, second paragraph. Since the original application was filed with an inventor's declaration, correction cannot be made merely by submitting a correct declaration. See 37 C.F.R. § 1.48(a) and (f). Thus, (A) is incorrect. (B) is incorrect because there was no deceptive intention on the part of the omitted inventor, Leftout. Under the facts of the question, (D) is incorrect because it omits the written consent of ManCo required under 37 C.F.R. § 1.48(a)(4). MPEP § 201.03, under the heading "37 CFR 1.48(a)," part D. (E) is incorrect because (D) is incorrect.

20. ANSWER: (D) is the correct answer because the statement complies with 35 U.S.C. §§ 119(a)-(d) and 251; 37 C.F.R. § 1.55 and 1.63; MPEP § 1417. (A), (B), (C), and (E) are wrong because their statements do not comply with MPEP § 1417.

21. ANSWER: (C). 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."

22. ANSWER: (B). See MPEP § 1209, p.1200-23, “Participation by Examiner.” As to (A), see MPEP § 705. As to (C) signature requirement does not apply. 37 C.F.R. § 1.196(b); MPEP § 1205. The notice will not be returned. As to (D), see *Gentry Gallery v. Berkline Corp.*, 134 F.3d 1473, 45 U.S.P.Q.2d 1498 (Fed. Cir. 1998)

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

24. ANSWER: (A) is the correct answer because it satisfies the requirements set forth in MPEP § 708.02, part (III). (B) is wrong because the requirement in MPEP § 708.02, part (I), calls for a statement by the applicant, assignee or an attorney/agent registered to practice before the Office. Applicant’s business competitor does not qualify as a prospective manufacturer. (C) is wrong because MPEP § 708.02, part (II), applies to “actual infringement,” and expressly excludes “prospective infringement.” (D) is wrong because MPEP § 708.02, part (V), calls for a statement by the applicant, assignee or an attorney/agent registered to practice before the Office. The Professor does not qualify. (E) is wrong because MPEP § 708.02, part (VII), calls for a statement by the applicant, assignee or an attorney/agent registered to practice before the Office. The Professor does not qualify.

25. ANSWER: (B). Answer (B) is not true since Jack was not the first to 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 (A) 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.

26. ANSWER: (C). MPEP § 1417. The procedure is similar to that for “Continuing Applications” in MPEP § 201.14(b). (A) is incorrect. MPEP § 1417. A “claim” for the benefit of an earlier filing date in a foreign country under 35 U.S.C. § 119(a) - (d) must be made in a reissue application even though such a claim was made in the application on which the original patent was granted. (B) is incorrect. New matter is excluded from a reissue application in accordance with 35 U.S.C. 251. Also see MPEP § 1411.02. (D) is incorrect. MPEP § 1412.02, “Reissue Claims Have Same Or Broader Scope In All Respects.” The recapture rule bars a patentee from acquiring through reissue claims that are, in all respects, of the same scope as, or are broader than, those claims canceled from the original application to obtain a patent. *Ball Corp v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). (E) is incorrect. A practitioner’s failure to appreciate the full scope of the invention has been held to be an error correctable through reissue. *In re Wilder*, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984); MPEP § 1402.

27. ANSWER: (B). MPEP § 716.01(a). Affidavits or declarations containing objective evidence of criticality, unexpected results, commercial success, long-felt but unsolved needs, failure of others, skepticism of experts, is considered by an examiner. (A) is incorrect. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); MPEP § 716.01(c), subsection styled “Attorney Arguments Cannot Take The Place of Evidence”; 2145, part I. Arguments of counsel cannot take the place of factually supported objective evidence. (C) is incorrect. MPEP § 2145. The burden shifts to the applicant to come forward with arguments and/or evidence to rebut the prima facie case. *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). (D) is incorrect. *In re Soni*, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995); MPEP § 2144.05, subsections II and III. (E) is incorrect. *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979) (finding that mere recognition of latent properties in the prior art does not render **the a** known invention unobvious); MPEP § 2145, subsection II.

