

**Examination for Registration to Practice in Patent Cases
Before the U.S. Patent and Trademark Office
April 12, 2000**

Afternoon Session Model Answers

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1. ANSWER: (D) is correct because gross sales figures must be measured against a logical standard in order to determine whether or not there is commercial success. The recitations of accompanying evidence in (A), (B), and (C) are logical in that they provide a comparative basis for determining commercial success. (D), on the other hand, recites accompanying evidence which is illogical in that it does not provide a comparative basis for determining commercial success. (E) is wrong because it provides a logical basis for attributing commercial success to the design of the device, rather than the utilitarian function of the device. MPEP 716.03(b).
2. ANSWER: (E). *In re Tiffin and Erdman*, 171 USPQ 294 (CCPA 1971). MPEP § 716.03(a). (A), (B), (C), and (D) are wrong. *In re Tiffin and Erdman*, 170 USPQ 88, 91, 92 (CCPA 1971). MPEP § 716.03(a).
3. ANSWER: (D). MPEP § 2292. As to (A) see 37 C.F.R. § 1.602(a). As to (B) see 37 C.F.R. § 1.601(m), which provides that the senior party has earliest effective filing date. As to (C), see MPEP § 2285 regarding merger of reissues and reexamination proceedings. As to (E), (D) is true.
4. ANSWER: (D). Answer (A) does not provide proper antecedent basis for “said first end” in part (ii) of the claim and “said second end” in part (iv) of the claim. Answer (B) fails to provide proper antecedent basis for “said dispensing chamber” in part (iii) of the claim, and “said second end” in part (iv) of the claim. Answer (C) fails to provide proper antecedent basis for “said second end” in part (iv) of the claim and “said longitudinal sides of said channel” in part (v) of the claim. Answer (E) fails to provide proper antecedent basis for “said dispensing chamber” in part (iii) and subsequent parts of the claim.
5. ANSWER: (E) is the most correct reply. Beverly’s thesis constitutes a printed publication as of January 29, 1999. *In re Hall*, 228 USPQ 453 (Fed. Cir. 1986). Since (B) and (C) are both correct statements, the most correct response is (E). (A) is incorrect. To be used under 35 U.S.C. § 102(b) as a prior art printed publication against a United States application for patent filed January 15, 2000, the published thesis must have been published more than one year before the application for patent. The publication of Beverly’s thesis on January 29, 1999, is less than one year before the filing of the application on January 15, 2000.
6. ANSWER: (C) is correct because it sets forth the modified showing discussed in MPEP § 711.03(c), item subsection II, and complies with the fact noted in MPEP § 711.03(c), subsection

I, that a petition to withdraw holding of abandonment does not require a fee. (A) and (B) are wrong because they fail to recite that each petition must be accompanied by a petition fee as set forth in 37 C.F.R. §§ 1.17(l) and (m), respectively. MPEP § 711.03(c), item subsection III. (A) is also incorrect because a mere statement that the delay was unavoidable is insufficient. Evidence is necessary showing the delay was unavoidable.

7. ANSWER: (A). 37 C.F.R. § 10.66(a). If not an actual conflict of interest, clearly there is a potential conflict of interest between a present and prospective client. The partner practitioner already represents ANY Corp. The prospective client is being accused by the practitioner's present client of infringing its about-to-be issued patent. Acceptance of the proffered employment would be likely to involve the practitioner in representing differing interests. (B), (C), (D), and (E) are not the most correct answers. Even in potential conflict of interest situations, the practitioner must obtain the consent of ANY Corp., after full disclosure, before acting on behalf of XYZ Corp. 37 C.F.R. § 10.66(c). There are no given facts showing that informed consent of ANY Corp. has been obtained.

8. ANSWER: (A). 35 U.S.C. § 305; 37 C.F.R. § 1.530(d)(3); MPEP § 2250, 2258, subsection III (“A broadened claim: A claim is broader than another claim if it is broader (greater in scope) ‘in any respect,’ even though it may be narrower in other respects. *In re Freeman*, 30 F.3d 1459, 1464, 32 USPQ2d 1444, 1447 (Fed. Cir. 1994).”). The claim is broadened by changing “knife” to “cutting means,” which is not limited to a knife, but may be a blade, scissors, etc.

9. ANSWER: (C) is the most correct answer. As explained in MPEP § 710.02(e), pages 700-82 and 83, if an applicant initially replies within 2 months from the date of mailing of a final rejection, and the examiner, however, does not mail an Advisory Action until after the end of 3 months, the shortened statutory period will expire on the date the examiner mails the Advisory Action and any extension fee may be calculated from that date. (A), (B), (D), and (E) are contrary to MPEP § 710.02(e), and therefore are incorrect.

10. ANSWER: (B). See MPEP §§ 2287 and 2288. As to (E), Sam must request to withdraw and obtain permission from the PTO in accordance with 37 C.F.R. § 10.40 and MPEP § 402.06. As to (A), bankruptcy will not stay a reexamination. As to (C), false representations are prohibited by the rules. As to (D), there are no divisional reexaminations.

11. ANSWER: (E). As to (A) continuation need only have one inventor in common. MPEP 201.07. As to (B), failure to timely file a divisional application is not considered “error” and proper grounds for filing a reissue application. MPEP 1402. As to (C), “since in a patent it is presumed that a process if used by one skilled in the art will produce the product or result described therein, such presumption is not overcome by a mere showing that it is possible to operate within the disclosure without obtaining the alleged product. *In re Weber*, 405 F.2d 1403, 160 USPQ 549 (CCPA 1969).” MPEP 716.07. As to (D), the application is not abandoned. MPEP 1215, page 1200-36.

12. ANSWER: (E). Protests may be filed pursuant to 37 C.F.R. § 1.291. See MPEP § 1901.02. However, since protester may not be advised as to the outcome of protest, it behooves him to file a patent application listing both parties as co-inventors in accordance with 35 U.S.C. § 116. As to (D), since the inventorship is not correct, and was deceptively filed, the issued patent is likely to be declared invalid and he would not recover any royalties. (A) is incorrect because Clem is misrepresenting that he believes himself to be the sole inventor, whereas he has admitted that the invention “was partly Tine’s idea.” 37 C.F.R. § 1.56.

13. ANSWER: (D). 35 U.S.C. § 41(a). For fee calculation purposes, MPEP § 608.01(n), subsection G.2, states that “claims in proper multiple dependent form may not be considered as single dependent claims for the purpose of calculating fees. Thus, a multiple dependent claim is considered to be that number of dependent claims to which it refers. Any proper claim depending directly or indirectly from a multiple dependent claim is also considered as the number of dependent claims as referred to in the multiple dependent claim from which it depends.”

14. ANSWER: (B). Certificate of mailing is not required for Express Mail. See 37 C.F.R. § 1.10(e); MPEP 513 at 500-47. As to the others see 1.10(e) or MPEP 513 at 500-49. (A), (C), (D) and (E) are necessary to comply with the provisions of 37 C.F.R. § 1.10(e).

15. 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.

16. ANSWER: (B). *In re Merck & Co.*, 231 USPQ 375 (Fed. Cir. 1986); *Newell Cos. v. Kenney Mfg.*, 9 USPQ2d 1417 (Fed. Cir. 1988). Statement (A) is not correct because, although nearly simultaneous invention may be a factor in making an obviousness determination, it does not in itself preclude patentability. *Environmental Designs, Ltd. v. Union Oil Co.*, 218 USPQ 865 (Fed. Cir. 1983). Statements (C) and (D) are incorrect because nearly simultaneous invention bears on neither long-felt need nor commercial success. Statement (E) is incorrect because statement (B) is correct.

17. ANSWER: (B). 35 U.S.C. § 102(g); MPEP § 2138.01; *Mahurkar v. C.R. Bard, Inc.*, 38 USPQ2d 1288 (Fed. Cir. 1996). If statement (A) was correct, there would be no need for interference proceedings. Statement (C) is incorrect because Debbie need not establish diligence for the period from February 1999 until just before Billie’s conception on May 15, 1999. Statement (D) is incorrect. Debbie needs to show diligence only from May 14th to her actual reduction to practice in June. Debbie is not required to show diligence between actual reduction to practice and her subsequent constructive reduction to practice in December 1999, so long as she has not abandoned, suppressed or concealed the invention. 35 U.S.C. § 102(g). Statement (E) is inconsistent with 35 U.S.C. § 102(g).