28. ANSWER: (B). MPEP § 706.01. (A) and (C) are incorrect. As stated by MPEP § 706.01, “The practical difference between a rejection and an objection is that a rejection, involving the merits of the claim, is subject to review by the Board of Patent Appeals and Interferences, while an objection, if persisted, may be reviewed only by way of petition to the Commissioner.” (D) is incorrect. MPEP § 706.03(d). (E) is incorrect. As stated in MPEP § 706.01, “If the form of the claim (as distinguished from its substance) is improper, an “objection” is made. An example of a matter of form as to which objection is made is dependency of a claim on a rejected claim, if the dependent claim is otherwise allowable. See MPEP § § 608.01(n).”

29. All Answers Accepted.

30. ANSWER: (E) is correct 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.

31. ANSWER: (D). 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. (C) 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); 35 U.S.C. § 102(d); MPEP § 2129 under the heading “Admissions By Applicant Constitute Prior Art.”

32. ANSWER: (D). “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.

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 correct answer. MPEP § 706.07(b). In both I and III the finality is improper. MPEP § 706.07(b). Therefore (A) and (C) are incorrect. In II the finality is proper. MPEP § 706.07(b). Therefore (B) and (E) are incorrect.

35. ANSWER: The best answer is (E). MPEP § 609(B)(4). Statements (A), (B) and (C) do not apply (at least) because the IDS was not filed within three months of the filing date or before the mailing date of a notice of allowance. 37 C.F.R. § 1.97(c). Statement (D) does not apply because the issue fee has been paid. 37 C.F.R. § 1.97(d).

36. ANSWER: (C). It is essential that Sam file broader claims and indicate his intention to broaden within the two year time limit of 35 U.S.C. § 251. See MPEP § 1412.03, p.1400-13, and *In re Graf*, 111 F.3d 874, 877, 42 USPQ2d 1471, 1473-74 (Fed. Cir. 1997). As to answer (D), according to MPEP § 1451, p.1400-38, the requirement of 37 C.F.R. § 1.177 requiring that all divisional reissue applications issue simultaneously will be routinely waived *sua sponte*. As to a continuation application, they may also issue at different times as explained at MPEP § 1451, p.1400-38. Since (C) is true, (A), (B) and (E) are false. Further as to (E), claims reading on subject matter not covered by the original claims are broader.

37. ANSWER: The correct answer is (C). The one-month extension of time filed February 17, 2000 properly extended the deadline for filing a reply to Friday, March 17, 2000. When a timely reply is ultimately not filed, the application is regarded as abandoned after midnight of the date the period for reply expired, *i.e.*, the application was abandoned at 12:01 AM on Saturday, March 18, 2000. The fact that March 18 was a Saturday does not change the abandonment day because the reply was due on March 17, a business day. MPEP § 710.01(a).

38. ANSWER: (A). See 37 C.F.R. § 1.292; MPEP § 720. (B) is unreasonable at least because no employee at Ace can legitimately be identified as an inventor. (C) and (D) are unreasonable at least because re-examination may not be based on public use. (C) is also unreasonable in suggesting that nothing can be done because the application is maintained in confidence by the

Patent Office. (E) is incorrect at least because a protest is not conducted as an *inter partes* proceeding. 37 C.F.R. § 1.291(c); MPEP § 1901.07.

39. ANSWER: (E). 35 U.S.C. § 122; 37 C.F.R. §§ 1.11 and 1.14. Statements (A) and (B) are untrue because neither publication of a foreign counterpart application or disclosure of the U.S. patent application waives confidence under 35 U.S.C. § 122. (C) and (D) are wrong because § 122 controls the actions of the USPTO, not private parties.

40. All Answers Accepted.

41. ANSWER: (D). See 37 C.F.R. § 1.196(b); MPEP § 1214.01. As to (A) see MPEP §1206, p.1200-8, “(5) Summary of Invention.” As to (B), the recapture doctrine prevents claims from being recaptured. See MPEP § 1412.02. As to (C) 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. *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 11 USPQ2d 1866, 1869 (Fed. Cir. 1989) (a reexamination is conducted *ex parte* after it is instituted); *In re Opprecht*, 10 USPQ2d 1718 (Fed. Cir. 1989) (third parties do not participate before the USPTO).