18. ANSWER: (E) is the most correct answer because each statement, (A), (B), (C) and (D) is correct. (A) is correct. See MPEP 2141.02 (subsection styled, “Applicants Alleging Discovery Of A Source Of A Problem Must Provide Substantiating Evidence”); *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979). (B) and (C) are correct. See MPEP 716.01(c); *In re Knowlton*, 500 F.2d 566, 572, 183 USPQ 33, 37 (CCPA 1974) (where the record consisted substantially of arguments and opinions of applicant's attorney, the court indicated that factual affidavits could have provided important evidence on the issue of enablement). Arguments of counsel alone cannot take the place of evidence in the record once an examiner has advanced a reasonable basis for questioning the disclosure. See *In re Budnick*, 537 F.2d at 538, 190 USPQ at 424; *In re Schulze*, 346 F.2d 600, 145 USPQ 716 (CCPA 1965); and *In re Cole*, 326 F.2d 769, 140 USPQ 230 (CCPA 1964). (D) is correct. MPEP 716.01(c) and 2145.

19. ANSWER: (B) is the most correct answer. As to (A) and (B) see MPEP 2286, page 2200-97, stating, “[t]he issuance of a final district court decision upholding validity during a reexamination also will have no binding effect on the examination of the reexamination.” Thus, (A) is incorrect because a final holding of invalidity is binding on the PTO. As to (C), the PTO may discover new art and find claims unpatentable as that art would raise a substantial new question. MPEP §§ 2216 and 2286. As to (D), the patentee could file a prior art statement under 35 U.S.C. § 301, or disclose prior art in reissue application if the original patent (through error without deceptive intent) is defective or claims more or less than should be claimed. As to (E), preponderance of evidence standard does not change in reexamination proceedings. MPEP 2286.

20. ANSWER: (C) is the most correct answer. MPEP § 710.06. (I) is incorrect since this does not constitute error by the examiner. (II) is incorrect, since a reply would be due by the reply date, regardless of whether the rejection was traversed. Thus (A), (B), and (D) are incorrect. (E) is incorrect because C is correct.

21. ANSWER: (E). Roberts is not entitled to a patent because he did not himself invent the subject matter sought to be patented. 35 U.S.C. § 102(f). Therefore, statement (C) cannot be correct. Statement (A) is incorrect because, although the machine was known by others, it was not known by others in this country as required under 35 U.S.C. § 102(a). Similarly, statements (B) and (D) are incorrect because, even if there was a sale or public use more than a year before Roberts’ filing date, it was not “in this country” as required by 35 U.S.C. § 102(b).

22. ANSWER: (B). See 37 C.F.R. § 1.10. Parties using “Express Mail” drop boxes do so at their own risk. As explained in MPEP § 513:

37 C.F.R. 1.10(b) further provides that correspondence should be deposited directly with an employee of the USPS to ensure that the person depositing the correspondence receives a legible copy of the "Express Mail" mailing label with the "date - in" clearly marked, and that persons dealing indirectly with the employees of the USPS (such as by depositing correspondence in an "Express Mail" drop box) do so at the risk of not receiving a copy of the "Express Mail" mailing label with the desired "date - in" clearly marked. On petition, the failure to obtain an "Express Mail" receipt with the "date - in" clearly marked may be considered an omission that could have been avoided by the exercise of due care, as discussed below. While the Office strongly urges direct deposit of "Express Mail" correspondence in order to obtain a legible copy of the "Express Mail" mailing label, parties are not precluded from using "Express Mail" drop boxes, but do so at their own risk.

A paper or fee placed in an "Express Mail" box receptacle after the box has been cleared for the last time on a given day will be considered to be deposited as of the date of receipt ("date-in") indicated on the "Express Mail" mailing label by the Postal Service "Express Mail" acceptance clerk. 37 C.F.R. 1.10(d) permits the Office to correct a USPS "date - in" error when the correspondence is deposited in an "Express Mail" drop box prior to last scheduled pick up of the day, that is, the time clearly marked on the "Express Mail" drop box indicating when the box will

be cleared for the last time on the date of deposit. 37 C.F.R. 1.10(d) sets forth the procedures to be followed to be entitled to such a correction.

Parties who do use drop boxes can protect themselves from uncertainty due to illegible mailing labels by routinely maintaining a log of "Express Mail" deposits in which notations are entered by the person who deposited the correspondence as "Express Mail" within one business day after deposit with the USPS. Such evidence could be useful to later support a petition filed under 37 C.F.R. 1.10(c), (d) or (e). Evidence that came into being after deposit and within one day after the deposit of the correspondence as "Express Mail" may be in the form of a log book which contains information such as the "Express Mail" number; the application number, attorney docket number or other such file identification number; the place, date and time of deposit; the time of the last scheduled pick-up for that date and place of deposit; the depositor's initials or signature; and the date and time of entry in the log.

23. ANSWER: (C). As to answer (A), the publication in Popular Scientist was not enabling. Unless it is a statutory bar, a rejection based on a publication may be overcome by a showing that it was published either by applicant himself/herself on his/her behalf. MPEP § 715.01(c). The level of disclosure required within a reference to make it an "enabling disclosure" is the same no matter what type of prior art is at issue. It does not matter whether the prior art reference is a U.S. patent, foreign patent, a printed publication or other. *Cf.* MPEP § 2121. "In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure'..." *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). MPEP § 2121.01. As to answer (B), 35 U.S.C. 132 states that "[n]o amendment shall introduce new matter into the disclosure of the invention." As to (C), statutory bars of 35 USC 102(b) are applicable even though public use is by a third party. MPEP § 2133.03(e)(7). The statutory bar would apply to the modification by Ajax to use the windshield wiper device on trucks. As to (E), it is not necessary that the applicant be aware of the public use by the third party Ajax. As to (D), Chris would be barred by the public use of the truck embodiment by Ajax on September 1, 1998 as the C-I-P would not receive the benefit of the earlier filing date with respect to the truck embodiment since the original disclosure did not include the truck embodiment.

24. ANSWER: (E). An applicant dissatisfied with a decision by the Board of Patent Appeals and Interferences may appeal the decision to the United States Court of Appeals for the Federal Circuit (35 U.S.C. § 141) or may have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia (35 U.S.C. § 145). MPEP § 1216.

25. ANSWER: (B). MPEP 324, and 402.07. The submission may be signed by a person in the organization having apparent authority to sign on behalf of the organization – an officer. In (B), the submission is signed by the President, an office having apparent authority. (I) and (III) are incorrect since Joe is neither a registered practitioner nor an officer of the company. (III) also is incorrect since the assignment by Smith to Fix does not automatically operate as a revocation of

the power of attorney. 37 C.F.R. § 1.36. Thus, (A), (C), and (D) are incorrect. (E) is incorrect since (B) is correct.

26. ANSWER: (A) is the most correct answer. 37 C.F.R. § 1.121(a)(2)(ii); MPEP § 608.01(n). (B) and (C) are incorrect because the claim does not refer back in the alternative only. MPEP § 608.01(n). (D) is incorrect because it combines procedures for adding a claim (claim 4), and amending an existing claim (claim 3). For example, a newly added claim would not contain underlined words. 37 C.F.R. § 1.121(a)(2)(ii). (E) is incorrect because the claim number is underlined as are all the words in the claim even though no matter is added. 37 C.F.R. § 1.121(a)(2)(ii).

27. ANSWER: (B) is the most correct answer. 37 C.F.R. § 1.121; MPEP § 714.22. The amendment in (B) specifies the exact matter to be inserted, the exact point where the insertion is to be made, and is limited to five words or less. (A) is incorrect because there are two occurrences of “steam” in line 4, and the exact location where the insertion is to occur is unspecified. (C) is incorrect because the amendment does not specify the exact point where the insertion of “two” is to occur. (D) is incorrect because the amendment would insert more than five words. (E) is incorrect because it fails to identify the correct point where the deletion and insertion is to made.