42. ANSWER: (D). A non-provisional application filed without at least one claim is regarded as incomplete and will not be accorded a filing date. 35 U.S.C. § 111(a); 37 C.F.R. § 1.53(b); MPEP § 506. (A) is wrong because the component parts of a provisional application necessary to obtain a filing date do not include claims. 35 U.S.C. 111(b); 37 C.F.R. § 1.53(c); MPEP § 506 under heading “Incomplete Provisional Applications.” (B) and (C) are wrong because “[a]n error in or failure to identify inventorship does not raise a filing date issue.” MPEP § 506.02. (E) is wrong. Under 37 C.F.R. § 1.8(a)(2)(i)(A) no benefit is accorded to a certificate of mailing date. The effective date is the actual date of receipt, and not the certificate of mailing date.

43. ANSWER: (D) is the correct answer because a substitute drawing is usually submitted to replace an original informal drawing, not an original formal drawing. MPEP § 608.02 under the heading “Definitions.” (A), (B), (C), and (E) are wrong answers because they accord with the definitions set forth in MPEP § 608.02.

44. ANSWER: (A). 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, 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. (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: (C). 35 U.S.C. §§ 102(b) and (e); 37 C.F.R. § 1.131(a). A reference under 35 U.S.C. § 102(b) cannot be antedated. Therefore, (A), (B) and (E) are incorrect. (D) is incorrect because it is non-responsive, and it does not matter when the Spot patent issued.

46. ANSWER: (D) is the correct answer. 35 U.S.C. § 113; MPEP § 608.02(a), under heading “Handling of Drawing Requirements Under The Second Sentence Of 35 U.S.C. 113,” p.600-87. (A) is incorrect inasmuch as I is false. The examiner will normally require a drawing where the case admits of illustration. 37 C.F.R. § 1.81(c). (B) is incorrect because III is also true. (C) is incorrect because II is also true. (E) is incorrect because I is false.

47. ANSWER: (A). 37 C.F.R. §§ 1.31 and 1.34; MPEP § 713.05. Statements (B) and (D) are incorrect because Blackacre may participate in the interview if he possesses a copy of the application file and states he is authorized to represent the applicant. (E) is therefore also incorrect. (C) is incorrect because a mere power to inspect is insufficient authority for an examiner to grant an interview involving the merits of an application. *Id.*

48. ANSWER: (A). Under 37 C.F.R. § 1.53(c)(2), a nonprovisional patent application “may be converted to a provisional application and be accorded the original filing date of the” nonprovisional patent application. MPEP § 601.01(c). (B), (C), and (D) are wrong because they recite dates other than the original filing date of the nonprovisional patent application. (E) is wrong because (A) is correct.

49. ANSWER: (E). As to (A), see MPEP § 708.02 where no such requirement is stated. See also, MPEP § at 1200-2 under Special Case. As to (B), see MPEP § 1209 and 37 C.F.R. § 1.194. As to (C), reply brief must be filed within two months of examiner’s Answer. MPEP § 1208.03. As to answer (D), see MPEP § 1214.03 at MPEP § 1200-28.

50. ANSWERS: (D) and (E). As to (A) see MPEP § 1442. All reissue applications, except those under suspension because of litigation, will be taken up for action ahead of other “special” applications. Therefore, it would do no good to file a petition to make special. As to (B), maintenance fees are always calculated from the patent issue date. MPEP §§ 2506 and 1415.01. As to (C), claims may not enlarge the scope of the claims in a patent during a reexamination. However, since a dependent claim is construed to contain all the limitations of the claim from which it depends, the dependent claim must be at least as narrow as the independent claim from which it depends, and thus does not broaden the patent. Thus, one does not necessarily enlarge the scope of the patent by broadening the claim. 37 C.F.R. § 1.193(a)(2); MPEP §§ 1412.03 (page 1400-13), 2258, subsection III, A (page 2200-60). As to (D), it is accepted due to ambiguity contained therein.