28. ANSWER: (E). See MPEP 1414 Content of Reissue Oath/Declaration and 37 CFR 1.175(a) which states that reissue oaths/declarations must meet the requirements of 37 CFR 1.63, including 1.63(c) relating to a claim for foreign priority. As to (A), 37 CFR 1.192(c)(7) requires appellant to state that the claims do not stand or fall together. Appellant must present appropriate argument under 37 CFR 1.192(c)(8) why each claim is separately patentable. Merely pointing out differences in what the claims cover is not argument why the claims are separately patentable. MPEP 1206, pages 1200-8 and 9. As to (B), see MPEP 1002 and the sentence bridging pages 1000-2 and 1000-3. As to (C), 37 CFR 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner’s answer. As to (D), continuation may be filed during pendency of parent.

29. ANSWER: (A) is the most correct answer. 35 U.S.C. § 102(d), and MPEP § 2135 expressly list (B), (C), (D) and (E) as the four conditions which, if all are present, establish a bar against the granting of a patent in this country. The foreign patent or inventor’s certificate described in (A) need not be published to establish a 35 U.S.C. § 102(d) bar. MPEP § 2135.01(III)(E).

30. ANSWER: (B). 37 C.F.R. § 1.6(d); MPEP § 502. Choices (A) and (C) are incorrect since a request for reexamination may not be properly transmitted by facsimile. 37 C.F.R. § 1.6(d)(5). Choice (D) is incorrect because a filing date for a national patent application filed under 37 C.F.R. § 1.53(b) may not be obtained by filing through facsimile. 37 C.F.R. §§ 1.6(d)(3) and 1.8(a)(2)(i)(A). (E) is incorrect since (B) is correct.

31. ANSWER: (E). 35 U.S.C. §§ 112, fourth paragraph, and 251. The claim is not a proper dependent claim because it is broader than the claim from which it depends. The expression “up to 300 amps” would include 0 to 300 amps, which is outside the 100-300 amp range disclosed in

the specification, and recited in Claim 1. (A) is a proper dependent claim because the wattage is within the range limitation set out in Claim 1. (B) is a proper dependent claim because the wattage and voltage are within the range limitations set out in Claim 1. (C) and (D) are proper dependent claims because the wattage and voltage are within the range limitations set out in Claim 1.

32. ANSWER: (C) is the most correct answer. The method of use is neither disclosed nor suggested by the prior art. 35 U.S.C. §§ 102(b) and 103. (A) is incorrect because the process of using the composition as a fishing lure is not disclosed in the prior art, and the PTO guidelines support such a claim in these circumstances. MPEP § 2112.02. (B) is incorrect because the claim is anticipated. 35 U.S.C. § 102(b). (D) is incorrect because the composition is anticipated. 35 U.S.C. § 102(b). (E) is incorrect because filing a Disclosure Document does not provide the invention with protection afforded by the PTO. The Disclosure Document may be relied on only as evidence of its content, and is not a patent application. MPEP § 1706.

33. ANSWER: (A) is correct. MPEP § 2173.05, part (c) indicates that a preferred narrower range set forth within a broader range may render the claim indefinite if the boundaries of the claim are not discernable. (B), (C) and (D) are incorrect. MPEP § 2173.05(c), part (I) indicates that reciting in a single claim both a broad range and a preferred narrower range within the broad range may render the claim indefinite. (E) is incorrect. The doctrine of equivalents operates to expand claim coverage beyond the literal scope of the claim language.

34. ANSWER: (C) is correct. 35 U.S.C. § 151; 37 C.F.R. § 1.311; MPEP §§ 505 and 1306. (A) is incorrect. The procedure complies with 35 U.S.C. §§ 21(b) and 151. (B) is incorrect. The procedure complies with 35 U.S.C. § 151, and 37 C.F.R. § 1.7. (D) is not correct. The procedure complies with 35 U.S.C. §§ 21(b) and 151, and 37 C.F.R. § 1.8. (E) is incorrect because (B) and (D) are incorrect.

35. ANSWER: (B) is the most correct answer because different embodiments or modifications must be shown in the drawings. MPEP § 1503.01. Answer (A) is a proper statement. MPEP § 1503.01, page 1500-3. Answer (C) is a correct statement. 37 C.F.R. § 1.152(a)(2). Answer (D) is a correct statement. A design application may only contain a single claim. MPEP § 1503.03 and 37 C.F.R. § 1.153(a). Answer (E) is a correct statement which states how designs are evaluated. MPEP § 1504.

36. ANSWER: (B). As to (B), see 37 C.F.R. § 10.11(b), where “the names of individuals so removed will be published in the Official Gazette.” The rule does not require notice to be published before the names of individuals are removed. As to (A), a practitioner must notify the Director as set forth in 37 C.F.R. § 10.11 (a). As to (C), see 37 C.F.R. § 10.84(b)(2). As to (D) registration only entitles one to practice before the USPTO in patent cases. 37 C.F.R. §§ 10.5 and 10.14(a). As to (E), see 37 C.F.R. § 10.23(c)(4)(iii) regarding improperly bestowing of any gift, favor or thing of value.

37. ANSWER: (A). 37 C.F.R. § 1.111; MPEP § 714.02. (B) is incorrect because the fee must be paid when the request for extension of time is made. 37 C.F.R. § 1.136(a); MPEP 710.02(e). (C) is incorrect. The client did not give instructions to file the amendment today. Further, an

amendment canceling all claims is non-responsive to the non-final rejection. As stated in 37 C.F.R. § 1.111(b), “In order to be entitled to reconsideration..., the applicant...must reply to the Office action. The reply...must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner’s action and must reply to every ground of objection and rejection in the prior Office action.” MPEP § 714.19, item (H). (D) is incorrect. “A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.” 37 C.F.R. § 1.111(b). (E) is incorrect inasmuch as it does not comply with 37 C.F.R. § 1.111(b).

38. ANSWER: (B) is the most correct answer. *Ex parte Utschig*, 156 USPQ 156, 157 (Bd. App. 1966); MPEP § 2137.01 (section styled “Inventorship Is Generally ‘To Another’ Where There Are Different Inventive Entities With At Least One Inventor In Common”). (A) is incorrect. The same inventive entity obtains, regardless of the order in which the inventors are listed, inasmuch as the same inventors are recited. (C) is incorrect. The presence of a common inventor in a reference patent and application does not preclude determination that the inventive entity in the reference is to another within the meaning of 35 U.S.C. § 102(e). *Ex parte DesOrmeaus*, 25 USPQ2d 2040 (Bd. Pat. App. & Inter. 1992). (D) is incorrect. Merely the fact that the inventive entities differ does not cause the patent to necessarily be prior art. *Applied Materials Inc. v. Gemini Research Corp.*, 835 F.2d 279, 281, 15 USPQ2d 1816, 1818 (Fed. Cir. 1988); MPEP § 2137.01. (E) is incorrect because (A) and (C) are incorrect.

39. ANSWER: (B). When, as here, a broadening reissue is applied for within the two-year time limit set forth in 35 U.S.C. § 251, an amendment presenting further broadened claims after the two-year period is appropriate if the later-presented claims are supported by the original reissue oath. *In re Doll*, 419 F.2d 925, 928, 164 USPQ 218 (CCPA 1970); MPEP § 1412.03. Thus, answers (A), (C) and (D) are not correct. Answer (E) is not correct because a broadening reissue application does not preclude presentation of narrower claims. 37 C.F.R. § 1.175(a)(1) “more or less than patentee had a right to claim”; MPEP § 1444.

40. ANSWER: (E). Under 35 U.S.C. § 42(d) the Commissioner may refund any fee paid by mistake or in excess of the fee required by law. Where the fee is not paid by mistake or in excess of the fee required by law, the Commissioner is not obligated to make the refund. *Miessner v. United States*, 228 F.2d 643, 108 USPQ 6 (D.C. Cir. 1955). (A), (B), (C) and (D) are incorrect inasmuch as fees were not paid by mistake or in excess of the fee required. 37 C.F.R. § 1.26.

41. ANSWER: (A). MPEP 706.02(a). (B) is incorrect since the foreign patent, published more than one year before the effective filing date of the application, would serve as a bar regardless of the attempt to claim priority. 35 U.S.C. § 102(b). (C) is incorrect since market testing is not a proper exception to a statutory bar under 35 U.S.C. § 102(b). MPEP 2133.03(e)(6). Also, the facts do not involve testing the invention, but only the packaging. (D) is incorrect since a reference may be used to reject claims under both 35 U.S.C. § 102 and 35 U.S.C. § 103. MPEP 2141.01. (E) is incorrect since only (A) may not properly be used.

42. ANSWER: (E). The claim in (A) recites sufficient acts performed on subject matter, e.g., passing the signals through the filter. See MPEP 2173.05(q), and *Ex parte Porter*, 25 USPQ2d

1144 (Bd. Pat. App. & Int. 1992) cited therein. Thus, (A) is a proper process claim. The claim in (B) recites the act of polymerizing an organic compound by sufficient acts. Therefore, (B) appropriately claims a process. The claim in (C) is not a proper process claim because it does not recite an act specifying how a use or process is accomplished. Therefore, the claim is indefinite, 35 U.S.C. § 112, and/or an improper definition of a process under 35 U.S.C. § 101. See MPEP 2173.05(q); *Ex parte Erlich*, 3 USPQ2d 1011 (Bd. Pat. App. & Int. 1986) (a claim to “A process for using monoclonal antibodies of claim 4 to isolate and purify human fibroblast interferon” was held to be indefinite because it merely recites a use without any active, positive steps delimiting how this use is actually practiced); *Clinical Products Ltd., v. Brenner*, 255 F.Supp. 131, 149 USPQ 475 (D.D.C. 1996) (claim to “The use of a sustained release therapeutic agent in the body of ephedrine absorbed upon polystyrene sulfonic acid” is not a proper process claim under 35 U.S.C. § 101). (D) is incorrect because (C) is incorrect.

43. ANSWER: (D). See 37 CFR § 10.40 where it states: “(b) Mandatory withdrawal. A practitioner representing a client before the Office shall withdraw from employment if:... (4) The practitioner is discharged by the client.” As to (A), practitioner may not enter into a partnership with a nonpractitioner where any of the practice of the partnership consists of patent, trademark or other law before the PTO. 37 C.F.R. § 10.49. As to (B), see 37 C.F.R. § 10.23(c)(7) regarding knowingly withholding from the Office information identifying a patent of another from which one or more claims have been copied. As to (C), a practitioner is proscribed from neglecting an entrusted legal matter. 37 C.F.R. § 10.77(c). The practitioner must file a request to withdraw and avoid foreseeable prejudice to the client’s rights where a client refuses to pay a practitioner. 37 C.F.R. § 10.40. As to (E), practitioner may not accept compensation from someone other than his or her client. 37 CFR § 10.68.

44. ANSWER: (A) is the most correct answer. See MPEP § 2137, p.2100-89. (B) is incorrect. The mere fact that the claim recites components, all of which can be argumentatively assumed to be old, does not provide a basis for rejection under 35 U.S.C. § 102(f). *Ex parte Billottet*, 192 USPQ 413, 415 (Bd. App. 1976); MPEP § 2137. (C) is incorrect. One must contribute to the conception to be an inventor. *In re Hardee*, 223 USPQ 1122, 1123 (Comm’r Pat. 1984). Unless a person contributes to the conception of the invention, the person cannot be an inventor. *Fiers v. Revel*, 984 F.2d 1164, 1168, 25 USPQ2d 1601, 1604-05 (Fed. Cir. 1993); MPEP § 2137.01 (section styled “An Inventor Must Contribute To The Conception of the Invention”). (D) is incorrect. An inventor may consider and adopt suggestions from many sources. *Morse v. Porter*, 155 USPQ 280, 283 (Bd. Pat. Inter. 1965); *New England Braiding Co. v. A.W. Cheterton Co.*, 970 F.2d 878, 883, 23 USPQ2d 1622, 1626 (Fed. Cir. 1992); MPEP § 2137.01 (section styled “As Long As The Inventor Maintains Intellectual Domination Over Making The Invention, Ideas, Suggestions, And Materials May Be Adopted From Others”). (E) is incorrect. *In re DeBaun*, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982) (“there is no requirement that the inventor be the one to reduce the invention to practice so long as the reduction to practice was done on his behalf”); MPEP § 2137.01 (section styled “The Inventor Is Not Required To Reduce The Invention To Practice”).

45. ANSWER: (C). MPEP § 1411.02. (A) is incorrect because a rejection for new matter in a reissue application must be made under 35 U.S.C. § 251, and not 35 U.S.C. § 132. (B) is incorrect because patent complied with 35 U.S.C. § 101 inasmuch as the patent disclosed a use

for the invention, and Jones is not required by the Patent Statute to disclose the best mode for achieving commercial success. (D) is incorrect because the embodiment was not disclosed in the original patent. (E) is incorrect because (B) and (D) are incorrect.

46. ANSWER: (A). 35 U.S.C. § 41(h); 37 C.F.R. § 1.9; and MPEP § 509.02. Choices (B) and (C), although raising issues involving a “Petition to make special” MPEP § 708.02, are not provided for regarding small entity status. Choice (D) is incorrect. (E) is incorrect since (A) is correct.

47. ANSWER: (A). MPEP 706.07(c) and (d) set forth that prematureness of a final rejection may not be advanced as a ground for appeal. (II) is therefore improper. (II) is also improper because required fees have not been paid. 37 C.F.R. §§ 1.191 and 1.192. (III) is improper because the filing of the petition does not stay the period for reply. MPEP 1002. Thus, choices (B), (C), and (D) are incorrect. (E) is incorrect because (A) is correct.

48. ANSWER: (D) is the most correct answer. 35 U.S.C. § 103(a); *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977) (“In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question...but also to those properties of the subject matter which are inherent in the subject matter *and* are disclosed in the specification...”); MPEP 2141.02 (section styled, “Disclosed Inherent Properties Art Part of ‘As A Whole’ Inquiry”). (A) is incorrect. MPEP 2141.01(a). PTO classification is some evidence of analogy/non-analogy, but structure and function carry more weight. *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973). (B) is incorrect. MPEP 2141.02. The question under 35 U.S.C. § 103 is whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). (C) is incorrect. MPEP 2141.02 (section styled, “Distilling The Invention Down To a ‘Gist’ or ‘Thrust’ Of An Invention Disregards ‘As A Whole’ Requirement”). *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987), *cert. denied*, 481 U.S. 1052 (1987) (district court improperly distilled claims down to a one word solution to a problem). (E) is incorrect. As stated in MPEP 2141.02 (section styled, “Disclosed Inherent Properties Are Part Of ‘As A Whole’ Inquiry”), “Obviousness cannot be predicated on what is not known at the time an invention is made, even if the inherency of a certain feature is later established. *In re Rijckaert*, 9 F.2d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993).”

49. ANSWER: (E). The applications C and D were abandoned after midnight of July 21, 1999, therefore they are technically not abandoned on July 21, 1999. There is no copendency between applications E and any prior application. MPEP § 201.11 (“If the first application is abandoned, the second application must be filed before the abandonment in order for it to be co-pending with the first.”). See MPEP § 710.01(a), fourth paragraph.

50. ANSWER: (A),(B), or (E). As to (A) it is true that reissues may be filed within two years to correct errors made without deceptive intent. 35 U.S.C. § 251. Regarding (B), there is no limit on the number of parties or countries or winners. A given inventor may have reduced to practice certain counts without having reduced to practice others. As to (E), it too is true inasmuch as no

facts are given that the request is filed for purposes of harassment. As has been stated in the see MPEP § 2240 regarding harassment of the patent owner wherein it states:

SECOND OR SUBSEQUENT REQUEST FILED DURING REEXAMINATION

If a second or subsequent request for reexamination is filed (by any party) while a reexamination is pending, the presence of a substantial new question of patentability depends on the prior art cited by the second or subsequent requester. If the requester includes in the second or subsequent request prior art which raised a substantial new question in the pending reexamination, reexamination should generally be ordered. This is because the prior art which raised a substantial new question of patentability resulting in an order for reexamination continues to raise a substantial new question of patentability until the pending reexamination is concluded. However, in aggravated situations, upon petition by the patent owner under 37 CFR 1.182, where it appears clear that the second or subsequent request was filed for purposes of harassment of the patent owner, the request should be denied.

As to (C) see 37 C.F.R. § 3.56. As to (D), see 37 C.F.R. § 3.81.